

O-013-07

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RESPECT OF
REGISTRATION NO. 2235699 IN THE NAME OF RAPIER 1 LIMITED**

AND

**APPLICATION FOR REVOCATION THERETO UNDER NO. 82515 BY
ALLIED TELESYN INC**

TRADE MARKS ACT 1994

IN THE MATTER OF AN
interlocutory hearing in respect
of registration No.2235699 in
the name of Rapier 1 Limited

and

application for revocation thereto
under No. 82515 by Allied Telesyn Inc

Background

1. Registration No. 2235699 for the trade mark RAPIER stands in the name of Rapier 1 Limited and has a registration date of 2 February 2001. On 31 May 2006, a Form TM26(N) was filed by Lloyd Wise on behalf of Allied Telesyn Inc who sought to revoke the registration, in respect of some of the goods and services for which it was registered, on the grounds of non-use.

2. Following revision of the statement of the grounds of the application for revocation, the registrar sent a copy of the Form TM26(N) and accompanying statement of grounds to the registered proprietor in accordance with the provisions of Rule 31(2). The registered proprietor was allowed until 29 September 2006 to file a Form TM8 with counter-statement and evidence of use, or reasons for non-use.

3. On 4 September 2006 the registered proprietor filed a Form TM22, Notice to surrender a registration. Thereafter the Trade Marks Registry issued a letter dated 6 September 2006 which stated:

“ I am writing with reference to the Form TM22 filed by Beck Greener, dated 4 September 2006 requesting to surrender the above registration.

The total cancellation has been agreed to and the file has been passed to the relevant section to be processed. In view of this the revocation proceedings have now been marked off.”

4. Not surprisingly, Beck Greener, agents acting for the registered proprietor queried this letter. In their letter dated 13 September they stated:

“ Your letter indicated that the revocation proceedings have now been “marked off”.

Can you confirm that this means that official form TM8 and counterstatement together with evidence of use previously due to be submitted on **29th September 2006** are no longer required, and revocation action 82515 is concluded?

This is of some importance as the deadline cannot be extended and we do not (sic) wish this revocation action to affect the corresponding seniority based on British trade mark registration no. 2235699 which is now entered against European Community Trade Mark registration no. 1924950 **RAPIER.**”

5. The Trade Marks Registry responded, in a letter dated 20 September, thus:

“I can confirm that official Form TM8 and counterstatement together with evidence of use due to be submitted on 29 September 2006 are no longer required and that revocation action 82515 is concluded.”

6. On 25 September 2006, a faxed letter from the applicant and dated 8 September 2006 (and which appears originally to have been sent elsewhere within the Trade Marks Registry but which did not reach the file), was received in the registry’s Law Section. This letter stated:

“Registration No: 2 235 699 is the basis for a seniority claim in Community Trade Mark Registration No: 1 924 950. Accordingly, and pursuant to the provisions of Statutory Instrument 2006 No: 1027, Paragraph 3(1), we hereby apply for the declaration set out in Section 3(3) that the registration, had it not been surrendered, would have been liable to revocation under Section 46 of the Trade Marks Act 1994, as called for in the Statement of Grounds for Revocation No: 82515. We also ask that the seniority claim from Registration No, 2 235 699 be correspondingly revoked.”

7. This letter was responded to on 27 September 2006 when a letter was sent by fax to both parties. Referring to the applicant’s letter of 8 September it stated:

“[The applicant’s] letter requests the registrar to issue a declaration pursuant to the provision of Statutory Instrument 2006 No 1027.

The registry must therefore follow the procedure for revocation, as set out in paragraph 4 of the above Statutory Instrument. The revocation action shall therefore continue.

As indicated in the telephone conversation between your Mr Buehrlen and Mr Atfield of this office, you should therefore complete form TM8 and counter statement and return it with two copies of the evidence of use or reasons for non-use on or before **29 September 2006.**”

8. I should say at this point that I am concerned to note that I have no information before me about the telephone conversation referred to, as the Registry’s papers contain no record of it. That said, I would expect any party who wished to query or comment on anything of substance to put that query or comment in writing and copy it to the other party so that all parties are aware of the current state of play. In any event a further letter issued from the Registry on 28 September. It stated:

“Following surrender of trade mark registration number 2235699, currently the subject of revocation action, you requested a declaration under paragraphs

3(1)(b) and 3(3) of the Community Trade Mark Regulations 2006 (Statutory Instrument 2006 No. 1027).

Given that an application for revocation, No. 82515, has already been filed it is our preliminary view that this be adopted on the basis of paragraph 3(1)(b) of the above mentioned S.I. The registered proprietor therefore has until 29 September 2006 to file their defence.

A period of **14 days from the date of this letter** i.e. on or before **12 October 2006** has been allowed to provide full written arguments against the preliminary view and to request a hearing under Rule 54(1).”

9. The registered proprietor filed a Form TM8, counter-statement and evidence on 29 September 2006. However, in a letter dated 3 October 2006 it objected to the course of action the Trade Marks Registry had taken. In summary, its objections were:

- Revocation No. 82515 should be deemed concluded;
- The applicant had not objected to the surrender of the registration;
- Following the surrender of the registration the applicant had not asked for the revocation proceedings to continue;
- Revocation No. 82515 was filed before the mark was surrendered and cannot therefore support an application for a declaration that the mark would have been liable to revocation as provided for by the Community Trade Mark Regulations 2006.
- An application for such a declaration requires the filing of a discrete application for revocation, filed after the surrender of the mark and with a relevant statement of grounds
- Notwithstanding the above, the registered proprietor has been seriously prejudiced by having to file its TM8, counter-statement and evidence of use at less than two day’s notice.

10. This letter appears to have crossed in the post with the registry’s letter of 28 September but by way of a letter dated 10 October 2006, the registered proprietor requested to be heard.

11. A hearing was arranged and took place before me by videolink on 23 November 2006. Mr Buehrlen of Beck Greener represented the registered proprietor whilst Ms Széll of Lloyd Wise represented the applicant.

Submissions

Registered proprietor’s submissions

12. Mr Buehrlen began by giving some background. He explained that the applicant in these proceedings had filed its own Community Trade Mark application which was later opposed by the registered proprietor in these proceedings on the basis of the existence of an identical mark. The parties had entered into negotiations to settle the dispute but had been unable to reach agreement.

13. Mr Beuhrlen said that this led to the applicant seeking revocation of UK registration No. 2235699. But because the opposition proceedings relating to the Community Trade Mark application were, as Mr Buehrlen put it “seniority claim dependant”, the opponent, (the registered proprietor of UK registration No. 2235699) decided to surrender its UK registration so that they could still rely on it in the Community opposition proceedings. In filing its request to surrender the registration, the registered proprietor had made it clear what purpose was behind it. The registered proprietor applied to surrender its registration during the period allowed for it to file a Form TM8, counter-statement and evidence of use in the revocation proceedings.

14. Mr Beuhrlen went on to say that the Trade Marks Registry actioned the surrender and advised the parties that the revocation actions were “marked off”. The registered proprietor made two telephone calls to the Registry raising concerns as to what this meant but received written confirmation that the revocation action had been concluded and there was no need for it to file its Form TM8 etc. The registered proprietor then received a further letter from the Trade Marks Registry to say that the proceedings were re-instated and that it should file its Form TM8 etc by the original date, some two days later. Unknown at that time to the registered proprietor, the applicant had then written to the Trade Marks Registry on 8 September 2006 seeking to make an application under the Community Trade Mark Regulations 2006.

15. The Community Trade Mark Regulations lay down the procedure to be followed when making such applications, he said. By the provisions of Regulation 4(2) such applications are subject to the provisions of Rule 31 of the Trade Mark Rules 2000 (as amended by the Trade Marks (Amendment) Rules 2004). Those provisions were not followed in this case. The applicant’s letter of 8 September 2006 was not sufficient to found such an application. The alternative view was to superimpose on that letter a request to re-instate the proceedings, with the letter forming an amended statement of case. If the letter was to be taken as an amended statement of case, where amendment of the statement as originally filed would be required, then in line with the decision in *Lowden v Lowden Guitar Co Ltd* [2005] RPC 18 and the relevant tribunal practice notice (TPN 4/2000), the proper course of action would have been for the Trade Marks Registry to have served the amended statement on the registered proprietor and allowed it a full three months to file a Form TM8 etc, in response. Instead the registered proprietor was told on the 27 September that it had until 29 September to file the required documentation. The registered proprietor had filed the documentation within the period given to it but was prejudiced in doing so. In answer to my question, Mr Buehrlen indicated that the registered proprietor would have filed different evidence had it had more time to do so.

Applicant’s submissions

16. For her part, Ms Széll submitted that in surrendering its registration, the registered proprietor was attempting to by-pass the revocation action as surrender has the effect of allowing it to maintain the rights it has up to the point of surrender.

17. Ms Széll went on to say that if the applicant was forced to file a fresh application for revocation under the Community Trade Mark Regulation then the relevant dates would change. By the registered proprietor surrendering the registration and the applicant having to file a fresh application for revocation, the registered proprietor

would gain significant extra time to file evidence of use. As far as the surrender request was concerned, the applicant had been given no prior opportunity to make any objections to it but in effect that was what it was now doing.

18. The applicant wanted the revocation action to continue but knows of no other way this could be done. Relying on the decision in *Pharmedica* [2000] RPC 536, Ms Széll said that the registrar has the power to regulate procedure and that this could be done by allowing the application for revocation of the registration as originally filed to become an application for a declaration that the surrendered registration would have been liable to be revoked under the Community Trade Mark Regulations. This would be in accordance with Regulation 4(2) which stated that such actions should follow Rule 31 of the Trade Marks Rules “with the necessary modification”.

19. Ms Széll submitted that requests for a declaration under the Community Trade Mark Regulation 2006 were a new issue which may be why it took some time for the Trade Marks Registry to respond to the request. But this was a standalone issue, separate to whether the application for revocation can be “converted” into an application for a declaration under the regulations. If the registered proprietor felt that it had been subject of prejudice in having been told at such short notice to file its Form TM8 etc, then it can do something about it by making an appropriate request.

Decision

20. Following the hearing I issued a letter advising the parties of my decision. My letter, dated 24 November 2006 stated:

“The hearing was to consider the registrar’s preliminary view that the application for revocation of the registration should continue and be treated as an application for a declaration under the Community Trade Mark Regulations 2006. I do not consider it possible to “convert” an application for revocation of a registered trade mark into an application for a declaration of liability to revocation under the Community Trade Mark Regulations 2006 and therefore my decision is to overturn the preliminary view. That however, is not the end of the matter.

From my review of the papers, it is clear that following the receipt of the request to surrender the registration, the Trade Marks Registry actioned that request and subsequently recorded the withdrawal of the revocation proceedings. The request to surrender appears to have been actioned without any consideration being given to the ongoing proceedings. Similarly, the proceedings themselves were recorded as withdrawn by the Trade Marks Registry without any consideration being given to the possibility of revocation from a date anterior to the requested surrender and, crucially, with no request from the applicant to do so. It seems to me that in carrying out both of these actions in this way, the Trade Marks Registry fell into error and that these errors constitute an irregularity in procedure which should be corrected.

I therefore intend, insofar as it is possible, to put the parties back to the position they would have been in had the errors not occurred. Invoking the provisions of rule 66, and subject to any appeal against my decision, I direct:

- the recordal of the surrender of the registration be rescinded and the registration restored to the register;
- the recordal of the withdrawal of the application to revoke the registration also be rescinded and these proceedings restored;
- the request for surrender be stayed pending the outcome of the application for revocation;
- the application for revocation continue on the basis of the claims as set out in the previously amended statement of grounds dated 23 June 2006.

The position will then be that there is a live registration and live revocation proceedings against that registration. I also take into account the fact that in withdrawing and then re-starting the revocation proceedings, the Trade Marks Registry “interrupted” the period for the registered proprietor to file its TM8 and counter-statement etc. I therefore also direct:

- that the registered proprietor is allowed a period of four weeks from the date of the decision set out in this letter, i.e. on or before 22 December 2006, either:
 - to confirm that it does not wish to defend the application for revocation, or,
 - to confirm, should it wish to defend the application for revocation, that it wishes to rely on the Form TM8 and accompanying material which was filed on 29 September 2006, or,
 - to file a replacement Form TM8, counter-statement and evidence of use (or reasons for non-use) (in which case the material already filed will be returned).

Given that I reserved my decision at the hearing, I indicated that I would allow a period for the parties to file, in writing, any submissions they may wish to make in respect of the costs of the hearing before me. I therefore allow a period of fourteen days from the date of this letter for any such submissions.

This letter does not contain a full statement of reasons for this decision. If either party wishes to appeal the decision, they should file a Form TM5 together with the required fee (£100) requesting a statement of reasons within one month of the date of this decision.”

21. A Form TM5 was filed subsequently by the registered proprietor requesting a statement of the reasons for my decision and these I now give.

Statement of reasons

22. The hearing was to consider the registrar's preliminary view that the revocation proceedings under No. 82515, an application for revocation of registration No. 2235699 on the grounds of non-use, should continue as an application for a declaration under the Community Trade Mark Regulations 2006.

23. Regulations 3 and 4 of the Community Trade Mark Regulations 2006 state:

“3. (1) Where the proprietor of a Community trade mark claims the seniority of a registered trade mark which-

(a) has been removed from the register under section 43, or

(b) has been surrendered under section 45,

any person may apply to the registrar or to the court for the declaration set out in paragraph (3).

(2) Where such a proprietor claims the seniority of an international trade mark (UK) which has been removed from the International Register or surrendered, any person may apply to the registrar or to the court for the declaration set out in paragraph (3).

(3) The declaration is that if the trade mark had not been so removed or surrendered, it would have been liable to be revoked under section 46 or declared invalid under section 47.

(4)

(5)

4.-(1) In proceedings on an application under regulation 3(1) or (2) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration.

(2) In the case of such proceedings before the registrar, the provisions of rules 31 to 37, 54 to 62, 67 to 69 and 72 of the Trade Marks Rules 2000 with necessary modifications, shall apply.

(3).....”

24. The combined effect of regulation 3(1)(b) and 3(3) is that it allows any person to apply for a declaration that a registered trade mark which has been surrendered would have been liable to be revoked had it not been surrendered.

25. As the regulations refer to a registered trade mark which *has been surrendered*, I take the view that no such application can be made unless and until the surrender of that mark has been requested and effected.

26. The request to surrender the registration was filed on 4 September 2006 and recorded on the register on 15 September 2006. An application for a declaration under Regulation 3 could therefore only be made after 15 September 2006. The application under No. 82515 seeking revocation of registration No. 2235699 was filed on 31 May 2006, some three and a half months before the surrender was effected.

27. As I indicated at paragraph 6 above, the applicant appears to have sent a letter to the registrar dated 8 September 2006 but that letter did not reach the file. It was re-sent under cover of a fax received on 25 September 2006 which clearly post dates the recordal of the surrender of the registration. By this letter the applicant was said to “hereby apply” for a declaration under the Community Trade Mark Regulations. Regulation 4 of those regulations makes it clear that the procedures to be followed are those under the relevant provisions of the Trade Marks Rules. In respect of an application for revocation of a trade mark the relevant rule is Rule 31 which states:

“(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made”

28. Section 66 of the Trade Marks Act 1994 provides:

“**66.** (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceedings before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.”

29. Rule 3 of the Trade Marks Rules further provides:

“**3.** (1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this Rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.”

30. The use of prescribed forms was considered in the case of *Uniter SpA v KML Invest AB* [2004] RPC 47. Geoffrey Hobbs QC sitting as the Appointed Person said:

“The purpose of Rule 3(2) is to allow inexact equivalents of the prescribed forms to be used with the approval of the Registrar. The essential features and functions of the prescribed forms must be preserved. The Registrar is able to decide whether departures from the prescribed forms are acceptable, but

cannot exempt anyone from the obligation to use an acceptable form as and when required by the substantive provisions of the Act and the Rule”.

31. He went on to say:

“In Re M’s Application [1985] RPC 249 the importance of insisting upon the use of prescribed forms was explained by Falconer J. at p.260 in the following terms:

“.....it means that the Office knows at once how to process a document coming in. If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the Office could not as a practical matter operate and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality, and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not substance.”

32. The combined effect of Regulations 3 and 4(2) of the Community Trade Mark Regulations 2006 and Rules 3 and 31 of the Trade Marks Rules 2000, as amended by the Trade Marks (Amendment) Rules 2004, is that an application for a declaration that a mark would have been liable for revocation had it not been surrendered, requires the applicant to file a Form TM26(N) or a replica thereof with a statement of the grounds for the application and requisite fee after a registration has been recorded as having been surrendered.

33. The registered proprietor’s letter dated 8 September 2006 received on 25 September 2006 is not a Form TM26(N) nor is it a replica of that form. The Form TM26(N) filed on 31 May 2006, was filed before the registration was surrendered. Neither the letter dated 8 September 2006 nor the form filed 31 May 2006 set out any statement of the reasons for seeking an application for a declaration under the Community Trade Mark Regulations 2006. I was not persuaded by Ms Széll’s argument that the inclusion of the words “with necessary modifications” in Regulation 4(2), enabled me to “convert” an application for revocation of a registration on the grounds of non-use and filed on Form TM26(N) before the filing of a request to surrender a registration, into an application for a declaration that a registration which has been surrendered, would have been liable to revocation under Regulations 3 and 4 of the Community Trade Mark Regulations 2006. I therefore overturned the registrar’s preliminary view.

34. The relevant statutory provisions relating to surrender of a registered trade mark are to be found in Section 45 of the Act:

“45.-(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) Provision may be made by rules-

- (a) as to the manner and effect of a surrender, and
- (b) for protecting the interests of other persons having a right in the registered trade mark.”

35. The rule made under the above provision, namely Rule 26, states:

“26.-(1) Subject to paragraph (2) below, the proprietor may surrender a registered trade mark, by sending notice to the registrar-

- (a) on Form TM22 in respect of all the goods or services for which it is registered; or
 - (b) on Form TM23, in respect only of those goods or services specified by him in the notice.
- (2) A notice under paragraph (1) above shall be of no effect unless the proprietor in that notice-
- (a) gives the name and address of any person having a registered interest in the mark, and
 - (b) certifies that any such person-
 - (i) has been sent not less than three months’ notice of the proprietor’s intention to surrender the mark, or
 - (ii) is not affected or if affected consents thereto.
- (3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the same.”

36. The Trade Mark law makes no specific provision as to the effective date of surrender. In the absence of submissions to the contrary I am of the view that the effective date of surrender would be the date of receipt of a properly completed request (certainly in this case no earlier date has been requested even if it were possible).

37. The Form TM22 filed by Beck Greener on behalf of the registered proprietor indicated that no other party had a registered interest in the mark. Box 5 of the form requires the filer to cross out any of the four statements printed thereon that do not apply. The four statements are:

- I declare that I have the authority to surrender this registration.
- I confirm that no-one else has an interest in the mark; or
- I confirm that I have notified everyone listed as having a registered interest in this mark three months before sending this form; or

- I confirm that everyone listed as having a registered interest in this mark consents to its surrender.

38. None of these statements had been crossed out on the form filed by Beck Greener.

39. As was indicated in *Skaga AB v Skaga UK Ltd* O/134/03, Section 45 appears to grant the proprietor of a registered trade mark an absolute right to ask for its surrender subject only to completion of the formalities specified in Rule 26(1) and compliance with the requirements of Rule 26(2). I take into account however, that the applicant had sought revocation of the registration under Sections 46(1)(a) and (b) in relation to some of the goods and services for which the trade mark is registered which, if it succeeded would have the effect of removing the registration from dates anterior to the date of filing of the surrender request. If a registration were to be revoked from a date anterior to the date of filing of a request for surrender, it would have the consequence of making the surrender request a nullity.

40. Following receipt of the Form TM22 which sought surrender of the registration, the Trade Marks Registry took action on it with no apparent consideration being given to the ongoing revocation proceedings, nor to the possibility of the applicant wishing to continue those proceedings and nor to the fact that if they continued the proceedings and were successful, it would lead to revocation of the registration (insofar as revocation was sought) from a date anterior to the date of the request for surrender. It appears to me that the Trade Mark Registry simply recorded the surrender and assumed that this would lead to the death of the revocation action. It did so of its own volition and without having made any enquiries of the applicant to ascertain what its intentions were. Certainly the applicant give no indication that it would wish to withdraw its application for revocation.

41. It seemed to me that in handling matters as it did, the Trade Marks Registry fell into error.

42. Rule 66 of the Trade Marks Rules states:

“66. Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.”

43. It further seemed to me that the Trade Marks Registry’s errors should be rectified. In invoking the provisions of Rule 66, my intention, insofar as it was possible, was to put the parties back to the position they would have been in had the errors not occurred. I therefore directed:

- the recordal of the surrender of the registration be rescinded and the registration restored to the register;
- the recordal of the withdrawal of the application to revoke the registration also be rescinded and these proceedings restored;
- the request for surrender be stayed pending the outcome of the application for revocation;

- the application for revocation continue on the basis of the claims as set out in the previously amended statement of grounds dated 23 June 2006.

44. As regards the original revocation proceedings, the registered proprietor had been allowed until 29 September 2006 to file its Form TM8, counter-statement and evidence of use (or reasons for non-use). On 6 September 2006 it was told that this documentation was no longer required as the proceedings had come to an end. Then, by way of a letter dated 27 September 2006 it was told that proceedings were being re-instated, albeit as proceedings for a declaration, but that the original due date of 29 September 2006 still applied. The “dead” period amounts to just over three weeks. As I went on to indicate in my letter issued following the hearing:

“The position will then be that there is a live registration and live revocation proceedings against that registration. I also take into account the fact that in withdrawing and then re-starting the revocation proceedings, the Trade Marks Registry “interrupted” the period for the registered proprietor to file its TM8 and counter-statement etc. I therefore also direct:

- that the registered proprietor is allowed a period of four weeks from the date of the decision set out in this letter, i.e. on or before 22 December 2006, either:
 - to confirm that it does not wish to defend the application for revocation, or,
 - to confirm, should it wish to defend the application for revocation, that it wishes to rely on the Form TM8 and accompanying material which was filed on 29 September 2006, or,
 - to file a replacement Form TM8, counter-statement and evidence of use (or reasons for non-use) (in which case the material already filed will be returned).”

Further Issue

45. For the benefit of any appellate tribunal, there is a further issue which I would mention. In my letter to the parties informing them of my decision following the hearing, I allowed them a period of fourteen days from the date of my letter to make such submissions on costs as they felt appropriate. In the event, it became clear that the registered proprietor would be seeking a full statement of the grounds of my decision and lodging an appeal against it. The applicant responded by way of a letter dated 7 December 2006 indicating that it considered it appropriate, in the circumstances, for the question of costs to be considered when the proceedings were

concluded. The registered proprietor made no comments on costs. I confirm that I have made no determination on the matter of costs.

Dated this 9th day of January 2007

**ANN CORBETT
For the Registrar
The Comptroller-General**