

O-514-15

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2537778
OF THE TRADE MARK CREDIT TODAY
IN THE NAME OF ATHENE PUBLISHING LIMITED
AND
AN APPLICATION FOR RECTIFICATION UNDER NO. 84753
THERE TO BY BLUE MOON GROUP**

BACKGROUND

- 1) On 29 January 2010 Blue Moon Group Ltd applied for registration of the trade mark “CREDIT TODAY” in respect of the following:
 - Class 9: Online information (downloadable)
 - Class 16: Magazines
 - Class 41: Awards ceremonies and shows
- 2) The registration procedure was completed on 11 November 2011.
- 3) On 11 October 2011 the mark was assigned to Athene Publishing.
- 4) On 5 January 2012 trade mark 2537778 was merged with trade mark 2479716 with the surviving number being 2537778.
- 5) On 20 January 2012 a request was made to rectify the register as due to a clerical error, the mark was in the name of Athene Publishing instead of Athene Publishing Limited. The register was amended on 26 January 2012.
- 6) On the 18 June 2015 Blue Moon Group applied to rectify the register in respect of the above registration. In a witness statement, dated 16 June 2015, by Gerard Dugdill a director of Blue Moon Group (BMG) states:
 - “1. Following discussions in 2011 in a bid to end proceedings in relation to the subject trade mark and another application for “Credit Today”, an assignment form TM16 was sent to the registry on 9 September 2011 to change the recorded owner of the trademark from BMG, the original applicant to Athene Publishing. Please see exhibit GD1, form TM16.
 2. The applications and proceedings which were consolidated were:
 - Application number 2479716, opposition proceedings 99321
 - Application number 2537778 –i.e. the subject trademark-and opposition proceedings 100667.
 3. The recorded owner of the subject trademark was duly changed from BMG to Athene Publishing. Proceedings ended, with parties bearing their own costs. Case number 2479716 was then merged with case 2537778, with application 2479716 being declared dead. I exhibit GD2, the case history of subject trademark 2537778, with an excerpt from the registry’s files showing the “dead” status of application 2479716.
 4. However, before the office recorded an assignment in relation to trademark 2537778 no assignment had been drawn up between the parties, as should have been the case. As such, the recorded owner of the trade mark needs to revert to the

rightful owner, BMG. Following recent communications with the Registry, I now submit a request for this to happen via the enclosed form TM26R.”

7) Mr Dugdill included the following exhibit:

- Exhibit GD1: a copy of the TM16 form dated 8 September 2011 requesting to record a change of ownership from Blue Moon Group Ltd to Athene Publishing, signed by Mr Dugdill.

8) On 22 October 2015 the agent for Athene Publishing Ltd, Withers & Rogers responded. The agent states that as Mr Dugdill stated, the mark was assigned from BMG to Athene Publishing in order to bring to an end opposition proceedings. They point out that the assignment form TM16 was signed by Mr Dugdill. They state that there is no legal requirement that an assignment be in place prior to the filing of form TM16.

9) That concludes my review of the evidence. I now turn to the decision.

DECISION

10) Rectification of the register is provided for under Section 64 of the Trade Marks Act 1994. Section 64 reads as follows:

“**64.**-(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) ...

(5) ...”

11) The applicant for rectification BMG is seeking to reverse the assignment which amended the registration from Blue Moon Group Limited to Athene Publishing, and hence the later merging of registrations 2537778 and 2479716. The only ground raised is that prior to the form TM16 being sent to the Registry as assignment document was not drawn up. However, I note that Mr Dugdill accepts that he signed the form and that the action was taken to conclude opposition proceedings between the two parties with both sides bearing their own legal costs. Clearly the “cost” to BMG was giving up their trade mark to the other party. Whilst I have no written evidence of a formal assignment document, the fact that Mr Dugdill signed the request to record the assignment is prima facie evidence that he entered into such an agreement and, in the absence of evidence to the contrary, his application for rectification fails. I therefore conclude that the assignment from Blue

Moon Group Ltd to Athene Publishing was legal and the Register accurately reflects this company as the owner of UK trade mark No.2537778.

CONCLUSION

12) The ownership of UK trade mark No. 2537778 currently stands in the name of Athene Publishing Ltd and it should remain in this name.

COSTS

13) As Blue Moon Group has been unsuccessful in its rectification attempt the registered proprietor of the mark in suit is entitled to a contribution towards its costs.

Presenting its case and considering the evidence and claims of the other side.	£400
TOTAL	£400

14) I order Mr Dugdill t/a Blue Moon Group to pay Athene Publishing Ltd the sum of £400. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of November 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**