

**O-082-16**

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 LIMITED

## **BACKGROUND AND PLEADINGS**

1. On 29 January 2010, Blue Moon Group Limited (BMG) applied for registration of the trade mark CREDIT TODAY in respect of:
  - Class 09: 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; on 5 January 2012 trade mark No 2537778 was merged with trade mark No 2479716. The surviving trade mark being No 2537778.
4. On 26 January 2012, the register was amended to reflect a clerical error with the owner's name being changed to Athene Publishing Limited (APL) from Athene Publishing.
5. On 18 June 2015, BMG applied to rectify the register in respect of registration No 2537778 CREDIT TODAY.

## **Evidence of the Applicant for Rectification**

6. This is a witness statement, dated 16 June 2015, from Mr Gerard Dugdill, a director of BMG. He explains that in 2011, discussions took place (the nature of which is not divulged) with a view to ending opposition proceedings in relation to trade marks 2537778 and 2479716 (opposition proceedings 99321 and 100 667). To this end an assignment form TM16 (signed by Mr Dugdill) was sent to the registry on 8 September 2011 to change the recorded owner for both marks (at this point the registrations had not been merged) from BMG to Athene Publishing. This was actioned by the registry, proceedings ended and each party bore its own costs. However, Mr Dugdill goes on to explain that no written assignment has ever been drawn up between the parties. As such, the application for rectification should succeed.

## **Response from the Registered Proprietor**

7. On 22 October 2015, the agent for APL, Withers & Rogers responded. They made the following submissions:
  - That the mark was assigned in a bid to end proceedings between the parties;
  - That the TM16 was in fact signed by Mr Dugdill;
  - That there is no legal requirement that an assignment be in place prior to the filing of form TM16.

## Submissions of the Applicant for Rectification

8. On 9 November 2015, BMG responded, making the following submissions:
  - That no written assignment was ever entered into. As such, the provisions of Section 24(3) of the Trade Marks Act 1994 are critical;
  - The applicant for rectification was not professionally represented at the time and so was unaware that signing the form TM16 would result in the registration being transferred away;
  - The form TM16 itself states: “it is not a substitute for the assignment document or other proof of the transaction”.
  - A number of decisions of the registry are also relied upon as regards Section 24(3) of the Act<sup>1</sup>.

## DECISION

9. Rectification of the register is provided for under Section 64 of the Trade Marks Act 1994. This 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).....”

## Sufficient interest

10. The applicant, BMG, must have a sufficient interest to apply for rectification. A claim to being the legal owner of the registration is one of the clearest forms of interest possible. BMG has an interest in this matter sufficient for the purposes of section 64(1) of the Act.

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<sup>1</sup> See for example: BL O/239/05; BL O/408/11.

## Written deed of assignment

11. Section 24(3) of the Trade Marks Act 1994 reads as follows:

“An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative”.

12. Both parties appear to accept that discussions took place with a view to ending the aforementioned opposition proceedings by way of an assignment. Mr Dugdill accepts that he signed the form TM16 in order for the registry to record a change of ownership. The submission from APL that there is no legal requirement for an effective assignment to be in place prior to the filing of a form TM16 is nonsensical. The whole point of a TM16 is to record something and that something must surely have taken place. If there was any agreement between the parties regarding assignment, it was an oral one. That Mr Dugdill signed the form TM16 does not elevate this action into a written agreement of an effective assignment. It is merely a request to record a change of ownership. It is clearly not enough to satisfy the requirements of Section 24(3). **The application for rectification succeeds.**

## CONCLUSION

13. The application for rectification is successful. The register will be rectified by the replacement of the name Athene Publishing Limited as the recorded proprietor with the name of Blue Moon Group Limited. The assignment to Athene Publishing Limited is deemed never to have been made.

## COSTS

14. As BMG has been successful, it is entitled to a contribution towards its costs. For presenting its case; filing evidence and submissions and considering APL's submissions, I award it £300.

15. I order Athene Publishing Limited to pay Blue Moon Group Limited the sum of £300. 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 15<sup>th</sup> day of February 2016**

**Louise White  
For the Registrar,  
The Comptroller-General**