

O/0314/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. 801383231

IN THE NAME OF HIMATSINGKA AMERICA INC.

AND

APPLICATION NO. 84858 TO RECTIFY THE REGISTER

BY

JD SPORTS FASHION PLC

Background

1. On 4 July 2022, JD Sports Fashion Plc (“the applicant”) applied to rectify the register of trade marks by removing the following goods (“the contested goods”) from the list of goods of UK trade mark number 801383231 (“the contested mark”):

Class 24: Comforters; duvet inserts; pillow covers; pillow inserts; bed covers; bed spreads; cotton fabric; duvet covers; duvets; fabrics for textile use; pillowcases; quilts; towels.

Class 25: Blouses; dress shirts; dresses; jeans; t-shirts; undergarments.

2. The contested mark has a filing date of 28 November 2017 and a registration date of 31 October 2019. It claims a priority date of 6 October 2017 from US trade mark number 87637270 for “comforters; duvet inserts; pillow covers; pillow inserts”. The contested mark was not applied for in the UK in the normal way. It is a comparable mark (IR), created in accordance with s. 54A and Schedule 2B (“the Schedule”) of the Trade Marks Act 1994 (“the Act”) from an international trade mark protected in the EU (“IR(EU)”).

3. The applicant claims that there was an error in the creation of the contested mark because by IP completion day (31 December 2020) the trade mark applications and registrations upon which the IR(EU) is based (the “basic applications” or “basic registrations”) had ceased to have effect in relation to the goods specified at paragraph 1, above. This ceasing of effect had occurred during the period in which the IR(EU) is dependent on the basic applications or registrations. Accordingly, the applicant says that the EUIPO register should have been updated before IP completion day to reflect the narrowed specification for which the IR(EU) remained valid. Had that occurred, the contested mark would have been created with the correct specification, without the contested goods, rather than the specification for which it currently appears on the register.

4. A case management conference was held before me on 7 September 2022 to determine whether the application should be struck out. For the reasons I gave in my letter of 9 September 2022, I allowed the application to proceed.

5. The proprietor was invited to file a counterstatement but chose not to do so. Even though the application to rectify is not contested, I must still be satisfied that the register does stand in error before I can allow any rectification.

6. The applicant is represented by Murgitroyd & Company. The proprietor's representation has changed during proceedings and it is now represented by Venner Shipley LLP.

Evidence

7. The applicant filed evidence from Gareth Price, a Director at the applicant's professional representatives.

8. Mr Price's evidence shows the International Register entry for international trade mark registration number 1383231 against which are recorded three basic applications, namely US trade mark application numbers 86690464, 86981698 and 87637270, and US basic registration number 5178102.¹

9. Prints from the US Patent and Trademark Office ("USPTO") show that:

- US application number 86690464, for "bed covers; bed spreads; cotton fabric; duvet covers; duvets; fabrics for textile use; pillowcases; quilts; towels" in class 24 was abandoned on 4 March 2019;
- US application 86981698 was registered as US registration 5178102 for "bed linen; bed sheets" in class 24 and remains live;
- US application 87637270 for "comforters; duvet inserts, namely duvets without covers; pillow covers" in class 24 was abandoned on 8 June 2020.²

10. Mr Price's evidence also includes:

- A response dated 17 July 2018 to a USPTO refusal in which class 25 is deleted in its entirety from the specification of US application 87637270 and a proposal

¹ Exhibit GIP1.

² GIP2.

is made to amend class 24. “Pillow inserts” are deleted and “duvet inserts” are limited to “duvet inserts, namely duvets without covers”;³

- A Notification of Ceasing of Effect from the USPTO to the International Bureau.⁴ It states that US application 86690464 was abandoned on 4 March 2019. It says that “Class 25 is deleted”. The Notice also states that US application 87637270 was abandoned on 8 June 2020. It specifies that “bed linen; bed sheets” are still covered by the US basic registration 5178102 but asks that the International Bureau cancel any other goods/services. Mr Price’s evidence is that the UPSTO notification was sent on 5 January 2021;
- Notifications from the International Bureau for the cancellations effected for class 25 and class 24, except for “bed linen; bed sheets”, in respect of the international registration.⁵ The ceasing of effect was recorded in the International Register on 12 February 2021.
- Prints from the EUIPO and UK registers show that IR(EU) 1382321 and IR(UK) 1383231 stand registered for “bed linen; bed sheets” in class 24 as of 4 July 2022.⁶ The international registration date is shown as 28 November 2017.

Decision

11. Rectification is provided for at s. 64 of the Act, which reads:

“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-

³ GIP3.

⁴ GIP4.

⁵ GIP4.

⁶ GIP5.

(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) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The registrar may remove from the register matter appearing to him to have ceased to have effect.”

12. The applicant says that it meets the requirement for “sufficient interest” under s. 64(1) because it is the owner of UK trade mark number 3738053, which at the date of the application was opposed by the proprietor and the opposition was based on the contested mark.

13. A party whose trade mark has been challenged on the basis of the contested mark clearly has sufficient interest to bring proceedings. The official file shows that the opposition against UK3738063 was withdrawn and the mark registered on 9 December 2022. Nonetheless, the applicant remains vulnerable to, for example, invalidation or infringement proceedings based on the contested mark. In addition, the applicant’s trade mark is registered for goods in class 25, as is the contested mark. The applicant therefore appears to be a trader in the same field as the proprietor. Each of these reasons constitutes sufficient interest.

14. The Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (“the Withdrawal Agreement”) sets out at Article 56 the obligation on the UK to ensure continued protection of IR(EU)s after Brexit:

“The United Kingdom shall take measures to ensure that natural or legal persons who have obtained protection before the end of the transition period for internationally registered trade marks or designs designating the Union pursuant to the Madrid system for the international registration of marks, or pursuant to the Hague system for the international deposit of industrial designs, enjoy protection in the United Kingdom for their trade marks or industrial designs in respect of those international registrations.”

15. Part 1 of the Schedule to the Act provides as follows:

“1.—(1) A trade mark which, immediately before IP completion day, is an international trade mark which is protected in the European Union in accordance with Article 189(2) of the European Union Trade Mark Regulation (an “existing IR(EU)”) is to be treated on and after IP completion day as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services in respect of which the international trade mark is protected in the European Union.

[...]

(4) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (IR).

(5) This Act applies to a comparable trade mark (IR) as it applies to other registered trade marks except as otherwise provided in this Schedule.

[...]

3.—(1) The registrar must as soon as reasonably practicable after IP completion day enter a comparable trade mark (IR) in the register.

(2) The particulars of the goods or services in respect of which the comparable trade mark (IR) is treated as if it had been registered must be taken from the English language version of the entry in the International Register for the corresponding (IR).

(3) Where on or after IP completion day the entry in the International Register containing the particulars referred to in sub-paragraph (2) is modified to correct an error pursuant to Rule 28, a person having a sufficient interest may apply to the registrar for rectification of the register by the substitution of the English language version of the entry for the corresponding (IR) in the International Register as modified.

(4) In this Schedule, the “corresponding (IR)”, in relation to a comparable trade mark (IR), means the existing IR(EU) from which the comparable trade mark (IR) derives.”

16. Article 6 of the Madrid Protocol concerns the ceasing of effect of basic applications and registrations.⁷ It reads:

“Period of Validity of International Registration; Dependence and Independence of International Registration

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation,

⁷ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (As Amended on November 12, 2007).

in respect of all or some of the goods and services listed in the international registration. The same applies if

- (i) an appeal against a decision refusing the effects of the basic application,
- (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- (iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.”

17. The registration date of the international mark is 28 November 2017. The abandonment of US 86690464 on 4 March 2019 and of US 87637270 on 8 June 2020 took place within five years of the international mark’s registration date. The USPTO therefore had several months before IP completion day in which to notify the International Bureau of the changes. Once received, the International Bureau acted

relatively quickly to notify relevant parties of the ceasing of effect. I therefore agree with the applicant that if notification had been sent to the International Bureau promptly, it is likely that the specification in the International Register would have been amended prior to IP completion day to “bed linen; bed sheets” in class 24. Had that happened, the contested mark would have been created only in respect of “bed linen; bed sheets”.

18. Paragraph 1(1) of Part 1 of the Schedule requires an IR(EU) to be treated as if an application had been made and the trade mark registered under the Act “in respect of the same goods or services in respect of which the international trade mark is protected in the European Union”. Further details follow at paragraph 3 of that Part, which specifies that the details of the goods and services for which the comparable mark is to be treated as if it were registered under the Act be taken from the International Register. That is what happened and, therefore, the original entry of the comparable mark is prima facie valid, in accordance with s. 72 of the Act.

19. However, Article 6(3) of the Madrid Protocol states that the protection resulting from an international registration “may no longer be invoked” if the basic application or registration has lapsed, been renounced, rejected, revoked or otherwise cancelled. The dates of the ceasing of effect of the basic applications are recorded in the International Register and the protection resulting from the international registration for “comforters; duvet inserts; pillow covers; pillow inserts” and “bed covers; bed spreads; cotton fabric; duvet covers; duvets; fabrics for textile use; pillowcases; quilts; towels” could no longer be invoked from the dates on which basic applications US 87637270 and 86690464 were renounced. The International Register at IP completion day therefore did not reflect the protection to which the IR(EU) was legally entitled. There was, at IP completion day, no obligation under international law to protect the contested goods. In turn, under Article 56 of the Withdrawal Agreement the proprietor was not entitled to continued protection in the UK for the contested goods because, despite what the International Register suggested, at IP completion day it had not “obtained protection” for those goods.

20. There do not appear to be any provisions in the Schedule, or elsewhere in the Act, which allow for the possibility that the information contained in the International Register might have been inaccurate, such as in the present case where there was a

delay in notifying the International Bureau of relevant matters. There are, as a result, no specific remedies to correct such errors. Although paragraph 3(3) of the Schedule allows for the correction of an error, I do not understand this to include the ceasing of effect of a basic application or registration. The reference is to Rule 28 of the Regulations under the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (“the Common Regulations”). This concerns corrections in the International Register. Guidance published by WIPO specifies the circumstances in which a correction may be effected.⁸ It specifically excludes changes to the list of goods and services unless the error was made by the office of origin when presenting the documents to the International Bureau. There was no such mistake here. However, the Common Regulations were not intended to cover the creation of comparable marks, so the absence of a provision is not determinative.

21. The requirement that a comparable mark (IR) be treated as if it were registered under the Act means that the provisions of s. 64 apply to comparable marks (IR) as they do to a national mark. On the face of it, the delay in updating the International Register led to an error in the original entry of the contested mark in the register because it included goods in respect of which the proprietor was not entitled to protection. The power of the registrar to correct errors or omissions in the register under s. 64 is subject to the proviso “[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”. The meaning of this restriction has received some attention in previous cases. In *Andreas Stihl AG & Co's Application*, O/379/00, Geoffrey Hobbs Q.C., sitting as the Appointed Person, considered the limits of s. 64 as follows (p.4 of the decision):

“This Section is quite awkwardly worded. It permits rectification, but only as an exception to the general rule. The general rule is represented by the exclusion contained in the proviso to sub-section (1). That exclusion (of matters affecting the validity of the registration of a trade mark) is apparently intended to restrict the availability of rectification under sub-section (1) to errors and omissions of a kind which can properly be deemed never to have been made (unless otherwise directed) under sub-section (3). I infer that the general rule is intended to prevent circumvention of the unwaivable statutory requirements

⁸ *Guide to the International Registration of Marks under the Madrid Protocol*, paragraph 617.

affecting the registration of a trade mark. These include the requirements of Section 38 to 40 of the Act. I think it is necessary, in order to ensure that the requirements of those sections are not circumvented, to interpret the reference to “matters affecting ... validity” in the proviso to Section 64(1) quite broadly.”

22. This was a case in which the registry had advertised the trade mark for a specification which differed from that which had been agreed between the applicant and the registrar. The applicant applied for the register to be rectified in two respects. The first was that the published “mechanical hard operated hedge clippers” be corrected to read “mechanical and hand-operated hedge clippers”. The second was the insertion of “high pressure and vacuum cleaners for industrial use”, which had been omitted from the list of goods advertised. The first amendment was allowed but the second refused. Mr Hobbs concluded that the second correction sought related to an error affecting the validity of the registration and that s. 64 could not apply:

“[...] the protection conferred by the Applicant’s registration would be extended post-registration, by correction of the relevant omission, to goods in respect of which the trade mark has not been advertised for the purposes of opposition. According to my understanding of the purpose and effect of the exclusion contained in the proviso to Section 64(1), that is a matter affecting the validity of the registration by virtue of Sections 38 to 40 of the Act. I therefore agree with the hearing officer in thinking that the request for correction of the omission was not allowable under Section 64.” (p. 5)

23. Although the decision was that s. 64 did not apply because it concerned an error affecting the validity of the registration, the proposed correction raised the issue of validity because it would have added goods which had not been properly advertised for opposition purposes as required by the Act. Instead, the error was liable to correction under rule 74 of the Trade Marks Rules 2008 (“TMR”) because that rule allowed the registrar to correct the irregularity in procedure by withdrawing and then re-advertising the trade mark for the correct list of goods and services.

24. The meaning of the proviso to s. 64(1) was considered for a second time by Mr Hobbs, again as the Appointed Person, in *Ray Ennis v Alan Lovell (The Swinging Blue Jeans TM)*, O/148/14. This was a case about a dispute between members of a band,

in which Mr Ennis applied for rectification of the register on the grounds that the filing of the mark by Mr Lovell amounted to an act of misappropriation. Mr Hobbs concluded:

“18. Sections 63 and 64 are all about the recordal of particular items of information in the Register. Section 64 enables the Registrar to change the Register by adding, altering or removing information for the purpose of correcting errors or omissions, but only within the latitude allowed by the proviso to Section 64(1). The proviso prevents him from adding, altering or removing information for the purpose of correcting any error or omission affecting the validity (which I take to mean the legality) of registering the trade mark to which the information relates. Since nothing can be done under Section 64 to correct such errors or omissions, it is a key concern when considering an application under that Section to ascertain whether the applicant actually is seeking to rectify an error or omission which lies outside the scope of the proviso.”

25. In this case, s. 64 did not apply because the objections were covered by the grounds identified at ss. 3(6) and 5(4)(a), which have application in invalidity proceedings because of s. 47. The meaning of “validity” must have the same meaning at s. 64 as it does elsewhere in the Act; the grounds for invalidity are set out exhaustively at s. 47. The correction currently sought is not a correction which affects validity as covered by the grounds at s. 47 (i.e. ss. 3 and 5) and does not, therefore, concern matters which should properly be made by way of an application for invalidation. Nor is it a correction which would raise the issue of validity because the application had not been registered in accordance with the proper procedures for registration, in particular the absence of publication for opposition. I consider that the error is both one capable of correction under s. 64 and that the specification should be amended to remove the contested goods.

26. Alternatively, rule 74 TMR reads, “Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office”. As the rule applies to any irregularity “connected with” matters before the Office, I see no reason why this would not include errors which occur elsewhere but which affect matters before the Office. A failure to notify the International Bureau promptly of the ceasing of effect of the basic applications, which resulted in an error

on the international register at IP completion day and led to the incorrect protection for a comparable in the UK is an irregularity in procedure connected with matters before the Office. Had it been necessary, I would have found that rectification of the error was also possible under this power.

27. Further, s. 64(5) reads, "The registrar may remove from the register matter appearing to him to have ceased to have effect". There does not appear to be any requirement that an application be made by a third party before the registrar removes such material. The protection relating to the contested goods had ceased to have effect by IP completion day because of the backdated entries on the International Register. Therefore, even if I am wrong that the error is one capable of correction under s. 64(1), I would direct that the specification be corrected under s. 64(5).

Conclusion

28. The application for rectification has succeeded and the goods listed at paragraph 1 above will, subject to appeal, be removed from the specification.

Costs

29. The applicant has been successful and is entitled to an award of costs. There is no official fee associated with filing an application to rectify the register. I consider an award of £800 appropriate for filing the form TM26R and supporting evidence, and for attending the case management conference. I order Himatsingka America Inc. to pay JD Sports Fashion Plc £800. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of March 2023

Heather Harrison

For the Registrar

The Comptroller-General