

TRADE MARKS ACT 1994

**IN THE MATTER OF A REQUEST BY
FLINTRIDGE LTD
FOR REVOCATION OF THE REGISTER (ON THE BASIS OF NON-USE)
AGAINST TRADE MARK NO: 1552062**

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IN THE MATTER OF A REQUEST BY FLINTRIDGE LTD FOR REVOCATION OF THE REGISTER (ON THE BASIS OF NON-USE) AGAINST TRADE MARK NO: 1552062

BACKGROUND

1. On 3 November 2000, Flintridge Ltd of Dorking, Surrey filed form TM26(N) seeking to revoke trade mark No: 1552062 which is in respect of the trade mark **DREAMBOYS** in Class 16 in the name of Dreamboys Stars Ltd, London. The mark was applied for on 29 October 1993 and was subsequently registered for a specification of goods reading:

“Printed matter; posters; calendars; books, photographs, prints, lithographs; diaries; address books; stationery, pens, pencils, writing instruments, erasers; playing cards; materials for wrapping and packaging; decalcomanias, transfers; greetings cards; all included in Class 16”.

2. In the Statement of Grounds attached to the form TM26, the applicants’ professional representatives, Castles, explained their reasons for the request in the following terms:

“1. The applicants are interested in use of the mark DREAMBOYS. The registration in suit was revealed in a trade mark search.

2. UK Companies House records were searched but no record could be found for Dreamboys Stars Limited, despite the Trade Mark Registry’s particulars showing a UK address.

3. The applicants contend that the registration in issue has not been used by the proprietor or with his consent in the United Kingdom in relation to any of the goods covered by the registration at any time during the last five years, and there are no proper reasons for non use.

4. The applicants seek the complete revocation of registration No: 1552062 under the provisions of Section 46(1)(b) of the Trade Marks Act 1994”.

3. In accordance with Section 43 of the Act (and the Transitional Provisions set out in Schedule 3 paragraph 15 of the Act) the trade mark in suit was due for renewal on 29 October 2000. No request for renewal was received (nor has been since).

4. In a letter dated 16 November 2000 to Castles, the Trade Mark Registry stated:

“I refer to the form TM26 dated 3 November 2000.

I note that you, on behalf of Flintridge Ltd, are seeking the revocation of registration number 1552062 which stands in the name of Dreamboys Stars Ltd, but as the status of

the registration is currently expired (the renewal fee became due on 29 October 2000), you should note that it is not possible to pursue the revocation action.

Section 63(1) of the Trade Marks Act 1994 sets out the definition of a registered trade mark which means a registration in the Register. Section 43(2) states as follows:-

Provision shall be made by rules for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

From which it is clear that the registration (therefore the registered trade mark), no longer exists on the Register once the registration has expired. In the circumstances, it is not possible, to institute or pursue revocation proceedings in respect of a trade mark which is not on the Register.

In view of the above, a refund of the fee paid in respect of the form TM26 will now be arranged. The registered proprietor of the expired trade mark has not been notified of the request and will not be copied into this correspondence”.

5. On 4 December 2000, Castles wrote to the Registrar in the following terms:

“We refer to your letters of 16 and 23 November 2000 [the latter dealt with the refund of the fee].

We would have expected Section 43 of the Trade Marks Act 1994 to be interpreted by considering the effect of s.43(5) on s.43(3) as follows:

Section 43(3) - a request for renewal must be made, and the renewal fee paid, before the expiry of the registration. Failing this the request may be made and the fee paid within such further period (of not less than six months) as may be prescribed, in which case an additional renewal fee must also be paid within that period

AND:

Section 43(5) - if the registration is not renewed in accordance with the above provisions the Registrar shall remove the trade mark from the Register.

We submit therefore that a registration is not removed from the register *at all* if the additional renewal fee is paid within the six months “further period” in accordance with Section 43(3). Therefore we submit that registrations in this position remain on the register and are open to revocation.

If we are wrong then this represents a serious loophole in the law which would give an advantage to a proprietor who had not made use of his mark to deliberately avoid paying the renewal fee in due time and perhaps make preparations to bring the mark into use shortly before the end of the six months “late renewal” grace period.

We therefore request that the revocation action filed is reinstated, failing which we request a hearing as soon as possible”.

6. In a letter dated 19 December 2000, the Trade Marks Registry responded to Castles’ letter maintaining the original view, adding that a hearing would be arranged.

7. This Preliminary Hearing took place before me on 26 January 2001 at which the applicants for revocation were represented by Mr Roland Wilding of Castles. Having considered Mr Wilding’s submissions, I determined that the Trade Marks Registry acted correctly in refusing to accept the application for revocation. This decision was confirmed in my letter to Castles of 29 January 2001.

8. Following the issue of my decision, Castles filed form TM5 requesting a statement of the grounds of my decision. These are provided below.

GROUND OF DECISION

9. For present purposes, the relevant sections of the Act (and where appropriate the associated rules) are reproduced below:

“**63.** - (1) The registrar shall maintain a register of trade marks.

References in this Act to “the register” are to that register; and references to registration (in particular, in the expression “registered trade mark”) are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act-

(a) registered trade marks,

(b).....

(c).....

(3).....”

“**43.** - (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of a renewal fee.

(2) Provision shall be made by rules for the registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration.

Failing this, the request may be made and the fee paid within such further period (of

not less than six months) as may be prescribed, in which case an additional renewal fee must also be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with the above provisions, the registrar shall remove the trade mark from the register.

Provision may be made by rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(6) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner”.

10. In the context of Section 43 of the Act, rules 27 to 30 of The Trade Rules 2000 are relevant. These are reproduced below:

“27. - (1) Subject to paragraph (2) below, at any time not earlier than six months nor later than one month before the expiration of the last registration of a trade mark, the registrar shall (except where renewal has already been effected under rule 28 below) send to the registered proprietor notice of the approaching expiration and inform him at the same time that the registration may be renewed in the manner described in rule 28 below.

(2) If it appears to the registrar that a trade mark may be registered under section 40 at any time within six months before or at any time after the date on which renewal would be due (by reference to the date of application for registration), the registrar shall be taken to have complied with paragraph (1) if she sends to the applicant notice thereof within one month following the date of actual registration.

28. Renewal of registration shall be effected by filing a request for renewal on Form TM11 at any time within the period of six months ending on the date of the expiration of the registration.

29.- (1) If on the expiration of the last registration of a trade mark, the renewal fee has not been paid, the registrar shall publish that fact; and if, within six months from the date of the expiration of the last registration, the request for renewal is filed on Form TM11 accompanied by the appropriate renewal fee and additional renewal fee, the registrar shall renew the registration without removing the mark from the register.

(2) Where no request for renewal is filed as aforesaid, the registrar shall, subject to rule 30 below, remove the mark from the register.

(3) Where a mark is due to be registered after the date on which it is due for renewal (by reference to the date of application for registration), the request for renewal shall be filed together with the renewal fee and additional renewal fee within six months after the date of actual registration.

(4) The removal of the registration of a trade mark shall be published.

30. - (1) - Where the registrar has removed the mark from the register for failure to renew its registration in accordance with rule 29 above, she may, upon a request filed on Form TM13 within six months of the date of the removal of the mark accompanied by the appropriate renewal fee and appropriate restoration fee, restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, she is satisfied that it is just to do so.

(2) The restoration of the registration shall be published, with the date of restoration shown”.

11. Section 63 requires the Registrar to maintain a register and Section 63(1) defines a registered trade mark, ‘unless the context otherwise requires’ as ‘to registration in that register’. It follows from that that requests for revocation (Section 46) and requests for declarations of invalidity (Section 47) can be set in terms in respect of such registrations - both Section 46 and Section 47 state that “The registration of a trade mark may be.....”. The question to be determined here therefore is whether the trade mark the applicants wish to revoke is one which can be termed ‘The registration

12. Mr Wilding submitted that the Trade Marks Registry was not empowered to remove the trade mark from the register until six months after the date it was due to be renewed (Section 43(3) and Rule 29(2)) in that period it continued to be in the register and therefore capable of being declared invalid or, as in this case, revoked.

13. Mr Wilding also prayed in aid the First Council Directive (89/104/EEC) which he submitted did not differentiate, in his view, between the status of registrations which could and could not be the subject of invalidation or revocation action.

14. It is, I think, self evident that a trade mark which is placed on the register becomes a registration in the terms of Section 63, and can remain so, as long as it is renewed under the provisions of Section 42 and 43. Thus Section 43 provides for the payment of renewal fees, but subsections (2) and (3) both refer to the expiry of a registration which I take to mean that if the renewal fee is not paid by the due date the registration expires. There are nevertheless provisions for the late renewal of the trade mark on payment of the renewal fee and an additional fee. But unless and until such fees are paid the registration remains expired.

15. The fact that the trade mark must be removed from the register only after it has been expired for six months does not effect matters - that it is a practical consequence of Section 43(5). This is borne out by the subsection itself which refers to, to remove the trade mark from the register, in contrast to the language of other sections which refer to registered trade marks.

16. The practical consequences of all of this are that acts which require a current registration of a trade mark cannot be under taken once the registration is expired. For example, the owner of a trade mark the registration of which has expired may not take action for infringement (Section 14); the Registrar cannot merge registrations, because there are no registrations to merge; and in a case such as this an application for revocation cannot be pursued because the registration of

the trade mark does not exist.

17. Mr Wilding also raised the matter in the context of the Directive which does not, of course, deal with the procedural matters surrounding the renewal of trade mark registrations. However, I note that Article 1 of the Directive applies to every trade mark which is the subject of registration. Also, Articles 3 and 4 refer to revocation and invalidation in respect of trade marks which are registered. In my view, and on the basis of the above, the Act and the rules are consistent with the Directive in that actions may only be taken against trade marks which are registered and not against a registration which has expired.

18. The Trade Marks Registry was right to refuse to process this application for the revocation of Trade Mark No 1552062, because at the date of filing the application the trade mark was not a registration of a trade mark (Trade Marks Act 1994) or a registered trade mark (Directive).

Dated this 30 day of May 2001

**M KNIGHT
Hearing Officer
For the Registrar, the Comptroller-General**