

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
REGISTRATION No 2140143B
IN THE NAME OF JOHN DEVERE**

AND

**IN THE MATTER OF AN APPLICATION FOR
RECTIFICATION OF THE REGISTER No 11446
BY FAREL BRADBURY**

TRADE MARKS ACT 1994

**IN THE MATTER of trade mark
registration No 2140143B in the
name of John DeVere**

and

**IN THE MATTER of an application for
rectification of the Register No 11446
by Farel Bradbury**

Background

1. The trade mark “GOLF COURTS” is registered as of 25 July 1997 under No 2140143B (“the registration”) in respect of the following specifications of goods and services:

Class 16: Golf related printed matter being score cards and booking forms.

Class 28: Golf equipment and accessories; golf course equipment and accessories.

Class 35: Business management of golf courses.

Class 37: Golf course construction; golf course club house construction.

Class 41: Management of golf courses.

Class 42: Golf course design; golf course club house design.

2. It stands in the name of John DeVere (“the registered proprietor”).

3. By an application on Form TM26 dated 10th February 2000, Farel Bradbury (“the applicant”) applied for rectification of the Register. The Statement of Grounds on which the application to rectify the Register is made includes some historical background on the invention of the concept and inception of the term “Golf Court/s” and pleads the exclusive ground under section 60(3)(b) of the Trade Marks Act 1994 for the substitution of the applicant’s name as the proprietor of the registered trade mark.

4. The registered proprietor filed a counterstatement accepting parts of the applicant’s Statement of Grounds, expressly denying other parts and neither accepting or denying others. The applicant is put to strict proof on some of his claims. At paragraph 17 of this counterstatement, the registered proprietor states the following:

“It is denied that the Applicant is the proprietor of the Trade Mark in a Convention country. The Applicant is put to proof that he is the proprietor of the Trade Mark in a Convention country. As the Applicant is not the proprietor in a Convention country, the provisions of Section 60(3)(b) of the Trade Marks Act 1994 (“the Act”) do not apply. Without prejudice to the generality of the foregoing, it is further denied that the Proprietor was at any time acting as an agent of the Applicant.”

5. The significance of why I refer specifically to this will become apparent below.
6. The proceedings then entered in to their formal statutory evidence rounds. This rectification action No. 11446 was filed in conjunction with another rectification action between the same two parties No. 11445 (the “Golf Courts and device” mark). All the evidence filed under No. 11445 was also relied upon by both parties in this action. Without going into detail, the following was filed as evidence by both parties:

Applicant’s evidence

- (a) A 4 page Affidavit of Farel Bradbury (the applicant) dated 24th July 2000, is a summary of an 11 page Affidavit of the same date filed under Rectification action 11445 documenting a painstaking account of the history and chronology of the applicant’s dealings relating to the marks in suit and many associated business ventures
- (b) Associated exhibit FB2 is a compact version of exhibit FB1 filed under Rectification action 11445 comprising (I estimate) a 200+ page bound volume of copies of letters, agreements, publicity documentation, solicitors letters etc supporting the events, facts and claims of the affidavit of the applicant.

Registered Proprietor’s evidence

- (c) An 7 page Witness Statement by the registered proprietor John DeVere (also known as John Sale), in which he *inter alia* gives his version of the origins of the trade mark “Golf Courts”, the events leading him to make the trade mark application in suit and of his business dealings with Farel Bradbury, the applicant. At paragraph 25 of the Witness Statement, he supplements the denial in paragraph 17 of his counterstatement reproduced above, with his observation that Mr Bradbury has produced no evidence that he has any “trade mark registrations of the GOLF COURT mark” in any convention country, and he goes on to say that he has been advised by his trade mark agent that the section of the Trade Mark Act 1994 that he has relied upon to bring this rectification action should not apply. I shall comment on this later.
- (d) Mr DeVere attaches four exhibits to his Witness Statement, which I need not detail here.

Applicant’s evidence in reply

- (e) Mr Bradbury files a clause by clause reply to the registered proprietor’s evidence. I do not intend to summarise this save his response to the paragraph 25 of the registered proprietor’s evidence which I refer to above. Referring to this, Mr Bradbury says “...JdV’s arguments as to my own registrations, or lack of them, are immaterial to this action which is that the registration was either stolen or made on my behalf while the trade mark was covered by legal agreement. I would expect all overseas matters relating to be dealt with subsequently and as appropriate and that such action to rectify overseas registrations as can be taken by the UK Trade Marks Registry, should be taken

and the Rectification, if granted, published”.

- (f) Exhibit FB4 contains supporting documents to the reply evidence and is the same document filed as exhibit FB3 in corresponding Rectification action No 11445.

The Decision

7. Both parties seek the Registrar’s decision without recourse to a hearing. I have studied the evidence submitted by both parties in detail, which particularly from the applicant was very meticulous and quite substantial. It can be seen from the foregoing, however, that I have not found it necessary to summarise it in any substantial detail, and there is very good reason for that approach.

8. The part of the statute on which the applicant relies by virtue of the application FormTM26 and his Statement of Grounds is but a singular one. It is section 60(3)(b) of the Act. Section 60 reads in it’s relevant parts as follows:

60.-(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2)

(3) *If the application (not being so opposed) is granted, the proprietor may -*

(a) apply for a declaration of the invalidity of the registration, or

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4)

(5)

(6).....

9. Section 60 provides a remedy for the proprietor of a mark in a country party to the Paris Convention whose agent or representative applies to register or registers the mark in his own name in the United Kingdom. It implements Article 6 septies of the Paris Convention. Section 55 of the Act defines a Convention Country as follows

55 - (1) In this Act-

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20 1883, as amended from time to time, and

(b) a “Convention country” means a country, other than the United Kingdom, which is party to that Convention. (Emphasis added).

10. This then is the statutory background to this action. There are two basic prerequisites before any application made to be substituted as the proprietor of the mark on the Register can be determined. They are:

- (a) the proprietor of the registered trade mark has to be an agent or representative of the applicant when the registration took place, and
- (b) the applicant has to be the proprietor of the trade mark in a Convention country.

11. There is some fundamental dispute in the evidence between the parties on the first of these issues. However, the second element seems to be far more clear cut. The specific matter of the second question was raised by the registered proprietor in both his counterstatement (see paragraph 4 above) and evidence in chief (see paragraph 6 (c) above). It was addressed in the evidence in chief of the applicant under Rectification action No 11445 in a way that suggested he had a mis-understanding of the requirements. At lines 444 - 445 of his Affidavit under Rectification 11445 Mr Bradbury says “I have used the mark from its inception in 1993 throughout the UK, a convention country, and the World”. In this action No. 11446, Mr Bradbury says at lines 132-133 of his Affidavit “I have used an identifiable direct derivative of the device mark in the UK, a convention country”. There is no evidence to support the claim of worldwide use in Rectification 11445 (see below) and clearly Mr Bradbury is unaware of section 55(1)(b) of the Act. The matter was dismissed as being “immaterial” in the applicant’s evidence in reply (see paragraph 6(e) above). Clearly it is not.

12. I of course have to consider both these questions. However, as it transpires, it is not necessary to determine both. On a careful reading through the evidence of the applicant, I can find no evidence to fulfill the basic requirement under section 60(3) of the Act that the applicant is the proprietor of the mark in suit in a Convention country. Neither can I subscribe to the applicant’s view that this is “immaterial”. The nearest Mr Bradbury’s evidence suggests any kind of involvement with a foreign (Convention) country is at lines 250-263 of the applicant’s Affidavit filed under Rectification No. 11445 where some dealings with an Irish entrepreneur are documented and again at lines 287 - 293 and 318 - 338 where dealings with two Irish companies are referred to. There are corresponding references in the Affidavit submitted in this action at lines 58-77. However, these references are far from conclusive evidence that the applicant satisfied the terms of section 60(3) of the act.

13. At paragraph 25 of his Witness Statement, the registered proprietor suggests that the applicant has shown no evidence of “trade mark registrations of the GOLF COURT mark” in a Convention country. That, I too find, is a true statement, but not a true assessment of what is required by the law. Evidence of *registration* in a Convention country is not the test. Proprietorship, is what is called for, but what constitutes proprietorship is not defined and neither has there been much guidance on this point in case law under section 60(3). However, registration is one means of proof of proprietorship, but not the only. Footnote 47 at Chapter 13-190 of the thirteenth edition of Kerly’s Law of Trade Marks and Trade Names comments thus:

“...It appears that it is not a requirement that the mark is registered in the Convention or member country of origin, although it seems that it must be in use and properly so by the person claiming to be the proprietor if he is to be so regarded.”

14. The applicant's evidence falls well short of proving anything resembling proprietorship in any convention country. In the light of this finding, I need not consider whether the proprietor of the registered trade mark was an agent or representative of the applicant when the registration took place, nor indeed to consider any further surrounding issues to determine whether the applicant should be substituted as the proprietor on the Register. No other ground other than rectification under section 60(3) has been pleaded and I find on that sole ground the application fails.

15. The registered proprietor is entitled to a contribution towards his costs. I order the applicant to pay the registered proprietor the sum of £435. This sum is to be paid within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2001

**G J Rose'Meyer
For the Registrar
the Comptroller-General**