O-121-05

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 81755

IN THE NAME OF JAILHOUSE ROCK RIGHTS LTD.

FOR REVOCATION OF TRADE MARK No. 2039615

REGISTERED IN CLASS 41

IN THE NAME OF DAVID ALEXANDER BRODIE

DECISION

---

1. On 8th June 2004 Jailhouse Rock Rights Ltd applied under Section 46(1) of the Trade Marks Act 1994 for revocation of trade mark number 2039615 registered in respect of various services in Class 41 in the name of David Alexander Brodie.

2. A copy of the application for revocation was sent to the registered proprietor at his address for service on 11th June 2004.

3. The registered proprietor then had 3 months within which to file a counter statement and evidence of use of the trade mark (or reasons for non-use of the mark) in accordance with the provisions of Rule 31(3) of the Trade Marks Rules 2000 as amended.

4. On 13th September 2004 the registered proprietor agreed to assign the trade mark in suit to Jailhouse Rock Rights Ltd in return for payment of a four figure

sum. However, the parties omitted to inform the Registrar of the agreement they had reached for the trade mark to be assigned.

5. On 22nd September 2004 Mr. Graham Attfield issued a decision on behalf of the Registrar revoking the trade mark registration with effect from 8th June 2004. The decision was issued without prior notice under Rule 54. It was issued under the provisions of Rule 31(3) which enable the Registrar to treat an application for revocation under Section 46(1) of the Act as unopposed if the proprietor of the relevant trade mark does not file a counterstatement and evidence of use (or reasons for non-use) within the period prescribed for that purpose.

6. On 20th October 2004 the registered proprietor gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. He asked for the decision issued on 22nd September 2004 to be set aside on the ground that the registration was not, in fact, vulnerable to revocation because the trade mark had been used during the relevant 5 year period.

7. Belatedly, in February 2005, the solicitors for the parties wrote to the Treasury Solicitor's Department: (1) confirming that the parties had made an agreement on 13th September 2004 for assignment of the trade mark in suit to the applicant for revocation; and (2) asking for the decision of 22nd September 2004 to be set aside by consent in order to allow the application for revocation to be withdrawn and the assignment to be carried into effect.

8. The Registrar confirms that he is agreeable to my dealing with the present appeal in the same way as I dealt with the appeal in the matter of Application No. 12462 by Pepsico Inc. for revocation of Trade Mark No. 1077371 registered in

Class 30 in the name of Citylink Group Ltd. (SRIS 0-576-01, 13th December 2001).

9. In that case an applicant for revocation became entitled to the trade mark in suit during the pendency of the proceedings; the parties to the proceedings omitted to inform the Registrar of the assignment which had taken place; the Registrar issued a decision revoking the registration of the trade mark for default of defence on the part of the erstwhile registered proprietor; the applicant for revocation asked for the decision to be set aside on appeal; and the Registrar did not oppose the request for an order to that effect.

10. I decided that the order for revocation could properly be set aside on the basis: (i) that the parties had ceased to have opposing interests in the subject matter of the proceedings upon execution of the relevant assignment; (ii) that the lis between them had abated for lack of any continuing need or desire on either side to have the status of the relevant registration determined by the Registrar; (iii) the Registrar had been legally and factually entitled on the ground of abatement to make no order for revocation under the Trade Marks Rules when the order under appeal was made; and (iv) the order for revocation would not have been made if the Registrar had not thought that there was an unresolved dispute between the parties which remained to be determined.

11. The present case stands upon essentially the same footing. I see no reason to deal with it differently. If the parties had been notified under Rule 54 of the Registrar's intention to order revocation for default of defence under Rule 13(3), the abatement of the proceedings would, in all probability, have come to light at

that juncture and the matter would then have been resolved in the manner now proposed.

12. I therefore determine, without recourse to a hearing, that the decision issued on 22nd September 2004 be set aside by consent. There will be no order for costs in respect of the appeal or the proceedings before the Registrar.

Geoffrey Hobbs Q.C.

15th March 2005