

O-102-15

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3056577
IN THE NAME OF VENTURI SPIRITS LLC
FOR THE TRADE MARK**

OLD PEPPER BOURBON

IN CLASS 33

AND

**AN APPLICATION FOR
RECTIFICATION OF THE REGISTER
UNDER NO. 84747
BY GEORGETOWN TRADING CO LLC**

Background and pleadings

1) Trade Mark number 3056577 for the mark OLD PEPPER BOURBON is registered in the name of Venturi Spirits LLC (“the proprietor”). The application for registration was originally filed on 21 May 2014 and completed its registration process on 29 August 2014. The proprietor claimed a priority date of 21 November 2013 based on US trade mark 85693721 (“the US mark”).

2) An application for rectification of the register under section 64 of the Trade Marks Act 1994 (“the Act”) was made by Georgetown Trading Co LLC (“the applicant”) on 15 October 2015. The application was made on statutory form TM26(R). The claim is that the priority date claimed and recorded in respect of the registration is incorrect.

3) The claim is that the US mark was filed on 2 August 2012. Exhibit 2 provided with the form TM26R is a copy of the record of the US mark obtained from the online Trademark Electronic Search System of the United States Patent and Trademark Office (“the USPTO”). This appears to confirm the filing date as alleged by the applicant. The consequence of this filing date, if correct, is that the right of priority based upon the US mark expired on 2 February 2013. As the applicant points out, this is over 15 months before the contested registration was filed.

4) The applicant further points out that the priority date claimed, namely 21 November 2013, is exactly six months before the filing of the contested registration. The applicant claims that the proprietor merely counted backwards from the filing date. The challenged priority date results in the registration pre-dating at least some of the applicant’s own applications/registrations.

5) The applicant submitted that if the priority claim had not been made, or if it had been refused, its marks would constitute earlier rights within the meaning of Section 6 of the Act and it would be in a position to oppose the registration.

6) The applicant submits that the priority date should be removed and costs awarded in its favour.

7) The application was served upon the proprietor on 27 October 2014, at the address of its representative (as recorded on the Trade Mark Register). The proprietor was invited to file a counterstatement, together with evidence or submissions, by 29 December 2014.

8) In its serving letter, the Registry also directed “under Rule 62 that the proprietor’s evidence in defence of the rectification should include evidence to support its priority claim, in the form of a certified copy, from the US trade mark office, of the earlier right relied upon”. Rule 62(1)(a) provides the Registrar with a general power to direct that a party provide documents, information or evidence that the Registrar thinks fit. I note that Rule 44(2)(b) also provides the Registrar with the specific power to give directions regarding the filing of evidence in rectification proceedings. No response was received. The Registry wrote again to the proprietor on 21 January 2015, stating that as no counterstatement had been filed, it was minded to treat the proprietor as not opposing the application for rectification and that it will rectify the registration as

no defence has been filed within the prescribed period. Both sides were provided with a final chance to be heard, but once again the proprietor did not respond.

Decision

9) Rectification of the register is provided for under Section 64 of the Trade Marks Act 1994 (“the Act”):

“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) 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.”

10) The applicant has provided *prima facie* evidence in the form of an extract from the USPTO's own online search facility. This indicates that the priority date claimed by the proprietor is incorrect and that the US mark relied upon by the proprietor does not, in fact, provide a valid priority date for the registration. The Registry required that the proprietor provide evidence to support the priority date claimed, but it has failed to do so or to provide any further information. In fact, it has chosen not to communicate with the Registry at all in respect of these proceedings.

11) In light of all of the above, I find that the priority claim is incorrect and that the US mark cannot be relied upon as a basis of a priority claim. This is because the right of priority based upon the US mark expired on 2 February 2013 and the earliest date that the contested registration was entitled to claim priority is 21 November 2013, some nine months later.

12) Having found that the priority claim is incorrect, this constitutes an error capable of rectification and the Registry rectifies the register by removing the priority claim

from the registration. Under Section 64(3), the effect of this is that the priority claim was never made. As a consequence, the proprietor is unable to rely on this priority date.

Costs

13) The applicant has been successful and is entitled to a contribution towards the costs of filing the application. There is no official fee for filing an application for rectification. I keep in mind that the evidential burden on the applicant was light, consisting of case details printed from the USPTO's website and that the proprietor did not engage in the proceedings and as a result the applicant was not required to consider and respond to any arguments or evidence from it. The Registrar normally awards costs according to the published scale in Tribunal Practice Notice 4/2007 and I award costs of £200 in respect of preparation of the statement of case.

14) I order Venturi Spirits LLC to pay Georgetown Trading Co LLC the sum of £200 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 9th day of March 2015

**Mark Bryant
For the Registrar,
the Comptroller-General**