

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION N° 10721
BY JOHNSTON BROTHERS (CONTRACTORS) LIMITED FOR
RECTIFICATION OF THE ENTRY ON THE REGISTER
IN RESPECT OF TRADE MARK N° 541471
STANDING IN THE NAME OF
JAMES THOMAS MITCHELL JOHNSTON

TRADE MARKS ACT 1994

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IN THE MATTER OF Application N° 10721
by Johnston Brothers (Contractors) Ltd
rectification of the entry on the Register
in respect of Trade Mark N°, 541471
10 standing in the name of James Thomas Mitchell Johnston

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BACKGROUND

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The trade mark, NIMPACTOCOTE, N° 541471 was applied for on 15 May 1933 in the name of James Thomas Mitchell Johnston and was registered on 4 August 1933 in that name. The registration currently stands in that name.

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By an application filed on 10 May 1999, Johnston Brothers (Contractors) Limited (hereinafter referred to as “the applicants”) applied for rectification of the register on the grounds that the applicants have been responsible for renewing registration N° 541471 and have been using the mark continuously since its registration. It is submitted therefore that the registration belongs to the applicants and that the Register should be rectified to reflect this.

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In their statement of grounds for rectification, the applicants set out the history to the application for registration and detail the relationship between the registered proprietor and the applicants for rectification.

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In summary the history outlined in the statement of grounds is as follows. Mr J T M Johnston (the registered proprietor, hereinafter referred to as “the proprietor”) was a co-founder, with his brothers, of the company Johnston Brothers in 1904. This company initially commenced trading by importing and selling basalt for road making. This company was the forerunner of the Johnston Group of Companies which expanded from its initial road surfacing activities to road construction, building and civil engineering activities. The proprietor, it is claimed, was simultaneously a major owner, director and employee of the various companies in the group, of which the applicants became a member on 25 March 1933. It is further claimed that the proprietor was a director of the applicants from the date of their incorporation.

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It is claimed that the NIMPACTOCOTE carpet was a semi-dry asphalt designed and first produced by Johnson Brothers in 1932. It is further stated that as the Johnson Group developed and expanded, this dressing continued to play an important role in the road surfacing activities of the Johnston Group.

The applicants go on to claim that at the time the application for registration N° 541471 was made, it was understood that the proprietor was holding the registration in trust for the applicants which was carrying out the road surfacing activities of the group. It is then stated

that the proprietor resigned as a director of the applicants shortly before he died in 1961 and the use of the trade mark continued in the United Kingdom by the relevant part of the company.

5 **APPLICANTS' EVIDENCE**

10 The applicants have filed 2 statutory declarations in support of their applications completed by Mr John Holmes Falkner, Group Company Secretary of Johnston Group Plc and Ms Teresa Anne Bucks, a partner of Boulton Wade Tennant, a firm of Trade Mark Attorneys which represents the applicants.

I will briefly summarise the contents of each declaration.

15 Statutory Declaration of John Holmes Falkner

In his declaration Mr Falkner states his position, as outlined above, and states that he has been employed by his company for seventeen years. He states that he has full access to the records and papers of his company and is authorised to make the declaration on behalf of his company.

20 Mr Falkner details the history between the proprietor and the applicant, which I have previously detailed in this decision. He further states that his company, Johnston Group Plc is the parent company of the applicants.

25 He states that the applicants have been subject to further name changes and he exhibits at Exhibit JHF1, a chart showing the relationship between his company and the applicants.

30 Mr Falkner then states that the proprietor was a director of the applicants from the date of incorporation. He introduces into the proceedings at Exhibit JHF2, a certified copy of the Register of Directors for the applicants to illustrate this point. He explains that the proprietor resigned as a director of the applicants shortly before he died in 1961.

35 Mr Falkner closes his statutory declaration by explaining that the NIMPACTOCOTE semi-dry asphalt carpet, was first produced by Johnston Brothers in 1932. The application for registration was filed on 15 May 1933 in the name of the proprietor. He further states that the trade mark has since that time been used by the applicants and it is that company which has been responsible for paying the renewal fees for the trade mark registration.

Statutory Declaration of Teresa Anne Bucks

40 In her declaration Ms Bucks states her position, as outlined above, and states that she has been associated with her firm for 13 years. She states that she has full access to the papers and records of her firm and is authorised to make the declaration on its behalf.

45 Ms Bucks exhibits to her statutory declaration at Exhibit TAB1, a copy of an exhibit to a previous statutory declaration filed in respect of another trade mark application. This exhibit, which is a copy of a brochure, describes the history of the Johnston Group and of the applicants and Ms Bucks states that this confirms that the proprietor was simultaneously a major owner, director and employee of the various companies in the group.

5 She confirms from her firm's records that the trade mark application resulting in registration N° 541471 was filed on 15 May 1933 in the name of the proprietor. Ms Bucks goes on to state that whilst her firm's original file relating to the registration has long since been destroyed, her firm's current records indicate that her firm's instructing principal in relation to this registration was the applicants. She states that it is the applicants with whom her firm corresponds in relation to the registration and it is the applicants who authorise and pay for the renewal of the NIMPACTOCOTE [registration].

10 Ms Bucks goes onto state that she has found from her firm's records that the applicants were, in her words, reputedly "owner" of the trade mark registration at least when they instructed her firm to pay the original renewal fee for registration N° 541471 in 1947. At exhibit TAB2 is a copy of her firm's renewal log (now on microfiche) which, Ms Bucks states, confirms that this is the case. She further states that her firm's records show that the applicants have paid the renewal fees up to the present day.

15 That concludes my review of the evidence.

20 DECISION

I now turn to consider the grounds of rectification under Section 64 of the Act, which states:

25 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.

30 (2) An application for rectification may be made either to the registrar or to the court, except that-

35 (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.

40 (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.

45 (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.

5 I am satisfied that the applicants have the qualifying status required by Section 64, that is, they have sufficient interest in the registration. In reaching this view I take particular notice from the evidence before me that the applicants have paid the renewal fees for this registration. I am also satisfied that this is not a request which should have been made to the Court and therefore I go on to consider the substance of the request.

10 As can be seen from the wording of Section 64, outlined above, and in particular Section 64(1) provision is made so that “any person having a sufficient interest may apply for the rectification of an *error or omission* in the register” (my emphasis added). Section 64(3) makes provisions that any error, if proven, will be deemed to have been never made. With this in mind I consider that, given the registration has always stood in the name of Mr J T M
15 Johnston, it is for the applicants for rectification to prove that an error occurred at the time of making the application for registration. In the instant case that date is of course 15 May 1933. I have reviewed the applicants’ statement of grounds and the evidence filed in support of their request but can find no evidence of an error having taken place at the time of filing the application for registration in 1933. In fact in paragraph 3 of the applicants’ statement of case
20 it is stated:

“At the time the application for registration N° 541471 was made it was understood that Mr Johnson was holding the registration in trust for Johnston Brothers (Contractors) Limited.....”

25 From this I consider that the applicants themselves do not consider that any error has occurred. It is apparent that they consider that the application for registration was applied for in the correct name i.e. Mr J T M Johnston, who according to their evidence was holding the registration in trust for the applicants for rectification. It would appear to be the case that the
30 only error or omission to have occurred would be the failure to assign the registration to the applicants at or before the time the proprietor left the applicant company.

The applicants in their statement of case ask for the Register to be rectified to reflect the fact that the applicants have been responsible for paying the renewal fees for the registration and the applicants have been using the mark since its registration. Section 64 does not provide the Registrar with the power to rectify the Register in the way sought by the applicants.

35 As I have found that I do not have the power under Section 64 to rectify the register to substitute JOHNSTON BROTHERS (CONTRACTORS) LIMITED for JAMES THOMAS MITCHELL JOHNSTON, the application for rectification of registration N° 541471 is accordingly refused.

Dated this 24th day of November 1999

45 J S PARKER

Acting for the Registrar
The Comptroller General