

O/206/12

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 2296637 OF THE TRADE MARK



IN THE NAME OF KEVIN DAKIN

AND

**AN APPLICATION FOR RECTIFICATION UNDER NO. 83980
THERE TO BY CONDOR CYCLES LIMITED**

BACKGROUND

1) A decision in this case was issued on 2 May 2012 under number O/182/12. That decision also dealt with a revocation action between the two parties. It is now accepted that the revocation action should not have been addressed at the hearing that was held on 11 April 2012 and as such the earlier decision has been withdrawn.

2) On 28 March 2002 PDM Sports Ltd (hereinafter PDM) applied for registration of the following trade mark:



3) In respect of: “Bicycles; including parts and fittings for bicycles” in Class 12.

4) The application was numbered 2296637. The form TM3 was signed on behalf of PDM Sports Ltd by Mr Kevin Dakin. Following examination of the application, it was accepted and published before being registered on 6 September 2002. On 20 February 2003 a request was received by the Registry to change the name of the proprietor from PDM Sports Ltd to Mr Kevin Dakin, the form was dated 16 April 2002. This was accepted by the Registry.

5) On 14 January 2011, an application to rectify the register was filed by Condor Cycles Ltd (hereinafter CC). They requested that, “The registration should be cancelled because it was either registered in error or as a result of a deliberate endeavour to obtain falsification of the Register.” In the statement of grounds the applicant for rectification sets out the sequence of events which is as follows:

Event	Date
Application for registration filed by PDM (signed by Mr Dakin).	28 March 2002
High Court Petition to wind up PDM	17 May 2002
High Court orders winding up of PDM	24 July 2002
Trade Mark registered	6 September 2002
Form TM16 filed amending register from PDM to Mr Dakin. Signed by Mr Dakin as MD of PDM, and as a private individual.	20 February 2003 (although form dated 16 April 2002).

6) CC contend that Mr Dakin may not have disclosed the trade mark application to the Official Receiver, that the mark should have been registered in the name of the Official Receiver when the registration was granted (the Registry had not been informed of the winding up of PDM), and that Mr Dakin predated the form TM16, deliberately entering a date just prior to the winding up order. They contend:

“5. It follows, that Mr Dakin was instrumental in assigning the mark to himself (a) either in error on the date of filing Form TM16, namely on 20 February 2003, when he was no longer an authorised signatory on behalf of PDM or (b) surreptitiously by predating both his signatures to 16 April 2002 on Form TM16 and therefore causing falsification of the Register.”

7) CC provides as exhibits to its statement, copies of the relevant documents such as the TM16, Court Orders etc to corroborate the above timetable. Also included is a letter written to the Official Receiver in Brighton which states:

“In the year 2002, you were appointed as the Official Receiver in the matter of the compulsory liquidation of the above-mentioned company, PDM Sports Limited, ordered by the High Court on 24 July 2002. The sole Director of the company was Mr Kevin Paul Dakin.

Following winding-up of the company, Mr Dakin applied to the Trade Marks Registry on 20 February 2003 to be recorded in the Trade Marks Register as the owner of UK Trade Marks Nos. 2296672, 2296608 and 2296637 that were all previously owned by PDM Sports Limited. There is no assignment in the official file of the Trade Marks Registry in support of the change of ownership and therefore we should be obliged if you will determine from your liquidation files whether the aforementioned trade mark registrations were disposed of by you to a purchaser, such as Mr Dakin, or whether these assets are perhaps to be regarded as bona vacantia.

If you assigned the marks, or your records indicate that they were assigned before your appointment on 24 July 2002, please be so kind and let us have a copy of the assignment or any other relevant document that we can file at the Registry in evidence.”

8) The response from the Official Receiver in Brighton is also included as an exhibit. It states:

“With reference to your email today, please note that the Official Receiver’s case file in this matter is destroyed. However, please note the following from the remaining records available to him. The Official Receiver received his release as liquidator of PDM Sports Limited on 31 October 2003 and the company was subsequently dissolved on 2 March 2004.

There is no record on the Official Receiver’s database referring to a transfer of the Trade Marks to Mr Dakin or a third party and no record of any funds being received for such a transaction. In light of the limited information available, The Official Receiver takes the view that the Trade Marks specified in you [sic] mail are bona vacantia.”

9) Both sides filed evidence. Both ask for an award of costs. The matter came to be heard on 11 April 2012 when Mr Dakin represented himself; CC chose not to attend but provided written submissions which I shall refer to as and when required.

MR DAKIN'S EVIDENCE

10) The registered proprietor, Mr Kevin Dakin, filed a witness statement, dated 4 May 2011. He states that because of the number of years which have passed since the mark in suit was applied for and assigned he does not have all the original documentation. He states that since 1992 he has produced and sold goods such as bicycles, frames, bicycle kits and related parts and equipment under brands and logos using the word SQUADRA. He states that he traded this way as a sole trader and through a licensee company which he owned, PDM. He states that between 1996 and 2002 he licensed PDM to use the trade mark and he was the sole director of PDM. Mr Dakin states that both he and PDM used Hart Reade solicitors on a number of legal issues. He instructed them to register the trade mark on his behalf, and he personally paid the legal fees. However, the solicitors incorrectly registered the mark in the name of PDM. Mr Dakin admits that he signed the form by mistake and it was only later that he found out about the error. Upon realising the error he contacted his solicitor who informed him it was an easy thing to amend and merely required sending in a form to the Registry. As he had lost confidence in his solicitors he decided to complete the form himself. He denies that he deliberately falsified the date of his signature. He states that he is at a loss to explain why the form was so delayed, and after so much time has passed he can only speculate. He postulates that the Registry lost it in its post room for a time, or that the Post Office lost it for some time. Alternatively it may have been left with the papers handed to the liquidator of PDM and subsequently posted by them.

11) Mr Dakin states that the liquidation of PDM was not sinister, it was simply that it could not recover a debt it was owed and so rather than trade whilst insolvent, which is illegal, he was advised to put the company into liquidation. In his discussion with the liquidator he disclosed all the documents and correspondence of PDM including the issue of the trade mark and the error of the solicitor. He states that the mark was never the property of PDM and the liquidator accepted this. He states that it is unsurprising that the liquidators file does not show an entry in relation to the assignment as it took place before the company went into liquidation. Attached to his statement is exhibit KD1 which is a copy of a letter from Hart Reade solicitors to Mr Dakin personally. It is dated 31 October 2001 and mentions discussions regarding the registration of various trade marks including the mark in suit. The letter includes the following:

"2. SQUADRA

You explained that "SQUADRA" is a term used for racing bikes and you want this mark registered in classes 12 and 28. You explained that you are currently working on the design in respect of this mark which will consist of a pictorial representation together with the word element."

CC'S EVIDENCE

12) The applicant filed a witness statement, dated 25 November 2011, by Mr George Myrants it's Trade Mark Attorney. This and the attached exhibits are identical to the statement of case set out in paragraphs 4-7 above. Mr Myrants also provides a witness statement, dated 10 August 2011, in which he states that the registered proprietor was notified in 2010 that the registration in suit would be attacked. Mr Myrants looks to put the registered proprietor to strict proof of use on certain of his claims. Mr Myrants states that

solicitors are “hardly likely” to make such a fundamental error and that Mr Dakin could not have overlooked the error when he signed the form. He questions whether Mr Dakin has produced and sold goods under the mark in suit since 1992. He also seeks a letter from Hart Reade confirming that they erred, and that they acted for Mr Dakin personally and that they charged him as an individual.

13) That concludes my review of the evidence. I now turn to the decision.

DECISION

14) Rectification of the register is provided for under Section 64 of the Trade Marks Act 1994. Section 64 reads as follows:

“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) ...

(5) ...”

15) The applicant for rectification CC is seeking to reverse the assignment which amended the registration from PDM to Mr Dakin. CC contend that at the date which the Registry received the rectification/assignment request, 20 February 2003, PDM was in liquidation and Mr Dakin was no longer a director of the company and so was not in a position to request such an amendment. It is contended that the registration should either be cancelled because PDM has been dissolved, or the registration should reside with the Official Receiver. They provide a letter from the Official Receiver which states that whilst the file has been destroyed, it is possible to ascertain from financial records that no assignment was made by the Official Receiver, as no payment was made into the account. I fully accept that the Official receiver did not assign the mark. CC also allege that Mr Dakin post dated the form when he submitted it. However, they have adduced no evidence to support this contention. For his part, Mr Dakin states that the mark was initially used by him as a sole trader and that when he set up PDM he licensed them to use the mark. Given that Mr Dakin was effectively PDM, he was the sole director, this is

unsurprising. Mr Dakin states that he used the same solicitors for his personal affairs and for his business affairs, and consequently also used the same firm for PDM. He contends that having discussed the issue of registering his trade mark in his name he requested his solicitors to complete the paperwork, which he then signed. The registration was processed and it was only once the registration certificate was received by Mr Dakin that he realised that the mark had been mistakenly registered in the name of PDM and not his name. He states that he therefore completed a form TM16 in early 2002.

16) CC contend that a solicitor would not make such an error and that Mr Dakin would have realised the mistake when he signed the form. Regrettably, the Registry sees errors made by solicitors and even Trade Mark Attorney on a regular basis, it is one of the reasons that a rectification process exists. CC also question whether the solicitors were acting for Mr Dakin on a personal basis, something clearly answered by the letter from the solicitors addressed to Mr Dakin in a personal capacity, filed as part of his evidence. Mr Dakin states that he discussed the issue of the registration being in the wrong name when subsequently PDM went into receivership in May 2002. He states that the Official Receiver was content that a genuine mistake had been made and consequently there was never any question of the mark belonging to PDM, hence no assignment. Mr Dakin cannot explain why the form was not received by the Registry until February 2003. He puts forward some possibilities, such as the Registry receiving the form but misfiling it, the Post Office mislaying the item for 10 months or the form being amongst papers that the Official Receiver had but were only posted by the Official Receiver once it had finished all of its work. Unfortunately, I have to accept that the first possibility is not unknown. There have been occasions when papers have been inadvertently linked in the IPO and only discovered some time later. Equally the Post Office accepts that it does, albeit rarely, "lose" items only to discover them, sometimes years later, and then deliver them to the correct address. Similarly, the Official Receiver's office would have to accept they too sometimes make similar errors. It is therefore not inconceivable that such an event would take place. Given that there is no time limit upon assignments/rectifications, receipt of a form TM 16 sometime after it is signed is not that unusual in the Registry's experience. I also note that Mr Dakin volunteered to be cross examined under oath on this issue. On the balance of probabilities, and in the total absence of any evidence to the contrary, I accept Mr Dakin's version of events. The request for rectification filed by Condor Cycles Ltd is refused.

CONCLUSION

17) Condor Cycles has failed in their rectification under No. 83980.

COSTS

18) Mr Dakin has been successful and it is therefore entitled to a contribution towards his costs. He has, for the most part, been professionally represented and so the costs awarded reflect this and also take into account that he represented himself at the hearing.

Preparing statements and considering the other side's statements	£300
Preparing evidence	£600
Preparing for and attending a hearing	£600
TOTAL	£1500

19) I order Condor Cycles Limited to pay Mr Kevin Dakin the sum of £1,500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of May 2012

**G W Salthouse
For the Registrar
the Comptroller-General**