

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No 1425663
STANDING IN THE NAME OF SOYO COMPUTER INC**

AND

**IN THE MATTER OF AN APPLICATION FOR RECTIFICATION (No 80719)
BY SOYO EUROPE B.V.**

TRADE MARKS ACT 1994
IN THE MATTER OF registration No. 1425663
standing in the name of Soyo Computer Inc

and

IN THE MATTER OF an application for rectification (No. 80719)
by Soyo Europe B.V.

BACKGROUND

1. The above identified trade mark was applied for on 22nd May 1990 in the name of Soyo Technology Co Limited. The trade mark was subsequently registered in that name.
2. On 9th May 1998 a Form TM16 was filed to record an assignment of the trade mark to Soyo Europe B.V. (hereafter referred to as EUROPE), the applicant for rectification in this matter. This assignment was recorded on the register and the details published in the Trade Marks Journal on 1st July 1998.
3. A further Form TM16 was filed on 26th February 2001 to record an assignment of the trade mark to Soyo Computer Inc (hereafter referred to as COMPUTER), the current registered proprietor. This assignment was also recorded on the register and the details published in the Trade Marks Journal on 18th April 2001.
4. By an application for rectification filed on 5th February 2002, EUROPE seek to rectify the Register by the removal of the name of COMPUTER as the current registered proprietor and replacing it with their own name. In essence the annulment of the assignment detailed at paragraph 3 above is requested.
5. A copy of the application was sent to the registered proprietor's recorded address for service on 12th February 2002. The registered proprietor was invited to file a counterstatement or face the possibility that any opposition to the application would be deemed withdrawn. No counterstatement was filed.

DECISION

6. Section 64 of the Trade Marks Act 1994 deals with the rectification of the register, it reads:

“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 on the register.
- (5) The registrar may remove from the register matter appearing to him to have ceased to have effect.

7. I am satisfied that the applicant has the necessary qualifying status required by Section 64(1). The removal of an alleged erroneous assignment with the consequent entry of the applicant as registered proprietor clearly demonstrates a sufficient interest. I am also satisfied that this is not a request that should have been made to the court nor is it one that should be referred to the court. I therefore go on to consider the substance of the request.

Supporting documents

8. To support their request for annulment of the assignment, the applicant has filed a number of supporting documents, namely:

- (a) A letter addressed to the Benelux, UK, Irish & Swedish Trade Mark Registry's from Mr RCM van Moorsel, the bankruptcy trustee appointed by the Court of Rotterdam in respect of the bankruptcy of EUROPE.
- (b) An English translation of a provisional court order made by the Rotterdam District Court in respect of the assignment between EUROPE and COMPUTER.
- (c) A copy of the Statement of Annulment sent to COMPUTER by the bankruptcy trustee of EUROPE.
- (d) English translations of the relevant articles of the Dutch Bankruptcy Act.

9. From these supporting documents a number of facts emerge:

- (i) EUROPE was declared bankrupt on 15th May 2001 by the Rotterdam

District Court. Mr RCM van Moorsel was appointed bankruptcy trustee.

- (ii) Shortly after agreeing to a sale of EUROPE's assets to a third party (unrelated to these proceedings), the bankruptcy trustee discovered that all of the assets had already been sold and transferred to COMPUTER. This took place less than one year prior to the bankruptcy of EUROPE.
- (iii) A Statement of Annulment was issued by the bankruptcy trustee (the statement having been approved by a supervisory judge of the District Court of Rotterdam) to COMPUTER on 16th July 2001. This informed them that the assignments were considered to be annulled in accordance with Article 42 of the Dutch Bankruptcy Act and consequently that the trade mark was considered to be part of the estate of EUROPE.
- (iv) It was then asserted by the bankruptcy trustee before the Rotterdam District Court, that on the basis of Article 42 (paragraph 1) of the Dutch Bankruptcy Act, that the sale and transfer of the trade marks should be declared invalid.
- (v) The above claim (which was not rebutted by COMPUTER) was upheld in a public court hearing of the Rotterdam District Court on 2nd May 2002.

10. The registered proprietor has not filed a counterstatement to oppose the application for rectification, however I cannot simply allow the application in default. There must still be merit in the application, therefore I must consider the above facts and ascertain whether they establish that an error does stand on the register and that it is capable of rectification. I do however take cognisance of the fact that the registered proprietor has not challenged the application nor have they notified me of any appeal against the Rotterdam District Court's decision. As such I take the above facts to be a true statement of the current situation i.e. that through the powers of the bankruptcy trustee and with support from the Rotterdam District Court, the assignment of the trade mark from EUROPE to COMPUTER has been annulled.

The erroneous assignment

11. I do not feel it necessary to go through the Dutch Bankruptcy Act in any great detail. It is sufficient to say that in the present situation the annulment of the assignment to COMPUTER was requested by the bankruptcy trustee as he considered the assignment to be prejudicial to the creditors of EUROPE as provided for in the provisions (primarily paragraph 42) of the Dutch Bankruptcy Act.

12. In the absence of any rebuttal from COMPUTER, the District Court of Rotterdam upheld the request of the bankruptcy trustee and a judgement was delivered accordingly.

Conclusion

13. It should be noted that the recordal of an assignment at the UK Registry (carried out by filing a Form TM16) is merely a recordal of a change of proprietor that has taken place in the “real world”. It is normally a deed of assignment that constitutes the actual assignment of a trade mark, the Form TM16 will then follow the event and asks the Registry to simply record what has happened.

14. In the present situation the actual assignment carried out between EUROPE and COMPUTER has been annulled by the bankruptcy trustee of EUROPE with support from the District Court of Rotterdam. As EUROPE is a Dutch corporation then this action is clearly within their jurisdiction. The application for rectification seeks only to annul the recordal of the assignment on the UK register. As matters currently stand I find that the register does contain an error in that the current registered proprietor of the trade mark is a party who has obtained their proprietorship via what has been determined to be an invalid assignment. This therefore requires correction, and may be corrected under the provisions of Section 64 of the Act.

15. I therefore direct that the register be rectified by the correction of the registered proprietor’s details to read:

**Soyo Europe B.V.
Signaalrood 19
2718 SH Zoetermeer
Rotterdam
The Netherlands**

16. Correction of these details will not affect the validity of the registration and I consider it right to exercise the Registrar’s discretion in this case. In accordance with Section 64(3) I deem that the error in respect of the registration was never made.

Dated this 29 day of November 2002

**Oliver J Morris
For the registrar
The Comptroller General**