

O/1130/25

TRADE MARKS ACT 1994

IN THE MATTER OF THE FOLLOWING TRADE MARK REGISTRATION NO.

UK00003015732:



IN CLASS 29

IN THE NAME OF SAINT ANTHONY CHARCUTERIE LIMITED

AND

APPLICATION NO. 84941 TO RECTIFY THE REGISTER

BY PETER WOODHAM

BACKGROUND AND PLEADINGS

1. On 7 September 2021, the UK trade mark shown on the cover page of this decision (“the contested mark”) was assigned from Stephen Williams and Peter Woodham-Kay (“the applicants”) to Saint Anthony Charcuterie Limited (“the proprietor”) for the following goods:

Class 29 Meat, fish, poultry and game; Meat.

2. On 25 March 2024, Peter Woodham, formerly Peter Woodham-Kay, (“the applicant”) filed a Form TM26R claiming that the register should be rectified in accordance with section 64 of the Trade Marks Act (“the Act”) because the ownership of the mark had been changed without his knowledge and he had not filled out any forms in relation to the transfer of the mark.

3. As the application for rectification was made by a person other than the registered proprietor, it was necessary to serve the application on the proprietor, in accordance with rule 44(2) of the Trade Marks Rules 2008 (“the Rules”). Accordingly, on 1 May 2024, the Registry served the Form TM26R on the proprietor, setting a deadline of 1 July 2024 to file a counterstatement and evidence or submissions.

4. On 20 May 2024, a counterstatement was received from the proprietor denying the basis of the application for rectification. It is noted that the counterstatement contained a witness statement without a statement of truth, which was accompanied by evidence not filed in the correct evidential format. Consequently, on 5 June 2024, the Registry issued an official letter giving the proprietor a month, that was until 5 July 2024, to file its evidence in the correct format.

5. On the 20 June 2024, the proprietor re-filed its evidence. This was not received by the Registry, but the proprietor provided proof of postage. Nevertheless, the witness statement still did not include a statement of truth. Therefore, in an official letter dated 9 September 2024, the Registry gave the proprietor 14 days, that was until 23 September 2024 to file a Form TM9R, requesting a retrospective extension of time to file its evidence in the correct format. A Form TM9R was filed on 10 September 2024,

alongside the witness statement of Mr Anthony Charles Taylor dated 20 May 2024 containing a statement of truth, accompanied by **exhibits 001** and **002**. This was accepted by the Registry and Mr Taylor's witness statement contains the following information:

1. Mr Taylor is the Director of the proprietor, and he states that he purchased the goodwill of Good Game Limited from the licenced insolvency practice Findley James on 31 March 2021.
2. **Exhibit 001** contains a printout from Companies House of Good Game Limited, company number 09300248, which was dissolved on 17 January 2023. I note its registered address is "Saxon House, Saxon Way, Cheltenham, GL52 6QX".
3. **Exhibit 001** also contains the following invoice:

Good Game Limited in Liquidation

C/O Findlay James, Saxon House, Saxon Way, Cheltenham GL52 6QX

INVOICE LQ01

31 March 2021

Saint Anthony Charcuterie LTD
Unit 10
Topsham Quay
Topsham
Devon
EX3 0JB

Item List:

1 Stainless Steel work benches
2 Butchers Block
3 Knives and Sundries
4 Uniforms
5 Avery Berkle scale
6 Sausage making stainless table
7 Mixer Grinder
8 Good Will
9 Website

£ 3,000.00

Vat @ 20.00%

600.00

3,600.00

I confirm that this invoice passes title of the above property to Saint Anthony Charcuterie LTD, title passing on receipt of cleared funds for the invoiced amount.

Alisdair J Findlay, Liquidator
For and on behalf of
Good Game Limited in Liquidation

4. At paragraph 1 of Mr Taylor's witness statement, he states that the "good will" listed in the above invoice "includes customers and logo etc.... This made [the proprietor] the legal owner of all trade marks associated with and used by [Good Game Limited] including the logo UK00003015732 formally registered to Stephen Williams and Peter Woodham, as owners and directors of [Good Game Limited]". At paragraph 3 of his witness statement, he again states that the goodwill includes the logo.
5. Mr Taylor states that Mr Woodham attended most of the meetings associated with the liquidation and dissolving of Good Game Limited, and completed paperwork for any meetings he was unable to attend, in accordance with the correct procedures of the licenced insolvency practice. There are recordings and notes from all of these meetings but to "obtain them would incur a substantial cost".
6. Mr Taylor states that he attended all of the meetings with Findley James and that a licenced insolvency practitioner "would not have continued with the process if it was not conducted correctly and in accordance with the law and due process".
7. Mr Taylor states that Peter Woodham was "a minority shareholder" and so did not have a casting vote even if he did object to the liquidation process.
8. Mr Taylor states that Peter Woodham signed a blank TM16 document in preparation to transfer the trade mark, which is in Mr Taylor's possession. The change of ownership was completed by lawyers at WBW of Exeter, and that all this information can be obtained from them at £350 an hour.
9. Mr Taylor states that based on all of the above (being present at the liquidation meetings, signing the Form TM16, and being a director and minority shareholder), Peter Woodham would have known that the mark was transferred to the proprietor.
10. Mr Taylor states that "should this transfer be undone by this current process" he will immediately transfer the mark back to the proprietor.

DECISION

6. The power to rectify the register is set out in section 64 of 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.”

Sufficient interest

7. The applicant must have a sufficient interest to apply for rectification. The applicant was the former proprietor of the trade mark before the transfer of ownership was recorded. I therefore accept that the applicant has sufficient interest.

Is it an error capable of correction?

8. Where an application is filed to record the assignment, the information provided on the Form is taken at face value. The registrar does not investigate or otherwise seek to establish the legality of the claim to change of ownership unless the recordal of change of ownership is challenged. When the ownership is challenged, it is incumbent on the proprietor to show that the contested mark was transferred to the proprietor under a valid assignment. Section 24(3) of the Act is as follows:

“An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.”

9. When the proprietor filed the Form TM16, they ticked the box that indicated that an assignment had taken place. Therefore, on this basis, for the assignment to be effective, it must be in writing and signed by the assignor (or their representative).

10. In this case, the only exhibited evidence before me is an invoice between Findlay James on behalf of Good Game Limited (which was in Liquidation) and the proprietor, and a Companies House print out for Good Game Limited. I also have the Form TM16 before me. However, the issue with this limited evidence is threefold.

Issue 1: Good Game Limited were not the legal owners of the contested trade mark

11. The contested mark was originally owned by Mr Stephen Williams and Mr Peter Woodham-Kay. The only evidence that connects Mr Williams and Mr Woodham-Kay to Good Game Limited is Mr Taylor’s witness statement which states that they were the directors and shareholders of the company. However, the Companies House evidence does not list Mr Williams and Mr Woodham-Kay as directors, and their names do not appear on the invoice evidence. Mr Woodham’s Exeter address (as contained in the Form TM26R) also does not appear on the invoice or Companies House evidence, and the only address provided on the Companies House printout for Good Game Limited is the Liquidator’s address (Findlay James).

12. I note that as Mr Williams and Mr Woodham owned the trade mark, they would have had to give express permission, via a licence, for example, for Good Game Limited to use the mark, and I do not have a physical licence as evidence before me. I bear in mind that a licence does not have to be in writing, however, neither party has not provided me with any narrative evidence to suggest that there was a licence between Mr Williams, Mr Woodham and Good Game Limited. I am therefore not able to confirm if there was licence in place, and if there was, did the licence allow or give Good Game Limited the power to assign the mark to another company. Furthermore, if the company Good Game Limited was liquidated, on the basis that they did not own the contested mark, the contested mark would not have been a part of the company assets to liquidate, sell or assign via the invoice provided at **exhibit 001**.

Issue 2: Goodwill does not encompass trade marks

13. I bear in mind that Section 24(1) and (2) of the Act states that:

(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

It is so transmissible either in connection with the goodwill of a business or independently.

(1A) A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered, or

(b) in relation to use of the trade mark in a particular manner or a particular locality.”

14. Goodwill is the attractive force which brings in customers,¹ and as per Section 24 of the Act above, a trade mark can be transferred with goodwill or transferred independently (without the goodwill). Therefore, while the invoice lists that Mr Taylor did pay for the Good Game Limited’s “good will”, this does not automatically mean that he also paid for their logo (as the goodwill could have been transferred independently from any trade mark). There is also no accompanying evidence, or definitions provided within the invoice evidence, to confirm that the use of the word “good will” was meant to encompass the assignment of the contested mark. On this basis, I do not consider that the words “good will” contained in the invoice encompasses the purchase of the contested trade mark. Furthermore, it cannot be inferred that the invoice encompasses the purchase of the contested trade mark on the basis that the contested mark was not owned by Good Game Limited. As noted above, the contested mark was owned by Mr Williams and Mr Woodham. I therefore have no physical evidence which shows that the proprietor purchased the contested trade mark, or that it was assigned from the applicants to the proprietor.

Issue 4; the signed Form TM16

15. While Mr Woodham states that he had not filled out any forms in relation to the transfer of the mark, it is clear that the Form TM16 that was filed on 7 September 2021 was signed by Mr Williams and Mr Woodham-Kay. Mr Woodham has not stated that the Form TM16 was, for example, signed without his permission, or that his signature on the Form is fraudulent. Therefore, I find that Mr Woodham has signed a Form TM16 which is an application to record a change of ownership.

16. However, I also have to bear in mind that, the Form TM16 is not a deed of assignment and the Form itself carries a warning to parties completing it that it is not a substitute for a deed of assignment. Put simply, the Form TM16 is the notification to the Registry that an assignment has already taken place so that the Register may be

¹ *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL)

updated. Moreover, as noted by Section 24 of the Act above, a mark is transmissible by assignment, which is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative. However, I have no evidence before me to show that a proper assignment has taken place. Without this evidence, I consider that I am bound in finding that the contested trade mark cannot have properly changed ownership to the proprietor.

17. For the sake of completeness, I note that there are three other ways in which a transfer of ownership may take place which are noted on the Form TM16. These are by 'court order', 'assent of personal representative' and 'company merger'. There is no court order or company merger that has been identified by the parties, and an assent of personal representative relates to transferring property after death which is clearly not applicable here.

CONCLUSION

18. As there is no evidence of a written assignment of the contested trade mark, the rectification is allowed.

19. The register is to be rectified to record Mr Williams and Mr Woodham-Kay as the proprietors, as was the position prior to the filing of the contested Form TM16.

COSTS

20. No request for costs has been made and I make no order in this regard.

Dated this 1st day of December 2025

L FAYTER

For the Registrar