

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

Kerten Unlimited Company (Holder/Proprietor)

and

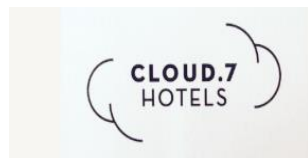
Ms Clara Munz (Applicant for Revocation)

CONCERNING

Trade Mark No. 253702

The registered trade mark.

1. **Kerten Unlimited Company**, of 13-18 City Quay, Dublin 2 is the registered holder of



the Trade Mark, , which is registered under TM No. 253702 in the following classes:

Class 36: Real estate administration; Real estate services; Real estate investment; Real estate management; Rental of real estate; Management of real estate; Lease of real estate; Leasing of real estate; Capital investment in real estate.

Class 41: Entertainment.

Class 43: Temporary accommodation; Accommodation reservations (Temporary -); Temporary accommodation reservations; Temporary accommodation services; Reservations (Temporary accommodation -); Providing temporary accommodation; Accommodation (Rental of temporary -); Provision of temporary accommodation; Arranging of temporary accommodation; Booking of temporary accommodation; Reservation of temporary accommodation; Provision of food and beverages; Preparation of food and beverages; Providing food and beverages; Serving food and drinks; Catering of food and drinks; Catering for the provision of food and beverages.

Class 44: Clinics (Medical -); Medical spa services.

The mark in question is an Irish Trade Mark that was registered on 09/04/2016 with a registration date of 10/09/2015.

Application for revocation

2. On 7th June 2022, Ms Clara Munz, of Kurt-Schumacher-Allee 42, Dietzenbach, 63128, Germany, made an application under Section 51 of the Trade Marks Act, 1996 and Rule 41 of the Trade Marks Rules, 1996 for revocation of the above Trade Mark registration and included with the application a statement of the grounds on which it was made.

The Applicant, in their statement of grounds, contended that within the period of five years following the date of publication of Irish Trade Mark No. 253702, the said trade mark was not put to genuine use in the State, by or with the consent of the proprietor in relation to the services for which the said trade mark is registered and that there are no proper reasons for such non-use. It was further stated that use of the said trade mark has been suspended for an uninterrupted period of five years prior to the date of the present application and that there are no proper reasons for such non-use.

On 10th June 2022, the Office sent a copy by registered post of the application for revocation together with a statement of grounds to the Proprietor at their then registered address for service. This letter was also emailed to the Proprietor. The letter advised the Proprietor that, in accordance with Rule 43(3) of the Trade Mark Rules, 1996, they should file a notice of opposition and evidence of use within three months of the date of the letter i.e. by 9th September 2022. An Post advised that they had unsuccessfully attempted to deliver the registered post item which was returned to the IPOI on 24th June. The Office procedure in such cases is to send again by ordinary post which was done on 27th June 2022. No reply or acknowledgement was received by the Office to either the postal or email communications.

FRKelly were recorded as the address for service for this registration on September 13, 2022. On 23rd November 2022, in the absence of a response from the Proprietor to the official correspondence issued under the allowable additional time of Rule 63, Trade Mark registration 253702 was revoked with effect from 7th June 2022. On 1st December 2022, F R Kelly requested a rescindment of the Revocation decision on the basis that the Proprietor never received the correspondence issued by the IPOI. They further stated that the Office failed to inform F R Kelly of the existing proceedings when recording that firm as the address for service for the Proprietor's mark. The Office response to this on 7th December 2022 included a summary of the efforts made to contact the Proprietor within the time limits allowed as detailed above. It further denied that the Office had an obligation to inform FRKelly of the revocation proceedings when recording it as the

address for service. It had merely been asked on 13th September 2022 to record the firm as the address for service and promptly did so that same day. Accordingly, the Office advised that it could not agree to the request for the revocation decision to be rescinded. On 6th January 2023, FRKelly wrote again to the Office and requested a rescindment of the Revocation citing various arguments including that the email address to which correspondence was sent was defunct as the employee to whom it was addressed had left the Proprietor's company, This letter further claimed that the Office should have consulted the records of the Companies Registration Office for the new address of the Proprietor after An Post were unable to deliver a copy of the Revocation application which also contained advice of the need to supply a Notice of Opposition together with evidence of use within the time allowed. On 23rd January 2023, the Office replied to the Agent. In this, it was stated that the Office used all the contact information provided to it in relation to Trade Mark 253702 and its actions were consistent with well proven and understood practices employed for many years in regard to correspondence returned to it. The Office did not accept that, when recording FRKelly as the Address for Service, it had a duty to simultaneously inform them of the Revocation action and to enquire if it had been received. If there was a change to the Address for Service at any stage, the onus was on the Proprietor to request that such changes be recorded at the earliest possible opportunity. This would ensure that they would receive any correspondence relating to their application. Accordingly, the Office did not propose to rescind the decision to revoke Trade Mark 253702 and referred the Agent to the options available under Section 79 of the Trade Marks Act 1996. On 17th February 2023, F R Kelly requested a Hearing or alternatively Written Grounds of the Revocation decision.

The Hearing

3. An ex-parte Hearing was held on 15th May 2023. The Proprietor was represented by Mr Paul Kelly of FRKelly. At the outset, I advised that the Hearing would be confined strictly to the decision of the Office to revoke Trade Mark 253702 which was based on the failure of the Proprietor to reply to the correspondence and to supply a Notice of Opposition together with evidence of use within the time allowed. The principal points of Mr Kelly's submission at the hearing can be summarised as follows.

The Proprietor of the mark is currently defending a number of similar proceedings filed by the same applicant for revocation in respect of its UK and EU marks and defences and evidence of use have been filed in respect of these.

The Office was aware that the Proprietor had not received notice of the revocation proceedings due to their non-delivery.

The Agent was recorded as an Address for Service for the Proprietor on 13th September 2022, a short period beyond that in which a defence was required to be filed.

Mr Kelly stated that, in a previous unrelated case, the Office had tried to ensure that an application for revocation was delivered to the owner of a trade mark registration. It was his view that this should have been done in the present case also. Mr Kelly went on to quote cases whereby consideration of the need to do justice when exercising jurisdiction has been acknowledged. Specifically, in the present case, given that the service of the application for revocation sent by registered post had been returned, a review of the records of the Companies Registration Office would have revealed the correct registered office of the company and this would have enabled the delivery of the notice of revocation to have been completed.

The Registered Proprietor stood to be prejudiced or adversely affected by revocation of their mark in the absence of a defence arising from a default judgement. It was the view of the Agent that the Proprietor's mark could otherwise be defended against the application for a declaration of revocation against it. If the decision to revoke TM 253702 was maintained the Proprietor stood to be more prejudiced or adversely effected in the absence of a defence due to the default judgement.

Decision

4. The application, under Section 51 of the Trade Marks Act, 1996 and Rule 41 of the Trade Marks Rules, 1996 for revocation of Trade Mark registration number 253702 was made on 7th June 2022. The proprietor of the mark was advised by registered post on 10th June that the deadline to file a Notice of Opposition and evidence of use was 9th September 2022, within three months of our letter of 10th June 2022. On being informed by An Post that our letter had been marked as "not called for", it was re-sent as per our standard procedure. The letter was also sent by e-mail to the address on file with us. Notice of the appointment of FRKelly as agents for the Proprietor was received on 13th

September 2022. It was possible, under Rule 63(4), for an extension of time of two months in which to file a response to be requested. No such request was made.

Following on from the above, the Applicant and the Proprietor were informed that the Controller decided to grant the application for revocation and revoke the registration of the mark with effect from 7 June 2022 in accordance with Section 51(6)(b) of the Trade Marks Act, 1996.

After full consideration of the arguments put forward by the agent at the Hearing and a review of the correspondence in relation to this case, the Controller has decided that all reasonable efforts to inform and provide the Proprietor with a copy of the revocation documentation were made by the Office. It is my view that, due to the failure of the Proprietor to respond, in accordance with Rule 19(1) or within the additional period allowed under Rule 63(4), the Office was correct in its decision to grant the request for revocation. This was confirmed in our letter of 23rd November 2022. The Office followed the well-established procedures for this matter in line with the governing legislation. I don't accept the position suggested by the Agent that the Office should have checked the records of the Companies Registration Office to determine if the Proprietor's address had changed. While we endeavour at all times to assist interested parties in a reasonable manner, this could not be expected to be extended to check contact information officially filed against external databases.

Due to the failure of the Proprietor to file a Notice of Opposition and evidence of use to the application for revocation or to seek an extension of time within the period allowed for this, the Office was correct in its decision to grant the application for revocation and revoke the registration of the mark with effect from 7 June 2022 in accordance with Section 51(6)(b) of the Trade Marks Act, 1996.

John Nolan
Acting for the Controller

6th November 2024