TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark Numbers

1272101, 1332727, 1229890, 1332733, 1235690 & 1525250

IN THE NAME OF Mr Nicholas Dynes Gracey

AND

APPLICATION FOR REVOCATION THEREOF Nos

9593, 9594, 9595, 9596, 9597, 9608, 9609

BY Trocadero Plc

BEFORE MR SIMON THORLEY (SITTING AS THE APPOINTED PERSON)

APPEAL OF AN INTERLOCUTORY DECISION

DECISION

MR THORLEY: On 6 December 1999 I issued an interim decision in this matter. This followed a hearing during which I heard Mr Gracey, not in person, but on a conference telephone link.

The sole question for determination on that appeal was whether Mr Attfield, the officer acting for the Registrar, had acted ultra vires in issuing his decision on 1 October 1999 without first giving the parties an opportunity to attend and make submissions at an oral hearing.

I concluded, for the reasons set out in my decision, that Mr Attfield had acted ultra vires. I therefore set aside the decision and remitted the matter back to the Registrar for a hearing to take place.

As appears from that decision, the applicants for revocation, Trocadero Plc, did not appear and were not represented and indeed neither they nor their appointed agents, David Keltie Associates, played a significant part in the appeal process. They raised one question concerning rule 57 and I ruled on that in my decision.

At the end of my decision I indicated a provisional view on the question of the costs of the appeal, but invited submission in writing on the question. I shall deal first with the submission made by David Keltie Associates, although those come later in time.

By letter dated 8 February 2000, David Keltie submitted that it would be wholly unjust for an award of costs to be made against the applicants and they gave the following reasons, and I read from that letter:

> "As the Appointed Person states on page 19 of his decision, the applicants were not instrumental in the issuing of the decision on 1 October 1999, nor did we receive Mr Gracey's fax of 30 September 1999 until after office hours. In fact we did not see this communication until the next day, 31 September 1999, leaving no time to seek comments from our client before the decision by the Hearing Officer was made.
>
> Moreover, Mr Gracey's reason for the appeal was the result of action by the Trade marks Registry in respect of which the applicants were not involved.
>
> In the circumstances, we trust that no award of costs will be made against the applicants."

Mr Gracey made more substantive observations, first, in a one page fax of 13 December 1999 and then in a more amplified eight page fax of Monday, 10 January. He also requested that there should be a further hearing to discuss the question of costs and that hearing has taken place this afternoon. The applicants elected not to attend and once again I have heard Mr Gracey on a telephone conference line.

Mr Gracey's submissions, both in the faxes and before me, fall into two parts, and I think I should deal with those two parts separately. First, he makes observations as to matters recited in my decision which he contends are erroneous and he invites me to correct. Secondly, he makes observations as to his perception of the conduct of the registry leading up to Mr Attfield's decision which he contends should lead to an award of costs being made against

them. In the alternative he seeks to associate the applicants with that conduct and contends that an award of costs should be made against the applicants. I shall deal with those two separate matters in turn.

My decision of the 6 December has not yet been perfected in the sense that no order embodying it has yet been signed. I do not believe that this decision stands in any different position to a judgment of the High Court or the Court of Appeal which has not been perfected.

Until that time, I apprehend it is open to the court of tribunal giving the judgment or decision to make alterations to it. Indeed, in an exceptional case the decision can be withdrawn if the courts sees fit. The case of **Cutts v Head** [1984] Ch 2 90 is an extreme example of this. But once a decision is given, I understand the position to be that a court or tribunal should not, save perhaps in very exceptional circumstances, allow the matter to be re-argued

Mr Gracey contended in correspondence that there were three matters in my decision which ought to be corrected. First, in paragraph 12 he contended that the second sentence was incorrect. In that sentence I recited that he had told me in the course of the hearing that he had been involved in over 1,000 trade mark matters. Mr Gracey tells me today that is incorrect. I have had the opportunity since rendering the decision of seeing a shorthand note of the hearing and it does not record the figure of 1,000 which I thought I had heard. Mr Gracey has told me today that a more accurate figure is of the order of 80. That change does not alter the substance of my conclusion that Mr Gracey is not a stranger to the trade marks system, which was the substance of the comment in paragraph 12.

Secondly, he referred me to paragraph 25 of my decision which relates to an issue which arose in the registry as to the capacity of a Ms Fiona Dodds to notarise certain affidavits. Nothing that Mr Gracey has said today causes me to conclude that the recitation of facts in paragraph 25 was other than accurate.

The third matter he raised was in paragraph 38 which, now he has had the opportunity to see

the transcript, he does not wish to pursue.

In substance therefore it is his concern about the reference to 1000 matters when the figure should be 80. Plainly the correction to that does not amount to having the matter re-argued. The error is perhaps an indication of the hazards of holding hearings on a conference phone. Whilst there are undoubtedly benefits in terms of costs and time in using the telephone, the scope for misunderstanding is increased. I therefore direct that my decision of 6 December be read in conjunction with this decision so that paragraph 12 is set in its correct light.

I turn now to the question of costs. Mr Gracey's submission that an award of costs should be made against either the applicants or the registry or both is founded primarily, as I understand it, on his dissatisfaction with the way in which his complaint about the form TM33, which was filed in these proceedings, was dealt with subsequent to his lodging of a form TM5.

This is referred to as part of the narrative in paragraph 18 of my decision. I have no doubt that Mr Gracey feels hard done by the course of events relating to the TM33. The form TM33 and its provenance may or may not have relevance in the substantive issues in the opposition. I make absolutely no observations on that at all.

The plain fact however is that the debate about the form TM33 has no relevance whatever to the issue which I had to decide at the hearing in December, and what was the subject of my decision of 6 December. The sole question I had to decide was whether or not Mr Attfield had power to issue the decision he did and I concluded that he did not. In my decision it was only necessary to recite the history of the matter, including the history relating to the TM33, in order to put into perspective the circumstances in which that decision was made.

My job is to exercise my discretion on the question of costs of that appeal. Mr Gracey has not presented any argument before me today with regard to what I perceive to be a fundamental obstacle in his path. In issuing his decision, Mr Attfield was acting in a judicial capacity. In my judgment, as appears from my decision, he acted in error, but I know of no authority for inflicting an order for costs against a person acting in a judicial or quasi-judicial position in

circumstances where a superior court reverses that decision.

Mr Gracey's submission related to the conduct of other officers in the registry in dealing with the form TM33 matter. That is irrelevant to the question of the appeal and the payment of costs on this appeal. I am satisfied that it would be wrong in principal for me to make any order against the registry in relation to this appeal and I do not propose to do so.

So far as concerns the applicants, as I set out in my decision, they have played but a small part in this appeal. They raised a question under Rule 57 and in paragraphs 53 of my decision I drew attention to that. Mr Gracey today has addressed his submissions with regard to the position of the applicants, again, with reference to the form TM33 debate.

For similar reasons, I do not believe that I am entitled to take that conduct, whatever it may have been, into account in reaching my decision on costs in this appeal. I have reflected upon the matters set out in my decision, which set out a provisional view as to costs. I have considered carefully whether it would be right to penalise the applicants for having raised the question under Rule 57 by making an award of costs against them in circumstances where, in substance, the appeal is one that has been carried out by Mr Gracey in the absence of representation by the applicants.

In the final event, I believe that the correct exercise of my discretion, to ensure that justice is properly done here is to decline to make any award of costs in favour of either party. I therefore propose that the appeal should be allowed, but there should be no award as to costs.

There are two additional matters I should deal with. First, in his written submissions Mr Gracey contended that the question of costs might be different because Mr Knight of the registry had appeared at the hearing of the appeal. Mr Knight appeared at my invitation and with Mr Gracey's consent to address me on registry procedure. There is, I believe, no objection to a tribunal such as this being addressed either by an officer from the registry or by counsel acting, as it were, as an amicus so as to assist the tribunal. That is what occurred here. It is not a matter which should give rise to an award of costs either in favour of the

registry or against them.

The final matter. Mr Gracey raised in his original statement of grounds of appeal, and has pursued before me today, the suggestion that I should make an order that Mr Attfield's decision, having been set aside, should be withheld or removed from publication on the Internet. I am not persuaded that this is a matter within my power and certainly I do not believe it is appropriate. Inherent in the giving of any decision, which is possibly the subject of appeal, is the possibility that on appeal it will be held to be wrong. This does not prevent the earlier decision being reported and published. It is a fact that the second decision, the decision of the appellant tribunal, sets aside the earlier decision and therefore renders the decision without effect. I cannot by any act of mind make the decision not to have been made. As a matter of fact, it was made and I see no objection to it remaining in existence even if I have the power to direct that it should not be. I am therefore not able to accede to that request by Mr Gracey.

That is the end of my decision. An order will be drawn up, Mr Gracey, in the usual way and will be made available to you by Mr Prior.

2 MARCH 2000

Mr Gracey spoke on his own behalf as registered proprietor via a telephone link
The applicants for revocation did not attend