

1 THE PATENT OFFICE

Court 3
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

2
3 *M. M. Knight*

4 Thursday, 10th August, 2000

5 Before:

6 THE REGISTRAR'S PRINCIPAL HEARING OFFICER
7 (Mr. M. Knight)

8 (Sitting for the Comptroller-General of Patents etc.)

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10 In the Matter of the Trade Marks Act 1994

11 and

12 In the Matter of Trade Mark Application No.
1226399 in the name of THE GILLETTE
13 COMPANY

and

14 In the Matter of Revocation thereto by
15 NICHOLAS DYNES GRACEY under Revocation
16 No. 11654

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18 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
19 Midway House, 27/29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-7405-5010. Fax No: 020-7405-5026)

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21 MR. SIMON AYRTON (Messrs. Bristows) appeared on behalf of
the Registered Proprietor.

22 The Applicant for Revocation did not appear and
23 was not represented.

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25 D E C I S I O N
(As approved)

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1 THE HEARING OFFICER: This is in the matter of revocation number
2 11654 where the registered proprietor is The Gillette Company
3 and the applicant for revocation is Mr. Nicholas Dynes Gracey.
4 This application for revocation was filed on 6 June, 2000. In
5 addition we have a set of opposition proceedings between the
6 same parties. The opposition number is 49435. In that case
7 the applicant for registration is Mr. Nicholas Dynes Gracey
8 and the opponent is The Gillette Company.

9 The purpose of the hearing today is to consider a number
10 of requests from Mr. Nicholas Dynes Gracey in relation to both
11 sets of proceedings. However, the first matter I need to deal
12 with is the appointment of the hearing itself.

13 This morning before me the opponent and registered
14 proprietor is represented by Mr. Ayrton of Bristows. The
15 applicant for registration and the applicant for revocation,
16 Mr. Nicholas Dynes Gracey, is not present or represented, and
17 has not provided any written submissions in terms of the
18 substantive issues.

19 The background to Mr. Nicholas Dynes Gracey's
20 non-appearance seems to be as follows. He was notified by the
21 Trade Marks Registry on 26 July, 2000 of the date for this
22 hearing, at the same time as the other side to the dispute
23 were informed. Bristows were informed of the date by means of
24 the Post Office's special delivery service which guarantees
25 next day delivery and is also a trackable service to ensure
26 that the Trade Marks Registry is aware that the notification
does go to the parties within the 14 days allowed by the rules

1 as a minimum period of time for the notification of a hearing
2 date. This is a service used by the Trade Marks Registry's
3 law section to notify all parties of the dates of hearings.

4 In the case of Mr. Nicholas Dynes Gracey, the
5 notification was sent by first class mail. It was sent by
6 first class mail, I understand, because Mr. Nicholas Dynes
7 Gracey does not accept any post_ which requires a signature,
8 which the Post Office's special delivery service does. As a
9 concession therefore to Mr. Nicholas Dynes Gracey, who is
10 involved in a number of proceedings before the Registrar, the
11 Trade Marks Registry's law section sends out notifications of
12 hearings, and indeed all notifications to Mr. Nicholas Dynes
13 Gracey, by first class mail. Clearly this particular service
14 for Mr. Nicholas Dynes Gracey carries some risks, but the
15 alternative notification in the usual way by Post Office
16 special delivery would mean that he may not receive any
17 notifications, in particular notifications of hearing dates,
18 at all. However, I regard the risk of non-notification within
19 the prescribed 14-day period (Rule 48(2) of the Trade Marks
20 Rules 2000) as one that accrues to him out of his choice not
21 to receive Post Office special deliveries.

22 In this particular case the notification was despatched,
23 as I have said, on 26 July, 2000 by the Trade Marks Registry,
24 and Mr. Nicholas Dynes Gracey has stated that he received it
25 on 28 July, 2000. In my view, the period between 28 July and
26 August 10, the date for which the hearing was fixed, amounts
to 14 days on an inclusive basis. Had the notification gone

1 to Mr. Nicholas Dynes Gracey by the usual means, i.e. by Post
2 Office special delivery, then it would have been delivered to
3 him on 27 July (the date on which it was received by Bristows
4 on behalf of the other side) and it would have provided 14
5 days' notice clear.

6 I do not regard the fact that his receiving the notice
7 one day after the other side to this dispute nullifies the
8 notification that was sent to Mr. Dynes Gracey. As I have
9 indicated earlier, the risk attached to not receiving mail by
10 the usual method is one which Mr. Nicholas Dynes Gracey must
11 bear. It would be outwith the scope of the rules, and in
12 particular the spirit of proportionality behind procedures
13 following Lord Woolf's report, for the Trade Marks Registry to
14 take action in relation to Mr. Nicholas Dynes Gracey by
15 advancing dates in order to cater for his particular
16 requirements.

17 In the circumstances, I do not regard the fact that he
18 believes that he did not have the required 14 days' notice as
19 sufficient reason for him not to appear today, and make
20 submissions (written or oral) and therefore this hearing he
21 requested goes ahead.

22 I should add that in the course of what might be termed
23 correspondence between Mr. Nicholas Dynes Gracey and the Trade
24 Marks Registry, he did ask for this hearing to be postponed.
25 However, the answer he got from the Trade Marks Registry was a
26 resounding "no". This was because in the Trade Marks
Registry's letter of 26 July there was a paragraph, which is a

1 standard paragraph, going to all parties who are invited to be
2 heard, and this stated as follows: "Please note that the
3 Registrar will only consider changing the hearing date if the
4 parties submit an alternative date agreed between them which
5 is convenient to the Registrar, provided the request is made
6 within a convenient time scale. The venue may be changed on
7 the same basis. Please confirm your attendance within one
8 week of the date of this letter."

9 I have confirmed today with Bristows that there was no
10 approach from Mr. Nicholas Dynes Gracey to them on the basis
11 of an agreed alternative date to be put to the Trade Marks
12 Registry, and therefore I think the Trade Marks Registry was
13 right to dismiss the request for postponement on that basis.

14 Mr. Nicholas Dynes Gracey has also been in touch, I
15 understand, with the Trade Marks Registry this morning, the
16 day of the hearing, asking if a telephone conference was to be
17 arranged in the usual way. He was given the answer "no",
18 because the letter of 26 July, 2000 indicated that the hearing
19 would take place in London and there had been no request from
20 either side, bearing in mind the paragraph in the letter set
21 out earlier, for a change of venue or a change in the way in
22 which the hearing should take place. Therefore I do not
23 regard this last-minute approach for an alternative
24 arrangement to be one which it would have been reasonable to
25 accede to.

26 In summary therefore, I believe that Mr. Nicholas Dynes
Gracey was, in all of the circumstances attaching to his

1 particular needs, advised within an appropriate time scale,
2 and indeed within the 14 days set out in rule 48(2), in terms
3 of a date for this hearing. It is not unreasonable therefore
4 for the hearing to continue on the basis of a careful study on
5 my part of all of the papers provided by the respective
6 parties to the proceedings directed to the issues involved,
7 and that includes a skeleton argument by the opponents and the
8 registered proprietors.

9 I will deal then with the application for revocation and
10 the statement of case presented by Mr. Nicholas Dynes Gracey
11 in these proceedings.

12 As I said earlier, this is an application for revocation
13 by Mr. Nicholas Dynes Gracey in relation to a trade mark, No.
14 1226399, which is one of the trade marks on which The Gillette
15 Company are basing their opposition to the registration of
16 Mr. Nicholas Dynes Gracey's application. That particular
17 application for revocation was filed on 6 June and had
18 attached to it a statement of case. That statement of case
19 was not considered by the case officer in the Trade Marks
20 Registry's law section as being a sufficiently clear statement
21 of the case on which the action was based to allow the
22 proceedings to commence.

23 In her letter of 8 June, 2000 to Mr. Nicholas Dynes
24 Gracey, which was copied to Gillette Management Inc., a number
25 of deficiencies in that statement of case were highlighted by
26 the case officer. Mr. Nicholas Dynes Gracey has
communicated to the Trade Marks Registry a response to that

1 letter seeking a hearing on the matter because in essence he
2 considers that the statements made in that letter are
3 sufficiently clear to indicate to the registered proprietor
4 the basis on which the action is to take place.

5 It might be helpful if as background I set out where I
6 think the Trade Marks Registry is coming from in its current
7 practice of examination of proceedings. There have been a
8 number of reported cases, the principal ones being **Julian**
9 **Higgins' Trade Mark Application**, **Club Europe Trade Mark**, and
10 **Demon Ale Trade Mark**, all of which appear in [2000] RPC from
11 page 321 onwards, where the Trade Marks Registry were
12 criticised for allowing pleadings to be run by parties which
13 did not focus on the issues involved.

14 Additionally there has been a decision by the Appointed
15 Person, Mr. Simon Thorley, in **Coffeemix** [1998] RPC 17 which
16 set out what pleadings ought to contain, which in essence are
17 the facts on which the action has been brought. Bearing that
18 in mind, it seems to me that the statement of case provided by
19 Mr. Nicholas Dynes Gracey in support of his application for
20 revocation on the grounds of non-use does leave a great deal
21 to be desired. A copy of the statement of case is attached to
22 this decision, and the paragraphs I refer to later are the
23 paragraph numbers of that statement of case.

24 It could be said that there is no provision within the
25 Trade Marks Act 1994, or indeed the Trade Marks Rules 1994,
26 for the Trade Marks Registry to interfere with the pleadings
provided by parties to disputes before the Registrar.

1 Certainly the Civil Procedure Rules have no part to play in
2 proceedings before the Registrar. That is not my statement,
3 that is one by Ferris J. in the *St. Trudo* case [1995] FSR 345.

4 However, in a very recent case before Pumfrey J., this
5 was in the matter of International Application No. 649830 by
6 *Pharmedica GMBH* and opposition thereto by *Dalgety Holland BV*
7 [2000] RPC 536 it was held: "Notwithstanding the fact that
8 the Registrar is, like the County Court, a tribunal which is
9 established by statute, I have no doubt that the Registrar has
10 the power to regulate the procedure before her in such a way
11 that she neither creates a substantial jurisdiction where none
12 existed, nor exercises that power in a manner inconsistent
13 with the express provisions conferring jurisdiction upon her.

14 I consider that these propositions follow from what Lord
15 Donaldson of Lynton, Master of the Rolls, said in *Langley's*
16 case at page 613. 'Although there is no statutory authority
17 for making local practice directions, none is needed because
18 every court has inherent jurisdiction to regulate its own
19 procedures, save in so far as any such direction is
20 inconsistent with statute law or statutory rules of court. It
21 is no doubt for this reason that CCR Ord 50, r 1 empowers the
22 Lord Chancellor to "issue directions for the purpose of
23 securing uniformity of practice in the county courts".'

24 It is to be observed that there is no distinction, for
25 these purposes, between the jurisdiction of the County Court
26 (which is entirely statutory) and that of the Registrar of
Trade Marks (which is also entirely statutory)."

1 Taking that judgment into account, it seems to me that no
2 further authority is required for the Registrar to intervene
3 in the matter of a statement of case in order to produce the
4 desired result, i.e. statements of case that set out what the
5 particular action is concerned with and the facts upon which
6 the action is based.

7 Bearing that in mind, I turn to the statement of case
8 submitted by Mr. Nicholas Dynes Gracey. As far as I can see,
9 paragraph 1 consists of information which has little to do
10 with the application for revocation. I therefore direct that
11 the whole of this paragraph should be struck out, with the
12 exception of the last one and a half lines, and that paragraph
13 will then read: "Trade Mark 1226399 should be revoked for
14 non-use in the period five years prior to Thursday, 1 May,
15 1997, the date of application for Trade Mark No. 2137569."

16 As far as I am concerned, paragraph 2 of the statement of
17 case consists of Mr. Nicholas Dynes Gracey's view of a matter
18 and is not relevant and should therefore be struck out;
19 similarly paragraphs 3 and 4. Paragraph 5 remains because it
20 is simply seeking an award for costs in favour of the
21 applicant for revocation.

22 The registered proprietor in the case of this revocation
23 action has not yet, as far as I am aware, been formally served
24 the Form TM26, although they have received a copy of the
25 statement of case. In those circumstances, the Trade Marks
26 Registry will, as soon as practicable after the issue of this
decision, send to them a copy of the TM26 together with the

1 statement of case with the offending lines or paragraphs
2 deleted, and from a date then to be determined by the sender
3 of that Form TM26 they will have three months in which to file
4 their counter statement and evidence of use of the trade mark
5 in suit. Thereafter the proceedings will continue in
6 accordance with rule 31 of the Trade Marks Rules 2000.

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STATEMENT OF CASE:-

(1) 21 'agreements' expressed in the Opponent's Exhibit 'AJR 5' in Opposition proceedings Opp.49,435 still leaves in question the validity of Opponent's TM 1,226,399 (single heart), so my 'Applicant' desire (re TM 2,137,569) is to rely upon my TUE.11.MAY.99 Counterstatement / 'Affidavit' and Oral Evidence at the Substantive Hearing, in relation to the arguments raised in that TUE.11.MAY.99 Testimony - but to do so it is now being formally alleged by way of the accompanying Form TM26(N) that TM 1,226,399 should be revoked for non-use in the period 5 years prior to THU.01.MAY.97 (the date of application for TM 2,137,569);

(2) In my opinion, it was in the Registered Proprietor's interest to fulfil my requests for further and/or better information (TM Rule 57 & CPR Part 18) following receipt of my TUE.11.MAY.99 Counterstatement in the Opp.49,435 proceedings (ie over a year ago) because such conduct would have been a reasonable way to reduce costs and time spent on this matter (CPR Part 44);

(3) Following the Registered Proprietor's declaring the new position on questions relating to TM 1,226,399 revocation - then an opportunity should be given for my filing of evidence in relation to Opp.49,435;

(4) The Registrar's previous 'presumption of validity' of TM 1,226,399 is accepted, but my counterstatement / counterclaim to Opp.49,435 is that TM 1,226,399 is an invalid TM and in those circumstances, which raise ...'a question'... as to use and validity, then under the TM Act 1994 the Registered Proprietor should attempt to provide evidence of use of TM 1,226,399 within the specified 5 year period, having particular regard for section 46(5) & section 100.

(5) In relation to the Registered Proprietor's conduct since the offer made via paragraph #3 of my WED.03.FEB.99 letter to the Registrar - an award of costs is requested in my favour in addition to the £200 fee for filing the Form TM26(N).

Nicholas Gracey ©20:28/09

STATEMENT OF TRUTH: My belief is that the facts stated in this communication are true...

TUE.06.JUN.00

NICHOLAS DYNES GRACEY