

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**-and-**

**IN THE MATTER OF REGISTRATION NO. 2180562 in the name of HARRY  
MUNRO SINGER**

**For the mark 'CHINGGIS KHAN'**

**-and-**

**IN THE MATTER OF APPLICATION FOR REVOCATION NO. 83913 BY APU  
JOINT STOCK COMPANY**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MS. JUDI  
PIKE, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF  
TRADE MARKS DATED 16<sup>TH</sup> JANUARY 2012**

**DECISION**

1. This is an appeal by Mr Harry Singer, registered proprietor of trade mark 2180562. The mark consists of the words CHINGGIS KHAN, registered in relation to alcoholic beverages (except beers) in class 33. An application to revoke the mark on the grounds of non-use was made by APU Joint Stock Company ("APU"). By a Decision dated 16 January 2012, the registration was revoked by order of the Hearing Officer Ms Judi Pike.

2. For reasons which will become clear, it is necessary to set out the procedural history of the application to revoke.
3. The application was made by APU by way of Form 26N filed on 19 November 2010. 2 periods of non-use were relied on (under s46(1)(a) and 46(1)(b)). APU acted through trade mark attorneys Fry Heath and Spence. Mr Singer chose to act in person. He filed his TM8(N), counterstatement and evidence of use on 24 January 2011. The Registry refused to accept it on the basis that a separate witness statement was required. Mr Singer rectified this defect on 5 April 2011 and the documents were then accepted. Directions for further evidence and submissions were given on 21 April 2011.
4. Both parties filed evidence and the Registry issued what I take to be their standard letter in such cases on 26 August 2011. This gives a straight choice to the parties as to whether to have the matter decided on the papers following written submissions, or whether to request an oral hearing. The letter includes the statement that 'If there is to be cross-examination a hearing will of course be necessary. Any request for cross-examination must be made at the same time as requesting a hearing.'
5. On 2 September 2011, APU (through its agents, Fry Heath and Spence) wrote to the Registry in relation to Mr Singer's reply evidence. They wished permission to submit further evidence under Rule 38(8) and permission to cross-examine Mr Singer. The Registry replied on 19 October 2011, asking which issues were intended to be covered by the new evidence and asking for reasons why Mr Singer needed to be cross-examined. On 2 November 2011, APU responded, dealing with these points. They also sought permission to amend form TM26N to add a third period of non-use.
6. On 24 November 2011, the Registry responded to Fry Heath and Spence in a letter copied to Mr Singer. The letter is set out in full below:

*Thank you for your letter of 2 November 2011. The Hearing Officer has reviewed all the evidence and is mindful of the requirement to deal with cases in ways which are proportionate to the complexity of the issues. Accordingly, in this case, both parties should now file written submissions as to whether the registered proprietor has proven genuine use (or proper reasons for non-use). On the basis of the pleadings and the evidence, the Hearing Officer does not feel that there will be benefit in the case being heard orally, although the parties retain the right to be heard.*

*If the Hearing Officer finds that the registered proprietor has not met the burden placed on him to prove genuine use (or proper reasons for non-use) then the question of further evidence and cross-examination (and amendment to the pleadings) will fall away because the revocation action will have succeeded and a written decision will follow. However, upon receipt of the parties' written submissions, should the Hearing Officer consider that the registered proprietor has an arguable case, then the question of further evidence and cross-examination and amendment to the pleadings can be revisited at that point and the appropriate directions made at a Case Management Conference.*

*Written submission must be filed on or before 22 December 2011.*

7. Written submissions were duly filed. By a Decision dated 16 January, the Hearing Officer found that there had not been genuine use of the mark in either of the two periods relied on and revoked the mark as from 24 April 2004.
8. Mr Singer duly appealed to the Appointed Person and the matter came before me at a hearing attended by Mr Edenborough QC acting for APU and Mr Singer in person.

9. I made it clear at the outset of the hearing my preliminary view that the procedure adopted in this case by the Hearing Officer was fundamentally flawed and procedurally unfair to Mr Singer. I should make it clear here as I did at the hearing that I make no criticism at all of APU or their representatives, who have acted entirely properly. Indeed, Mr Edenborough QC very fairly accepted at the outset of the hearing that the procedure adopted by the Hearing Officer was 'unusual' and ultimately did not actively disagree with my preliminary view. In the end, the parties were content that I should set aside the Decision of the Hearing Officer and remit the matter to the Registry with no order as to costs.
  
10. I set out below the reasons why I consider that the procedure leading up to the making of the Decision was flawed and unfair and that the Decision should be set aside for that reason.
  
11. Mr Edenborough QC was certainly correct to characterize the course taken in the present case as unusual. The Hearing Officer was faced with a case in which the procedural steps were not complete. Although the ordinary rounds of pleadings and evidence had finished, the Applicant had made a formal application both to file further evidence and to cross-examine the Respondent. This application clearly needed to be disposed of before a final determination of the Application to revoke could be made.
  
12. The Hearing Officer, clearly with saving costs and time in mind, seems to have decided to try to cut short this process on the basis that, if the Application to revoke was going to succeed anyway, there was no point in the Applicant serving any further evidence or cross-examining the Respondent. So she took it on herself to make a final decision on the Application to revoke without considering the pending application at all. Whilst one can understand her motives, the decision to proceed in this was (with respect) a fundamentally bad idea.

13. Assume she found (as she did) for the Applicant and revoked the mark. Further assume that the matter was then appealed to the Appointed Person and her decision was overturned. The Applicant would then be prejudiced by not having had the opportunity to file its further evidence or to cross-examine the Respondent, and it would be too late to do anything about it. Mr Edenborough had wrestled with this problem in his skeleton argument before me, and suggested that the Decision was in fact only an 'interlocutory decision on a preliminary issue' and not a final decision (relying on the 24 November letter). Thus, he submitted, I could never have been in a position to find in Mr Singer's favour and dismiss the application to revoke. The problem with this is that the issue which has been decided is not a 'preliminary' issue. It is the only issue – namely whether the mark should be revoked for non-use.
14. Furthermore, the approach set out in the 24 November letter carries with it the strong risk of ending up with two determinations of the matter. The first without the new evidence and cross-examination, and the second with the new evidence and cross-examination. Not only would this be extremely wasteful, what would the status of the first decision actually be in those circumstances? Would the parties be able to argue the same points on the old evidence and pleadings all over again?
15. The fact that the process adopted by the Hearing Officer was unwise would not in itself amount to procedural unfairness. However, the letter of 24 November, seeking to explain the process to the parties, was entirely inconsistent and confusing as to the nature of the determination which the Hearing Officer was intending to make.
16. Most of the letter of 24 November is consistent with an intention to make a final decision one way or the other on the evidence as it stands as to whether Mr Singer has 'proven' his case of use. However, suddenly in the second paragraph it suggests that the question talks in terms of whether Mr Singer had shown an 'arguable case'.

17. These are quite different concepts. The latter is consistent with some kind of summary judgment process, which, if favourable to Mr Singer, would lead to another hearing but which would only be unfavourable to Mr Singer if the Hearing Officer judged his case to have no reasonable chance of success. However, there is no sign of that test being applied in the Decision itself. This does not approach the matter on the basis of 'arguable case' at all.
18. This blatant ambiguity alone is in my view a fundamental procedural unfairness requiring the Decision to be overturned. One can imagine that a litigant in person in the position of Mr Singer receiving this letter might well be very confident that he had got over the hurdle of an 'arguable case' (particularly since the Registry had accepted his Form TM8 and its associated evidence) and decide on that basis not to request a request a hearing. He might take a different view if he realized that a final determination on the question of use was going to be made.
19. There is another issue which also gives me great concern, namely the encouragement given in the letter of 24 November 2011 for the parties not to seek an oral hearing.
20. The starting point here is that this is not a straightforward case. On Mr Singer's evidence as it stands, he had a genuine business interest in importing vodka into the UK bearing the mark, and had made attempts to do so. He had attended annual major exhibitions seeking to promote the brand. His evidence is that he was thwarted in his desire to actually bring the vodka into the UK by the inadequacies of the Applicant. It is notorious that 'small scale' or 'preparatory' use cases are legally and factually difficult.. When such cases are further complicated by a complaint that there would have been greater use had it not been for problems beyond the control of the proprietor, they can be thorny indeed.

21. In Hypnotiser I expressed some views in a very different context about how litigants in person should be treated in trade mark proceedings. I would expand on those views here. Where it is apparent that the case is a difficult one both in terms of the underlying facts and in the application of the facts to the law, the Registry should not in my view encourage litigants in person to have their cases decided without a hearing. The Hearing Officer in such a case cannot be certain that all arguments have been fully understood by the litigant, or that the case which has been presented is complete and clear.
22. Furthermore, I believe that it is bad practice for the same Hearing Officer who is about to decide the case to write (or direct the writing of) a letter of giving such encouragement. It gives rise to serious risk of perceived unfairness if the Hearing Officer then decides against the litigant in person.
23. The letter in this case was explicitly written after a consideration of the evidence and the pleadings by the very Hearing Officer who was going to decide the case. It is perfectly reasonable for the litigant to think in these circumstances 'She must have known that she was going to decide against me before she wrote the letter encouraging me not to turn up.' This tends to lead to a feeling that justice has not been done.
24. Finally on this point, the Decision itself illustrates the danger of deciding difficult cases like this involving a litigant in person without a hearing. In para 22 the Hearing Officer recognizes the point being made by Mr Singer that he was unable to exploit the mark as he would like because of production difficulties in Outer Mongolia caused by the Applicant. She says as follows:

*'The hearsay evidence from the three individuals does no more than point to the same picture that Mr Singer has drawn in his evidence, which is of sporadic, intermittent and frustrated attempts at importing vodka to sell in*

*the UK. There were supply obstacles all the way through; the position does not appear to have changed between 1999 and 2010. Proper reasons for non-use has not been pleaded as a defence in the counterstatement. Mr Singer has consistently maintained as his defence that the mark has been used/promoted. Mr Singer is a litigant in person but it would be wrong for me to introduce a point that he himself has not taken and to do so would be protagonistic and contrary to the neutral nature of a tribunal.'*

The Hearing Officer cites in relation to the last sentence my Decision in Hypnotizer O/115/10. However, I note than in Hypnotizer, paras 17-18 I drew the important distinction between cases where a litigant in person is present at an oral hearing and cases where he or she is not. In the former case, I said this [para 17]:

*'In the usual case, where the litigant in person is present at the hearing, the tribunal will explore with him or her in the course of argument the precise ambit of the submissions being made, and may take the opportunity to explain elements of the relevant law on the issue. A new point or even a new ground of appeal may be identified in the course of such discussion which the litigant had not previously relied on, and the litigant may then decide for himself whether to seek to pursue it. This is entirely legitimate and the fact that the point was only identified in the course of discussion with the tribunal is not a problem in itself, provided that the opponent is properly protected against being taken by surprise (potentially by an adjournment).*

I went on in para 18 to explain that this was not possible where the litigant in person was not present because it would amount to the tribunal acting on behalf of the litigant.

25. This highlights the danger of the Hearing Officer encouraging litigants in person not to request a hearing. In the present case, a potential 'proper reasons for non-use' argument was identified by the Hearing Officer but was rejected on a pleading point. The litigant in person would have had



the opportunity to seek to amend if this had been raised at a hearing. Whether or not this application would have succeeded, the result is that he has been procedurally prejudiced by not electing for an oral hearing – a decision which he was encouraged to come to by the tribunal itself. This kind of thing tends to reduce confidence in the legal process.

26. I therefore consider that it was unfair procedurally in the circumstances for the Hearing Officer to have encouraged the litigant in person not to have an oral hearing.

27. In all the circumstances I have decided to set aside the Decision of the Hearing Officer on the ground that the defects highlighted above were inconsistent with the right to a fair trial and/or were breaches of natural justice. I will direct that the matter be remitted to the Registry. Mr Singer has indicated before me that he wishes to apply to amend to introduce the question of 'proper reasons for non-use'. Mr Edenborough QC will wish to pursue his applications for further evidence, an amendment of his pleading and the right to cross-examine Mr Singer. Those applications should be considered and the Registry should then give directions for the final determination of this matter. I would recommend that the matter be allocated to a different Hearing Officer. I have made no order as to costs since the fault here did not lie with either of the parties.

28. I would conclude by making the following general comments which arise from this case:

(a) It is not appropriate to short-cut a procedural application for further evidence, amendment of pleadings or cross-examination by deciding the entire case on the merits. If an application of that kind has been made, it should be dealt with before deciding the case.

(b) There is no procedure by which the Registry, having accepted the TM8, Counterstatement and evidence of use, can later of its own

motion decide to take to make some form of 'summary determination' or 'strike out' of the Counterstatement on the basis that the evidence filed in support does not show an 'arguable case'.

(c) Any correspondence with the parties about a proposed decision should be clear as to the nature of that decision, and in particular should not confuse final determination with the question of whether there is an 'arguable case'.

(d) The Registry should consider whether it is ever appropriate for the Hearing Officer who is about to decide an Application to express views as to whether the parties should take advantage of their right to an oral hearing. I do not know whether this is common practice, but in my view it should not happen. It certainly should not happen (as in this case) where one of the parties is a litigant in person or (again as in this case) before seeing the parties' written submissions, and therefore before it is clear that the case has been adequately presented.

(e) If views are to be expressed by the Registry as to whether there should be an oral hearing, they should take into account whether the parties are legally represented. Where one side in a dispute is a litigant in person, there are likely to be good reasons for having an oral hearing before deciding the ultimate question in dispute.

**IAIN PURVIS QC**  
**THE APPOINTED PERSON**  
**19 September 2012**