

1 THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London EC48DP.

2
3
4 Tuesday, 21st March 2006

5 Before:

6 MR. G. HOBBS QC
7 (The Appointed Person)

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9 In the matter of THE TRADE MARKS ACT, 1994.

10 and

11 In the matter of Trade Mark Application No. 216526 by
12 Nicholas Dynes Gracey (now registered and
13 assigned to Colin Theodore Gracey and
14 Elizabeth Gracey)

15 and

16 In the matter of Opposition No. 95052 thereto by Hi Tec
17 Sports Plc (now withdrawn)

18 - - - - -

19 Appeal of the Applicant from the
20 Decision of Mrs. A. Corbett

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22 (Transcript of the Stenograph Notes of Marten Walsh Cherer
23 Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.
24 Telephone No: 020-74055010 Fax No: 020-74055026)

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MR. NICHOLAS DYNES GRACEY (the Applicant) appeared by telephone
conference.

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APPROVED DECISION

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1 THE APPOINTED PERSON: On 12th January 1998 Mr. Nicholas Dynes
2 Gracey applied under No. 2160526 to register a series of six
3 signs as trade marks for use in relation to various goods and
4 services in Classes 3, 9, 16, 28 and 38.

5 The application was opposed by Hi Tec Sports plc on 13th
6 October 2003. The Applicant joined issue with the Opponent in
7 a counterstatement filed on 21st January 2004. The opposition
8 was subsequently resolved in the circumstances I shall now
9 describe.

10 In a fax letter of 13th April 2005 and in a form TM21
11 transmitted to the Trade Marks Registry on the same date, the
12 Applicant applied to restrict the scope of his application in
13 Class 9. In his letter, and by means of annotations to the
14 form TM21, he invited the Opponent to withdraw its opposition
15 on the basis that the amendments were sufficient to overcome
16 its objections to registration.

17 On 18th May 2005, the Opponent's representatives wrote
18 to the Trade Marks Registry confirming that they had been
19 instructed by the Opponent to withdraw the opposition. The
20 letter stated: "Both parties have agreed that they will meet
21 their own costs in respect of the opposition." Whether or not
22 the withdrawal of the opposition was precipitated by the
23 amendments proposed by the Applicant on 13th April, the effect
24 of the withdrawal of the opposition on these terms was to
25 bring the opposition to an end. That cleared the way for the

1 application to proceed to registration, which it duly did on
2 19th August 2005.

3 On 14th September 2005, according to Registry records,
4 the resulting registration was assigned in full to Colin
5 Theodore Gracey and Elizabeth Gracey.

6 During the pendency of the opposition, various disputes
7 arose in relation to matters of case management and the
8 procedural validity of certain aspects of the conduct of the
9 proceedings.

10 A hearing took place before Mr. C.J. Bowen, representing
11 the Registrar, on 14th April 2005, for the purpose of
12 determining a number of the matters in dispute. On 18th April
13 2005 the Applicant sent 36 pages of material to the Registry
14 by fax. This was intended for the Hearing Officer's
15 consideration. The Registry subsequently confirmed that he
16 had taken it into account. Mr. Bowen notified the parties of
17 his decisions in a five page letter of 4th May 2005. I do not
18 think his letter can have left the parties in any real doubt
19 as to the reasons why he had reached the decisions he did. In
20 numbered paragraph 16 of the letter he nevertheless followed
21 the usual Registry practice of stating and I quote: "This
22 letter does not contain a full statement of reasons for my
23 decisions. If either party wishes to appeal the decision they
24 should file a form TM5 requesting a statement of reasons,
25 together with the required fee (£100) within one month of the

1 date of this letter."

2 On 6th June 2005 the Applicant sent a letter to the
3 Registry by fax stating: "3. In respect of Section 6 and
4 Article 8 of the Human Rights Act 1998 and paragraph #16 of
5 your 5-page WED.04.MAY.2005 letter: (a) Please debit £100 from
6 deposit account D03027; and (b) Please provide a full
7 statement of reasons having regard for the issues documented
8 by my 36-page MON.18.APR.2005 fax [including page 36]."

9 The Registry responded on 10th June 2005, pointing out
10 that the opposition proceedings were concluded and stating
11 that: "... the registrar takes the view that the preparation
12 of a written statement of grounds on issues which have now
13 abated is neither necessary or appropriate."

14 The Applicant replied in a letter sent to the Registry
15 on 15th June 2005. In paragraph 3 of his letter he stated:
16 "3. In respect of Sections 6 to 9 and Article 8 of the Human
17 Rights Act 1998 and paragraph #16 of your 5-page
18 WED.04.MAY.2005 letter: (a) Please debit £100 from deposit
19 account D03027; and (b) Please provide a full statement of
20 reasons having regard for the issues documented by my 36-page
21 MON.18.APR.2005 fax [including page 36, especially paragraphs
22 #1.35 & #1.39]; and (c) In respect of Rule 62(2) of the Trade
23 Mark Rules 2000 and paragraph #1.38 of page 36 of my 36-page
24 MON.18.APR.2005 fax, please issue the full statement of
25 reasons, as requested above or appoint a telephone hearing

1 pursuant to Rule 54 of the Trade Mark Rules 2000."

2 On 5th July 2005 the Registry wrote to the Applicant
3 offering him a hearing as he had requested in paragraph 3 of
4 his letter under reply.

5 The hearing subsequently took place on 9th November 2005
6 before Mrs. Ann Corbett. The Applicant's requests for a full
7 statement of reasons were evidently based on the provisions of
8 Rule 62(2) of the Trade Marks Rules 2000. Rule 62 provides as
9 follows: "62. - (1) When, in any proceedings before her, the
10 registrar has made a decision, she shall send to each party to
11 the proceedings written notice of it, and for the purposes of
12 any appeal against that decision, subject to paragraph (2)
13 below, the date on which the notice is sent shall be taken to
14 be the date of the decision.

15 "(2) Where a statement of the reasons for the decision
16 is not included in the notice sent under paragraph (1) above,
17 any party may, within one month of the date on which the
18 notice was sent to him, request the registrar on form TM5 to
19 send him a statement of the reasons for the decision and upon
20 such request the registrar shall send such a statement; and
21 the date on which this statement is sent shall be deemed to be
22 the date of the registrar's decision for the purpose of any
23 appeal against it."

24 It appears to me that the requests made by the Applicant
25 were open to objection on two grounds.

1 First, the Applicant's requests were irregular for lack
2 of compliance with the requirement to apply on Form TM5 within
3 the prescribed period of one month for a full statement of
4 reasons, in accordance with Rule 62(2), or in accordance with
5 Rule 3(2) by the use of a replica of that form or of a form
6 which is acceptable to the registrar and contains the
7 information required by the form as published and complies
8 with any directions as to the use of such form. The
9 irregularity could not simply be ignored, for the reasons
10 noted in my decision in KML Invest AB's Trademark Application
11 [2004] RPC 47, 972. So far as I can see, no correction of the
12 irregularity was sought or obtained under Rule 66.

13 Second, the opposition proceedings had come to a
14 conclusion. The proceedings in which the decision letter of
15 4th May 2005 had been issued were past and closed and there
16 were, accordingly, no relevant proceedings in respect of which
17 the Applicant could any longer claim the status of a party for
18 the purposes of Rule 62. All in all, the Applicant's requests
19 for a full statement of reasons were liable, in my view, to be
20 regarded as inappropriate and unnecessary in the events which
21 had happened.

22 In her decision issued on 10th November 2005 following
23 the hearing on 9th November 2005, Mrs. Corbett rejected the
24 Applicant's requests. As I read her decision, she did so for
25 each of the two reasons I have identified above. In paragraph

1 15 of her decision she observed: "Mr. Gracey's requests for a
2 statement of reasons were not filed on Form TM5. Rule 3(2) of
3 the Trade Marks Rules provides that a requirement for use of a
4 published form is satisfied by use of 'either a replica of
5 that form or of a form which is acceptable to the registrar
6 and contains the information required by the form as published
7 and complies with any directions as to the use of such a
8 form'. None of the three requests filed by Mr. Gracey were
9 made on a published form TM5, nor were they made on a replica
10 of that form. They were made in faxed letters."

11 Her concluding observations, as stated in paragraphs 19
12 to 22 of her decision letter were as follows: "19. Mr. Gracey
13 submitted that in refusing to provide a statement of reasons,
14 the registrar was not only withholding his reasons for
15 reaching the decision he arrived at but was also infringing
16 his (Mr. Gracey's) human rights, including his right to an
17 education. As a tribunal, the registrar's role is to
18 adjudicate in disputes involving the registration of trade
19 marks. I do, however, agree with Mr. Gracey that it is a
20 principle of natural justice that parties should know the
21 reasons behind any particular decision. In my opinion, the
22 letter issued by Mr. Bowen following the hearing - a full five
23 pages - gave adequate information to enable both parties to
24 understand the basis for his decision and the consequences
25 thereof.

1 "20. Following the issue of Mr. Bowen's letter, the
2 opposition was withdrawn. The proceedings are no more. They
3 have ceased to be. Rule 62, which provides for the
4 preparation of a full statement of reasons, does so only in
5 the context of proceedings. Once the opposition was withdrawn
6 there were no longer any proceedings in train. The opponent
7 withdrew the opposition in a letter dated 18 May 2005.
8 Mr. Gracey's first request for a statement of reasons was made
9 on 6 June 2005. There were therefore no proceedings ongoing
10 when any of the requests for a statement of reasons were made.
11 Following withdrawal of the opposition the application
12 proceeded to registration. On 14 September 2005 an assignment
13 of the registration from Nicholas Dynes Gracey to Colin
14 Theodore Gracey and Elizabeth Gracey was recorded.

15 "21. Mr. Bowen gave an explanation for the decision he
16 reached following the interlocutory hearing. The proceedings
17 themselves have concluded and Mr. Nicholas Dynes Gracey has
18 assigned the registration to others. In view of these factors
19 and, taking into account the specific wording of rule 62 and
20 the overriding objective, I can see no justification for
21 allocating the registry's precious resources away from other,
22 live, cases and towards the preparation of a statement of
23 reasons in proceedings which no longer exist. I do not accept
24 that there is any breach of the Human Rights Act. It would
25 not, in my opinion, be proportionate or in any way further the

1 overriding objective, to prepare a full statement of reasons
2 of Mr. Bowen's decision.

3 "22. For these reasons my decision is to uphold the
4 preliminary view not to provide a full statement of reasons."

5 On 8th December 2005 the Applicant gave notice of appeal
6 to an Appointed Person under Section 76 of the 1994 Act. To
7 be more precise, he sent four notices of appeal to the
8 Registry by fax, these being successively timed at 22:56,
9 23:01, 23:57 and 23:59 on 8th December. He subsequently
10 confirmed that the relevant notice of appeal was the one timed
11 at 23:59. This is the notice of appeal which I have taken
12 into account. This maintained that the requests he had made
13 for a full statement of reasons in June 2005 were valid and
14 effective for the purposes of Rule 62. It also claimed
15 costs/damages/compensation/aggravated damages/special damages
16 against the Registrar for breach of his Convention rights
17 under the Human Rights Act 1998.

18 In relation to the latter claim, I refer to paragraphs
19 49 and 50 of my decision dated 23rd September 2002 In the
20 Matter of Application No. 80092 in the name of Hi Tec Sports
21 UK Limited for a declaration of invalidity in respect of Trade
22 Mark No. 2061071 in the name of Nicholas Dynes Gracey; and
23 paragraphs 28 to 30 of my decision dated 23rd September 2002
24 In the Matter of an Application by Nicholas Dynes Gracey for
25 rectification of procedural irregularity in relation to Trade

1 Mark Registration No. 2024326 in the name of MEATLOAF. For
2 the reasons given in those decisions, I consider the
3 Applicant's claim for compensation in the shape of costs and
4 damages to be unmaintainable on appeal to an Appointed Person
5 under Section 76 of the Trade Marks Act 1994.

6 In relation to the appeal based on the provisions of
7 Rule 62, I have listened with care to the arguments that the
8 Applicant has addressed to me. Those arguments included, to a
9 not insignificant degree, personal slurs and unparticularised
10 allegations of bias and lack of good faith against Registry
11 officials. I make it clear that, for the purposes of this
12 decision, I am not taking those accusations into account.

13 As to the remainder, I remain unpersuaded that
14 Mrs. Corbett was wrong to have arrived at the decision she
15 did. I consider that the Applicant's requests under Rule 62
16 were indeed liable to be rejected on each of the grounds I
17 have identified above. The principal ground for refusal was,
18 I think, the second of the two I have mentioned. I consider
19 that the hearing officer's decision in that regard was
20 correct.

21 I have thus far dealt with the appeal as a matter of
22 interpretation of the rules. If and in so far as it would be
23 necessary or appropriate to deal with the matter as a matter
24 of discretion, I would simply express the view that I see no
25 reason why any such discretion should not have been exercised

1 in the way in which it was by the Hearing Officer.

2 For these reasons, shortly stated, the appeal is
3 dismissed.

4 Is there anything more you would like to say?

5 I believe there is no question of costs arising on this
6 appeal.

7 MR. GRACEY: In terms of potentially taking this to judicial
8 review, I would like you to address, or at least consider,
9 that I am having challenges finding anywhere in the decision
10 the issue about the fact that the document of 6th June arrived
11 on the Saturday -- sorry, arrived on a Monday -- and you have
12 actually made that your first point, but there still seems to
13 be zero basis of that. There is no mention of the words
14 Saturday or the fact that the 6th June one was late; whereas,
15 in the paragraph 20, it quite clearly states "Mr. Gracey's
16 first request for a statement of reasons was made on 6 June
17 2005."

18 So in so far as there is zero basis whatsoever for the
19 statements you have made in your decision, it seems, from my
20 point of view, that your decision is biased in itself.

21 THE APPOINTED PERSON: I believe that brings the proceedings to a
22 conclusion, Mr. Gracey.

23 MR. GRACEY: OK. I would conclude that I thank you for all your
24 time. I brought these proceedings in good faith myself. I
25 would say it is unfair to say it was a slur on Mrs. Corbett

1 because I have the highest regard for Mrs. Corbett as a human
2 being and everything I have brought in these proceedings was
3 in good faith.

4 The reason why I raised the issues in relation to
5 Mrs. Corbett was to support my arguments in relation to the
6 Human Rights Act 9(1)(a) and it would not have been possible
7 to raise issues about matters other than good faith without
8 drawing your attention to them. I was very careful to word
9 the matters that I raised about Mrs. Corbett of being other
10 than in good faith and without mentioning the word bad faith,
11 to avoid any allegation that I was making a slur against any
12 officers.

13 So again, to round up, I would say that I feel that it
14 is wrong that that word "slur" was used, in so far as the
15 transcripts should show the attempts that I made in terms of
16 language to avoid the term bad faith.

17 Thank you for your time and thank you especially to the
18 transcriber for, obviously, the time involved in the lengthy
19 submissions which were largely, I think, in me defending the
20 issues about the form of the TM5 and the fact that the matters
21 arrived on the Monday, when it was the Saturday it was due.

22 Again, all things aside, thank you for your time as a
23 human being and everything else. Have a good day.

24 THE APPOINTED PERSON: We will stop there, then.

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