

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
-and-
IN THE MATTER OF THE TRADE MARKS ACT 1994
-and-
IN THE MATTER OF
the TRADE MARK No. 1,301,046 for the word mark ACADEMY
REGISTERED in the name of TRITONSTYLE LIMITED
-and-
IN THE MATTER OF
AN APPLICATION FOR REVOCATION No. 9,214
by NICHOLAS DYNES GRACEY

DECISION

1. This is an appeal to the Appointed Person from a Decision of Mr. Salthouse dated 27th November 1998 arising out of an application for revocation made by Nicholas Dynes Gracey on 30th September 1996 under section 46(1) of the Trade Marks Act 1994. The mark the subject of the application is registered trade mark No. 1,301,146 in the name of Tritonstyle Limited and the ground of revocation was that there had been no genuine use of the mark for a period of more than 5 years.
2. The mark in question, ACADEMY, was registered as of 14th February 1987 in Class 25 in respect of articles of clothing. On 24th July 1996 Mr. Gracey applied for registration of a series of marks including the word ACADEMY in a wide variety of Classes including in Class 25 in respect of a specification of goods entitled "Clothing, footwear, headgear".
3. This application was reported to Tritonstyle by the Trade Marks Directory Service on 13th August 1996 and on 29th August 1996, Marks & Clerk, the agents acting for Tritonstyle, wrote to Mr. Gracey drawing his attention to the existence of registered trade mark No. 1301046. They requested that Mr. Gracey should withdraw his trade mark applications and refrain from using

the trade mark ACADEMY in relation to articles of clothing or other goods in Class 25. Although there was some attempt at correspondence between the parties, no resolution of the matter had been reached by 19th September when the form TM26 seeking revocation was completed and sent to the Registry.

4. As is set out in Mr. Salthouse's decision, the grounds stated were unusual but it is common ground that the application was made under section 46(1)(b) on the ground that there had been no genuine use of the mark in the United Kingdom by the proprietors or with their consent for a period of more than five years. Whilst there was a debate before Mr. Salthouse as to the precise dates of the five year period in question, nothing now turns on this and I was not asked to consider the correctness or otherwise of Mr. Salthouse's reasoning in relation to dates.
5. On 10th January 1997, Tritonstyle filed a Counterstatement denying all the allegations and, accepting that the burden was on them to prove use of the trade mark, (see section 100 of the Trade Marks Act 1994), proceeded to file evidence of use. This consisted, in the first instance, of a Statutory Declaration by Katherine Heather Dodd, the managing director of Tritonstyle, dated 6th January 1997.
6. The substantive part of this declaration reads as follows:
 2. *My company acquired the trade mark ACADEMY in 1987, and has used the mark extensively in the United Kingdom, and elsewhere, since that date. The trade mark has been used continuously by my company since its acquisition. That use has been in relation to a wide range (of) goods including articles of outer clothing such as jeans, jackets, shirts and T-shirts; articles of under-clothing, such as vests; articles of footwear, including boots and shoes; and articles of headgear including baseball caps. My company supplies sportswear, tracksuits and shellsuits under the*

trade mark and I can confirm that the mark has been used on a very wide range of garments, footwear and headgear during this period.

3. There is now produced and shown to me exhibit HD1 copies of invoices bearing the trade mark ACADEMY dated 1989 and 1996 which served to illustrate the sales made under the mark for the period. I confirm that sales have been continuous between the dates of the invoices shown in exhibit HD1.

4. There is now produced and shown to me marked Exhibit HD2 samples of my companies (sic) stationery including a compliments slip, a business card, an address label, an ACADEMY jeans badge, packing notes and order slips, all of which bear the trade mark ACADEMY and serve to illustrate the company's continuing use of the mark".

7. Exhibit HD1 consisted of a photocopy of an invoice dated 23rd May 1989 and an original copy of an invoice dated 10th December 1996. Exhibit HD2 consisted of original documents.
8. On 17th April 1997 Mr. Gracey sent to the Registry a document purporting to be an affidavit commenting upon this evidence. There was a debate before me as to whether the document was an affidavit, whether the witness was entitled to witness it and as to its status in these proceedings. Whilst I think it is entirely correct to say that a majority of the contents of the document are argument and not evidence and that it may be questionable as to whether the document had any status as an affidavit, I do not think that the parties were left in any doubt that Mr. Gracey was challenging the adequacy of the evidence filed by Tritonstyle.
9. Since I am aware that the question of whether or not a document in this form should be accepted by the Registry is the subject of debate in other

proceedings and since I do not believe it makes any difference for present purposes whether the document is an affidavit or merely submissions, I propose to make no further comment on this question in these proceedings save only to say this: that it is as important in proceedings before the Registry as in any other proceedings that a proper line is drawn between that which is truly evidence, which should be the subject of a properly prepared affidavit, statutory declaration or witness statement as the case may be, and submissions or arguments in relation to the matter in dispute which need not. To allow the two to be present in the same document is bound to lead to confusion and misunderstanding.

10. It is however apparent that Tritonstyle were under no misapprehension that Mr. Gracey was challenging the adequacy of their evidence since, on 27th May 1997, a second statutory declaration of Katherine Heather Dodd was filed. In paragraph 2 she exhibited as exhibit KHD1A a copy of an invoice dated 2nd May 1995 bearing the trade mark ACADEMY and stated that although further invoices were available her understanding was that this one invoice would be sufficient to rebut the allegation of non-use.
11. On 30th August 1997, Mr. Gracey sent to the Registry a further "affidavit" which contained, in 55 numbered paragraphs, details of all his objections to the evidence filed on behalf of Tritonstyle. I do not propose in this decision to go into the details of these. I think it is fair to say that he raised every conceivable objection to the evidence including going so far as to suggest in paragraph 28 that some of the exhibits to Ms. Dodd's declarations had been created fraudulently by Marks & Clerk, the agents acting for Tritonstyle.
12. At the hearing before Mr. Salthouse, he acceded to an application by a Mr. Edenborough, Counsel for Tritonstyle, that paragraph 28 should be redacted as it contained unfounded and scandalous allegations.

13. It was on the basis of this evidence that the matter came to be argued before Mr. Salthouse. As a preliminary matter Mr. Salthouse rejected Mr. Edenborough's invitation to reject outright the application on the ground that Mr. Gracey had no locus standi or that, if he had locus standi, the application was frivolous or vexatious or otherwise an abuse of process. Mr. Salthouse concluded that the evidence taken as a whole was sufficient to demonstrate use of the mark on articles of leisure wear (other than footwear) within the relevant period. He went on to hold that the use before him, although small, could not be considered be de minimis and qualified as genuine use. He accordingly concluded, having regard to section 46(5) of the Act which provides

"(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only".

that the specification of goods should be amended to *"articles of leisure wear, other than footwear"*.

14. To this extent, therefore, the application for revocation partly succeeded and partly failed. From this decision Mr. Gracey appealed to the Appointed Person by a Notice of Appeal dated 29th December 1998 which was subsequently amended and amplified in a document dated 30th January 1999. In that latter document Mr. Gracey also requested that a measure of disclosure be ordered against Tritonstyle to clarify matters which had been in dispute before the Registry and which had been raised in his "affidavit" of 30th August 1997.
15. The Notice of Appeal was duly sent to Marks & Clerk pursuant to Rule 57(3) of the Trade Mark Rules on 15th January 1999. By faxes dated 11th and 12th February 1999, Marks & Clerk requested, on behalf of their client, pursuant to Rule 58, that the appeal should be referred to the High Court.

16. This matter was argued by Mr. Edenborough at a hearing before me on 4th May 1999 and my reasons for rejecting that application are set out in my Decision of 10th May 1999.
17. At the hearing on 4th May 1999, Mr. Edenborough informed me that, if the matter were not to be referred to the Court, his client's would wish to have the opportunity of filing a Respondent's Notice including, if so advised, a cross appeal, and of seeking to adduce further evidence on the appeal. (see paragraphs 37 and 48 of my decision).
18. I gave leave to serve a Respondent's Notice and indicated that the correct course was for his clients to prepare such evidence as they saw fit, to supply it to Mr. Gracey and for the questions of admissibility and/or further disclosure to be determined at a further hearing.
19. Tritonstyle duly filed a cross appeal raising four matters:
 - (i) Challenging the locus standi of the applicant.
 - (ii) Challenging the decision to restrict the specification of goods.
 - (iii) Challenging the refusal by the Hearing Officer to redact certain paragraphs other than paragraphs 28 of the "affidavit" of Mr. Gracey and
 - (iv) Challenging the decision not to award costs in their favour.
20. The further evidence was in the form of a third declaration of Katherine Heather Dodd dated 3rd June 1999. Compared to the previous declarations, this is a document of substance. In paragraph 2 it lists all the articles of clothing which it is contended Tritonstyle have sold under the trade mark ACADEMY. It reads:

"My company acquired the trade mark ACADEMY in 1987 and has used the mark extensively in the United Kingdom and elsewhere, continuously since that date. My company has used the trade mark in relation to a

wide range of goods including articles of clothing, jeans, jackets, T - shirts, formal and casual shirts, sportswear, sweatshirts, rugby shirts, jog pants, waistcoats, shell suits, cycling shorts, tops, tracksuits, jeans, poloshirts, shirts, shorts, knitwear, silk shirts and jackets, interlock roll necks, baseball jackets, denim shirts, swim shorts, articles of under-clothing including vests, articles of footwear including boots and shoes and articles of headgear including baseball caps".

21. She then sets out the current retail prices of various articles of clothing including footwear and in paragraph 4 sets out the turnover of goods in the financial years 1992-1996. These range between £350,000 and £600,000 per annum.
22. In paragraph 5 she exhibits a number of invoices and orders received from customers dated between 22nd March 1993 and 4th May 1995 and in exhibit KHDIII she exhibits various products ranging from jackets and silk shirts to sweatshirts and boxer shorts and a boot.
23. In paragraph 9 she exhibits invoices from suppliers from dates ranging from 29th April 1992 through to 28th June 1995.
24. As can be seen from this brief analysis the third declaration is a comprehensive document giving significantly more information than was before Mr. Salthouse. It is staggering that this information was not contained in the second declaration since by his "affidavit" of 17th May 1999, Mr. Gracey had made it abundantly clear that he intended to challenge root and branch any suggestion that the mark had been used by Tritonstyle. Furthermore, I have no doubt that this evidence could have been produced before the hearing before Mr. Salthouse and that it was abundantly plain to Tritonstyle and its advisers from Mr. Gracey's "affidavit" of 30th August 1999 that he intended to attack the then existing evidence given on behalf of Tritonstyle in any way that he could.

Should this evidence be admitted on this appeal?

25. Before proceeding with the Appeal itself, it is necessary to consider whether or not this further evidence should be admitted since it was not before the Registrar and quite plainly could have been. It cannot be correct for a practice to develop in cases of non-use (where the burden is on the proprietor is on to prove use) for proceedings before the Registrar to be used as a means for testing the temperature of the water and thereafter to supplement before the Appeal Tribunal any deficiencies in the evidence identified by the Registrar. Practitioners should be under no misapprehension that any attempt to do this will be likely to result in this Tribunal refusing to admit further evidence. Nonetheless, in this case, Mr. Gracey, very sensibly and pragmatically, accepted that as the evidence had been produced it should be considered since, as I understood it, he accepted that if the evidence were shut out, it could nonetheless be used in any subsequent opposition to the registration of his trade mark and that therefore to have the current application for revocation decided without considering the full nature of the available evidence would be counterproductive.
26. Accordingly, and not without some hesitation, I allowed this further evidence to be adduced.

The Appeal on Non-Use

27. I propose to deal first with the substantive question on these appeals. This is whether, in the light of all the evidence now filed, the application for revocation should succeed either in whole or in part. The relevant law is as follows:

Section 46 (so far as relevant) provides:

"(1) The registration of a trade mark may be revoked on any of the following grounds:....."

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non use:.....

- (5) *Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only".*

Section 100 provides:

"If in any civil proceedings under this Act, a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show that use has been made of it.

28. Where a mark is registered in respect of specific goods it is of course a relatively simple matter for a registered proprietor to prove use upon those goods. Where, as here, the specification of goods is in a generic form "articles of clothing in Class 25", the question of use must be one of fact and degree. It cannot be that the registered proprietor can only discharge the burden by, in effect, providing full disclosure of all trading documents in his possession relating to the use of the mark over the period in question. Equally, however, if a proprietor wishes to maintain a generic registration of this sort, it will be inadequate merely to show use to a limited extent upon a limited selection of goods. In those circumstances the proper decision will be to limit the classification of goods to which the mark applies to the specific goods and to exclude others. Nor will it be sufficient for the registered proprietor to make an assertion of use. Section 100 requires that the proprietor should "show" what use has been made of it. An assertion will not suffice.
29. It will be apparent from the foregoing that I do not regard the First or Second Declarations of Ms. Dodd as going nearly far enough to justify the maintenance of the registration in respect of a broad category of goods. However matters are now different. I have the Third Declaration. To my

mind this is a full and proper document. It not only asserts use but gives examples of use and exhibits samples, it exhibits invoices within the relevant period and gives financial details as to the amount of sales. I do not doubt, as with most statutory declarations, that aspects of it can be criticised. For example I was not told the dates on which the various items exhibited were sold. Nonetheless I have concluded that reading this document as a whole it is more than adequate to satisfy me not only that the mark has been used in the relevant period in relation to a wide range of clothing including footwear but also that it has been extensively used in the amounts set out in paragraph 4 of that declaration.

30. On the evidence before Mr. Salthouse, he was only satisfied that the mark had been used in relation to leisurewear. Mr. Gracey accepted before me that use had now been proved in relation to sweatshirts, jogging pants and T-shirts and suggested that the registration could be restricted accordingly.
31. So far as concerns the Registrar's decision, I have difficulty with the expression leisurewear. What is formal wear for one person will be leisurewear for another and vice versa. Further it is quite plain from the third declaration of Ms. Dodd that the trade mark has in fact been used on a wider range of clothing than merely sweatshirts, jogging pants and T-shirts. In particular it has been used upon jackets, silk shirts and pullovers which might well not fall within the definition of leisurewear. It has also been used on head gear and footwear.
32. Taking all matters into account, I am satisfied that the evidence of use now filed is sufficient to justify the maintenance of the registration across the breadth of its current classification "articles of clothing included in Class 25".

33. Accordingly I propose to dismiss the appeal of Mr. Gracey which sought to revoke the mark in its entirety and to allow the appeal of Tritonstyle insofar as it sought to reverse the Decision of the Hearing Officer to restrict the specification of the mark to "articles of leisurewear other than footwear". In the final event therefore the application for revocation will be dismissed.

Other matters

34. In Tritonstyle's Notice of Appeal, a decision in their favour is also sought on the locus standi issue and on the basis that the application should be struck out having regard to an assertion that the way in which Mr. Gracey had conducted it constituted an abuse of the process of the Court.
35. Even if it is now necessary for an applicant for revocation to show any "interest". I am in no doubt that Mr. Gracey had such an interest. He had applied for the mark ACADEMY and had been challenged by Marks & Clerk in their letter of 26th August 1996. To react by seeking to revoke the mark which was the foundation of the challenge is perfectly proper. It is not therefore necessary for me to decide the question whether any interest and, if so, what interest, is necessary.
36. Mr. Edenborough on, behalf of Tritonstyle, amplified before me in a detailed skeleton argument the reasons why his clients felt that Mr. Gracey's conduct of this matter had been an abuse of process. I do not propose to enter into this. It is not necessary that I should do so. It is plain that the methods by which Mr. Gracey sought to defend his commercial interests in the Trade Mark Registry did not appeal to Tritonstyle and their advisers. In his "affidavit" of 30th August 1997, Mr. Gracey made a number of unsubstantiated allegations, the most serious of which was in paragraph 28 to which I have referred.
37. However Mr. Gracey made it absolutely plain before me that he was not alleging fraud against Marks & Clerk. With this statement I believe that this

matter can be laid to rest. The Hearing Officer correctly redacted paragraph 28 of Mr. Gracey's "affidavit" of 30th August 1997. Mr. Gracey is now well aware that allegations of impropriety should not lightly be made and he quite correctly did not pursue them before me. The remaining paragraphs to which Mr. Edenborough objected together with the assertions relating thereto which were maintained by Mr. Gracey have all been rendered academic by Ms. Dodd's third declaration. I therefore propose to say no more on this subject.

Costs

38. Tritonstyle have succeeded on this appeal. They have done so because, at a very late stage, they saw fit to put in evidence which could and should have been produced as long ago as 6th January 1997 when Ms. Dodd's first declaration was served. Most of the delay involved in these proceedings can be put down to that failure. Equally it can be said that Mr. Gracey's approach to defending the proceedings on occasions was unnecessarily combative. Since, in the final event Mr. Gracey has not succeeded at all, there can be no question of an award of costs in his favour. Tritonstyle have succeeded but, in my judgment, could have done so at an earlier stage by filing full and proper evidence before the Registrar. I am therefore not minded to make any award of costs in their favour on this Appeal nor to alter the order for costs made by the Hearing Officer.

39. As indicated at the hearing, if either party wishes to contend for an order for costs other than that which I have indicated above, they should make submissions in writing relating solely to the issue of costs within 7 days of receipt of this decision and should indicate in those observations whether or not they wish a further hearing. In default of any observations I shall make the order as to costs indicated above.

Simon Thorley Q.C.

4th May 2000