

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTERED TRADE MARK No. 2257307 IN THE NAME OF ISHTIAQ HUSSAIN ESQ**

**AND IN THE MATTER OF APPLICATION FOR REVOCATION THEREOF No. 82750 BY GUCCIO GUCCI SPA**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON BY THE REGISTERED PROPRIETOR AGAINST THE DECISION OF MR. MARK BRYANT DATED 3 NOVEMBER 2008**

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**DECISION**

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**Introduction**

1. On 6 January 2001, Cape Design Limited of 9 Kelfield Avenue, Harborne, Birmingham B17 0QN applied under number 2257307 to register the sign DUCCIO in Class 25 for use as a trade mark in relation to articles of clothing. The mark was published for opposition purposes on 7 March 2001 and actually entered in the Register on 22 June 2001. On 12 May 2006, an assignment of the trade mark from Cape Design Limited to Ishtiaq Hussain Esq. of 9 Kelfield Avenue, Harborne, Birmingham BN17 0QN was recorded in the Register.
2. On 17 January 2007, Guccio Gucci SpA filed an application on Form TM26(N) to revoke the registration for reasons of non-use. The application for revocation was based on section 46(1)(a) and section 46(1)(b) of the Trade Marks Act 1994. The relevant periods of alleged non-use were:
  - (a) 23 June 2001 to 22 June 2006;
  - (b) 16 January 2002 to 15 January 2007.

Revocation was requested from 23 June 2006 or 16 January 2007 in respect of all or some of the goods covered by the registration.

3. The registered proprietor denied the application in a Form TM8 Notice of defence and counterstatement filed on 26 April 2007. In a counterstatement signed by Mr. Ishtiaq Hussain and dated 24 April 2007, Mr. Hussain stated:

“3. I have been trading and manufacturing articles of clothing under the name Duccio since 2001.

4. The trade mark has been used since 2001 and a variety of goods have been manufactured bearing the Trade Mark 'Duccio' and sold through my retail outlet under the name Shafran.
  5. I can confirm the use of the Trade Mark 'Duccio' and will provide evidence showing the Trade Mark was used for the goods for [which] it was registered and within the time limits as required."
4. The Notice of defence and counterstatement was accompanied by evidence of use, which was sent by the Trade Marks Registry to the applicant for revocation under cover of a letter dated 3 May 2007. In that letter the applicant for revocation was given until 3 August 2007 to file evidence in support of the application. Since no evidence was filed in support of the application, the registered proprietor was informed by the Registry on 5 September 2007 that any evidence in support of the registration should be filed by 5 December 2007.
  5. On 16 January 2008, the Registry wrote to the solicitors acting for the registered proprietor stating that the evidence of use filed with Form TM8 was not in proper form and included sensitive information. A deadline of 16 February 2008 was set for the evidence to be resubmitted in accordance with rule 55 of the Trade Marks Rules 2000.
  6. Something then seems to have gone array. In a letter to the registered proprietor's solicitors dated 22 February 2008, the Registry:
    - (a) Explained that the evidence filed with Form TM8 should have been returned with its letter of 16 January 2008 and was now attached;
    - (b) Acknowledged receipt of Form TM54 and evidence comprising witness statement of Ishtiaq Hussain and exhibits IH1 – IH8 submitted on 18 February 2008.
    - (c) Pointed out that the TM54 evidence included material in addition to that submitted with Form TM8 and returned the Form TM54 evidence;
    - (d) Allowed until 22 March 2008 for the original evidence filed with Form TM8 to be put into proper form in accordance with rule 55.
    - (e) Informed that if it was requested that further evidence be allowed into the proceedings this should be sent in the proper format to the Registry with a request that it be admitted into the proceedings and copied to the other side.

It appears from the Registry file that the Form TM54 evidence submitted on 18 February 2008 included *inter alia* invoices since the date of registration to date, images of clothing sold under the DUCCIO mark and a DUCCIO branded carrier bag.

7. Following a further abortive attempt to submit the Form TM8 evidence, a witness statement of Ishtiaq Hussain dated 7 April 2008 with Exhibits IH1 – IH13 were filed at the Registry on 10 April 2008 and the parties were informed by the Registry on 15 April 2008 that the case was ready for decision. A short delay ensued due to the applicant for revocation not having received a copy of the evidence filed on 10 April 2008 (i.e., the resubmitted TM8 evidence). The applicant for revocation requested a hearing which took place before Mr. Mark Bryant, acting for the Registrar, on 7 August 2008. Mr. Simon Malynicz of Counsel, instructed by Addleshaw Goddard LLP, appeared on behalf of the applicant for revocation. Mrs Kamila Rahman of J. R. Jones, Solicitors appeared on behalf of the registered proprietor.
8. Objections to/criticisms of the registered proprietor's evidence of use were first raised in the applicant for revocation's skeleton argument delivered two days before the hearing on 5 August 2008. At the hearing before Mr. Bryant, the registered proprietor sought to introduce into the proceedings samples of clothing bearing the DUCCIO brand. Those were rejected on the basis that they originated after the end of the alleged period of non-use, although the transcript indicates that Mrs Rahman told the Hearing Officer that some of the samples were in fact the subject of invoices put in as evidence (returned stock, IH11).
9. Following the hearing, on 12 September 2008 the registered proprietor made an application on Form TM54 to admit further evidence into the proceedings. Mr. Hussain explained in a witness statement dated 8 September 2008 that the further evidence sought to be introduced was neither available nor known to him at the date of the hearing. The further evidence comprised four exhibits: (1) a DVD of a Liberty fashion show dated 2002 showing the DUCCIO mark being presented on jeans and waistcoats; (2) a DVD of a fashion magazine called "69" showing images of articles of clothing specifically jeans and waistcoats bearing the DUCCIO mark; (3) a CD of studio photographs taken in 2002 showing articles of clothing bearing the DUCCIO mark. The photographs were taken by photographer Andy Kruczek; (4) Photographs of the same model as in (3) with a letter from Andy Kruczek confirming the date of the photographs and that the DUCCIO label was visible on close up images of the jeans and waistcoats.
10. I was unable to inspect the actual exhibits as they were no longer on the Registry file. However, my papers on appeal contained copies of the exhibit front sheets, two pages from "69" magazine, the photographs taken by Mr. Kruczek and his letter. I note that "69" magazine has a short piece on an "extravagant Winter Fashion Show from some of Birmingham's top designer stores" held at Liberty's nightclub on 30 October 2002. Moreover, Mr. Kruczek says that he photographed some of the same items of clothing (referring back to images of waistcoats and jeans bearing the DUCCIO label) at Liberty's Nightclub, Birmingham but those images were no longer in his possession.
11. It appears that the Registry invited comments from the applicant for revocation on the further evidence although the correspondence was not on

file. There is no indication that the registered proprietor was afforded an opportunity to be heard before the Hearing Officer refused to admit the further evidence essentially on the ground that the further evidence was not material to the proceedings because it did not reveal any trade in the registered goods.

12. On 27 October 2008, Mr. Hussain made another application to file further evidence on Form TM54. There was no trace of that application or the evidence sought to be admitted on the Registry file but the Hearing Officer commented:

“This evidence takes the form of another “to whom it may concern” letter, this time from Mr Bob Manning, Course Director, ND Fashion & Clothing at Birmingham City University. My comments regarding the earlier “to whom it may concern” letter are equally applicable and I will not repeat my comments here other than to say that such exhibits carry little weight. As to the content of the letter, Mr Manning states that Mr Hussain, whilst a student attending his course (which he completed in June 2005), included garments incorporating the logo “Duccio” in his “final catwalk collection”. He also states that, during this time, Mr Hussain had his own fashion retail outlet called “Shafran” which sold his design work using his logo “Duccio”. Without supporting evidence that such use was for goods relevant to these proceedings and was more than mere token use, I find that this evidence is not material to the proceedings”.

[I return to the Registrar’s practice regarding “to whom it may concern” letters later in this decision.]

The Hearing Officer said that he had not invited submissions from the applicant for revocation on the further evidence and I surmise in the absence of contrary indication that Mr. Hussain was not provided with an opportunity to be heard.

13. In a written decision issued on 3 November 2008 under reference number BL O/300/08, the Hearing Officer revoked the registration in its entirety with effect from 23 June 2006. He found that no genuine use of the trade mark had been made during either of the relevant time periods and therefore revoked the mark from the earliest claimed date. In view of his findings, the Hearing Officer did not address the alternative claim for partial revocation.
14. On 1 December 2008, the registered proprietor filed notice of appeal to the Appointed Person under section 76 of the Act. By that time, the registered proprietor had dismissed his former agents and was acting on his own behalf. Before turning to the statement of grounds, it is convenient to set out the legislation applicable to this dispute.

## **Section 46, Trade Marks Act 1994**

15. Section 46 of the Act provides so far as relevant:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

[...]

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

[...]

(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.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

## **The Trade Marks Rules**

16. The governing rules were the Trade Marks Rules 2000, as amended. Rules 31 and 31A stated the procedure on application for revocation on grounds of non-use:

“31. - (1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made.

(2) The registrar shall send a copy of Form TM26(N) and the statement of the grounds on which the application is made to the proprietor.

(3) The proprietor shall, within three months of the date on which he was sent a copy of Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counterstatement, and be accompanied by –

(a) two copies of evidence of use of the mark; or

(b) reasons for non-use of the mark,

otherwise the registrar may treat him as not opposing the application.

(4) The evidence of use of the mark shall –

(a) cover the period of non-use alleged by the applicant on Form TM26(N), or

(b) where the proprietor intends to rely on section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.

(5) The reasons for non-use of the mark shall cover the period of non-use alleged by the applicant on Form TM26(N).

(6) The registrar shall send a copy of Form TM8 and any evidence of use, or reasons for non-use, filed by the proprietor to the applicant and the date upon which this is sent shall, for the purposes of rule 31A, be the “initiation date”.

31A. - (1) The applicant may, within three months of the initiation date, file any evidence he may consider necessary to adduce in support of the grounds on which the application was made.

(2) Where the applicant files no evidence under paragraph (1), the registrar shall notify the proprietor that no evidence was filed.

(3) The proprietor may, within the relevant period, file such evidence as he may consider necessary to adduce in support of his case.

(4) The relevant period -

(a) where the applicant files evidence under paragraph (1), is the period beginning on the date on which a copy of the evidence is filed and ending three months after that date; or

(b) where the applicant does not file evidence under paragraph (1), is the period beginning on the date on which the registrar sent the

proprietor a notification under paragraph (2) that no evidence was filed and ending three months after that date.

(5) Where the proprietor files evidence under paragraph (3), the applicant may, within three months of such evidence being filed, file any evidence in reply; such evidence shall be confined to matters strictly in reply to the proprietor's evidence.

(6) The registrar may, at any time if she thinks fit, give leave to either party to file evidence upon such terms as she thinks fit.

(7) Under this rule, evidence shall only be considered filed when –

(a) it has been received by the registrar accompanied by Form TM54; and

(b) it has been sent to all other parties to the revocation proceedings.

(8) Where the periods for filing evidence under paragraphs (1) and (3) and, if relevant, paragraph (5) have expired, the registrar shall request that the parties give written notice of whether they wish to be heard.

(9) Where any party requests to be heard, the registrar shall send to the parties notice of a date for the hearing.”

17. Rule 55 referred to by the Registrar in the abovementioned correspondence with the registered proprietor stated:

“55. - (1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

18. Rule 54 conferred a general opportunity to be heard:

“54. - (1) Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days’ notice of the time when he may be heard unless that party consents to shorter notice.”

19. The Trade Marks Rules 2008 superseded the Trade Marks Rules 2000, as amended on 1 October 2008. However, under the transitional provisions the latter were preserved for the filing of evidence in, *inter alia*, non-use revocation proceedings commenced before the former came into force. Rule 83(4) of the 2008 Rules states:

“... where prior to the entry into force of these Rules-

[...]

(b) an application for revocation of a trade mark on the grounds set out in section 46(1)(a) or (b) has been filed,

The previous rules shall apply with regard to the filing of any evidence in relation to those proceedings.”<sup>1</sup>

### **Grounds of appeal**

20. The registered proprietor’s statement of grounds of appeal filed on 1 December 2008 read:

“See Attached letter. I am Appealing on the grounds of negligence by my solicitors and want to submit new evidence, 56 pages. If I have made a mistake I will contact you Monday 1<sup>st</sup> December to correct the TM55. Appeal letter attached”.

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<sup>1</sup> In case there is doubt, the general right to be heard contained in rule 54 of the 2000 Rules was included in exactly the same terms in rule 63 of the 2008 Rules.

The statement and Form TM55 were signed by Mr. Hussain. That seems to have been followed with another signed copy omitting the reference to “56 pages” and the message to the Registry, but adding “2 pages of” to the beginning of the last sentence.

21. Mr. Hussain’s attached letter, dated 28 November 2008, listed several items he wished to be considered on appeal including “witness statements” of Mr. Adam Kirby and Mr. Bob Manning who had previously provided “to whom it may concern” letters, and twenty-four copy invoices dating from the period 2004 to 2005, which Mr. Hussain said showed very clearly that he was selling Duccio branded jeans, t-shirts and waistcoats. Some of the sales were in cash but copy credit card receipts were attached in most instances.
22. Mr. Hussain then queried certain findings of fact made by the Hearing Officer, which Mr. Hussain intimated were wrong. He concluded his letter by enclosing further copy invoices originating from 2002 and 2006 to show the role in these proceedings of a firm called Baltex, which I have also taken to be a complaint against a finding (or non-finding) of fact made by the Hearing Officer in relation to that company.
23. Mr. Simon Malynicz, appearing as Counsel on behalf of the applicant for revocation, said that the statement revealed no grounds of appeal (*COFFEEMIX Trade Mark* [1998] RPC 17, Mr. Simon Thorley QC sitting as the Appointed Person at pages 19 – 20). At best, Mr. Hussain’s Form TM55 must be treated simply as an application to adduce further evidence on appeal.
24. I rejected that argument. It seemed to me clear especially from Mr. Hussain’s challenges to findings of fact that Mr. Hussain intended to appeal generally against the Hearing Officer’s decision that there had been no genuine use of the DUCCIO trade mark, as well as to bring additional evidence forward for the attention of the appeal tribunal.
25. After hearing the submissions of both parties at length, I indicated my decision to remit the case to the Registry for reconsideration by a different Hearing Officer. That would provide Mr. Hussain with the opportunity if he so wished to make an application to file further evidence on Form TM54, which could then be considered pursuant to rule 31A(6) of the 2000 Rules according to the principles set out by Mr. Geoffrey Hobbs QC sitting as the Appointed Person QC in *Yosif Abdubrahman Al-Bassam Trading Establishment’s Application*, BL O/477/02, it being recognised that a determination based on those principles may result in evidence being admitted before the Registrar that would not be admitted under the more restrictive approach, which pertains on appeal (*Dualit Ltd v. Rowlett Catering Appliances Ltd* [1999] FSR 865 at 870; and see the recent discussion by Mr. Hobbs in *TUSHIES Trade Mark*, BL O/281/09). Any such application might include for re-assessment the further evidence, which Mr. Hussain had sought introduce on earlier occasions before the Hearing Officer.

26. I stated that my decision was based on an accumulation of procedural and other irregularities in the proceedings below, which I would set out fully in my written decision as follows.

### **The Hearing Officer's decision**

27. In *Pan World Brands Ltd v. Tripp (EXTREME Trade Mark)* [2008] RPC 2, Mr. Richard Arnold QC sitting as the Appointed Person remarked on: (a) the difference between the UK and Community positions on proof of use in that rule 22 of Commission Regulation 2868/95 implementing the Community trade mark regulation<sup>2</sup> specified the types of indications and evidence required whereas UK law did not; (b) the possibility that a registered proprietor might not be able to provide documentary evidence of use; and (c) the practice of refraining from challenging a proprietor's evidence of use until shortly before or at the hearing.
28. I believe that the Hearing Officer may have subjected the proprietor's evidence to an overcritical eye, which prevented him from reading the evidence fairly (*CHIC FEET*, BL O/199/06). To take three examples:<sup>3</sup>
- (a) A letter from Mr. Adam Kirby, Mr. Hussain's bank manager (IH9) was accepted as potentially important yet dismissed by the Hearing Officer because when viewed in isolation it contributed nothing to the proprietor's assertions. Mr. Malynicz conceded at the appeal hearing that it was inappropriate to treat items in isolation. Evidence of use must be assessed as a whole.
  - (b) An invoice from Baltex Clothing who described themselves as wholesale clothing manufacturers, specialists in denim wear (IH2) to Cape Design regarding 80 pairs of adult jeans was disregarded as containing no indication that the jeans featured the DUCCIO mark. The Hearing Officer failed to link that invoice with the invoices from V. M. Mason & Co., distributors of fasteners, eyelets and T.I.R. products, to Cape Design Limited (IH5) for DUCCIO brass antique buttons and rivets which were to be delivered to Baltex.
  - (c) A delivery note on Cape Design headed notepaper listing 99 items of different styles of jeans and waistcoats in the "Ladies/Gents smart casual jeans collection Duccio" supplied to a retail customer "Sales Return, on all stock"<sup>4</sup> (IH11) was thought unpersuasive because no prices were shown and the customer was only identified by number and branch.
29. Mr. Hussain also complained of factual errors made by the Hearing Officer in relation to the V. M. Mason invoices. The invoices were for:

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<sup>2</sup> Now Council Regulation (EC) No. 207/2009.

<sup>3</sup> The examples are not intended to be exclusive.

<sup>4</sup> Mr. Hussain explained that this meant sale or return.

- (a) 20 packs of 1000 (“20/000”) “R30 DUCCIO BRASS ANTIQUE BRASS” and 20 packs of 1000 (“20/000”) “R30 ALUMINIUM RIVET PIN” (invoice 02/04/02); and
- (b) 10 packs of 1000 (“10/000”) each of “CUSTOM ITEM – ‘DUCCIO’ LOGO 925 CAP ANTI BRASS”, “925 B SOCKET BRASS ANTIQUE BRASS”, “925 C STUD BRASS ANTIQUE BRASS” and “925 D POST BRASS ANTIQUE BRASS” (invoice 24/11/06).

The transcript indicates that Mr. Malynicz accepted those quantities of buttons and rivets at the hearing below. Yet in his decision the Hearing Officer acknowledges only quantities of 20 and 10 items respectively. Mr. Hussain pointed out that a similar error occurred regarding an invoice (IH6) for DUCCIO leather patches (pre print limited invoice of 28/02/02). That related to 3000 leather patches, not 30 as interpreted by the Hearing Officer.

- 30. The lower quantities were unlikely given the prices charged on the invoices. Any uncertainty could have been resolved using the Registrar’s power to require information under rule 57.
- 31. The leading authority on what constitutes genuine use of a trade mark is the judgment of the Court of Justice of the European Communities (“ECJ”) in Case C-40/01, *Ansul BV v. Ajax Brandbeveiliging BV* [2003] ECR I-2439. The Hearing Officer instructed himself by reference to paragraph 47 of the judgment, which contains the first part of the final ruling:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is ‘genuine use’ of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

32. The Hearing Officer did not however refer to the reasoning of the ECJ and in particular to paragraph 37:

“37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d’être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.”

33. The Hearing Officer appears to have thought that there was a requirement for actual trade in the goods concerned, which is not the case as the above paragraph shows (see also Case C-259/02, *La Mer Technology Inc. v. Laboratoires Goemar SA* [2004] ECR I-1159, *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 49). That influenced *inter alia* his consideration of a licensing arrangement entered into by the registered proprietor for use of the DUCCIO mark and also his determination of the materiality of the further evidence sought to be introduced on 12 September 2008 (see paragraph 9 above).

#### **To Whom It May Concern letters**

34. The original and further evidence considered by the Hearing Officer contained four “to whom it may concern” letters (IH1, IH9, letter from Andy Kruczek and letter from Bob Manning). The applicant for revocation’s skeleton argument criticised such letters with reference to the Registrar’s Tribunal Practice Notice (1/2008), Correspondence solicited for proceedings. The Hearing Officer seems also to have been guided by TPN 1/2008. There are concerns over TPN 1/2008<sup>5</sup>, which reads as follows:

“1. The Registrar has noted an increasing trend for evidence to be filed in the form of letters from third parties solicited by the parties to the proceedings. Typically, it is the Registrar’s experience that such letters are headed “To whom it may concern”, or even addressed to the Registrar, whilst others are less obvious in format. The procedures for filing evidence in trade mark proceedings before the registrar is governed by rule 55 of the Trade Marks Rules (2000) as amended. The rule states:

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<sup>5</sup> The parties were invited to address me at the hearing on the relevance of the Civil Evidence Act 1995 to TPN 1/2008.

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

2. Letters of the kind described above are not therefore a suitable means of introducing statements made by the person signing such a letter as his or her evidence in the proceedings. This is because such letters do not comply with the requirements of Rule 55(1) or (3).

3. Where such a letter is relied upon by a witness and attached as an exhibit to his or her affidavit, statutory declaration or witness statement, the statements of the person signing the letter are normally admissible as part of the evidence of the person making the affidavit, statutory declaration or witness statement. However, in these circumstances statements made by the person signing the letter are hearsay evidence.

4. Hearing Officers will give hearsay evidence of this kind such weight as it deserves. Statements made in letters which have been sent to a party for a purpose unconnected with the proceedings are, in general, likely to be given more weight than statements made in letters solicited for the purpose of the proceedings. However, each case will be assessed on its own merits.”

35. Ferris J. held in *ST TRUDO Trade Mark* [1995] FSR 345 that the strict rules of evidence apply in Registry proceedings for the purposes of the Civil Evidence Act (see also *CITYBOND Trade Mark* [2007] RPC 301). The Civil Evidence Act 1995 relevantly provides:

**“Admissibility of hearsay evidence**

1.-(1) In civil proceedings evidence shall not be excluded on the ground that it is hearsay.

(2) In this Act—

- (a) “hearsay” means a statement made otherwise than by a person while giving oral evidence in the proceedings which is tendered as evidence of the matters stated; and
- (b) references to hearsay include hearsay of whatever degree.

(3) Nothing in this Act affects the admissibility of evidence admissible apart from this section.

[...]

**Considerations relevant to weighing of hearsay evidence**

4.-(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

- (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
- (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- (c) whether the evidence involves multiple hearsay;
- (d) whether any person involved had any motive to conceal or misrepresent matters;
- (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

[ ... ]

**Meaning of “civil proceedings”**

11. In this Act “civil proceedings” means civil proceedings, before any tribunal, in relation to which the strict rules of evidence apply, whether as a matter of law or by agreement of the parties ...”

36. Tribunal Practice Notice, 1/2008 tends to conflate form and admissibility. Rule 55 of the 2000 Rules (now rule 64, 2008 Rules) dealt only with the formal requirements for the giving of evidence in Registry proceedings.
37. There are two ways in which “to whom it may concern” letters can be introduced in Registry proceedings. First, the writer of the letter can provide a verifying affidavit, statutory declaration or witness statement to which his or her letter is exhibited. Second, the party seeking to rely on the letter can provide an affidavit, statutory declaration or witness statement to which the third party letter is exhibited. In the first case, the letter is part of the writer’s own evidence. In the second case, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act. If neither of those mechanisms are adopted that is a procedural irregularity, which may be rectified or even waived according to the circumstances of the case (c.f., *EI Du Pont Nemours & Co v. United Kingdom Intellectual Property Office* [2009] EWCA 966, Jacob L.J. paragraphs 46 – 56; *Minnesota Mining & Manufacturing Company v. Johnson & Johnson Limited* [1976] FSR 6).
38. Tribunal Practice Notice 1/2008 is ambiguous insofar as:
  - (a) It suggests that where the second method is followed, third party “to whom it may concern” letters are admissible because (or only if) they are attached as exhibits to the affidavit, statutory declaration or witness statement of the witness seeking to rely upon them. However, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act. Rule 55 related only to the manner of introducing it into evidence.
  - (b) The structure of the Notice (despite paragraph 4) invites an assumption that “to whom it may concern” letters *per se* carry little weight for lack of attestation. If as in the present case, they contain hearsay evidence, then that evidence must be weighed in accordance with the factors listed in section 4 of the 1995 Act in the context of the evidence as a whole.
39. The Hearing Officer made a number of blanket observations with regard to the four “to whom it may concern” letters in question. That has made it difficult to ascertain whether the Hearing Officer accorded them proper weight in the context of the registered proprietor’s evidence overall.

### **Procedural issues**

40. I understand that there were contemporaneous opposition proceedings between the parties in the Registry that remain outstanding. Mr. Hussain said he made all his till receipts available to his representatives but for some reason more evidence was submitted in the opposition than in the revocation action. Hence his present application to introduce evidence of customer sales before me and his appeal on the ground of negligence on the part of his former solicitors.

41. Earlier in this decision I recounted that on 18 February 2008, Mr. Hussain's representatives filed Form TM54 Notice of giving evidence, which comprised a witness statement made by Mr. Hussain and eight exhibits. The Registry file records that those exhibits included *inter alia* invoices since the date of registration to date. It may be, therefore, that Mr. Hussain's representatives did attempt to file evidence that he now seeks to introduce. As mentioned, the Registry returned the evidence because it was more extensive than that originally filed with Form TM8. I do not understand why the Form TM54 submitted on 18 February 2008 was not treated as an application to file further evidence pursuant to rule 31A(6) of the 2000 Rules insofar as appropriate.
42. I have also mentioned that Mr. Hussain made subsequent applications to introduce further evidence on 12 September and 27 October 2008 respectively. However, it was not apparent that Mr. Hussain was afforded an opportunity to be heard compliant with rule 54 of the 2000 Rules before those applications were refused. There was also the possible misunderstanding as to the samples Mrs Rahman attempted to bring to the attention of the Hearing Officer during the revocation hearing (see paragraph 8 above).

### **Conclusion**

43. Due to an accumulation of the reasons set out above, I was not satisfied that the overriding objective of dealing with cases justly had been achieved in the proceedings below. I decided therefore to remit the case to the Registrar for reconsideration by a different Hearing Officer. Accordingly, the decision of Mr. Bryant is set aside. Mr. Hussain should make an application on Form TM54 to the Registrar (copied to the applicant for revocation) to admit the fresh evidence he had sought to introduce before me on appeal. He may wish to include the DVDs, CDs etc. that were the subject of the earlier applications but are no longer on the Registry file.
44. I will leave over the costs to be decided by the Registrar after the Registry proceedings have been determined.

Professor Ruth Annand, 28 October 2009

Mr. Ishtiaq Hussain appeared in person

Mr. Simon Malynicz of Counsel, instructed by Addleshaw Goddard LLP, appeared on behalf of Guccio Gucci SPA