

IN THE MATTER OF TRADE MARK NOS. 1272101, 1332727, 1229890, 1332733, 1235690, 1332734 AND 1524250 IN THE NAME OF NICHOLAS DYNES GRACEY AND APPLICATION NOS. 9593, 9594, 9595, 9596, 9597, 9608 AND 9609 BY TROCADERO PLC FOR REVOCATION AND A DECLARATION OF INVALIDITY.

DECISION

1. This is an appeal to the Appointed Person in relation to a decision of Mr. Attfield, the Officer acting for the Registrar dated 1st October 1999. The Appeal is however not against the reasoning in the decision but against the fact that the decision was given at all. The application before me is to have the decision set aside on the ground that it was reached without first having held a hearing contrary to rule 48 of the Trade Mark Rules 1994.
2. As long ago as June 1997, Trocadero Plc. made seven applications either for revocation or for a declaration of invalidity in respect of seven trade marks all relating to the word "Adrenaline" of which the proprietor was Nicholas Dynes Gracey. For the purposes of the present appeal it is unnecessary to distinguish between the applications or the dates on which they were filed and I shall refer to them together as the applications. The applications were made pursuant to sections 46 and 47 of the Trade Marks Act 1994.
3. The procedure following an application for revocation or declaration of invalidity is set out in Rule 31 of the Rules. So far as relevant this rule provides:

"31(1). An application to the Registrar for revocation under section 46 or for a declaration of invalidity under section 47 of the registration of a trade mark shall be made on form TM 26 together with a statement of the grounds on which the application is made.

(2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark, the Registrar shall send a copy of the application and the statement to the proprietor.

(3) Within 3 months of the date on which the Registrar sends a copy of the application and the statement to the proprietor, the proprietor may file a counter-statement together with form TM8 and the Registrar shall send a copy thereof to the applicant;

Provided that where an application for revocation is made on the ground of non-use under section 46(1) (a) or (b), the proprietor shall file (within the period allowed for the filing of any counter-statement) evidence of the use by him of the marks; and if he fails so to file evidence the Registrar may treat his opposition to the application as having been withdrawn.

(4) Subject to paragraph (2) and paragraphs (6) and (7) below, the provisions of Rule 13 shall apply to proceedings relating to the application as they apply to opposition proceedings to the registration of a trade mark, save that, in the case of an application for revocation on the grounds of non-use under section 46(1)(a) or (b), the application shall be granted when no counter-statement is filed.

4. Rule 13 deals with the procedure for opposition proceedings and it is relevant to note sub-rules 3-8 which provide as follows:

13(3) Within 3 months of the date on which a copy of the counter-statement is sent to the Registrar by the person opposing the registration, that person shall file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in

support of his opposition and shall send a copy thereof to the applicant.

(4) If the person opposing the registration files no evidence under paragraph(3) above he shall, unless the Registrar otherwise directs, be deemed to have abandoned his opposition

(5) If the person opposing the registration files evidence under paragraph (3) above or the registrar otherwise directs under paragraph (4) above, the applicants shall, within 3 months of the date in which either a copy of the evidence or a copy of the direction is sent to the applicant, file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his application, and shall send a copy thereof to the person opposing the application.

(6) Within 3 months of the date on which a copy of the applicants evidence is sent to him, the person opposing the application may file evidence in reply by statutory declaration or affidavit which shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy thereof to the applicant.

(7) No further evidence may be filed, except that in relation to any proceedings before him, the registrar may at any time if he thinks fit give leave to either party to file evidence upon such persons as he may think fit.

(8) Upon completion of the evidence the Registrar shall, if a hearing is requested by any party to the proceedings, send to the parties notice of a date for the hearing.

5. I complete this citation from the Rules by citing Rule 48 which provides:

48(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 a 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 him, give that party an opportunity to be heard.

(2) The Registrar shall give that party at least 14 days notice of the time when he may be heard unless that party consents to shorter notice.

6. Many of the functions of the Registrar relate to his duties in respect of the prosecution of trade mark applications to registration. These proceedings are ex parte in the sense that the applicant deals directly with the Registrar (through his various officers) and those officers are acting in an administrative capacity. The applicant has to satisfy the officers that the trade mark applied for is suitable for registration. In the course of the prosecution process, very often, interim decisions will have to be made by the relevant officer and, in any event, the relevant officer will have to make a final decision either accepting or rejecting the application. Before any such decision is made contrary to the interests of the applicant, he has a right to be heard pursuant to rule 48 and may thereafter demand a written decision. From that written decision an appeal lies either to the High Court or to the Appointed Person (see Section 76 of the Act).
7. In the case where an application has been accepted, it is published and thereafter registration may be opposed by any third party (see Section 38). If such an opposition is entered, it proceeds in accordance with the practice set out in rule 13.

8. Once registered, it is open to any third party to apply under sections 46 or 47 to revoke the registration or to seek a declaration of invalidity and the procedure is laid down in the rules I have cited.
9. It will be apparent from those rules that a structured approach is laid down which is not dissimilar to the procedure for the hearing of an action in the High Court. There are pleadings, in the case of revocation proceedings, a Statement of Grounds and a Counter-Statement. There is provision for three rounds of evidence within fixed time limits and, by rule 49(2), the Registrar has power to allow cross examination.
10. Accordingly, in relation to opposition and revocation proceedings, the Registrar's officers cease to perform an administrative function and act solely in a judicial (or quasi judicial) capacity. The distinction is I believe an important one, particularly in the circumstances of the present case. When acting in an administrative capacity, the Registrar has to enter the debate with the applicant, has to reason with him and necessarily will engage in correspondence or in conversations with the applicant in order to seek to resolve any matters arising. If this can be done to the applicant's satisfaction, there is no need for a hearing.
11. Once the Registrar begins to perform his judicial function, the position is different. The Registrar or his officer is acting as a judge. The proceedings are adversarial, the issues are circumscribed by the pleadings and the parties are free to adduce the evidence and the arguments that they wish. It is the Registrar's duty to adjudicate upon the issues raised. It is not his duty and, indeed, it would be wrong for him, when exercising this function, to enter into a debate with either party as to the validity or otherwise of the contentions put forward on any of the issues raised in the proceedings. For reasons which I shall develop below I fear that, out of a natural and laudable desire on the part of the Registrar's officers to assist Mr. Gracey, a litigant in person, they may

have lost sight of the judicial function the Act and rules requires them to perform in the present applications.

12. Although Mr. Gracey is a litigant in person, he is no stranger to the trade mark system. He told me in the course of the hearing that he had been involved over 1000 trade mark matters. It is quite plain from reading the voluminous correspondence in these applications that he has a thorough working knowledge of the Act and the rules. Unfortunately he also has an unusual prose style which makes his correspondence not readily comprehensible, at any rate on an initial reading.
13. With this introduction I revert to the history of these applications. The applicants, Trocadero plc, instructed David Keltie Associates, (Keltie), a well known firm of trade mark agents, to act on their behalf. As is not unusual, the applicants sought an extension of time until 16th April 1998 to file their evidence and this was granted by Mr. Connors, the officer acting on behalf of the Registrar, by letter dated 9th April 1998. This application was opposed by Mr. Gracey by a fax of 14th April 1998. By letter dated 16th April 1998, another officer, Jayne Francis, wrote to Mr. Gracey informing him why the extension had been granted.
14. This resulted on 22nd April 1998 in a 34 paragraph fax from Mr. Gracey to Mr. Norman Harkness, then a very senior officer in the Trade Mark Registry complaining at length at the granting of the extension.
15. It is worth quoting Mr. Harkness' reply of 28th April in full:
*"Thank you for your recent fax.
In an ideal world every party would file their evidence on time and no-one would ever have to ask for extensions of time.
Unfortunately that does not always happen. Also we deal with some thousands of requests each year since we have over 3,500 opposition and revocation proceedings before us at this time. Thus*

when reasons are given someone in the law section has to decide whether or not the reasons justify the requests. It is not an exact science no matter what guidance or directions we might issue.

That is the general background, you are of course concerned with your set of proceedings.

The relevant letter in relation to the first extension of time was to David Keltie Associates and dated 9th January 1998 which was copied to you.

You later commented on the grant of the extension but you did not request a hearing as set down in the final paragraph.

The second request dated 16th March 1998 requested time to complete the formality of signing the declaration by Mr. Donovan. One month was requested but in the event the signed document was filed within 3 days on 19th March 1998.

You were asked for comments re the request in the official letter dated 23rd March but your later faxes were not on that particular point. Thus the time is now passed for objecting or requesting a hearing to argue the matter. Without deciding the merits of this latest request, after the event, I think it will be very difficult for the Registrar to refuse evidence which was filed so soon after the relevant date. That of course is only my view from this point in time but does not take account of arguments which might have been presented. I appreciate that my reply may not totally satisfy you but I think you know how the system works. If you wish to object, then in most cases you will have to ask for a hearing to argue the matter".

16. I have recited this letter because it is but one example in the papers before me of the Registrar's officers going to the very greatest lengths to assist Mr. Gracey, to explain to him what is happening and why it is happening and to deal promptly, fairly and courteously with the objections raised by Mr. Gracey. I do not propose to burden this decision with further extensive

quotations from correspondence. For those with the fortitude to study the whole file, I believe that my comments with regard to the exemplary behaviour of the Registrar's officers are amply demonstrated throughout the progress (or lack of progress) in the prosecution of these applications.

17. In the event, Mr. Gracey availed himself of the opportunity of a hearing and this was held on 18th June 1998. The applicant for revocation was not present and Mr. Gracey made his observations via the video conference facility. The hearing officer was Mr. Knight, then the head of the law section. Mr. Knight upheld the extension of time and provided Mr. Gracey three months from the date of the hearing in which to file evidence in support of his defence (see letter dated 23rd June 1998).

18. In the course of that hearing Mr. Gracey had raised concerns over the right of Keltie to act on behalf of the applicants and Mr. Knight directed that the relevant form TM33 should be filed to make it plain that Keltie was properly instructed. The filing of this document became the source of further debate between Mr. Gracey and the Registry which lead to correspondence for many months.

19. In the event, on 8th December 1998, Jayne Francis of the Law Section rejected an application by Mr. Gracey for an extension of time to appeal the decision of 18th June 1998 and her letter concluded:

"As your evidence was due on 18th September 1998, you may now wish to file a back-dated request for an extension of time in order to file it.... please respond within 14 days of the date of this letter".

20. On 9th December 1998, Mr. Gracey complained to Mr. Paul Hartnack, the Chief Executive of the Patent Office and on 21st December 1998 Mr. Knight responded on behalf of Mr. Hartnack. That letter concluded:

"Insofar as your request for an extension of time to appeal the decision, set out in the above mentioned letter, in relation to the

interlocutory hearing held on 18th June 1998, I confirm that it was considered but was refused for the reasons set out in Ms. Jayne Francis letter of 8th December 1998. You may now, of course, seek a Statement of Grounds for that decision and, on the basis of that, appeal that decision. It is noted that your evidence in support of these registrations has not been filed, the case will therefore be placed before a hearing officer for a decision on the substantive issue, unless the parties wish to be heard on the matter".

21. This letter resulted in further correspondence from Mr. Gracey to Mr. Knight and Mr. Hartnack and to Ann Corbett and Alistair East, two other officers acting for the Registrar but no evidence was filed and no request was made for hearing. On 8th February 1999, Ann Corbett, the Deputy Head of the Law Section, declined to arrange a further interlocutory hearing and concluded:

"As no written request for a hearing on the substantive issues has been received from either party, arrangements are now being made for the issue of a written decision from the papers already filed. A copy of this letter is sent to David Keltie Associates under their reference RAC/3165.

22. This resulted in a fax from Mr. Gracey on 10th February 1999. Since it is relied upon by Mr. Gracey, I should set it out in full.

*"REQUEST FOR HEARING, RE. REGISTRAR
FRI. 15. JAN.99 DECISION, FOR TAKING
INTO ACCOUNT THE FULL CONTEXT OF MY
07-PAGE, 25 PARA, MON.16. NOV.98 FAX*

*Diary 12:30 - MON.15.FEB.99 (TO46)
Previous NDG ref => TO41PRHA/10.FEB*

*(1) In respect of para 2 of your
MON.08.FEB.99 letter and natural
justice please contact the
Applicant to find out if a copy of
my MON.16.NOV.98 fax has been
copied to the Applicant quoting*

Applicant TM33 ref 'RAC/3168'

(2) In respect of para 3 of your MON.08.FEB.99 letter and natural justice, please note that it is my desire to file testimony in response to the Applicant evidence (and this is a request for hearing on the substantive issues) pending the outcome of the interlocutory hearing in respect of the issues raised in my MON.16.NOV.98 fax;

(3) In respect of para 2&3 of your MON.08.FEB.99 letter and natural justice please reply to para (2)(b) of my 23:20 THU.04.FEB.99 fax to:- Mr. Paul R S Hartnack;

....

Warm thanks

I draw attention particularly to the passage in brackets in paragraph 2

"And this is a request for hearing on the substantive issues".

23. On 5th March 1999, Ann Corbett wrote a two page letter seeking to deal with all the outstanding issues and concluded by stating that arrangements were being made for the substantive hearing of the cases to take place. It also requested that all further correspondence should be addressed to Ms Francis. Notwithstanding this, a flurry of correspondence from Mr. Gracey then ensued to Mr. Hartnack, Ms Francis, and Ms. Alison Brimelow, by then the new chief executive officer at the Patent Office, and there were also some telephone calls.
24. By letter dated 31st March, Peter Lawrence, the then Director of Trade Marks at the Patent Office, responded to Mr. Gracey explaining the way in which the Registry ran and making it plain that senior officers of the Patent Office could not overrule decisions of officers who were responsible for a particular application. It repeated the request that any correspondence should be directed to the relevant case officer.

25. In the ensuing months, Ms Francis and her colleagues dealt extensively and repeatedly with the faxes sent by Mr. Gracey. Perhaps not surprisingly, their patience began to wear a little thin by the end of August when Mr. East sought to respond to all outstanding matters in a letter date 27th August. In particular a question had arisen with regard to the capacity of a person, Ms. Fiona Dodds, who had purported to notarise certain affidavits of Mr. Gracey, whom the Law Society had informed the Registry was not legally entitled to do so. Mr. East gave Mr. Gracey a final opportunity to provide comments provided those were received by 3rd September 1999.
26. This resulted in a further round of faxes to various officials at the Patent Office dated 3rd and 4th September 1999 and a response came from Mr. Knight on 20th September 1999, the material passages of which reads as follows:

"I note that all of the points covered by the correspondence have already been the subject of communications from yourself and replies from colleagues here. There seems therefore no point in continuing the correspondence.

The only outstanding point is that relating to Mr. Alistair East's letter of Friday 27th August 1999 in which he gave you a relatively short period of time in which to respond to comments made by the Trade Mark Registry. On that particular matter I agree that such short notice was somewhat discourteous given the length of time it had taken us to respond to your letter and I am therefore allowing you until the end of this month to reply on that particular point.

Apart from any response you wish to make on the particular point in Mr. East's letter, no further correspondence will be entered into on this case as the matter is now ready for hearing and I have asked one of the Registrar's hearing officers to issue the decision based on the papers before him".

27. In fact the position with regard to the substantive hearing had not altered since 21st December 1998. I find this a most regrettable state of affairs. There is a public interest that matters involving the validity of trade marks on the Register should be determined expeditiously so as to ensure that the rights of other traders are not wrongly interfered with. As will be apparent from my comments above, whilst I commend the Trade Mark Registry for their courtesy, patience and helpfulness, I do not believe they should have entered the debate with Mr. Gracey in the way that they did. If a party to an opposition or revocation proceedings wishes to raise an issue in those proceedings, the issue should be clearly formulated, either in the Statement of Grounds or the Counter-Statement or in a subsequent formal application so that the other party may have an opportunity to comment upon that issue, again by way of formal statement, and both parties can have an opportunity to file any necessary evidence. Once this is done the Registry can rule (following a hearing if necessary) whether the issue should be determined as a preliminary issue or whether it should stand over to be determined at the substantive hearing. Had this course been adopted in the present case, the delay and the undoubted expense to the Registry in dealing with Mr. Gracey's repeated faxes would have been avoided. I do not believe that the course I have outlined involves the Registry in any discourtesy to the parties to oppositions or revocations. By so doing, the Registry would be carrying out its judicial function by managing the cases before it in an expeditious and fair manner.
28. Nonetheless, I must deal with this case as I find it. Mr. Knight's letter of 20th September 1999 gave Mr. Gracey until "the end of the month to reply".
29. The last day of the month was Thursday 30th September. Late on the evening of that day Mr. Gracey sent two faxes to the Registry, one to Mr. Knight and the other to Alison Brimelow. It is plain that at least the former of these was received and date stamped 30th September 1999 at the Patent Office and was further date stamped by the Law Section on 1st October 1999. Both faxes

complain about the quality of service Mr. Gracey had received from the Registrar, made reference to the Human Rights Act and the laws of Natural

Justice but crucially in paragraph 2 stated as follows:

*"(2) Please explain why TM Registrar
(Michael Knight) 1 page
"Mon.20.SEP.99" dated letter,
post marked WED. 22.SEP.99 received
THU.23.SEP.99, states in para 4:-*

.. Apart from any response you wish to make on the particular point of Mr. East's letter no further correspondence will be entered into on this case as the matter is now ready for a hearing and I have asked one of the Registrar's Hearing Officers to issue the decision based on the papers before him ...

i.e. without respect to offering any hearing or any regard for my WED.10.FEB.99 written request ie ... ' this is a request for hearing on the substantive issues' ... to TM Registrar (Ann Corbett);

30. On 1st October 1999 the Decision appealed against was issued and was supplied to Mr. Gracey.
31. On 3rd October 1999 Mr. Gracey faxed the Treasury Solicitor with a document which he claims is a Notice of Appeal and sent a copy by fax to the Trade Marks Registry. Paragraph 1 refers to Rule 48 of the rules (which I have cited above) and paragraph 2 reads as follows:

*(2) Please arrange for a hearing by
The Appointed Person in respect of
the fact that the TM Registrar
repeatedly withheld any offer of my
being heard on the matter even
though my request to be heard had
been filed, in writing, before the
FRI.01.OCT.99 TM decision.*

32. Mr. Gracey claims that this document is sufficient to constitute an appeal to the appointed person for the purposes of section 76 of the Act. Rule 57 of the Rules provides

(1) Notice of Appeal to the person appointed under section 76 shall be sent to the Registrar within one month of the date of the Registrar's decision which is the subject of the appeal accompanied by a statement in writing of the Appellants Grounds of Appeal and of his case in support of the appeal.

33. Plainly the document in question was sent within one month. A copy was forwarded to Keltie. On 1st November 1999, Keltie responded as follows:

Rule 57(1) clearly states that "Notice of Appeal to the Person Appointed ... shall be sent to the Registrar within one month of the date of the Registrar's decision accompanied by a statement in writing of the appellants grounds of Appeal and of his case in support of the Appeal".

However, having reviewed Mr. Gracey's communication we submit that no grounds of appeal have been provided; it merely consists of a request for a hearing and a request for publication of the decision to be withheld from the Internet.

In the circumstances, we trust that Mr. Gracey's appeal will not be admitted.

34. The applicants were not represented at the hearing before me but it is necessary for me first to rule upon this question. Before me, Mr. Gracey contended that paragraph 2 of the fax of 3rd October 1999 contained adequate material to be a solid ground of appeal. When pressed by me to identify the document which he contended constituted his request to be heard, he identified

the fax of 10th February 1999, coupled with the repetition of the contents of that fax in his faxes of 30th September 1999.

35. In *Coffeemix* Trade Mark (1998) RPC 717, a decision of mine, sitting as the appointed person, I had to consider the nature and function of the statement of grounds required by Rule 57 (1). I concluded page 721 line 36 as follows:

"It will thus be seen that the Statement of Grounds of Appeal and Statement of Case form an important part in the appeal procedure. The provisions of the Act providing for a right of appeal to the appointed person are significant in that they provide for a quick and cheap method of testing any decision of the Registrar. The fact that no appeal lies from the decision of the appointed person enables finality at an early date. In the case of a trade mark application, this is important not only to the applicant but also in the wider public interest, so that the interested public may know at an early date the extent to which a monopoly by way of trade mark rights is to be granted to rival traders".

and continued (page 722 line 5):

"The above considerations highlight the importance of a full statement of Grounds of Appeal and Statement of Case being served pursuant to rule 57. When I say full, I do not mean that the document should be prolix or, indeed, drafted with any degree of formality, such as might be the case as with a Notice of Appeal to the Court of Appeal. It must be full in the sense that it must outline each of the grounds of appeal relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible but it must be complete".

36. Paragraph (2) of Mr. Gracey's fax of 3rd October 1999 is undoubtedly succinct. It raises the ground of appeal relied upon, namely, that he had not been heard before the decision was issued. What it does not do is to give any

details as to the nature of his request to be heard which it is contended was filed in writing. I do not doubt that, if the document had made reference to the fax of 10th February 1999, it would have complied with the rules. No other information would have been necessary. Reference to that fax would have been all that was necessary in order to determine whether or not it constituted a request for a hearing.

37. Without that reference it is strongly arguable that the grounds are not sufficiently complete. I have hesitated considerably on this aspect of the case. It is no use Mr. Gracey submitting, as he did, that by the time of the hearing that there was no doubt as to the communications being relied upon. For the reasons given in the *Coffeemix* case, if a Statement of Grounds of Appeal or a Statement of Case is inadequate, it can only be cured by amendment. The defect cannot be excused.
38. During the course of the hearing Mr. Gracey indicated that if I were minded to hold that his fax of 3rd October 1999 was defective, then he would ask for leave to amend it so as to insert reference to the fax of 10th February 1999 and the faxes of 30th September 1999.
39. In the event I have concluded that this is not necessary. Whilst incomplete, I do not believe that it can properly be said that paragraph 2 of the fax of 3rd October 1999 does not constitute both the Grounds of Appeal and Mr. Gracey's case in support. His case is that he had asked in writing for a hearing. Accordingly I reject the contention that the fax of 3rd October 1999 did not comply with Rule 57(1).
40. I turn then, at last, to the substantive issue in this appeal. In a normal appeal in contested proceedings, whether they be an opposition or an application for revocation, it is usual for the parties to be heard but for no representations to be made on behalf of the Registrar. This again is wholly in accordance with the concept that the Registrar is acting in a judicial capacity in such

proceedings. The Judge does not appear in the Court of Appeal to justify his own decision.

41. However, in the exceptional circumstances of this case, I felt that I would be assisted by representations on behalf of the Registrar to assist with the Registrar's practice in these matters. Mr. Gracey expressly accepted that this would be appropriate and I therefore heard submissions not only from Mr. Gracey but also from Mr. Knight on behalf of the Registrar.
42. There was no dispute from the Registry that rule 48 governed this case. Rule 13(8) provides for a date for the hearing to be fixed, if a hearing has been requested. Rule 48 requires the Registrar to give any party an opportunity to be heard and the question is whether, in the circumstances of this case, Mr. Gracey was given that opportunity which turns upon whether he requested a hearing.
43. It is also not in dispute that I have power to hear this appeal. Whilst in the normal case an appeal from a decision of the Registrar would involve a consideration of the substance of the decision, it must also be proper for an appeal to determine whether the Registrar had power under the Act and the rules to issue a decision which has been issued. (see. e.g. *Adidas S.A.R.L.'s trade mark* (1983) RPC 262 - a case heard before the Divisional Court under the 1938 Act in circumstances where no appeal either to the Board of Trade (the predecessor of the appointed person) or the High Court was possible).
44. I therefore have the power to set aside the decision, if it was reached without Mr. Gracie having had an opportunity to be heard, he having requested that opportunity.
45. I have concluded that Mr. Gracey did request such an opportunity. His fax of 10th February 1999, which I have quoted in full above, deals with the question of a substantive hearing in the most delphic terms. It can hardly be said that a

comment in brackets is the clearest way of indicating a desire for a hearing on a matter involving the continued existence of a property right, namely seven registered trade marks. Nonetheless the words are there and, are, on a careful reading, unequivocal. On behalf of the Registrar, it was suggested that this was a conditional request, conditional upon the previous resolution of certain interlocutory matters. I cannot read it like this. It may be an aside, in the course of what was then, to Mr. Gracey, a more important interlocutory matter but nonetheless it is a plain request for an opportunity to be heard on the substantive hearing.

46. This is reinforced by the faxes of 30th September which repeat the request in the language of the fax of 10th February 1999. Had it not been for the faxes of 10th February and 30th September 1999, it would have been quite proper for the Registrar to issue the decision on 1st October 1999. Mr. Gracey had been given until the end of the previous month to respond to outstanding matters and, had he not done so, the Registrar would have had no barrier in the way of issuing a decision and indeed would have been under a duty to do so.
47. However, in the circumstances, Mr. Gracey had requested an opportunity to be heard and was not given that opportunity. In issuing the decision the Registrar was in breach of rule 48 and thus had no power to issue the decision. Accordingly, in my judgment, the decision must be set aside and a date be set to give Mr. Gracey the opportunity of being heard. Plainly the hearing officer at the hearing should not be Mr. Attfield who has already reached a decision in this matter.
48. As appears from this overlong Judgment, I am greatly disturbed by the way in which this matter has proceeded. I do not blame the Trade Mark Registry at all. They have sought at all times to accommodate Mr. Gracey. Nonetheless a delay of this nature in the hearing of an application for revocation is wholly unacceptable. The further hearing should be appointed without delay and it should be a final substantive hearing. Whilst the manner in which the hearing

is to be conducted is entirely a matter for the hearing officer, it appears to me that this might be a case where the hearing officer could usefully call for written skeleton arguments, to be provided in advance of the hearing, identifying all the issues that the parties wish to raise so that there can be no misunderstanding as to the issues to be considered. This will enable the hearing officer to rule upon whether any particular issue is admissible and then to rule upon all admissible issues.

49. In conclusion therefore, for the reasons given, the appeal will be allowed and the decision of Mr. Attfield of 1st October 1999 will be set aside.
50. There remains the question of costs. This was not a matter which was canvassed at the hearing. It could not be, since no representative of the applicants was present. I do not have power to make an award of costs against the Registry in circumstances where they have acted in their judicial capacity. The sole question therefore is whether or not Mr. Gracey, having succeeded on this appeal, should have an award of costs in his favour against the applicants.
51. Not unnaturally I wish, if possible, to avoid the expense of any further debate on this appeal. Both parties are however entitled to make observations on the question of costs and to have a hearing if that is what they desire. It might however be helpful, in order for the parties to consider whether to make any further observations, if I were to indicate some provisional views.
52. Since December 1998, the applicants and their representatives have played little or no part in the debate which has been going on between Mr. Gracey and the Registry. They were not instrumental in the issuing of the decision on 1st October 1999. They were sent a copy of the fax of 30th September 1999 but again this was sent late in the evening. I do not believe that any blame can be attached to the applicants or their representatives for the fact that this appeal had to be made.

53. In the course of the appeal they have raised a question under rule 57(1). Whilst I have concluded that this objection was not well founded, undoubtedly it was proper to raise the matter. They made written observations by letter dated 26th November 1999 but this letter did no more than draw my attention to documents which I would have had to have regard to in reaching my decision. Taking these matters into account, my provisional view is that it would be unjust to require the applicants to make any contribution towards Mr. Gracey's costs of this appeal.
54. Since this decision is being issued in the run up to a vacation, I direct that any written observations confined strictly to the subject of costs should be served on the Treasury Solicitor on or before 10th January 2000. Those observations should expressly indicate whether or not a hearing is required in the event that my conclusion as to costs is against the party making the observations.

6 December 1999

SIMON THORLEY Q.C.