

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS 9593, 9594, 9595, 9596, 9608 AND 9609 FOR
REVOCAION AND DECLARATION OF INVALIDITY AND OF APPLICATION
9597 FOR DECLARATION OF INVALIDITY, BY TROCADERO PLC,
OF TRADE MARKS 1272101, 1332727, 1229890, 1332733, 1235690, 1332734 AND
1524250 (RESPECTIVELY)
IN THE NAME OF NICHOLAS DYNES GRACEY**

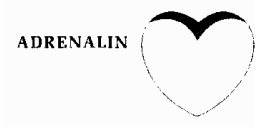
TRADE MARKS: ADRENALIN (IN VARIOUS FORMS)

TRADE MARKS ACT 1994

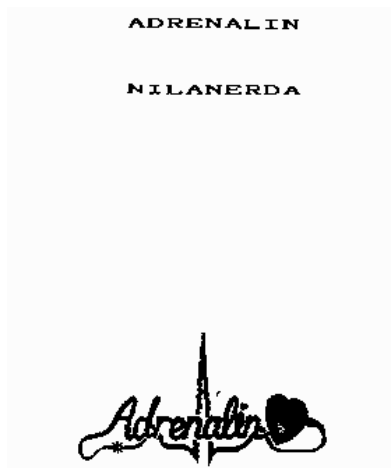
5 **IN THE MATTER OF Applications 9593, 9594, 9595, 9596, 9608 AND 9609 for**
revocation and declaration of invalidity and of Application 9597 for
declaration of invalidity, by Trocadero Plc,
of trade marks 1272101, 1332727, 1229890, 1332733, 1235690, 1332734 and
10 **1524250 (respectively)**
in the name of Nicholas Dynes Gracey

15 **DECISION**

The following trade marks are registered in the name of Nicholas Dynes Gracey.

20	<u>Mark</u>	<u>Number</u>	<u>Date</u>	<u>Class and Goods/Services</u>
	ADRENALIN	1272101	16 July 1986	Class 25: Shirts, shorts, t-shirts, windcheaters, tracksuits, trows, articles of clothing for gymnastics, swimming costumes, leotards, ski suits, articles of waterproof clothing, ski boots, deck shoes, wetsuits for surface watersports, wellington boots.
	ADRENALIN	1332727	22 January 1988	Class 35: Advertising; promotional services; publication of publicity texts; provision of business information; business consultancy services; telephone answering; marketing services; all included in Class 35.
		1229890	9 November 1984	Class 25: Shirts, shorts, T-shirts, tracksuits, articles of clothing for gymnastics, swimming costumes, leotards, ski-ing suits and footwear, all being articles of clothing; articles of waterproof clothing and wetsuits for surface water sports.

	ADRENALIN	1332733	22 January 1988	Class 41: Instruction in sporting activities; provision of club entertainment services; rental of sports apparatus; rental of video recorders and of video cassettes; publishing; all included in Class 41.
	ADRENALIN	1235690	13 February 1985	Class 16: Cards, labels, tags, posters, notepaper, stationery, packaging materials, decalcomanias; all being printed; pens and pencils; printed periodical publications; all included in Class 16; but not including any of the aforesaid goods relating to medical matters or hormones.
	ADRENALIN	1332734	22 January 1988	Class 42: Professional advisory services relating to the licensing of intellectual property rights; printing services; catering services; commercial and packaging design services; rental of video cameras; all included in Class 42.
5	ADRENALIN ADRENALINE (series of two)	1524250	19 January 1993	Class 25: Shirts, shorts, skirts, t-shirts, sweatshirts, windcheaters; jeans and trews; braces; tracksuits; articles of clothing for gymnastics; swimming costumes; leotards, skiing suits, ski boots, hats, gloves, socks, deck shoes, Wellington boots and footwear; articles of waterproof clothing, wet suits and dry suits; kilts, lingerie, bras, nightwear, pyjamas and underwear; babies' napkins; sarongs; sleep wear; sweatpants; sweaters; coats; jackets; raincoats; caps; visors; scarves; headbands; bandannas; sandals; sports shoes; belts; all included in Class 25.



Registration m 1332727 was filed as a series of three marks and recorded on the image database at the Registry as such, when advertised and registered the trade mark had been amended to a single word mark. This amendment was not recorded on the Registry image database and the error was reflected in the evidence adduced by the applicant, however nothing turns on the point. The mark as applied for is displayed to the left and the mark as accepted, published and registered is displayed above.

In five applications dated 2 June 1997 Trocadero Plc applied for revocation and declaration of invalidity of registered marks 1272101, 1332727, 1229890 and 1332733 and for a declaration of invalidity of registered mark 1524250. Further, in two applications dated 3 June 1997 Trocadero Plc applied for revocation and declaration of invalidity of registered marks 1235690 and 1332734.

Where revocation has been applied for the grounds are stated as non-use of the mark under the provisions of sections 46(1)(a) and 46(1)(b) of the Act, in that the registration has not been used or put to genuine use in the United Kingdom in relation to the goods or services for a continuous period of five years.

Declarations of invalidity have been applied for in all cases under the provisions of section 47 of the Act, on the grounds that the applications to register the marks were made in bad faith in breach of section 3(6) of the Act and that the applications to register the marks were made without a bona fide intention to use the marks in relation to the goods and services claimed. The latter issue of bona fide intention also is a breach of section 3(6) of the Act in as far as it is in breach of section 32(3) of the Act, which states.

32.- (3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

Finally the grounds request that the registrations be removed from the register and an award of costs be made in favour of the applicant.

The registered proprietor filed counterstatements, in the form of affidavits, in which he effectively denies the grounds on which the applications for revocation and the declaration of invalidity are based. This document also gives a history of the development of the registered proprietors business. This was accepted as evidence of use as required, by Rule 31(3) of the Trade Marks Rules (as amended), when a revocation action for non-use of a trade mark is commenced and I will return to these documents later.

During the course of these proceedings the registered proprietor has challenged a number of

procedural issues in these proceedings. However there would appear to be no further preliminary issues outstanding. Therefore as the applicants have filed evidence in these proceedings, the registered proprietor having filed no evidence beyond his counterstatement, and neither party having requested a hearing I now give this decision on the Registrar's behalf and after a careful study of the papers,.

Registered Proprietor's evidence

In accordance with Section 100 of the Act and Rule 31(3) the registered proprietor is required to file evidence of use of the registered trade mark or give valid reasons for non-use at the time of filing their form TM8 and counterstatement. In each case a document titled "AFFIDAVIT", clearly marked for these proceedings, signed by the registered proprietor and witnessed by Ms Fiona G Dodds, Solicitor, was submitted with the form TM8 and this was taken as evidence as required by this rule.

In these documents the registered proprietor interprets the relevant parts of ss.46 and 47 of the Act and effectively denies the claims in the applicants statements of grounds.

The registered proprietor goes on to give a potted history of his activities since graduating from university in 1983. He states that an unnamed sports company manufactured ADRENALIN related items, exactly what these were is unspecified, from 1986 and entered into collaborative negotiations in 1990, that he formulated a plan for an international franchising operation in 1991/1992 and in January 1993 licence fees were paid with an ADRENALIN office opened and marketing in media such as television, radio, magazines and newspapers. Later in 1993 the sports company met with financial problems and in 1994 they applied for the registered proprietor to be declared bankrupt.

During this period he won a silver medal in an international inventors exhibition but had his own financial problems that led to late payment of renewal fees of his registered trade marks. The registered proprietor won a technological innovation competition, launched by New Scientist magazine, and as a result opened a new office in Scotland.

From mid 1994 through to late 1996 the bankruptcy action continued and affected the ability of the registered proprietor to trade under the name ADRENALIN. Negotiations are still ongoing with the sports company to settle their differences and recommence trading.

From 1995 to 1997 he was in negotiation with a potential investor and this led to the setting up of another ADRENALINE company and a further application for an ADRENALIN-ADRENALINE trade mark, m 2061071, has been filed.

Further, the registered proprietor claims to have won a passing off action in 1987-1989 against an unnamed company and this involved registered trade mark 1229890, one of the registrations subject to these proceedings.

He suggests that as his marks are registered their existence is a matter of public record and that Trocadero Plc should have been aware of them prior to commencing their use of the mark ADRENALIN, as evidenced in their 1996 annual report. Also that he has attempted to open

negotiation and is desirous of settling this matter as part of an honest deal.

Applicant's evidence

5 The applicant for revocation and declaration of invalidity filed a single statutory declaration, under Rule 13(4), these proceedings having been consolidated, by Patrick Donovan, marketing director of Trocadero Plc.

10 He states that Trocadero Plc created a slogan, "The Adrenalin Zone", to emphasise the exciting nature of the attractions at the Trocadero Centre and as a precaution they instituted a trade mark search and became aware of the registrations subject of these proceedings. In his opinion the slogan was to be used in a descriptive manner, the customer would receive "an adrenalin rush" from the activities, and that this descriptive use would not conflict with any trade mark use. However an investigation into the nature of the use of the ADRENALIN marks by the registered proprietor was commissioned.

15 The investigator's report is exhibited, PD1, and states that all attempts to contact the registered proprietor directly or indirectly, at all the addresses uncovered in the investigation, failed to elicit a response. The Adrenalin Company Ltd was struck off the company register and dissolved in 1993, the balance sheet for 1991, from Companies House, showing that the company had been dormant that year; a copy of the company file is exhibited, PD2. A search at the Companies Registration Office showed a number of companies incorporating the word Adrenalin in their name but, besides The Adrenalin Company Ltd, only Adrenalin Limited appeared to have any association with the registered proprietor. Two former directors of Adrenalin Limited had resigned as a result of an apparent "problem" with their client and a copy of the company file is exhibited, PD3.

20 Mr Donovan believes that this investigation did not reveal any use of the mark ADRENALIN as a trade mark and his companies solicitors, Rowe & Maw, as a courtesy, wrote to the registered proprietor advising him of the applicants' intention to use the slogan "The Adrenalin Zone", this was acknowledged by Ms Dodds, the solicitor who witnessed the registered proprietors affidavit and in this communication gave her address as Adrenalin REsearch, ARE, CLOtherapy Hse, Tweed Horizons, Melrose, TD6 0SG, Scotland. This was followed by a communication from her expressing interest in negotiation, exhibits PD4 to PD6. Rowe & Maw then requested confirmation of the capacity in which Ms Dodds represented the registered proprietor and on what basis he would object to their client's use of the slogan, Ms Dodds acknowledged this letter with a request for a list of the goods and services to be promoted under the slogan, exhibits PD7 and PD8. This was followed by a communication, from the registered proprietor, requesting a draft licencing agreement and enclosing a copy of the registration certificate of trade mark m 1524250, exhibit PD9.

35 40 Regarding this as an attempt to extract money from them Trocadero Plc withdrew all merchandise bearing the word ADRENALIN. It is stated that this was done as a gesture of goodwill even though they did not believe that the registered marks could prevent the use of their descriptive slogan. Trocadero Plc then introduced a special ticket, the "Adrenalin Ticket", providing access to six attractions within the Trocadero Centre, the word adrenalin again being used to emphasis the nature of the attractions, i.e. adrenalin-inducing.

Subsequently, on 22 March 1997, Ms Dodds, on behalf of Adrenalin Licensing, sent a communication to Mr Nigel Wray, the Chairman of Trocadero Plc, referring to a photograph of an ADRENALIN T-shirt printed on the back cover of the Trocadero Plc annual report 1996, requesting advice on Trocadero Plc's interest in negotiating a licence agreement, 5 alleging that Trocadero Plc have used ADRENALIN since 19 January 1993 and providing a further copy of the registration certificate of trade mark **m** 1524250, exhibit PD10.

Mr Donovan goes on to state that Trocadero Plc did not use the term ADRENALIN as early as 1993 and does not know why such an allegation should be made. Also, he goes on to state 10 that he believes that his company should be free to use "Adrenalin Ticket" to describe this special ticket, that the rights given to trade mark registrations should not prevent other traders using an ordinary dictionary word in an innocent and non-trade mark manner and that it should not give the right to registered proprietors to seek financial gain from such innocent use. Further, his company is concerned that the registered proprietor is using his trade marks to 15 seek money in relation to what is, in his view, legitimate use of the word adrenalin and, as a result of the investigations, he believes that the registered proprietor has made no use of these trade marks.

Mr Donovan then states that he is advised by Rowe & Maw that the affidavits filed by the 20 registered proprietor are defective and invalid as they were executed by Ms Dodds, who is not a practising solicitor. In proof of this he exhibits PD11, a copy of a facsimile from the Law Society, which states that whilst admitted to the roll of solicitors on 1 November 1988, Ms Dodds has never held a practising certificate. He goes on to refer to Order 41/1/14 of the Rules of the Supreme Court, a copy exhibited as PD12, to support this contention and 25 requests that the affidavits be declared invalid.

In addressing the affidavits he contends that they do not have any accompanying proof of use of the marks which are subject to the revocation proceedings and, whereas the registered 30 proprietor claims to be negotiating with an investor, there is no documentary proof of this either. He goes on to state that the marks subject to revocation proceedings were filed between ten and fourteen years ago and as the registered proprietor can show no evidence of use this is, in his opinion, proof that they were filed with no bona fide intention to use.

Mr Donovan states that a further investigation was commissioned to confirm the earlier 35 report, exhibited as PD13, and this indicates that the registered proprietors' area of interest is in sustainable technology. He goes on to note that the report indicates that "sportswear to enhance the human thermoregulatory system" is marketed, by a company Adrenalin REsearch, and sold under the mark CLOtherapy. He admits that an ADRENALIN logo appears on the front of T-shirts in a picture within exhibit PD13 but contends that this is decoration, rather 40 than a trade mark to indicate the origin of the goods, and that it is clearly sold under the mark CLOtherapy. He notes that the ADRENALIN logo is similar to the bottom mark in the original application for **m** 1332727 in class 35.

Referring to the report he comments that Adrenalin REsearch is one of eighteen companies 45 making up the Tweed Horizons Centre for Sustainable Technology, set up to support the commercialisation of sustainable technology. Also, as the registered proprietors' degree is in medical biochemistry, Mr Donovan challenges that Mr Gracey had any intention to provide

such a wide range of goods and services, in particular those which require specialised training or facilities. He goes on to state that in his view these applications were not made in good faith or with any intention to make genuine and proper use of the marks in relation to any of these services or goods. In particular he refers to **m** 1235690; there is a limitation by way of
5 exclusion of any goods relating to medical matters or to hormones and Mr Donovan contends that this is precisely what these goods would relate to.

In referring to exhibits PD14 and PD15 Mr Donovan queries the motives of an individual who files for an excessively large number of trade marks, referring to 873 (by class) which have
10 been allowed to lapse and 163 (by class) registered and pending, and suggests that the number allowed to lapse is an indication that there was no intention to use these marks. He goes on to suggest that the investigations carried out show that, with the exception of the mark
CLOtherapy, they can find no evidence of use of any trade marks and he regards this as
15 another indicator that the registered proprietor is abusing the trade mark registration system by reserving marks with no bona fide intention to use them.

Mr Donovan then points to what he regards as another abuse of the trade mark registration system by the registered proprietor, in this instance the filing of applications for series of
20 marks, exhibit PD16.

Finally, Mr Donovan addresses the issue of Ms Dodds being a share holder in Trocadero Plc, he confirms that she is, exhibits PD17 and PD18, but with the unusual number of one share, he contends that the date on which this share was acquired may be significant if it is after the
25 commencement of these proceedings and challenges the registered proprietor to show the date on which this share was allocated to Ms Dodds.

In conclusion Mr Donovan requests that the Registrar exercise discretion by removing the registrations from the register on the grounds stated in the application and give an award of
30 costs in favour of the applicant.

That concludes my review of the evidence.

Decision

35 Revocation proceedings have been brought against registration **ms** 1272101, 1332727, 1229890, 1332733, 1235690 and 1332734 under ss.46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 on the grounds of non-use of the marks. To defend a registration against such a
40 ground of revocation the registered proprietor must file a form TM8, counterstatement and evidence of use, as specified in Rule 31(3) of the Trade Marks Rules 1994 (as amended), see below.

31.- (3) Within three 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
45 Form TM8 and the registrar shall send a copy thereof to the applicant.

Provided that where an application for revocation is based on the ground of non-use under section 46(1)(a) or 46(1)(b), the proprietor shall file (within the period allowed for the filing of

any counter-statement) evidence of the use by him of the mark; and if he fails so to file evidence the registrar may treat his opposition to the application as having been withdrawn.

5 This period of three months within which to file these documents is non-extendable. In these proceedings the registered proprietor filed a form TM8 and affidavit for each case, see Annex A - the front sheet of the affidavit filed in the proceedings against registration **m** 1272101, by way of both counterstatement and evidence of use within the time period allowed. The Trade Marks Registry accepted this evidence at face value as it appeared to meet the requirements as laid down in Rule 31(3). However, in response the applicants alleged that the registered
10 proprietors affidavits are defective and the applicants have brought the validity of these affidavits into question, and thus the validity of the evidence of use. The Registrar made independent enquiries with the Law Society as to the status of Ms Dodds and in a letter dated 23 April 1999 it was confirmed that the allegations made by the applicant were correct and Ms Dodds does not have the qualifying status to witness affidavits.

15 This matter of Ms Dodds witnessing the affidavits was raised in correspondence with the registered proprietor and in a reply, dated 3 September 1999, he answered with the following statement.

20 “My swearing of any Affidavit has yet to occur at any time in the 1990's, and my correspondence with Lord Woolf & the Judicial Studies Board, and the Oaths Act (RSC para 6174) and the current CPR Part 22 ‘Statements of Truth’ practice all support my choice to affirm my statement of truth with my signature witnessed as being my signature by Whoever is available to do so at the time;”

25 The Trade Marks Act 1994, s.69, and Trade Marks Rules 1994 (as amended), Rule 49, are given below and clearly state that evidence must be given in the form of an affidavit or statutory declaration.

30 69. Provision may be made by rules-

(a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;

(b)

(c)

35 49.- (1) Where under these Rules evidence may be admitted by the registrar in any proceedings before him, it shall be by the filing of a statutory declaration or affidavit.

(2)

40 Rule 49 states that “- - -, *it shall be* by the filing of a statutory declaration or affidavit.” (my emphasis) and this does not allow any discretion on the part of the Registrar to allow a witness statement in lieu of an affidavit or statutory declaration.

45 As the documents which are headed “Affidavits” have not been sworn before a person entitled to witness them they are not affidavits. (Note that the registered proprietor now does not recognise them as such.) The content cannot be evidence in these proceedings. Nevertheless these documents can be accepted as counterstatements as these do not need to be witnessed.

In relation to the revocation proceedings, which are based upon non-use of the trade marks, I have before me therefore in the defence of the registrations forms TM8 and counterstatements but no evidence of use of the trade marks. As no evidence has been filed and no circumstances have been put forward which would suggest that I should exercise discretion I therefore find
5 that opposition to the applications has been withdrawn. On this basis the revocation proceedings against registration **ms** 1272101, 1332727, 1229890, 1332733, 1235690 and 1332734 are successful and the registrations will be revoked from the date of the application for revocation, in the event that I may be found to be wrong on this point I now go on to consider the substantive issues.

10 In revocation proceedings the onus of proving use of the mark lies with the registered proprietor and if, on appeal, it is decided that the witness statements can be accepted as evidence I need to consider whether, and to what extent, the registered proprietor has complied with s.100 of the Trade Marks Act 1994, given below.

15 100. 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 what use has been made of it.

20 When evidence is provided by a proprietor in defence of their registration the Registrar would normally expect to see for example, figures detailing financial turnover or profit from sales of goods or services under the mark, details of exactly what goods or services have been offered under the mark, expenditure on advertising the mark with details of where and when the mark was advertised, exhibits demonstrating how the mark is promoted in advertising and how the
25 mark was placed on goods in the marketplace. None of this has been provided by the registered proprietor in these proceedings.

In the witness statement there is an assertion that an, unnamed, sports company manufactured
30 ADRENALIN related items, unspecified, from 1986 and with no indication if this manufacture has ended or whether it continues. I would assume that manufacture ceased as there are also assertions that the sports company encountered severe financial problems which had repercussions on the registered proprietor. There is also an assertion that the marks were advertised in a wide range of media, television, radio, magazines and newspapers, with, again, no accompanying detail which can be verified and no exhibits to give veracity to this assertion.
35 Finally there is an assertion that there is a potential investor waiting in the wings which has necessitated the filing of an additional application, but again there is no evidence by way of exhibits, possibly draft agreements, to verify this. In considering this I am mindful of the decision in the PALM trade mark case [1992 RPC 258] which at p.267, lines 21 to 46 states:

40 A person's intention, at any point in time, is, of course, a difficult matter for any other person to know with certainty. Intentions change as the circumstances which give rise to them change. The process of application for, and registration of, a trade mark is sufficiently lengthy to allow a number of different intentions to arise quite legitimately in the mind of the applicant. But I think it reasonable to assume that a businessman, with an established business, has a certain
45 fixity of purpose when preparing to do some act or take some step in relation to that business. This is especially so, I believe, in businesses which involve the use of premises specially adapted for a particular purpose. Such businesses are not "mushroom growth"; they do not spring up overnight. The decision to establish a significant development in business,

particularly a development overseas, is almost invariably recorded in a company's minutes; premises are viewed; locations considered; design details agreed; finance arranged. These and many other necessary preparations are stepping stones which lead eventually to a desired result; they also provide a trail for subsequent examination. Had there been a bona fide intention to set up a trade and to use the mark in the terms of section 68 of the Act, it would have been relatively easy for the registered proprietor to demonstrate that fact during the course of these proceedings by the exhibition of one or two of the stepping stones to which I have referred above. It is now nearly nine years since the original application for registration of the trade mark PALM was made, and seven since it was registered. There has been ample time, therefore, for at least some of the preparatory steps to have been taken. It appears that none has been taken and I am therefore of the view that the application for registration was merely "contingent", by which I mean that the registered proprietor registered the mark against a contingency that if and when market conditions in the United Kingdom proved propitious, he would open one or more restaurants using the mark PALM.

These assertions by the registered proprietor do not give clear and categorical evidence or proof of use of any of the marks on any of the goods or services for which they are registered and I am also reluctant to accept these assertions as evidence of proper reason for non-use as they are not framed in that manner.

I do not need to consider the applicants evidence at this stage but in turning to that they state that they could not find any use of any of the ADRENALIN marks but have found some evidence of trading by the registered proprietor. As evidence they provide a copy of a page from the Internet, as part of exhibit PD13. The top line clearly states:-

"Adrenaline REsearch (ARE), clothes division, have designed and patented CLOtherapy sportswear to enhance the human thermoregulatory system ..."

There is a picture of three persons wearing shirts which have an ADRENALIN logo, similar to the bottom mark in the original application for **m** 1332727 in class 35, with the caption.

"Geoff Capes former World Strongest Man sports a CLOtherapy '93 sweaT-shirt"

Throughout this page the emphasis is placed on the mark CLOtherapy with no reference to the mark ADRENALIN.

From this it would appear that the registered proprietor is not trading in any goods or services under the various ADRENALIN marks and also no evidence of use of any of the trade marks in suit has been supplied by the registered proprietor. No proper reasons for non-use have been put forward in a way which would suggest that there is merely a reasonable delay in commencing or licensing use in these trade marks. On this basis the revocation proceedings against registration **ms** 1272101, 1332727, 1229890, 1332733, 1235690 and 1332734 are successful and the registrations will be revoked from the date of the application for revocation.

Declaration of Invalidity proceedings have been brought against registration **ms** 1272101, 1332727, 1229890, 1332733, 1235690, 1332734 and 1524250 under s.47 of the Trade Marks Act 1994 on the grounds of bad faith and no bona fide intention to use the marks, s.3(6) of the Act.

Whilst denying these accusations the registered proprietor has remained silent, presumably relying upon his assertions of use to substantiate his position as a bona fide user of these marks.

5 Taking the best view I can from the papers filed by the registered proprietor there would appear to have been an intention to use the trade mark, at least on items of sportswear. The evidence for the applicants does not, in my view, cast doubt on that particular intention. However, the registered proprietor has not sought to provide evidence of use or an explanation as to non-use on anything else. It is almost as though the other registrations had
10 not formed part of these proceedings. For example, there is no information about how it was intended to use the trade mark on the provision of business consultancy services; the rental of sports apparatus, video recorders and video cassettes; the provision of advisory services relating to the licensing of intellectual property rights; or the provision of stationery.

15 I have to doubt, therefore, the registered proprietors bona fides in applying for the trade marks which fall in the classes 35, 41, 42 and 16. Allied to this is the volume of filings which have been made by the registered proprietor for marks such as SPORTS ACADEMY (m 2105825), INTERNET (m 2105841), CHEMISTRY (m 2100859), ENJOY (m 2104083), BIO (m 2105571), DNA (m 2106363) and EMOTION (m 2105543) which have
20 subsequently not achieved registration gives rise to doubts about the motives of the registered proprietor and his bona fide intention to use the marks. And, in the absence of any explanation from the registered proprietor I consider that the trade marks were sought to be registered in bad faith.

25 On this basis the declaration of invalidity proceedings against registration ms 1332727, 1332733, 1235690 and 1332734 are successful and the registrations will be declared invalid, that is they will be deemed to have never been made.

30 Also registration ms 1272101, 1229890 and 1524250, whilst not subject to the full provisions of the declaration for invalidity are only qualified to remain on the Register for “sportswear”. This is by virtue of Article 13 of the First Council Directive 89/104/EEC which states:-

35 “Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

40 Article 13 of the Directive is a mandatory provision and it must be assumed therefore, that it is included in the Trade Marks Act 1994, which was enacted in implementation of that Directive. In a recent decision, Mr Geoffrey Hobbs QC, sitting as the Appointed Person (Section 76(2) and Section 77 of the Act) in an appeal against the Registrar’s decision in the WILD CHILD case [1998 RPC 455] said:-

45 “The provisions of Art 13 are binding upon the Registrar of Trade Marks whose task it is to implement the Directive on behalf of the State in Registry proceedings in the United Kingdom.”

It therefore appears to me that the registrations in Class 25 should be allowed to remain on the register with their specifications amended accordingly and the amended specifications are detailed below.

- 5 1272101 Shirts, shorts, t-shirts, windcheaters, tracksuits, articles of clothing for gymnastics, swimming costumes, leotards, ski suits, articles of waterproof clothing, ski boots, wetsuits for surface watersports.

- 10 1229890 Shirts, shorts, T-shirts, tracksuits, articles of clothing for gymnastics, swimming costumes, leotards, ski-ing suits and footwear, all being articles of clothing; articles of waterproof clothing and wetsuits for surface water sports.

- 15 1524250 Shirts, shorts, skirts, t-shirts, sweatshirts, windcheaters; tracksuits; articles of clothing for gymnastics; swimming costumes; leotards, skiing suits, ski boots, hats, gloves, socks; articles of waterproof clothing, wet suits and dry suits; bras; sweatpants; sweaters; coats; jackets; raincoats; caps; visors; headbands; bandannas; sports shoes; all included in Class 25.

20 The overall effect of this decision is that registration **ms** 1272101, 1332727, 1229890, 1332733, 1235690 and 1332734 are to be removed from the Register. In the case of registration **ms** 1332727, 1332733, 1235690 and 1332734 they are deemed never to have been made and in the case of registration **ms** 1272101 and 1229890 they will be removed from the Register with effect from the date of application for their revocation. Registration **m** 25 1524250 will remain on the Register with the specification amended as detailed above.

Costs

30 All of the seven applications in these consolidated proceedings have succeeded to some extent. Six of the registrations were subject to revocation action and this has been successful and all seven registrations were subject to declarations of invalidity; three have had their specifications amended and four have been declared invalid. In all the circumstances, I order the registered proprietor to pay to the applicant the sum of £2,345 as a contribution towards the cost of these proceedings.

Dated this 1st. of October 1999

45 **G J Attfield**
For the Registrar
The Comptroller General

Affirmation filed on behalf of: *NICHOLAS DYNES GRACEY*

Deponent Initials & Surname: *N D GRACEY*

No. of Written Testimony: *1 [-ONE-]*

Date solemnly affirmed: *FRI.12.SEP.97*

Office date filed: *FRI.12.SEP.97 BY FAX @ 12:59*

IN THE UK PATENT OFFICE
- TRADE MARK REGISTRY
REVOCATION APPLICATION
UNDER THE TRADE MARKS ACT 1994

CASE NO. REV 9593
=====

TRADE MARK NO. 1272101
FILED WED.16.JUL.86 IN CLASS 25
ASSOC WITH CL. 25 TM NO. 1229890
IN NAME OF NICHOLAS DYNES GRACEY
AND REVOCATION NO. 9593
FILED MON.02.JUN.97
IN NAME OF TROCADERO PLC

between:-

TROCADERO PLC - APPLICANT
Agent-represented
by way of
David Keltie & Associates,
12 New Fetter Lane,
London, EC4A 1AP, UK.

-and-

NICHOLAS DYNES GRACEY - RESPONDENT
Self-represented
by way of
solemnly affirmed
written testimony

A F F I D A V I T

(C)09:28/10-FRI.12.SEP.97-10:22/14>

Respondent ref: R255AMDA
Applicant ref: RAC/3165

My name is NICHOLAS D GRACEY (NDG),
Designer/Inventor, of:-

Adrenalin, Tweed Horizons, Melrose,
Roxburghshire, Scotland, TD6 0SG
+
(F) +44 (0) 7000-78-1212

...
and my solemn and sincere
AFFIRMATION is to say as follows...