THE PATENT OFFICE

Court 3
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

Thursday, 10th August, 2000

Before:

THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(Mr. M. Knight)

(Sitting for the Comptroller-General of Patents etc.)

In the Matter of the Trade Marks Act 1994

and

In the Matter of Trade Mark Application No. 2137569 in the name of NICHOLAS DYNES GRACEY

and

In the Matter of Opposition thereto by THE GILLETTE COMPANY under Opposition No. 49435

(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT. Telephone No: 020-7405-5010. Fax No: 020-7405-5026)

The Applicant did not appear and was not represented.

MR. SIMON AYRTON (Messrs. Bristows) appeared on behalf of the Opponents.

D E C I S I O N
(As approved)

THE HEARING OFFICER: This is Opposition No. 49435. As indicated earlier, the applicant for registration is Mr. Nicholas Dynes Gracey and the opponents are The Gillette Company. The opposition was filed in February, 1999 and in providing a counter statement at that time, which I should add is headed as an affidavit, the applicant for registration sought then discovery, or what is now termed disclosure, from the opponents. As I understand it, what Mr. Nicholas Dynes Gracey was seeking was information about the use attached to the registrations which are used as the basis for the opposition.

At that time there was an exchange between Mr. Nicholas Dynes Gracey and the Trade Marks Registry and the representatives for the opponents. In the event the Trade Marks Registry wrote to Mr. Nicholas Dynes Gracey on 4 August, 1999 indicating that the request for disclosure was somewhat premature and that a request may be considered later. This decision by the Trade Marks Registry was taken in the light of the decision taken by myself in **Lifesavers** [1997] RPC 563.

Subsequently the opponents filed their evidence on 13 December, 1999, and the applicant for registration responded on 13 December, 1999 by indicating that he intended to rely on the affidavit (presumably the affidavit filed as a counter statement), together with oral evidence. That particular request was contained in correspondence from Mr. Nicholas Dynes Gracey and it reads as follows:

"(1) In respect of your TM Registrar (Miss Deborah Rich) 1-page Mon.20.Sep.99 letter & 2-enc, received Wed.22.Sep.99 ... (2.1) 21 'agreements' expressed in the Opponent's Exhibit 'AJR5' still leaves in question the validity of Opponent's TM 1,226,399 (single heart), so my 'Applicant' desire (re TM 2,137,569) is to rely upon my Tue.11.May.99 Counterstatement/Affidavit and Oral Evidence at the Substantive Hearing, in relation to the issues raised in my Tue.11.May.99 Testimony; (2.2) The format of my Affidavit had apparently been accepted by the Registrar prior to the Opponent filing its Testimony" -- and he quotes the RSC o.2, r.2) -- "and furthermore, the Registrar has previously accepted Testimony in my format as early as Fri.10.Jan.97 in respect of my Testimony in Rev 9206, in which the first five paragraphs were dedicated to 'putting on notice' my beliefs to the Applicant/Registrar as to why the Registrar should exercise discretion in the acceptability of my chosen (in good conscience in accordance with my beliefs) Testimony format (also please see TM Rule 49(2) & 60); (2.3) In addition to which, the Registrar (Stephen P. Rowan) Wed.17.Nov.99 Decision (Rev 9206) documents the Registrar's discretion being exercised toward the CPR ie/eg the 'Witness Statement' ('Statement of Truth') format; (3) Please reassess my request for discovery and fax a copy of the 'Lifesavers' [1997] RPC 563 case asa convenient." He ends that particular document with a statement of truth.

The Trade Marks Registry responded to that request by seeking, in particular, reasons why oral evidence might be required from the applicant and why disclosure was required. Those requests were sent to Mr. Nicholas Dynes Gracey on 7 March, 2000, and that letter is annexed to this decision.

Mr. Nicholas Dynes Gracey replied eventually. I say "eventually" because there was some hiccup over the delivery of his mail following his move from Melrose in Scotland to Pwllheli in Wales. However, having been granted a period of time in which to reply, there was eventually a response on 26 April, 2000. Again this document is annexed to this decision. Despite the fact that it is headed "Strictly in Confidence", that marking is not one which the Trade Marks Registry is prepared to recognise without an accompanying request that the document be held confidential. If indeed the writer, Mr. Nicholas Dynes Gracey, had wished that document to be held confidential, then he would have needed to make a separate submission in accordance with the Trade Marks Rules.

That particular response, in my view, did not advance matters at all. It refers in a number of areas to other cases in which Mr. Nicholas Dynes Gracey is involved, and it refers to the White Book, the Trade Marks Rules, the Civil Evidence Act, etc. But at no point are any reasons advanced as to why the applicant for registration should be allowed to give oral evidence at a main hearing on the

substantive issue, nor is any reason advanced as to why the opponents should be asked to disclose information in relation to their use of the trade marks on which their opposition is based.

At a later stage Mr. Nicholas Dynes Gracey sought a stay of proceedings. That stay was in order to allow the revocation proceedings, referred to earlier in this decision, to be concluded, as in his view they were material to the decision in this opposition case. There are therefore, in effect, on the table three requests from Mr. Nicholas Dynes Gracey which I have to consider. That is, agreement to grant an order for disclosure in relation to the commercial use of the trade marks used by the opponents, agreement to Mr. Nicholas Dynes Gracey giving oral evidence at a main hearing, and the question of whether or not to stay proceedings in this opposition case pending the outcome of the revocation action.

I will deal with the matter of disclosure first. Disclosure under the Trade Marks Act stems from section 69 of that Act and rule 51 of the Trade Marks Rules 2000. Although the Trade Marks Registry's hearing officers are given the role of an official of the Supreme Court in the matter of disclosure, the Civil Procedure Rules do not apply in proceedings before the Registrar (**St. Trudo** [1995] FSR 345) . Nevertheless, the Trade Marks Registry has taken the view that the principles involved in the Civil Procedure Rules are ones which it needs to take into

account, i.e. disclosure should only be ordered in respect of those documents relevant to the matter in dispute and which are necessary to dispose fairly of the proceedings.

The first point I make is that this opposition to the registration of Mr. Nicholas Dynes Gracey's application is based upon three sections of the Trade Marks Act 1994, section 5(2), section 5(4) and section 56. In all of those sections the hearing officer needs to be satisfied that there is the likelihood of confusion as between the applicants' trade mark and those of the opponents. Therefore, unless the situation was a particularly rare one, it is very likely that the matter can be determined by reference to section 5(2) of the Trade Marks Act without going any further. I say that because deliberations under section 5(2) do not need evidence, and I stress the word "need".

In relation to the Trade Marks Act 1938, and in paragraph 17-25 of Kerley, it is said that the question whether one mark so nearly resembles another as to be likely to deceive is a question for the tribunal and is not a matter for a witness. Those sentiments have been echoed somewhat in **Wagamama Ltd. v. City Centre Restaurants Plc** [1995] FSR by Laddie J. where, in commenting upon section 10 which mirrors the provisions of section 5, he says as follows: "The approach the court should adopt to infringement under section 10 was recently set out by Jacob

J. in **Origins Natural Resources Inc. v. Origin Clothing Limited** [1995] FSR 280 in which at 284 he said:

'section 10 of the Trade Marks Act presupposes that the plaintiff's mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered and then assess the likelihood of confusion in relation to the way the defendant uses its mark, discounting external added matter or circumstances. The comparison is mark for mark.'

A judge brings to the assessment of marks his own, perhaps idiosyncratic pronunciation and view or understanding of them. Although the issue of infringement is one eventually for the judge alone, in assessing the marks he must bear in mind the impact the marks make or are likely to make on the minds of those persons who are likely to be customers for goods or services under the marks."

I think it is clear from those authorities that the Trade Marks Registry's hearing officers (or indeed any appeal tribunal from their decisions) does not need evidence in order to assess whether one mark is the same or similar to another. Indeed, the factors for the comparison of marks was set out in a number of judgments by the European Court of Justice, namely, **Sabel BV v. Puma AG, Rudolf Dassler Sport** [1998] RPC 199, **Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.** [1999] RPC 117, and **Lloyd Schuhfabriken Meyer & Co. GmbH** [1999] ETMR 690. The

essence of those cases is that the respective marks are compared, taking account of the markets and marketplaces in which the respective parties are likely to be operating across the full range of goods or services for which the earlier rights are registered or the application is made, and for the hearing officer to reach a decision.

The only time evidence may be needed is when the holder of the earlier right wishes to seek to establish that, notwithstanding what might be a prima facie view that the marks might not be similar, there is some particular factor applying in the marketplace, or in relation to the particular goods or services, or indeed the marks, which might cause the hearing officer to reach a different view, but prima facie there is no need for evidence to determine an opposition under section 5(2) unless there are exceptional circumstances. As far as I am aware, no circumstances have been brought to my attention which would suggest that this particular case is one which would need evidence to determine the matter under section 5(2).

In any event, the opponents have put in evidence, and put in evidence of use of the trade marks that they have used in opposing this application for registration. I make no comment on the weight or substance of that evidence, but nevertheless it is there and it does provide some background to what use the opponents have made of their trade mark which is precisely the information Mr. Nicholas

Dynes Gracey sought disclosure on, and bearing in mind that an ~~assent of confirmability~~ assessment of confirmability does not require evidence.

All that said, I do not believe that an order for disclosure is necessary in order that a fair and just decision can be reached in this case. However, if I am wrong in reaching that view, I go on to consider whether the specific request is framed in such a way as to suggest that an order for discovery might be reasonable if other circumstances applied.

For that purpose I take account of the decision in **Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent** [1991] RPC 221, where part of the judgment stated: "The Comptroller has power to order discovery and does so in appropriate cases. The principles which he should apply were, it appears, canvassed before the superintending examiner. He concluded that he should follow the principles applicable to discovery in the High Court, namely, discovery should only be ordered if the documents relate to matters in question in the proceedings (RSC, Order 24, rule 1) and disclosure was necessary to dispose fairly of the proceedings. (RSC, Order 24, rules 8 and 13(1)) I believe he was right. Even though that is the test, it should not mean that the burden of discovery should become more widespread in Patent Office proceedings. It is not normal in proceedings before the Comptroller for there to be discovery and experience has shown that discovery has not been necessary in most cases which, in

the past, have come before him. No doubt that has been because complex questions on infringement and validity normally come before the court."

Although the **Merrell Dow** case was a patent case decided under the Patents Act and the Patents Rules, the Trade Marks Act gives comparable powers to the Registrar, and I believe that the principles set out in that judgment apply equally in trade marks cases.

The particular request for discovery is framed in the affidavit of Mr. Nicholas Dynes Gracey dated 11 May, 1999 in the following terms: "PARA 2 LINE 1-3 ..... Is questionable" (I believe that that relates to the statement of case by the opponents) "because the applicant has defined 9 marks in class 16 and yet excludes details of the commercial extent of use in relation to each of the marks listed, so in respect of TM Rules 1994 Section 51 and 52, the Registrar is requested to order discovery in relation to the relative commercial consideration of each of the 9 marks to the Applicant claimed. Intellectual Property Rights (IPR)."

In my view, that request for discovery borders on the ridiculous. The term in relation to the relative commercial considerations of each of the 9 marks means that the scope of the request is so wide that it would require, in my view, the opponents to search through drawers and cupboards not only at their offices, but at the offices of their suppliers and also at the offices of their customers.

That, in my view, is totally unreasonable, and I have therefore no hesitation in rejecting the request for disclosure on that basis alone.

In reaching that view, I bear in mind the judgment of Colman J. in **O Company v. M Company** [1996] and used by the Court of Appeal, in which he commented upon the judgment of Brett LJ in **Compagnie Financiere Pacifique v. The Peruvian Guano Co.** (1882) 11 QBD 55, dealing with the relevance in the following terms at page 351: "The excessively wide application of Brett LJ's formulation of relevance has probably contributed more to the increase in the costs of English civil and commercial litigation in recent years than any factor other than the development of the photocopying machine. That formulation must not, in my judgment, be understood as justifying discovery demands which would involve parties to civil litigation being required to turn out the contents of their filing systems as if under criminal investigation merely on the offchance that something might show up from which some relatively weak inference prejudicial to the case of the disclosing party might be drawn. On the contrary, the document or class of documents must be shown by the applicant to offer a real probability of evidential materiality in the sense that it must be a document or class of documents which in the ordinary way can be expected to yield information of substantial evidential materiality to the pleaded claim and the defence to it in the broad sense which I have

explained. If the document or class cannot be demonstrated to be clearly connected to issues which have already been raised on the pleadings, or which would in the ordinary way be expected to be raised in the course of the proceedings if sufficient information were available, the application should be dismissed."

Having regard to that judgment, I have already dismissed the request for disclosure, and I believe that I was right to do so.

I go on to consider the request by the applicant for registration that these opposition proceedings be stayed until the outcome of the revocation proceedings is known. Mr. Nicholas Dynes Gracey believes that the other proceedings, i.e. the revocation proceedings, will determine the outcome here.

The other side do not believe that that matter is so clear-cut. I agree with them. Mr. Nicholas Dynes Gracey has attacked, by means of the revocation action, one of the registrations on which the opposition is based. Clearly Mr. Nicholas Dynes Gracey believes that the registration on which he has served the application for revocation is a key registration in that, I assume, he believes that the single device of a heart is more likely to be confusingly similar to the heart that appears in his trade mark. That, however, is conjecture on my part. There are nine trade mark registrations which have to be taken into account in relation to section 5(2), 5(4) and section 56, and in my

view the remaining eight cannot be discounted, nor can it be taken as read that the particular registration that Mr. Nicholas Dynes Gracey has attacked is the one that is likely to be key to the outcome of these proceedings.

Given that a stay is not likely, at least on the information I have before me at the present time, to result in a saving of time or expense by the parties, I am not prepared to grant a stay. Moreover, I believe that this request for a stay based upon an action for revocation which was launched one year after the date on which the opposition was launched, is a factor that I need to take into account. In my view, the applicant for registration has had ample opportunity to launch a revocation action which could have run in tandem with the opposition proceedings, but for whatever reason chose not to do so until a very late stage. That being so, I do not see any reason why the opponents should be inconvenienced in the way in which a stay clearly would inconvenience them, because the revocation action has barely got underway whereas the trade mark opposition proceedings are in fact ready for a hearing. Therefore Mr. Nicholas Dynes Gracey's request for a stay is refused.

Finally, I come to the matter of whether Mr. Nicholas Dynes Gracey should be allowed to give oral evidence before the Trade Marks Registry in these opposition proceedings.

The position under the Trade Marks Act and the Trade Marks Rules is set out under section 69 of the Act and rule

49 of the Rules. In essence, parties to proceedings can give evidence under the Trade Marks Rules 1994 as amended, and I am using the old Rules rather than the new because at the time of Mr. Nicholas Dynes Gracey's request the Trade Marks Registry and its users were operating under the old Rules.

Those Rules made it clear that evidence was either by way of an affidavit or a statutory declaration, but that oral evidence could be given at the direction of the Registrar. I have annexed to this decision the communication from Mr. Nicholas Dynes Gracey in response to one from the Trade Marks Registry, which asked for reasons for the various requests. There is nothing, as far as I can see, in that communication which gives any reasons whatsoever which would enable me to consider Mr. Nicholas Dynes Gracey's request further.

I reach the view therefore that this request also should be refused, and in doing so I take account of the decision of the then Assistant Registrar, Mr. J.M. Myall in **PERMO Trade Mark** [1985] RPC 597. In that case he quoted from a decision in **Kidax Ltd's Applications** [1959] RPC 167, 295, and the judgment of the Court of Appeal, Lord Evershed MR, where he said: "..... the Registrar will normally deal with these matters on this paper evidence and that a party seeking to supplement such paper evidence -- either by cross-examining a deponent or otherwise -- has a substantial onus of proof to discharge. As a matter of

administrative necessity, if for no other reason, it would no doubt be impossible for the Registrar to do other than deal with these cases as best he can, by and large, on this written material."

That was the position under the Trade Marks Act 1938. However, I do not believe that the position is any different under the Trade Marks Act 1994. As a matter of practice, proceedings before the Trade Marks Registry are dealt with on paper, parties providing evidence by way of statutory declarations or affidavits, and on the basis of oral or written submissions provided at a hearing or otherwise, following which the Registrar's hearing officer makes a decision on the substantive issue involved.

In this particular case I have already indicated that no evidence is required in order to determine the issue under section 5(2) of the Trade Marks Act 1994, which I consider to be the principal ground of opposition. That being so, I do not consider that oral evidence by Mr. Nicholas Dynes Gracey is necessary. Certainly no reasons have been put forward to justify me granting a direction allowing evidence to be given, and in the circumstances this request too is refused.

I will then move into the area of costs. You have already indicated that you are seeking a sum of £500.

MR. AYRTON: We indicated in correspondence on one of the specific issues -- I think that is in the opposition -- that if a hearing was to go ahead, then the actual cost of

attending would be approximately of the order of £500. At that time we did not know how long the hearing would actually take, nor did we fully appreciate how much work would be required in preparing for it, and whilst I appreciate that the Registry has a scale of costs for these matters and that costs are not supposed to be compensatory, if it would be helpful I would like to outline why it is that we have actually spent a considerable amount of time on this matter.

You will have seen that the correspondence has been quite protracted. Dealing with correspondence from Mr. Gracey is a time-consuming matter since it is sometimes difficult to discern precisely what his point is, and, as solicitors, we felt it was our duty, as Mr. Gracey was effectively a litigant in person, to do our best to interpret his correspondence and deal with it in as sensible and reasonable way as possible, and that, I believe, we have done.

The hearing today, in our view, was unnecessary. Certainly on the revocation action, the amendment to the pleading could very easily have been dealt with by Mr. Gracey as requested by the Registry in correspondence, but he insisted on a hearing and indeed having insisted on a hearing has decided not to turn up, having been given the proper notice.

As to the other aspects of today's hearing, the disclosure request, which I think, sir, you described as

ridiculous in your decision, the stay, the request to be allowed to put in oral evidence, the position of the opponent, The Gillette Company, appears to have been upheld by the Registry on all counts.

The costs have also, of course, mounted up from our point of view as a result of there being a whole raft of issues to deal with, each one of which has taken time to prepare for and to prepare the bundles that we provided to you, and also the skeleton arguments that we provided to you yesterday.

The only other point I would bring to your attention is that, as I think you have already alluded, Mr. Gracey is no stranger to the Registry, and indeed we have done a search to see how many marks he has applied for in the past, and you will see at the end of the table a print-out, and it seems to us that there is a public interest in discouraging this sort of behaviour. Although undoubtedly the Trade Marks Registry should give free access to all, the access provided to Mr. Gracey appears to have been abused, and we see from the print-out of trade mark applications of Mr. Gracey that he has applied for words such as INTERNET, BIO and DNA, and yet when we have done searches against Mr. Gracey's business, it appears he is in the business of printing.

As result of all of those factors, our costs have not only considerably exceeded £500, which after all was just an estimate for the time of attending just the hearing on

the opposition rather than the revocation, but this is a case where the Registrar should exercise her discretion in some way to go further than simply award a nominal sum, and certainly my quick back-of-an-envelope calculation is that the cost to The Gillette Company of this series of interim hearings will certainly exceed £3,000.

Those are our submissions on costs.

THE HEARING OFFICER: Thank you. Clearly I have not got the benefit of oral submissions from Mr. Nicholas Dynes Gracey in this matter. However, I do understand -- and this could be said to be hearsay -- that he had your skeleton argument yesterday, although he did make a comment that he had not had time to read it. Nevertheless he had it, and the issue of costs is mentioned there and was also mentioned in correspondence. He therefore was well aware that it was a matter that was likely to be brought before me today and, as far as I am aware, he has made no comments at all which I need or should take into account.

I have heard what you have said in relation to Mr. Nicholas Dynes Gracey and his role, if you like, as a registered proprietor and litigant in proceedings before the Trade Marks Registry. That is not a matter I intend to deal with today in any way, shape or form, and any order for costs that I issue will not take account of that. There is nothing, as far as I am aware, in the Trade Marks Act 1994, or indeed the Rules, which prevents anyone from applying to register trade marks and, subject to them being

accepted by the Registry, being put on the register until they are either put to use, failed to be renewed, or someone challenges them, so I am not prepared to take a stance on what you term "public interest" today.

Looking at the two particular cases, the opposition and the revocation, I will deal with the revocation first. The first point I would put to you is that you did not need to be here for that. In essence it was a matter between the Trade Marks Registry and Mr. Nicholas Dynes Gracey, and you could, if you had wished, have waited until such time as that matter of the clarification of the statement of case had been resolved and then stepped in. Therefore I am not prepared to give you an award of costs in relation to that particular action.

In relation to the opposition proceedings, there were three separate issues, the stay, the request for disclosure, and the oral evidence. All three, I think, are matters of considerable substance in the sense that there was a need to prepare, to acquire some information on the relevant law, and to provide, if only for the benefit of your client, an indication of the line which you intended to take at the hearing today on those particular issues. All of those, I am sure, did amount to a significant sum of money.

In relation to the various bits of correspondence that have gone on between yourselves, us, and Mr. Nicholas Dynes Gracey, I am not prepared to make a separate allowance for

that. You may think Mr. Nicholas Dynes Gracey is a cross that you have to bear, but that is the case in any litigation. The fact that Mr. Nicholas Dynes Gracey is a litigant in person may add to the burden, but that is a fact of life and I make no separate award because of that particular factor.

I therefore have concluded that it would be reasonable to award you a sum of money, having been successful on these preliminary issues, but that I should not depart significantly from the practice set out by the Office that parties seeking to protect or defend their intellectual property rights will get no more than a contribution towards their costs. Therefore on the basis of the three substantive items of work required for the hearing in relation to the opposition, I will award you the sum of £600. That is £200 in essence for each of the substantive issues. There will be no separate amount for attending this particular hearing. If you do wish to make a further case for an award of costs for attending this particular hearing, then you can do so at the end of the substantive hearing.

As you are aware, this case is now ready to be heard. I say that because, as I understand it, you, the opponents have put in evidence. Mr. Nicholas Dynes Gracey intends to rely upon his affidavit/counter statement. I have refused his request for oral evidence, but he has indicated in

correspondence that he does require a hearing on the substantive issues.

Therefore I intend to set a date of 14 December, 2000 for the substantive hearing on this case. I think it will be possible to meet that date, even in the event of an appeal from any of my decisions today, either to the court or to the Appointed Persons, not least because representations will be made to either of the appeals tribunal in the event of an appeal by either side that the appeal should be expedited in order that the case can be heard by the Trade Marks Registry on the date I have just fixed.

MR. AYRTON: Thank you.

The Patent Office
Trade Marks Registry

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Nicholas Dynes Gracey
Adrenalin
Tweed Horizons
Centre for Sustainable Technology
MELROSE
TD6 0SG

Your Ref: T347D_RA/T131K_BB
Our Ref: Opp 49435/Law/AE
Date: 7 March 2000

Please quote our complete reference on all correspondence

Dear Mr Gracey

Application No. 2137569 by Nicholas Dynes Gracey
Opposition No. 49435 by The Gillette Company

Thank you for your letter dated 13 December 1999 in which you comment on the counterstatement, appear to make a request to file oral evidence at the Main Hearing and ask the registrar to reconsider the decision on discovery.

Counterstatement

In your letter you expressed the desire to rely upon your "Counterstatement/Affidavit and Oral evidence at the Substantive Hearing." However, your counterstatement was filed under Rule 13(2) of the Trade Marks Rules 1994 (as amended by the Trade Marks Amendment Rules 1998) and therefore it only performs the function of being a Counterstatement. As the period for filing evidence has expired, the case is ready for a Main Hearing.

Oral Evidence

Evidence in proceedings before the registrar are governed by Rule 49 which states:

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

You should note that as these proceedings are governed by the Trade Marks Rules 1994 (as amended by the Trade Marks Amendment Rules 1998), it is not possible for you to file witness statements in lieu of a statutory declaration or affidavit.

Additionally, while oral evidence may be allowed, it is clear that it is at the discretion of the registrar. Therefore, before the registrar considers the decision, the registrar requires further

information from you. This should seek to explain why:

1. you were unable to file evidence (either as a statutory declaration or an affidavit) within the period allowed in the official letter 20 September 1999;

2. why - as a date for the Main Hearing has not yet been set - you are unable to provide this evidence in a written format (in accordance with the rule 49) but under the provisions of Rule 13(8);

Discovery

In the previous letter concerning discovery (dated 4th August 1999), the registrar decided that discovery should not be ordered prior to the evidence rounds being completed. As noted above, those rounds have been completed.

Although the registrar has not made a decision on this issue, your attention is drawn to the fact that the opponents marks cited on the Grounds of Opposition are registered marks (with the exception of 1511065 which is currently expired) and that Section 72 of the Trade Marks Act 1994 gives each registration a presumption of validity.

You are therefore required to explain why:

3. discovery is required in this issue i.e. in what way is the opponents evidence insufficiently clear for the Registrar to take a decision on?

The information in relation to both issues should be supplied within one month of the date of this letter i.e. on or before **7th April 2000**. You should note that if you fail to elaborate on your reasons within this period, the Registrar cannot consider the requests and they will be deemed withdrawn. If your further reasons are filed within this period, the registrar will allow the opponents a period in which to respond before issuing a decision on the issues.

A copy of the Lifesavers decision [RPC 563] 1997 is available upon a request made to the Register Administration Section for which a small charge (£5) is made. I have asked my colleagues to prepare the request in readiness for you, but they are not able to dispatch it until they receive the fee.

Yours faithfully

A. East
Law Section Team Leader

cc Gillette Management Inc
ref C9832/SD/MR

U117A_EA/U098A_EA <= Our ref 1/2
Your ref => Opp [redacted]/Law/AE

>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>>
(C) Wednesday, 26th April 2000
<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<<

Strictly in Confidence @ 20:40/03
*
Mr Alistair East, Law Section,
The Patent Office, TM Registry,
Cardiff Rd, Newport,
Gwent, NP9 1RH, UK.
+
(F) 01633-81-1175 @
(F) 01633-81-4444 @
(F) cc TGC 0181-568-4082 @
GILLETTE (APPLICANT)
Your ref => C9832/SD/zal
(>) Diary 12:30-WED.03.MAY.00

OPPOSITION BY GILLETTE COMPANY TO
TRADE MARK APPLICATION NO.2,137,569
IN CLASSES 9, 16, 24 & 25
'BLOOD-FLOW' (C)LOGO/GRAPHIC
IN NAME OF NICHOLAS DYNES GRACEY
FILED BY FAX THU.01.MAY.97

(1) In respect of your TM Registrar (Alistair East) 02-page WED.12.APR.00 letter & 09-enc...

(2) My case in this matter is founded on my belief that TM 1,226,399 is an invalid TM suitable for revocation;

(3) My TUE.11.MAY.99 TM8 testimony is also my counterclaim that TM 1,226,399 is invalid;

/'CROSS APPEAL'

(4) The counterclaim made at TM appeal in REV 9214 for ACADEMY was made without the payment of any fee;

(5) 21 'agreements' expressed in the Opponent's Exhibit 'AJR 5' still leaves in question the validity of Opponent's TM 1,226,399 (single heart), so my 'Applicant' desire (re TM 2,137,569) is to rely upon my TUE.11.MAY.99 Counterstatement / Affidavit and Oral Evidence at the Substantive Hearing, in relation to the issues raised in my TUE.11.MAY.99 Testimony;

Cont/d... P. 1

(6) The format of my Affidavit had apparently been accepted by the Registrar prior to the Opponent filing its Testimony *(RSC O.2, r.2)*, and furthermore, the Registrar has previously accepted Testimony in my format as early as FRL10.JAN.97 in respect of my Testimony in REV 9206, in which the first FIVE paragraphs were dedicated to 'putting on notice' my beliefs to the Applicant / Registrar as to why the Registrar should exercise DISCRETION in the acceptability of my chosen (in good conscience in accordance with my beliefs) Testimony format for an 'Affidavit' - also please see *TM Rule 49(2) & 60* and the *Civil Evidence Act 1968 & Oaths Act 1978* (both in *Section 2* of *The White Book* - In addition to which, the Registrar (Stephen P Rowan) WED.17.NOV.99 Decision (REV 9206) documents the Registrar's discretion being exercised toward the CPR ie / eg the 'Witness Statement' ('Statement of Truth') format;

(7) A copy of *Gotha City v Sotherby's [1998] 1 WLR 114* is being pursued via the British Library;

(8) In my opinion, it is in the Opponent's interest to fulfil my request for further and/or better information (TM Rule 51 & CPR) at this stage because the matters are material to my counterclaim;

(9) Following the Opponent's declaring its position on questios relating to TM 1,226,399 - then an opportunity should be given for my filing of evidence in reply;

(10) The 'presumption of validity' of TM 1,226,399 is accepted, but my counterstatement / counterclaim is that it is an invalid TM and in those circumstances, which raise ...*'a question'*... as to use and validity, then under the *TM Act 1994* the Proprietor should provide evidence of use within the most recent 5 yr period, under *section 46(5) & section 100.*

STATEMENT OF TRUTH: IT IS WED.26.APR.00 AND IN RESPECT OF ANSWERING THE QUESTION: ARE ALL THE FACTS STATED IN THIS 2-PAGE DOCUMENT SOLEMNLY BELIEVED IN GOOD CONSCIENCE, TO BE TRUE - MY ANSWER IS YES...

Nicholas Gracey NICHOLAS DYNES GRACEY
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Warm thanks...

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