

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A REQUEST FOR DISCOVERY  
BY THE REGISTERED PROPRIETORS  
IN RESPECT OF APPLICATION NO. 10032  
BY UNILEVER PLC FOR REVOCATION OF  
TRADE MARK REGISTRATION NO. 1259790  
IN THE NAME OF  
MR N D GRACEY AND MRS E GRACEY**

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### Background

15 On 3 March 1998 UNILEVER PLC applied for the revocation of registration no. 1259790 in Class  
3 for the trade mark ADRENALIN on the grounds that the trade mark in suit had not been used  
in the United Kingdom for an interrupted period of five years. The applicants, in a statutory  
declaration executed on 22 October 1998 by Adam Wilder, stated that investigations were  
undertaken prior to filing the application for revocation which revealed that the trade mark in suit  
20 had not been used anywhere in the United Kingdom for an uninterrupted period of five years. In  
the declaration Mr Wilder also stated that in his opinion the reasons for the non-use of the trade  
mark given by Mr Gracey, for the proprietors, in an affirmation dated 26 June 1998, did not  
constitute proper reasons for non-use as referred to in the Act.

25 Mr Gracey has requested discovery in two areas:

1. When the investigations of the applicants in relation to the use of the trade mark in suit  
took place. Who was instructed to effect the investigations and what the results of the  
investigations were.
- 30 2. To support the opinion of Mr Wilder as to the grounds of non-use submitted by the  
registered proprietors.

35 In a letter dated 3 June 1999 the Registrar refused the request for discovery. Subsequent to this  
Mr Gracey requested an interlocutory hearing. The interlocutory hearing took place on 14 July  
1999. Mr Gracey participated by telephone, the applicants for revocation were not present and did  
not make written submissions. At the hearing I refused the request for discovery.

40 Consequent upon this decision the registered proprietors filed form TM5 requesting a formal  
statement of grounds.

### Decision

45 The powers of the Registrar in relation to discovery are encompassed by Rules 51 and 52(1) of the  
Trade Marks Rules 1994 (as amended), which state:

“51.- At any stage of any proceedings before the registrar, he may direct that such  
documents, information or evidence as he may reasonably require shall be filed within  
such period as he may specify.

52.-(1) The registrar shall in relation to the examination of witnesses on oath and the discovery and production of documents have all the powers of an official referee of the Supreme Court.

5 At the Hearing Mr Gracey confirmed that the trade mark in suit had not been used. Therefore there is no dispute between the parties as to the non-use of the trade mark, Mr Gracey relies upon proper reasons for non-use as a defence to the application.

10 At the Hearing Mr Gracey made reference to *Dubai Aluminium Co Ltd v Al Alawi and Others (1999) 1 Lloyd's Rep 478, (1999) 1 All Er (Comm) 1* and *Manatee Towing Co and another v Oceanbulk Maritime SA and another; Oceanbulk Maritime SA and another v Manatee Towing Co and others; Manatee Towing Co and another v McQuilling Brokerage Partners Inc (The Times 11 May 1999, 143 SJLB 111)* in support of his request for discovery. I do not consider that these authorities have a bearing upon the instant case. In the former case the issue related to privilege, not an issue that has been pleaded or is relevant in the instant proceedings. In the case of the proceedings involving Manatee Towing Company the documents for which disclosure were sought were required to dispose fairly of the proceedings and were evidentially material. Hence the following comments from Rix J:

20 “Take this case: McQuilling faces a claim for breach of warranty of authority from the defendants, which can only be resolved in this action, and which cannot be fairly disposed of without access to the plaintiffs' documents regarding the condition of the vessel. The court must therefore have the necessary documents, in case it concludes that, although due to excess of authority there was not a binding contract between the plaintiffs and the defendants, nevertheless McQuilling was in breach of its warranty of authority. In such a case, the quantum of the defendants' counterclaim could only be resolved in court. Since the documents would have to be accessible to the parties and to the court, it would be necessary, if Mr Eaton were right, to resort to a subpoena - but that would not be available against someone - such as the plaintiffs - outside the jurisdiction. More cumbersome procedures would therefore have to be employed, when in my judgment the obvious procedure, under Ord.24, r.3 and/or 7, lies close to hand.”

35 It is clear that in relation to requests for discovery due caution is to be exercised by the Registrar. Aldous J in the *Merrell Dow (1991) RPC 221* stated:

40 “The Comptroller has the 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 (R.S.C., Order 24, rule 1) and disclosure was necessary to dispose fairly of the proceedings (R.S.C., 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 this has been because complex questions of infringement and validity normally come before the court.”

I also take note of the comments of Coleman J in *O Co. v. M Co. (1996) 2 Lloyd's Rep 347*:

5 “The excessively wide application of Lord Justice Brett’s formulation of relevance has probably contributed more to the increase of the costs of English civil and commercial litigation in recent years than any factor other than the development of the copying machine. That formulation must not, in my judgement, 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 off-chance 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 in 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.”

20 Coleman J puts a strong onus of justification upon the applicant for discovery.

In the instant case Mr Gracey has indicated in his statement of case and confirmed at the hearing that there has been no use of the trade mark in suit. He has also failed to furnish any evidence of use as per Rule 31(3). It, therefore, cannot be of evidential materiality or necessary to dispose fairly of the proceedings to ascertain details of the investigation that took place as to use of the trade mark in suit. Such discovery can have no bearing upon the outcome of the proceedings. Both parties agree that there has been no use of the trade mark in suit.

30 The opinion of Mr Wilder is not a matter that is open to discovery. Discovery, or disclosure, relates to documents, in the broadest terms e.g. paper documents, videos or tapes. An opinion cannot be classified as a document, it is not something that lends itself to discovery. An opinion is born of a diversity of experiences and knowledge, it is not something that can be nailed down to a document. In relation to the opinion, Mr Wilder, or his representative, will have the facility to justify the opinion by reference to the facts of the instant case and the statute and case law in his submissions. It will also be open for Mr Gracey to put forward his opinion both of his own case and that of the applicants for revocation upon the basis of the facts of the instant case and the statute and case law.

40 From Mr Gracey’s submissions at the Hearing it became clear to me that the request for discovery in relation to the investigator was not motivated by a need to have the information discovered for the fair disposal of the instant proceedings. Mr Gracey wished to know the identity of the investigator because he had experienced problems with another investigator in other proceedings. Mr Gracey made reference to the Malicious Communications Act 1988. He appeared to want discovery in relation to the investigator in case he was the same investigator with whom he had previously had dealings; also he wished to know how the investigator had behaved. As well as not being materially relevant to the instant proceedings this is clearly a fishing expedition. Mr Gracey has no reason to believe that the investigator has acted in an untoward manner or that the investigator is the same person as has been involved in other proceedings in which he is joined.

In his request for a statement of grounds Mr Gracey attached references to *P. v. T. Ltd (1997) 4 All E.R. 200* and *Norwich Pharmacal v Customs & Excise Commissioners (1974) A.C. 113*. These cases were not pleaded before me at the Hearing and therefore do not have a bearing upon the decision I made. However, on the sake of completeness I will deal with them briefly. In *P. v. T. Sir Richard Scott V.-C.* states:

“For my part, I see no reason whatever why the *Norwich Pharmacal* principle should be regarded as inapplicable to assist a prospective plaintiff to obtain information and documents necessary for the bringing of an action of libel or malicious falsehood in circumstances such as exist in the present case.”

The circumstances in *P. v. T* were very different to the instant case. The plaintiff and the Court knew that a serious allegation had been made against the plaintiff, which could potentially result in an action for malicious falsehood or defamation; an allegation that had led to the plaintiff’s dismissal. There was a clear and concrete basis for the request for discovery of the identity of the person who had made the allegation. In the instant case there has been no indication or the slightest shred of evidence to indicate that the investigator has acted in a way that could give rise to any tort. The request for the discovery is the most extreme form of fishing expedition. Mr Gracey has not shown that any harm or potential harm has been done to him by the investigator. The logical effect of the basis for Mr Gracey’s request is that any and every case before the Registrar would be appropriate for discovery on the hypothetical, and unfounded basis, that the other party or their agents may have committed a tort. I cannot see that this can be an appropriate or correct use of the Registrar’s power of discovery. To fall within the parameters of *P. v. T* Mr Gracey would have had to demonstrate that some action of the investigator would be likely to give a basis for an action in law. He has not done so.

I consider that it would be an unsatisfactory position if in revocation actions for non-use before the Registrar, each and every investigation was to be the subject of discovery. It is a common and appropriate practice for an applicant to investigate the use of a trade mark for which he seeks revocation; otherwise there would be many applications for revocations that would be deemed to failure, resulting in unnecessary cost for both registered proprietors and applicants.

**Dated this 24 day of August 1999**

**DW Landau  
Principal Hearing Officer  
For the Registrar, the Comptroller-General**