

BEFORE:

MR S THORLEY QC

IN THE MATTER OF TRADE MARKS ACT 1994

AND

**IN THE MATTER OF REGISTRATION NO 1259790 IN THE NAME OF
MR N D GRACEY AND MRS E GRACEY AND
REVOCATION NO 10032 THERETO
BY UNILEVER PLC**

**APPEAL OF REGISTERED PROPRIETOR FROM THE DECISION OF
MR D LANDAU, ACTING ON BEHALF OF THE REGISTRAR
DATED 24TH AUGUST 1999**

D E C I S I O N

(approved by the appointed person)

Mr Thorley: This is an appeal from a decision of Mr Landau, the Principal Hearing Officer, acting for the Registrar dated 24 August 1999. In that decision he refused an application for disclosure made by Mr Gracey, one of the joint proprietors of registered trade mark number 1259790, which is the subject in these proceedings of an application for revocation by
5 Unilever Plc.

The application for disclosure arose in this way. The grounds of Unilever's application are based upon Section 46 of the Trade Marks Act 1994 which relates to non use for a period of more than five years. An investigator was, as I understand it, commissioned to investigate
10 whether or not use had taken place.

In the event, Mr Gracey has never disputed that the trade mark in suit has not been used. He made it clear both before the Registry and before me that the defence to the application by Unilever was going to be based upon the provisions of Section 46 which provide that even if
15 there has been no use of the mark for a relevant period, if there are proper reasons for non use, the mark need not be revoked.

The issue therefore that is before the registry on the substantive hearing will be as to whether or not there are proper reasons for non use within the meaning of Section 46.
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The powers of the registry to order disclosure are not in doubt. In the case of Merrell Dow [1991] RPC 221 Mr Justice Aldous (as he then was) stated as follows:

“The Comptroller has the power to order discovery and does so in appropriate cases.
25 The principles which he should apply were, it appears, canvassed before the superintending examiner. He concluded that he would 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, Rule1) and the disclosure was necessary to dispose fairly of the proceedings (RSC Order 24, Rule
30 8 and 13(1) I believe he was right.”

The first question therefore that has to be asked in any application for disclosure, and the application that is made here is for disclosure of the name of the investigator, is whether or not that disclosure relates to a matter which is in question in the proceedings. I should make it plain that before the Registrar wider disclosure was sought and refused, but in the appeal before me Mr Gracey has limited his application to documents relating to the name of the investigator.

Mr Gracey both in his written submissions in his statement of grounds of the 24 September, and in his address to me today, has urged that:

“There should be something within the Trade Marks Act which should within the principles of natural justice allow somebody who alleges use of an investigator to identify who that investigator is.”

I am reading from paragraph 8 of his grounds of appeal and he goes on to state:

“It is purely in the public interest so that persons can have redress to deal with any harassment that may or may not have been involved and it would be without any prejudice at all to the application who has the investigator if they had clean hands.”

I do not believe that submission faces up to the question of relevance. In order to obtain disclosure it is necessary that the document should relate to the matters in question. It is very well settled law that there is an implied undertaking on disclosure that documents will only be used for the purposes of the application in question and not for any collateral purpose, hence the requirement for relevance.

I have been able to discern in this case no conceivable relevance of the name of the investigator to the issues that remain in this application. The only issue is the question of investigator’s actions have no relevance whatever to that.

In this respect therefore I am wholly in agreement with Mr Landau where he stated on page 3

of his judgement:

5 “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 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.”

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Mr Gracey, in support of his primary contention that there should be something within the Trade Marks Act to allow him to find out the name of the investigator, made it quite clear that his objective in seeking the name would be to allow him to take legal action as appropriate.

Paragraph 12 of his grounds of appeal states:

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“Naming the Investigator as an agent acting for and on behalf of the application would allow my taking legal action (as appropriate re: the investigator’s action (after Friday 21 March 1997) against the applicants and/or the agent.”

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Plainly therefore his desire to know the name is to open to him the possibility of bringing a collateral action against the investigator or his agent.

For the reasons given above, the principles of disclosure have always been set against such collateral use except in the most extreme circumstances.

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Mr Gracey referred the Hearing Officer and me to the decision *P v. T Ltd* [1997] 1 W.L.R. 1309, a decision of the Vice-Chancellor Sir Richard Scott. This on analysis is an application to the High Court for discovery from a third party analogous to the well-known authority in *Norwich Pharmacal v Customs & Excise Commissioners* [1974] A.C 113. Such applications

30 are rare.

In my judgement, Mr Gracey has put forward insufficient grounds in the present case of invoking an application for discovery along the lines of the Norwich Pharmacal case. In any event, whilst I do not rule out the possibility that in any extreme case it may be appropriate for the Registrar to make discovery on a Norwich Pharmacal basis, I am most concerned that this should become a frequent practice. I have not heard full argument as to the possibility of an inferior tribunal, such as the registry, making an Norwich Pharmacal order and therefore I am unable to give conclusive directions as to whether this is possible. I should however state that it is my view that applications for disclosure on the basis of the Norwich Pharmacal case should in general be directed to the High Court and to a judge.

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In the present case however the matter does not arise since I am wholly satisfied that the facts put forward by Mr Gracey are insufficient to justify any Norwich Pharmacal order. In the circumstances therefore I shall dismiss this appeal. Unilever do not appear. They do not ask for costs and so I shall make no order for costs in their favour.

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Is there anything else, Mr Gracey.

Mr Gracey: The information that the investigators found out in the dialogue that they had by writing to the company. What comments do you have on their findings if they found out quite a lot of information that would have suggested there were commercial preparations for use?

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Mr Thorley: Mr Gracey, as I understand it, I am not here to discuss what material they had. Your application was for disclosure of their names and the for reasons I have given, I am not prepared to order disclosure.

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Mr Gracey: Fine. Listen, I would just like to thank you for your time and taking the two things in one go because initially you were only going to hear one. I did try to keep the first one short. Thanks for everything and thank you for the time of the other parties involved. Good evening.

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Mr Thorley: Good evening.