

O-270-07

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN CONNECTION
WITH A REQUEST BY HOKOCHEMIE GMBH
FOR CROSS-EXAMINATION OF MR YUJI OGAWA OF HOKKO CHEMICAL
INDUSTRY CO, LTD IN REVOCATION NO. 82334 AGAINST TRADE MARK
REGISTRATION NO. 1363050**

TRADE MARKS ACT 1994

IN THE MATTER OF an interlocutory hearing held in connection with a request by Hokochemie GmbH for cross-examination of Mr Yuji Ogawa of Hokko Chemical Industry Co, Ltd in revocation no. 82334 against trade mark registration no. 1363050

BACKGROUND

1. Registration no: 1363050 is for the following trade mark:



The mark, which stands in the name of Hokko Chemical Industry Co., Ltd (hereafter HCIC) was applied for on 9 November 1988 and the registration procedure was completed on 13 March 1992. The mark which is registered in respect of:

“Chemical products included in Class 1 for use in the manufacture of perfumery, plastics, resins, medical products, polymer membranes, polymer catalysts, electroconductive materials and of photosensitive materials”,

is subject to the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the words "Chemical Industry Co Ltd".

2. On 25 November 2005, Hokochemie GmbH (hereafter HG) applied to revoke the registration. They did so on the following basis:

“3. Investigation had revealed that trade mark 1363050 has not been put to use for at least an interrupted period of five years prior to 12 October 2005.

4. With letter dated 12 October 2005 the registered agents for the trade mark 1363050 have been informed that Hokochemie intends to apply for revocations on grounds of non use and have been invited to provide appropriate proof in case Hokochemie’s view of non use is erroneous. An initial deadline of 15 November 2005 was given.

5. The registered agents responded by providing alleged commercial invoices which in Hokochemie’s view did not prove that the trade mark was put to genuine use and which were not in relation to the goods covered by the trade mark.

6. The agents were immediately advised by facsimile dated 15 November 2005 about Hokochemie's view of the matter and invited to explicitly state what products of the trade mark product list the alleged proof they provided relates to.
 7. Hokochemie also challenged the reality of the transactions claimed by the proprietor as no documents other than verifiable documents such as customs documents were provided and due to blackening of essential but not commercially sensitive data no verification was possible.
 8. No reply was received by Hokochemie until 24 October 2005.
 9. Hokochemie requests that trade mark 1363050 be revoked with effect of 12 October 2005 with regards to Section 46(1) b respectively with effect of 13 March 1997 based on Section 46(1) a."
3. On 15 March 2006, HCIC filed a counterstatement, the relevant portions of which read as follows:
- "3. The Registered Proprietor believes that the non-use investigation conducted on behalf of Hokochemie GmbH is questionable and puts the Applicant to the specific proof thereof.
 4. The Registered Proprietor acknowledges receipt of Hokochemie GmbH's letter of 12 October 2005.
 5. The Registered Proprietor refutes and rejects the view of Hokochemie GmbH put forward in paragraph 5 of the Amended Statement of Grounds.
 6. The Registered Proprietor maintains its right to protect the identity of its customers and consignees in the UK as well as the value of its sales, which has been put under scrutiny by Hokochemie GmbH in paragraph 7 of the Amended Statement of Grounds. This is commercially sensitive and confidential information that the Registered Proprietor should not be compelled to share with the Applicant.
 7. The Registered Proprietor has put the mark registered under No. 1363050 to genuine use in the United Kingdom during the past five years in respect of all or most of the goods covered therein. This is demonstrated in the accompanying Witness Statement of James Terence McAllister and Exhibits JTM1-JTM12 thereto.
 8. It is specifically denied that registration No. 1363050 is vulnerable to revocation under Section 46(1)(a) and/or 46(1)(b) of the Act for the reasons outlined or at all."

4. HCIC's evidence, provided under the provisions of rule 31(3) of the Trade Marks Rules 2000 (as amended), consisted of a witness statement dated 15 March 2006 by James Terence McAllister accompanied by twelve exhibits. In his witness statement, Mr McAllister explains that he is an Associate in the employ of Marks & Clerk who are HCIC's professional representatives in these proceedings: He adds that:

“2. The facts in this my Witness Statement have been extracted from the Registered Proprietor's records and provided to us by the Registered Proprietor's Japanese Attorneys. As far as I am aware they are both true and accurate.

3. I am duly authorised to make this Witness Statement on behalf of the Registered Proprietor”.

5. I do not think it is necessary to summarise Mr McAllister's evidence here, but note that it claims that HCIC have made genuine use of the subject mark between 25 November 2001 and 25 November 2005 on or in relation to the goods covered in Class 1. This claim is they say supported by a range of documentation, including references to various invoices, brochures, web site material, and to photographic representations of drums said to contain the chemicals and to labels which appear on these drums. I note that where invoices are provided, details of, *inter alia*, the “To” and “Consignee” details and the monetary value of the invoice have been substantially redacted.

6. HG were allowed until 27 June 2006 to file their evidence-in-chief in the proceedings. On 19 June 2006, they filed a witness statement in the name of Dr Wolfgang Munk, dated 14 June 2006, together with eight exhibits. Here again there is no need to summarise Dr Munk's evidence in detail, but I note that his statement deals with the proceedings under a number of headings which I have recorded below and are I think sufficient to give a clear indication of his areas of concern. The headings are: “Non-submission of appropriate proof of use prior to Application for Revocation”, Questionability of statements by paid witnesses”, “Facts casting doubt on the authenticity of the invoices”, “Extent of use claimed by the Registered Proprietor” and “Products and Services claimed to be covered by the commercial invoices produced”.

7. HCIC were then allowed until 19 September 2006 to file any other evidence they considered appropriate. I note that this period was initially extended to 19 December 2006, and then to 4 February 2007. On 5 February 2007 (4 February fell on a Sunday), HCIC filed a facsimile copy of a witness statement, dated 5 February 2007, in the name of Mr Yuji Ogawa; the original copy of the witness statement was filed on 14 February 2007.

8. As will become clear later in this decision, it is Mr Ogawa who HG sought to cross-examine and it was this issue that the interlocutory hearing was held. I note that Mr Ogawa's statement approaches the issues using the same headings adopted in HG's evidence and was made at a time before HCIC agreed to provide un-redacted copies of the various invoices provided in Mr McAllister's evidence. In his witness statement Mr Ogawa explains, *inter alia*, that he is the General Manager of the Fine Chemical

Marketing Department of HCIC, a position he has held since 2005 having been with the company for 30 years; that he is directly involved in the day to day business and affairs of HCIC and that the facts in his witness statement are within his own personal knowledge or have been extracted from HCIC's records to which he has full and unrestricted access. He says that HCIC did not provide HG with information regarding the precise use of the goods sold, because HCIC took the view that as a chemical company themselves HG would or should have been aware of the various applications to which the chemicals were put and adds that Marks & Clerk as HCIC's representatives were instructed to respond on their behalf. Mr Ogawa responds to other issues in Dr Munk's witness statement but I do not feel it necessary to record his comments in this regard here.

9. HG were then set a period expiring on 5 May 2007 to file any evidence-in-reply they considered appropriate. This reply evidence took the form of a further witness statement by Dr Munk, dated 2 May 2007, together with two exhibits.

10. Dr Munk deals with the issues under a number of headings, namely: "Formal aspects of Witness Statement by Yuji Ogawa", "History of the registered proprietor of obstructing the law", "Synthesis of Salicylic Acid" and "Itemised comments to Witness Statement of Yuji Ogawa". Once again, this witness statement was made at a time before HCIC agreed to provide the un-redacted invoices mentioned above. I do not propose to summarise his evidence in any detail, but note that Dr Munk subjects Mr Ogawa's witness statement to a range of criticisms under the headings mentioned above, as well as raising a number of questions regarding the form of Mr Ogawa's witness statement. For example, he notes that the witness statement does not: (i) contain any indication as to Mr Ogawa's proficiency in the English language, (ii) carry any indication of the place it was signed, (iii) contain an indication that Mr Ogawa wrote the witness statement himself and (iv) indicate that he has any training in chemistry or provide any details of his formal education or professional activity.

11. In an official letter dated 10 May 2007, the parties were advised that the evidential rounds were considered complete. They were asked whether they required a hearing or if they were content for the matter to be determined from the papers on file.

12. HG responded in a letter dated 18 May 2007. As the contents of this letter were pivotal to the issue before me at the hearing (i.e. whether or not Mr Ogawa should be cross-examined), its contents are reproduced below in full:

"The Applicant for Revocation requests the Registrar to exercise her discretion and allow the witness Yuji Ogawa to be cross-examined.

The Applicant for Revocation has severe doubts as to the accuracy and truthfulness of various parts of the statements contained in said Witness Statement and it appears necessary – particularly as the Witness did not opt for an Affidavit – to proceed to a cross-examination of the Witness.

The issues, which are not necessarily limitative, the Applicant for Revocation wishes to cross-examine are the following:

Whether the language capabilities of the witness are sufficient that the first sentence of section 5 of the Witness Statement is credible;

Criteria the witness applied to differentiate between negligible/non negligible turnovers (section 6.3 of his Witness Statement);

The intended meaning of the word “illustrate” (section 6.5);

Applications of DMBCB, DMC and 3-buten – 1-ol (section 6.6) known to or presumed by the Witness;

The specific claims that Marks & Clerk were authorised to respond on the Registered Proprietor’s behalf (section 7.1);

The basis for the statement given in section 7.5;

The reasoning for the conclusions stated in section 8.1;

The mechanisms and synthetic routes the Witness bases his Statements of Section 9.4 & 9.6 on;

Determine which uses claimed rely on actual information available to the Witness in section 11 as there is a contradiction with Section 9.11;

Section 11 states “..all or most goods...” leaving doubt whether the Witness is fully aware of the issue as he is incapable to make an informed statement.”

13. HCIC were given an opportunity to comment on HG’s request to cross-examine Mr Ogawa. Their comments, contained in a letter dated 5 June 2007, have once again, given their importance to the issue before me at the hearing, been reproduced below in full.

“1. The Applicant, from the outset of the proceedings, has appeared to be overtly suspicious of the evidence of use put forward on behalf of the Registered Proprietor;

2. We do not believe that the Registry should indulge this suspicion by the Applicant, bearing in mind the invoices evidencing *bona fide* use already put forward on behalf of the Registered Proprietor; unaltered copies of which will be made available to the Trade Marks Registry (alone) on a confidential basis. These invoices in an unaltered form leave nothing for Hokochemie GmbH to test and this will be demonstrated at the Substantive Hearing;

3. The Applicant's overt suspicion has, with respect, had the effect of obscuring the central issue in this case i.e. whether or not the mark covered by registration No. 1363050 has been put to genuine use in the United Kingdom on or in relation to the goods covered in Class 1 between the period 25 November 2001 – 25 November 2005. This uncompromising attitude has been consistent throughout the proceedings and we believe that the request for Mr Ogawa to be cross-examined is merely a further example;

4. Several questionable allegations have been made in the Witness Statements of Dr Wolfgang Munk, all of which should be rejected and ignored, and Dr Munk should not be allowed to further pursue his line of questioning through a "fishing expedition";

5. Accordingly, we do not believe that the cross-examination of Mr Yuji Ogawa would be positively helpful to the tribunal in coming to a just decision in the above case; and

6. Bearing in mind all of the above, we submit that it is both inequitable and unreasonable to expect Mr Ogawa to travel from Japan to be cross-examined on the contents of his Witness Statement as the evidence of use adduced on behalf of the Registered Proprietor speaks for itself."

14. Having considered the respective parties' positions, the Trade Marks Registry, in a letter dated 8 June 2007, issued a Preliminary View indicating that the cross-examination of Mr Ogawa should be allowed. The official letter allowed until 22 June 2007 for a hearing to be requested, an offer accepted by HCIC.

The interlocutory hearing

15. An interlocutory hearing took place before me, by video conference, on 2 August 2007. At the hearing, HG were represented by Dr Wolfgang Munk of the Applicant company; HCIC were represented by Ms Lindsay Lane of Counsel instructed by Mr Michael Alge of Marks & Clerk.

The skeleton arguments

16. Only Ms Lane provided a skeleton argument, the main points emerging from which were:

- Hokko's primary submission is that cross-examination should not be permitted in this case. However, should cross-examination be ordered it is submitted that it should take place by video link;
- the Law Section manual indicates that cross-examination should not be permitted in the following circumstances: (i) where there is nothing to test, (ii) where the issues are unimportant to the overall determination, (iii) the request is unreasonable from a

practical point of view and (iv) where the request is unreasonable in the sense of the overall administration of justice. HG's request falls within these categories for the following reasons:

- a number of the paragraphs on which HG say it wishes to cross-examine are matters of comment and/or argument, in particular paragraphs 7.5, 8.1, 9.4, 9.11 and 11. Other paragraphs which HG wish to test are self evident, in particular, the meaning of "illustrate" in paragraph 6.5 and that Marks & Clerk were authorised to respond on behalf of HG, paragraph 7.1;
- the language capabilities of Mr Ogawa in order to be able to say at paragraph 5 that he had read the witness statement of Dr Munk and considered the exhibits are also self evident. Nevertheless, if necessary, and in order to avoid the unnecessary expense and inconvenience of cross-examination, HCIC is prepared to submit a further statement from Mr Ogawa confirming his language capabilities;
- that in relation to paragraph 6.3 and the difference between negligible and non-negligible, HCIC intends to provide unredacted copies of the invoices in question, accordingly, this should no longer be an issue. To the extent that it is, it is a matter for argument whether the amount is negligible or not;
- paragraph 6.6 concerns the contents of the letter sent by HCIC in response to HG's "letter before action" and is, at most, peripheral to the issues in the proceedings;
- paragraph 9.6 HG wishes to cross-examine Mr Ogawa on the "mechanism and synthetic routes", again this is of marginal if any relevance to the proceedings;
- that it is notable that most of the issues on which HG wish to cross-examine are either matters of argument or are entirely fanciful;
- it would be unreasonable, in the overall administration of justice to bring Mr Ogawa from Japan in order to subject him to questioning of an argumentative and fanciful nature which will have little or no bearing on the proceedings;
- the request is also unreasonable from a practical point of view since Mr Ogawa would have to travel from Japan at vast expense. He would also, very probably, need to give evidence with the assistance of an interpreter. This is because although he reads, writes and speaks good English, giving oral evidence is difficult even for a native speaker and nuances in meaning may be very important. This will greatly increase the costs associated with the evidence since not only will the interpreter need to be paid, cross-examination will take much longer. Even if the cross-examination takes place by video link, an interpreter will still be needed, the video link will be costly to arrange and special provision will have to be made to accommodate the 9 hour time difference and any documents the cross-examiner wishes to put to Mr Ogawa. It is not appropriate to put HCIC to this expense and inconvenience where the reasons which have been put forward for cross-examination are so weak.

The decision following the hearing

17. At the hearing I reserved my decision. I communicated my decision to the parties in a letter dated 6 August 2007. The substance of that letter was as follows:

“I have now considered the Applicant’s request in light of: (i) Ms Lane’s skeleton argument, (ii) the respective parties’ submissions at the hearing and (iii) the comments of Mr Justice Ferris in *Alliance & Leicester Plc and Lombard Bank Ltd* [2002] RPC 29 when he said:

“It seems to me that the words of Lord Evershed in *Kidax* provide the best guide, that is to say:

"It is only consistent with the general principles upon which we administer justice here that if a party desires to test the evidence which appears by affidavit or statutory declaration, then prima facie and within reason he should be allowed to do so."

And:

“Lord Evershed’s ensuing words indicate that he envisaged the qualification "within reason" as enabling the court to avoid doing something which would be "gravely oppressive". One can also envisage cases in which it might be said that there is nothing to test, because the evidence in question manifestly gets nowhere. But I do not think it necessary to show that there is a direct conflict of evidence on a particular point. It would suffice if a declarant says something which would be relevant if true but which the opposite party is not prepared to accept without probing of the kind which is appropriately undertaken in cross-examination. Nor do I consider it a sufficient answer to say that, in the absence of such probing, the tribunal will still be able to make up its mind.”

I have also now had sight of your letter of 1 August 2007 attached to which were un-redacted copies of the invoices provided as exhibits to the witness statement of Mr McAllister.

Having noted Ms Lane’s comment that it would be a rare case indeed where cross-examination was refused, given the nature of many of the points on which the Applicant indicated that they wished to cross-examine Mr Ogawa, together with what Ms Lane characterized as the unreasonableness of the request from a practical standpoint, I have, albeit with some hesitation, come to the conclusion that the Preliminary View expressed in the official letter of 8 June 2007 should be reversed and the Applicant’s request to cross-examine Mr Ogawa should be refused. However, in coming to that conclusion, I have borne in mind the filing of the un-redacted invoices mentioned above and the Registered Proprietor’s indication that they would file a further witness statement by Mr Ogawa attesting to his language capabilities.

Of course, neither were requests before me at the hearing, and I note that at the hearing Dr Munk appeared to object to the late filing of the un-redacted invoices. How then should these proceedings continue in those circumstances?

As always, this letter does not contain a full statement of reasons for my decision. If either party wishes to appeal the decision they should file a Form TM5 requesting a statement of reasons, together with the required fee (£100) **within one month of the date of this letter.** During this period the proceedings will be suspended, and the un-redacted invoices will lay on the official file as will the Registered Proprietor's offer to provide a further witness statement from Mr Ogawa on the basis indicated above.

If neither party appeals against my decision, the second paragraph of your letter mentioned above which reads:

“We trust that you will revert to us, should you have any additional requirements for the substitution of the un-redacted copy invoices”

together with the offer contained in paragraph 6(iii) of Ms Lane's skeleton argument which reads:

“...Nevertheless, if necessary, and in order to avoid the unnecessary expense and inconvenience of cross-examination, Hokko is prepared to submit a further short statement from Mr Ogawa confirming the witness's language capabilities”,

will be treated by the Trade Marks Registry as requests by the Registered Proprietor to file further evidence under the provisions of rule 31A(6) of the Trade Marks Rules 2000 (as amended) and the Trade Marks Registry will set a short period for the Registered Proprietor to file appropriate witness statements. The Applicant will then be given an opportunity to comment on these requests. Assuming the Applicant is content with the filing of this further evidence, it is likely given the nature of the requests and the stage reached in these proceedings, that the Trade Marks Registry will accede to the requests. The Applicant will then be set a further period to file any evidence-in-reply to this further evidence it deems appropriate, on receipt of which by the Trade Marks Registry, the evidential rounds will be considered complete and a date for a substantive hearing can be arranged.

Finally, I heard submissions on costs. While the Registered Proprietor has been successful at the hearing, its success is in no small part due to its filing of the un-redacted invoices and the offer to provide a further witness statement by Mr Ogawa. Had these concessions not come so late in the day, it is possible (and I put it no higher than that), that the Applicant may have reassessed his position on cross-examination and the hearing may have proved unnecessary. In the circumstances, I do not intend to award costs to either party.”

18. The parties were allowed a period of one month from the date of this letter to file Form TM5, and in so doing to request a written statement of reasons for my decision as a precursor to launching an appeal. HG filed Form TM5, following which, I now give the reasons for my decision below.

DECISION

The Law

19. Section 69 of the Trade Marks Act 1994 (as amended) and Rule 55 of the Trade Marks Rules 2000 (as amended) are relevant to the issue of cross-examination; these read as follows:

“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) conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and

(c) applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses before such a referee.

55. (1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, 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 she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4).....

(5)”

20. It is clear from the above, that as a matter of principle it was possible for HG to request the cross-examination of Mr Ogawa on the contents of his witness statement dated 5 February 2007.

The Leading Authority

21. The leading case on whether cross-examination should or should not be allowed, is *Alliance & Leicester Plc and Lombard Bank Ltd* [2002] RPC 29. In that case Mr Justice Ferris said, *inter alia*:

“It seems to me that the words of Lord Evershed in *Kidax* provide the best guide, that is to say:

"It is only consistent with the general principles upon which we administer justice here that if a party desires to test the evidence which appears by affidavit or statutory declaration, then *prima facie* and within reason he should be allowed to do so."

And:

“Lord Evershed’s ensuing words indicate that he envisaged the qualification "within reason" as enabling the court to avoid doing something which would be "gravely oppressive". One can also envisage cases in which it might be said that there is nothing to test, because the evidence in question manifestly gets nowhere. But I do not think it necessary to show that there is a direct conflict of evidence on a particular point. It would suffice if a declarant says something which would be relevant if true but which the opposite party is not prepared to accept without probing of the kind which is appropriately undertaken in cross-examination. Nor do I consider it a sufficient answer to say that, in the absence of such probing, the tribunal will still be able to make up its mind.”

The Trade Marks Registry’s practice in relation to cross-examination

22. This was mentioned in Ms Lane’s skeleton argument and can be found at paragraph 7.11 of the Trade Marks Registry’s Law Section Work Manual. For present purposes it reads as follows:

“7.11 Oral evidence and cross examination

“...The Registrar may, if she thinks fit, permit the other party(ies) to proceedings to call a person as a witness to be cross- examined on their written evidence. Thus their written evidence is taken to be their evidence in chief...”

...The test to be applied as to whether cross-examination should be allowed has been set out in *Lombard Bank Ltd v Alliance & Leicester plc* [2002] RPC 29 where Ferris J said, in rejecting the Registrar’s more restrictive test and approving

the case of *Kidax Ltd's Applications for the registration of trade marks* [1959] RPC 167 :

[quotation as above]

Expressed slightly differently, if a party desires to test the evidence which appears by affidavit or statutory declaration, then prima facie, and within reason, he should be allowed to do so. From this it can be said that there are nevertheless circumstances where the Registrar will not allow cross-examination, e.g.

- where there is nothing to test;
- where the issues are unimportant to the overall determination (but the fact that the Registrar can make a decision without cross examination is not, of itself, a reason to refuse);
- the request is unreasonable from a practical point of view (e.g. additional hearing time, costs, availability of witness);
- where the request is unreasonable in the sense of the overall administration of justice.

This is not an exhaustive list.”

23. From the case law mentioned above, the Trade Marks Registry’s practice, and Ms Lane’s comments at the hearing, it is quite clear that the starting point in determining whether cross-examination should or should not be allowed, is that where a party wishes to cross-examine another party’s witness they should, “within reason”, be allowed to do so. The words “within reason” were those used by Lord Evershed in *Kidax*, and in *Alliance & Leicester v Lombard* Mr Justice Ferris explained that this enabled the court to avoid doing something which would be “gravely oppressive” or where there was nothing to test because the evidence in question went nowhere. There are in addition, the considerations mentioned in the Trade Marks Registry’s Work Manual, in relation to the reasonableness of the request from the practical and administration of justice standpoints.

24. From a purely practical standpoint Mr Ogawa is of course based in Japan. As Ms Lane argued at the hearing, to bring Mr Ogawa to the United Kingdom would be expensive. There would be the additional expense of an interpreter which would increase the costs associated with the hearing, and the cross-examination would take longer. Ms Lane further argued that even if cross-examination took place by video conference link (which was her fall back position) an interpreter would still be needed, the video link would be costly and special provisions would need to be made to take account of both the time difference and any documents HG may wish to put to Mr Ogawa. These are in my view sensible practical considerations which need to be borne in mind when considering whether cross-examination in cases such as this are appropriate. That said, if I had felt that the basis of HG’s request to cross-examine Mr Ogawa was valid on its face, I would,

despite these practical difficulties have ordered his attendance. Given that Mr Ogawa is based in Japan, had I considered cross-examination to be appropriate, the use of a video conference link would, in my view, have been the most sensible way forward.

25. However in the circumstances, I did not think cross-examination of Mr Ogawa was appropriate. As I indicated in my letter to the parties following the hearing, I did not (in light of the comments in *Alliance & Leicester v Lombard*) reach this conclusion without some hesitation. In order to assess the nature of HG's request for cross-examination, it is necessary to refer to HG's letter of 18 May 2007 which contained the initial request. Although this letter indicates that the reasons provided "...are not necessarily limitative..", the reasons provided in the letter must, in my view, be those I need to consider. Before looking at that letter in some detail, it is important to note that HG's concerns regarding the language capabilities of Mr Ogawa and the redacted nature of the invoices provided as exhibits to the witness statement of Mr McAllister would, in my view, have substantially abated given HCIC's willingness to provide a witness statement from Mr Ogawa in relation to the former and to make copies of the un-redacted invoices on which they rely available to both the Trade Marks Registry and HG.

26. With that background established, the areas in which HG indicated they wished to cross-examine Mr Ogawa together with my comments in bold are as follows:

HG's reason: The Applicant for Revocation has severe doubts as to the accuracy and truthfulness of various parts of the statements contained in said Witness Statement and it appears necessary – particularly as the Witness did not opt for an Affidavit – to proceed to a cross-examination of the Witness.

Mr Ogawa's evidence which is provided in the form of a witness statement accompanied by a statement of truth is acceptable under the Trade Marks Act and Rules and is consistent with the majority of evidence filed by parties to proceedings in the Trade Marks Registry; there is no necessity for him to file his evidence by way of Affidavit.

The issues, which are not necessarily limitative, the Applicant for Revocation wishes to cross-examine are the following:

HG's reason: Whether the language capabilities of the witness are sufficient that the first sentence of section 5 of the Witness Statement is credible;

This concern could be addressed by the filing of a further witness statement by Mr Ogawa attesting to his language capabilities.

HG's reason: Criteria the witness applied to differentiate between negligible/non negligible turnovers (section 6.3 of his Witness Statement);

This concern could be addressed by the filing of the un-redacted invoices mentioned above.

HG's reason: The intended meaning of the word “illustrate” (section 6.5);

This query is in relation to the pre-action correspondence between the parties and is unimportant to the overall determination of the proceedings.

HG's reason: Applications of DMBCB, DMC and 3-buten – 1-ol (section 6.6) known to or presumed by the Witness;

As immediately above.

HG's reason: The specific claims that Marks & Clerk were authorised to respond on the Registered Proprietor's behalf (section 7.1);

In his witness statement Mr McAllister makes it clear that he is authorised to make his witness statement on HCIC's behalf adding that the information in his witness statement has been extracted from HCIC's records and has been provided to him by HCIC's Japanese Attorneys; he adds that he believes the information to be both true and accurate. The approach adopted by HCIC is consistent with that adopted in a range of proceedings before the Trade Marks Registry; in effect there is nothing to test.

HG's reason: The basis for the statement given in section 7.5;

As Ms Lane pointed out at the hearing, this paragraph is simply a matter of comment and/or argument; cross-examination on this point would be unreasonable from both practical and overall administration of justice standpoints.

HG's reason: The reasoning for the conclusions stated in section 8.1;

As immediately above.

HG's reason: The mechanisms and synthetic routes the Witness bases his Statements of Section 9.4 & 9.6 on;

In so far as paragraph 9.4 is concerned, see immediately above. In relation to paragraph 9.6 the issue is, as Ms Lane argued at the hearing, of marginal if any relevance to these proceedings.

HG's reason: Determine which uses claimed rely on actual information available to the Witness in section 11 as there is a contradiction with Section 9.11;

Section 11 states “..all or most goods...” leaving doubt whether the Witness is fully aware of the issue as he is incapable to make an informed statement.”

Despite the apparent tension between the wordings of these two paragraphs, I agree with Ms Lane that they represent comment and/or argument and are appropriate for legal submissions not cross-examination.

Conclusion

27. In summary, I concluded that having applied the comments of Justice Ferris in *Alliance & Leicester v Lombard*, and in particular keeping in mind the “within reason” exception mentioned in that decision, together with HCIC’s offer to provide: (i) a further witness statement from Mr Ogawa attesting to his language capabilities and (ii) un-redacted copies of the invoices supplied as exhibits to Mr McAllister’s witness statement, what remains of the areas specifically identified by HG as areas of concern in their letter of 18 May 2007 were not appropriate for cross-examination for the reasons indicated above; I also concluded that the request was unreasonable from both a practical point of view and in the context of the overall administration of justice.

28. Finally, I made no order as to costs for the reasons mentioned in my letter to the parties following the hearing, namely:

“... While the Registered Proprietor has been successful at the hearing, its success is in no small part due to its filing of the un-redacted invoices and the offer to provide a further witness statement by Mr Ogawa. Had these concessions not come so late in the day, it is possible (and I put it no higher than that), that the Applicant may have reassessed his position on cross-examination and the hearing may have proved unnecessary. In the circumstances, I do not intend to award costs to either party.”

Dated this 14th day of September 2007

**C J BOWEN
For the Registrar
The Comptroller-General**