

TRADE MARKS ACT 1994

**IN THE MATTER OF A REQUEST BY
MATSUSHITA ELECTRIC INDUSTRIAL CO LTD
FOR THE CROSS-EXAMINATION OF
THE APPLICANT FOR REGISTRATION IN
TRADE MARK APPLICATION NO: 2048599
AND OPPOSITION THERETO UNDER NO: 46229**

TRADE MARKS ACT 1994

**IN THE MATTER OF a request by
Matsushita Electric Industrial Co Ltd
5 for the cross-examination of
the applicant for registration in
Trade Mark Application No: 2048599
and Opposition thereto under No: 46229**

BACKGROUND

10 On 14 December 1995, Satish Wadhmal Raisinghani applied to register the mark **PANACELL**
for the following specification of goods in Class 9:

15 “Apparatus and instruments for recording, transmission and/or reproduction of
sound and/or images; magnetic data carrier; calculating machines; dry cells,
accumulators and batteries; battery chargers; amusement and games apparatus
adapted for use with television receivers; facsimile machines; telephones; electric
20 irons; computers; radio alarm clocks; vacuum cleaners; electric hair curlers; electric
hair styling implements; parts and fittings for all the aforesaid goods; but not
including cinematographic or photographic apparatus and instruments”.

25 The application was accepted by the Registrar and advertised for opposition purposes on 30
October 1996. On 15 January 1997 Matsushita Electric Industrial Co Ltd filed notice of
opposition. The grounds of opposition are based upon sections 3(6), 5(2), 5(3) & 5(4) of the Trade
Marks Act 1994. The opponent relies upon registrations of the trade mark PANASONIC in Class
9 for identical goods in support of its objections under sections 5(2) & 5(3) of the Act. It relies
upon use and reputation under the mark PANASONIC and other marks with a PANA- prefix, in
30 support of its objections under sections 3(6), 5(3) & 5(4) of the Act.

Both parties filed evidence and a substantive hearing was scheduled for 7 September 2000.

35 In a letter dated 24 May 2000, AA Thornton & Co, the agents acting for the opponent, asked the
Registrar to order that the applicant, Mr Raisinghani, attend the hearing on 7 September for cross-
examination on his evidence.

40 The applicant was notified of the request and, in his agents’ letter of 4 July 2000, asked for the
request to be refused. An Interlocutory Hearing was held on 4 August 2000, at which the opponent
was represented by Mr R Arnold QC . The applicant was not represented at the hearing, but had
provided written submissions in advance.

45 Having considered Mr Arnold’s submissions, and having borne in mind the views of the applicant,
the request for cross-examination was refused.

GROUND OF DECISION

Mr Arnold agreed that the Trade Mark Rules 2000 were applicable. My attention was drawn to

the comments of the Hearing Officer in *PECKITT'S* application [1999] RPC 337, in particular his conclusion that there is a presumption in favour of cross-examination under Rule 103(2) of the Patent Rules, which is essentially the same as Rule 55(2) of the Trade Mark Rules 2000. Even if that was wrong, Mr Arnold urged me to order cross-examination as, in his view, it was particularly helpful in cases where Section 3(6) was an issue. Mr Arnold further argued that, in passing-off cases, an intention to misrepresent is a relevant (although not essential) factor and the request for cross-examination therefore bears upon the grounds pleaded under Section 5, principally Section 5(4)(a).

I am mindful of the decision of the Hearing Officer in *PECKITT'S* application. It is clearly desirable for essentially the same words in the Patent and Trade Mark Rules to have the same meaning. However, the meaning I accord to Rule 55(2) must also be consistent with Rule 55(5) which first appeared in the Trade Mark Rules 2000. While Rule 55(2) states:

“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”

Rule 55(5) states:

“Where in proceedings before the Registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

It is, of course, well established that evidence before the Registrar is usually given by way of statutory declaration or affidavit (Rule 55(1) refers), although it can be by witness statement (see Rule 55(3)). The reference to “statement” in Rule 55(5) seems intended to cover all forms of written evidence. If that is so, the only way that Rule 55(2) can be reconciled with Rule 55(5) is if the former is interpreted as meaning that there is only a presumption in favour of cross-examination where a person gives oral evidence. In those circumstances the cross-examination can extend to that persons written evidence which will probably cover the same or related matters.

It is possible to argue that the word “statement” in Rule 55(5) is intended to have the more limited meaning of a **witness** statement. However, there does not appear to be any obvious reason why it should be discretionary to allow an opposing party to call and cross-examine a person who has made a witness statement when there would be a presumption in favour of cross-examination if the same person had given evidence by affidavit or statutory declaration.

I have therefore come to the view that there is no presumption in favour of cross-examination and each such request must be considered on its merits.

If the Registrar is to order cross-examination of a witness, she must be satisfied that the cross-examination “*would be positively helpful to the tribunal in coming to a just decision*” , as per Geoffrey Hobbs QC as Appointed Person in *Wild Child* [1998] RPC 455 at 463, quoting from *Permo Trade Mark* [1985] RPC 597 at 599.

5 The grounds pleaded under section 3(6) are at paragraph 7 of the Statement of Grounds based on
an allegation that the applicant has no bona fide intention to use the mark. I understood Mr
Arnold to accept that this was not relevant to the request for cross-examination. However, the
same provision is mentioned in paragraph 8 of the grounds on the footing that the applicant
10 adopted the mark PANACELL aware of the reputation of PANASONIC, and that registration and
use of his mark would therefore be contrary to sections 5&10 of the Act. Because the section 3(6)
ground is linked in this way to section 5, it seems to me that if the opponent is unsuccessful in
relation to the grounds of objection under section 5, there is no separate basis for a finding against
the applicant under section 3(6) of the Act. This is not therefore a case which is likely to turn
15 primarily on a finding of bad faith.

The applicant's motives may be relevant to the ground of opposition under Section 5(4) of the Act,
but in all the circumstances I concluded that the likely assistance that Mr Raisinghani could
provide, was not sufficient to order him to travel from his address in Spain to appear before the
tribunal for the purposes of cross-examination. In this regard, I find the comments of the Vice
Chancellor regarding cross-examination in *NASA* trade mark [2000] RPC 321 helpful, namely:

20 *“Without precluding now any possibility of cross-examination I will say only
that I think it very unlikely that it would ever be shown that the cost and expense
and time that would be taken to arrange for cross-examination of an American
deponent on this issue would be proportionate to what is at stake in the case”.*

At the same hearing, I allowed into these proceedings some additional evidence of a Ms Dawson
on behalf of the opponent. This related, inter alia, to an admission made in earlier proceedings on
the applicant's behalf regarding the adoption of the trade mark PANASHIBA, and details of the
manner of the use of the mark PANACELL and other similar marks on the applicant's web-site.
I gave the applicant the opportunity to file evidence-in-reply by way of statutory declaration or
affidavit. This will allow the applicant to respond to the opponent's evidence. I do not consider
that any additional benefit to be gained from cross-examination would be proportionate to the
inconvenience caused from requiring the applicant to attend the hearing for cross-examination.
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For the reasons indicated, I directed against the request for cross-examination.

Dated this 15 day of August 2000

40 **ALLAN JAMES**
For the Registrar
the Comptroller-General