

O-325-04

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN
RELATION TO REVOCATION Nos: 81019-81027 BY DEMP B.V. TO
REGISTRATION Nos. 1405130, 1450753, 1450754, 1450755, 1450756, 1450757,
1450758, 1456918 & 1579281 IN THE NAME OF HOMER TLC INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF an Interlocutory Hearing
held in relation to Revocation Nos: 81019-81027
by Demp B.V. to registration Nos. 1405130, 1450753,
1450754, 1450755, 1450756, 1450757, 1450758, 1456918
& 1579281 in the name of Homer TLC Inc**

BACKGROUND

1. Trade Mark Nos. 1405130, 1450753, 1450754, 1450755, 1450756, 1450757, 1450758, 14556918 & 1579281 are registered in a range of classes; the registrations stand in the name of Homer TLC Inc of Delaware, United States of America.

2. The trade marks and their relevant details are as follows:

(i) Trade Mark No. 1405130

Trade Mark: THE HOME DEPOT

Date Filed: 17 November 1989

Date Registered: 8 April 1994

Services: Design services, all relating to houses and gardens; all included in Class 42.

(ii) Trade Mark No. 1450753

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants and mordants; all included in Class 2.

(iii) Trade Mark No. 1450754

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Ironmongery; metal fasteners and door, drapery and curtain hardware; brackets, hooks, hinges, latches, locks, screws, bolts, handles and

closures; parts and fittings therefor; all included in Class 6.

(iv) Trade Mark No. 1450755

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Power-operated machines and power-operated tools, all for domestic or garden use; compressors for machines; electric hand-held drills; power-operated saws, power-operated screwdrivers; electric glue guns; garbage disposal machines; lawn mowers, electric edgers; electric tile laying machines; parts and fittings for all the aforesaid goods; all included in Class 7.

(v) Trade Mark No. 1450756

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Hand tools; hammers, drills, saws, screw drivers, chisels; lawn tools, garden tools; rakes, shovels, shears, clippers; parts and fittings for all the aforesaid goods; all included in Class 8.

(vi) Trade Mark No. 1450757

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Electric lighting apparatus and fixtures; fans, air conditioning apparatus; hot tubs; water supply and sanitary apparatus; wash hand basins; bath tubs; bath plumbing fittings; water heaters; pipes; parts and fittings for all the aforesaid goods; all included in Class 11.

(vii) Trade Mark No. 1450758

Trade Mark: THE HOME DEPOT

Date Filed: 22 December 1990

Date Registered: 29 December 1993

Goods: Building materials; lumber, flooring; panelling; doors, windows, concrete mix; parts and fittings for all the aforesaid goods; all included in Class 19.

(viii) Trade Mark No. 1456918

Trade Mark: THE HOME DEPOT

Date Filed: 27 February 1991

Date Registered: 11 December 1992

Services: Interior design services; planning and design of gardens, furnishings, fixtures and fittings for homes; all included in Class 42.

(ix) Trade Mark No. 1579281

Trade Mark:



WHERE LOW PRICES ARE JUST THE BEGINNING

Date Filed: 31 October 1994

Date Registered: 15 September 1995

Goods: Building and construction materials; all included in Class 19.

3. By applications dated 27 September 2002, Frank B. Dehn & Co acting as agents for Demp B.V. of Hagenweg, The Netherlands, applied for these registrations to be revoked. They did so on the following basis (using Revocation No.81019 as an indicative example):

“1. The trade mark covered by the registration in question is **THE HOME DEPOT** (hereinafter referred to as “the Trade Mark”). The registration covers the following services:

Class 42: Design services, all relating to houses and gardens; all included in Class 42.

2. Enquiries have been made by the Applicant for Revocation which show that the Trade Mark has not been put to genuine use by the proprietor or with its consent in the United Kingdom in relation to the services covered by the registration for an uninterrupted period of five years prior to the filing of this application for revocation, and there are no proper reasons for non-use.

3. Accordingly, the Applicant requests revocation of the registration under Section 46(1)(b) of the Act.

4. The Applicant also asks for an award of costs in these proceedings.”

4. On 15 October 2002, the Trade Marks Registry served these applications on the Registered Proprietor’s address for service namely: Ladas & Parry; a period for the filing of a defence was set at 15 January 2003. On 25 November 2003, Linklaters filed a Form TM33 indicating that they were going to act as the agent and address for service for the registered proprietor for the purposes of these revocation proceedings.

5. On 15 January 2003 the Registered Proprietor filed counterstatements. They did so on the following basis (once again using Revocation No. 81019 as an indicative example):

“1. The Proprietor denies the allegations made in paragraph 2 of the Statement of Grounds that its trade mark no. 1405130 for THE HOME DEPOT (the “Trade Mark”) registered in class 42 has not been put to genuine use by the Proprietor in the United Kingdom in relation to the services covered by the registration for an uninterrupted period of five years prior to the filing of the Application for Revocation. The Proprietor has used the Trade Mark in the UK during such period to advertise its services – as is further described in the witness statements filed by the Proprietor in support of this Counterstatement.

2. In the alternative, if and to the extent that the Registrar concludes that the Proprietor has not made genuine use of the Trade Mark in relation to all or any of the services covered by the registration for an uninterrupted period of five years prior to the filing of the Application for Revocation, the Proprietor has proper reasons for non-use of the Trade Mark: namely, the failure of joint venture discussions with a European trading partner, as further described in the witness statements filed by the Proprietor in support of this Counterstatement.

3. The Proprietor requests that this Application for Revocation be dismissed and that the costs of this Application be awarded in its favour”.

Having noted that this counterstatement was filed in response to an attack against a specification of services, I note that when defending the attacks against those trade marks registered for goods, paragraph 1 of the counterstatement filed, for example, in Revocation No. 81020 read as follows:

“1. The Proprietor denies the allegations made in paragraph 2 of the Statement of Grounds that its trade mark no. 1450753 for THE HOME DEPOT (the “Trade Mark”) registered in class 2 has not been put to genuine use by the Proprietor in the United Kingdom in relation to the goods covered by the registration for an uninterrupted period of five years prior to the filing of the Application for Revocation. The Proprietor has used the Trade Mark in the UK during such period: on products; on packaging for products exported to the UK; and in advertising – as is further described in the witness statements filed by the Proprietor in support of this Counterstatement”.

I should mention that the counterstatements filed in relation to the attacks on trade marks registered for either goods or services are for the most part the same. That said, I note that in, for example Revocation No. 81022, the defence in paragraph 1 mentions: “....by the proprietor and/or its licensee...”; as these slight variations to the manner of the defence are not relevant for present purposes, I need make no further mention of them in this Decision.

6. In a letter dated 15 January 2003 which accompanied the registered proprietor’s defence, Linklater’s comments (where relevant) were as follows:

“1.2. Two copies of the proprietor’s evidence in these actions, namely:

1.2.1 The witness statement of Steven Levy with accompanying exhibits; and

1.2.2. The witness statement of Ivan Aldea with accompanying exhibits (only one copy of Confidential Exhibits IA7(C), IA8(C), IA9(C), IA23(C) and IA24(C) is enclosed, as to which see below).

2. Application for consolidation

Our client hereby applies to have all these actions consolidated into one action. We shortly plan to seek the consent of the applicant for revocation to this application.

3. Application that Exhibits IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C) to the witness statement of Ivan Aldea be treated as confidential.

We hereby make an application under rule 51 of the Trade Marks Rules that the Exhibits IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C) to the witness statement of Ivan Aldea be treated as confidential on the following grounds:

3.1 The exhibits in question (the “Confidential Exhibits”) are confidential and commercially sensitive customer lists containing the names and addresses of customers of our client.

3.2 The applicant for revocation is a competitor of our client.

3.3. Our client would suffer irretrievable damage if the applicant for revocation obtained access to the Confidential Exhibits.

As part of the application that the Confidential Exhibits be treated as confidential, we specifically request that:

3.4. the Confidential Exhibits not be available for inspection by any person other than the Trade Marks Registrar or her delegate, our client, ourselves and the legal advisers to the applicant for revocation; and

3.5 the legal advisers to the applicant for revocation be permitted to inspect the Confidential Exhibits only at the Patents Office, and they not be permitted to take copies of the Confidential Exhibits”.

7. In an official letter dated 28 January 2003, the Trade Marks Registry sought the Applicant's views on the Registered Proprietor's requests for consolidation and confidentiality. In their response dated 28 February 2003, Frank B. Dehn & Co on behalf of the Applicant objected to both requests. I do not propose to reproduce in full the text of their letter here. That said, the following quotes do, I hope, give a flavour of their position. In relation to the confidentiality issue, they said, inter alia:

“.....In the present cases, we would submit that neither the circumstances nor the reasons provided by the other side warrant the granting of confidentiality. In particular, with reference to item 3.3. of the other party's letter, it has not been explained **how** Homer TLC Inc “would suffer irretrievable damage if the applicant for revocation obtained access” to the Exhibits in question. However, in the event that you are nevertheless minded to grant the other side's request, we would, in the alternative, ask that the terms of the confidentiality be amended so as to avoid the inconvenience of our having to attend the Patent Office in order to view the documents. In that event, we would be prepared to make a written undertaking that, if a copy of the documents were sent to us, it would not leave our firm's premises and would not be forwarded, copied or shown to the applicant for revocation.”

And in relation to the consolidation issue:

“As regards the other side's request that the nine separate revocation actions be consolidated into a single action, again we are unable to agree. The different actions address different use issues, relate to separate classes of goods and services, and do not all concern the identical mark. We believe that the issues in question should be kept separate”.

8. In an official letter dated 19 March 2003, the Trade Marks Registry expressed the preliminary view that the request for confidentiality should be refused. Having considered the further comments contained in Linklaters letter dated 2 April 2003, the Trade Marks Registry, in an official letter dated 23 April 2003, maintained that preliminary view. In so far as the consolidation issue was concerned, having considered both side's comments, the Trade Marks Registry's preliminary view was that the proceedings should be consolidated. Following an exchange of correspondence between the Trade Marks Registry and the parties, an Interlocutory Hearing was arranged at which both issues i.e. confidentiality and consolidation could be considered.

THE INTERLOCUTORY HEARING

9. On 23 June 2003, an Interlocutory Hearing took place before me to consider the Registered Proprietor's requests mentioned above. At the Hearing Ms Anna Carboni (then) of Linklaters represented the Registered Proprietor; the Applicant for Revocation was represented by Mr Phillip Towler of Frank B. Dehn & Co.

THE SKELETON ARGUMENTS/SUBMISSIONS

10. Ordinarily, I would provide here a brief summary of the parties' skeleton arguments and submissions at the Hearing. However, as the parties' submissions at the Hearing followed (for the most part) their respective skeleton arguments, I have provided a more

comprehensive summary, as I hope it will assist any appellate body who may be required to adjudicate on the correctness or otherwise of the approach I adopted at the Hearing.

The Registered Proprietor's submissions

“Background to the confidentiality request

3. The Confidential Exhibits are referred to in the Witness Statement of Ivan Aldea, the General Manager of the export division of the Proprietor's US trading company, Home Depot USA Inc (“Home Depot”). As is evident from his Witness Statement (7, 29 and 30), these comprise the following documents:

Exhibits

IA-7(C), IA-8(C) and IA-9(C) Print –outs of customer names and addresses on Home Depot's Export Catalogue mailing list.

IA-23(C) A spreadsheet of names and addresses of Home Depot's customers outside the US who hold a Home Depot store charge card.

IA-24(C) A spreadsheet listing customers outside the US, Canada, Mexico and Puerto Rico who have ordered products through “special services desks” of Home Depot stores.

4. From the customer information contained in the Confidential Exhibits, Mr Aldea has drawn the following conclusions:

(i) Home Depot has 106 UK-based customers on its Export Catalogue mailing list (Aldea 7 and Confidential Exhibits IA-7(C), IA-8(C) and IA-9(C));

(ii) at least 63 UK-based customers hold a Home Depot store charge card (Aldea 29 and Confidential Exhibit IA-23(C)); and

(iii) export sales have been made from “special services desks” in Home Depot stores to approximately 415 UK-based customers (Aldea 30 and Confidential Exhibit IA-24(C)).

5. These conclusions will be relied on in the substantive part of these proceedings to support the Proprietor's contention that it has made genuine use of the Trade Marks. Under the confidentiality regime proposed by the Proprietor, the applicant for revocation would be in a position:

(i) to verify the conclusions drawn by requesting its trade mark attorneys to check whether the numbers of UK-based customers have been calculated correctly; and

(ii) to present arguments as to whether such conclusions support a claim to genuine use, - in each case, without there being any need for its own internal representative to examine the Confidential Exhibits.

6. The outline reasons for the Proprietor's request that the Registry impose an express confidentiality regime are:

(i) the absence of a clear implied duty of confidence or other limitation on use of information disclosed in revocation proceedings before the Registry;

(ii) the confidential and commercially sensitive nature of the Confidential Exhibits;
and

(iii) the fact that the information concerned comprises personal data of private individuals to whom both the Proprietor and the Registrar owe a duty of confidence and/or privacy.

7. The applicant for revocation has objected to the Proprietor's request by letter from Frank B. Dehn & Co dated 28 February 2003:

(i) firstly asserting that, ".....the customer lists in question presumably relate to sales in the US and appear to be irrelevant..." ; and

(ii) secondly, referring to the notice appearing in TMJ No 6202 of 19 November 1997 which states that confidentiality of evidence filed in inter partes proceedings will be granted "only in exceptional circumstances and for the most transparent and compelling reasons" and submitting that neither the circumstances nor the reasons given warrant the granting of confidentiality.

8. As to the first point, the trade mark attorneys for the applicant for revocation will be in a position to check that UK-based customers are included on the customer lists concerned, and the argument about relevance will be a matter to be dealt with in the substantive proceedings. The Proprietor's response to the second point and to the Registry's refusal to grant confidentiality is set out below.

When should confidentiality be granted?

The principles to apply in determining whether to grant confidentiality were set out by Aldous J and approved by the Court of Appeal in *Roussel Uclaf v ICI* [1990] RPC 45 at 49:

"Each case has to be decided on its own facts and the broad principle must be that the court has the task of deciding how justice can be achieved taking into account the rights and needs of the parties. The object to be achieved is that the applicant should have as full a degree of disclosure as will be consistent with adequate protection of the secret. In so doing, the court will be careful not to expose a party to any unnecessary risk of its trade secrets leaking to or being used by competitors. What is necessary or unnecessary will depend upon the nature of the secret, the position of the parties and the extent of the disclosure ordered. However, it would be exceptional to prevent a party from access to information which would play a substantial part in the case as such would mean that the party would be unable to hear a substantial part of the case, would be unable to understand the reasons for the advice given to him and, in some cases, the reasons for the judgment. Thus what disclosure is necessary entails not only practical matters arising in the conduct of a case but also the general position that a

party should know the case he has to meet, should hear matters given in evidence and understand the reasons for the judgment”.

Duty not to disseminate personal data

10. The information which the Proprietor seeks to protect comprises personal data (names, addresses and other contact details) of individuals, that has been disclosed to Home Depot by such individuals for the purpose of: obtaining copies of the Home Depot Export Catalogue; obtaining a Home Depot charge card; or obtaining products via Home Depot’s special services desks. When individuals entrust their personal details to Home Depot (as is the case for other retailers) they do so with the intention and on the understanding that this information will be used only for these specified purposes. Therefore, Home Depot has a duty to protect the privacy of these individuals and to avoid making their personal details available to any third party or the public at large without their consent.

11. Such is the public interest in controlling the way in which personal data may be dealt with, it is governed in Europe by the Data Protection Directive (Council Directive 95/46/EEC) as applied in the UK by the Data Protection Act 1998 (the “DPA”). Home Depot may not in fact be subject to the DPA (since it maintains its customer databases in the USA), and there is in any event an exception which allows for personal data to be disclosed, without the consent of the data subject, where the disclosure is necessary for the “...purpose of legal proceedings or for the obtaining of legal advice or for establishing, exercising or defending legal rights” (s35(2)DPA). Nevertheless, it is clear that UK based customers expect – and reasonably so – that retailers to whom they supply their personal information will not make such information available to the world at large.

12. As a public authority acting in the capacity of a tribunal, the Registrar is, pursuant to section 6(1) of the Human Rights Act 1998 (the “HRA”), required to exercise her discretion in a manner that is compatible with Convention rights, as defined in section 1(1) HRA. Such rights include the “right to respect of private and family life” (HRA Schedule 1 Part 1, Article 8). In circumstances where the individuals concerned are unaware that their information may be put onto a public file, they are not in a position to raise a complaint under the HRA. Nevertheless, the potential for such a claim to be raised and the related public policy weigh in favour of granting the Proprietor’s confidentiality request.

Commercial Advantage

13. The applicant for revocation is the intellectual property subsidiary of Bauhaus AG, which is in the same business as Home Depot. Both the applicant for revocation and any other competitor to whom the Confidential Exhibits were made available by being published on the Registry file would benefit enormously from having Home Depot’s customer lists. These lists are commercially sensitive documents which are currently confidential to Home Depot. Unfettered disclosure would provide the applicant for revocation, Bauhaus and other competitors with the means to market directly to Home Depot’s customers and prospective customers in the UK. This would lead both to the potential loss of sales and customers and damage to Home Depot’s goodwill, the latter particularly if the customers find out that Home Depot was the source of the

disclosure.

14. If these revocation proceedings were taking place in the High Court, CPR Rule 31.22 would apply, such that the applicant for revocation would be prohibited from using any of the Proprietor's evidence for any purpose other than for the purpose of the proceedings, subject to recognised exceptions. No such limitation appears to apply in the Registry. There is therefore a legitimate concern that the information contained in the Confidential Exhibits could be used for commercial purposes.

15. No technical knowledge or industry know-how is required for someone to be able to understand the information contained in the Confidential Exhibits. Accordingly, this is not a case where the trade mark attorneys for the applicant for revocation would need assistance to interpret the information. The applicant for revocation itself will not be prejudiced by not viewing the contact details of Home Depot's customers and prospective customers. Their trade mark attorneys will be able to summarise how many relevant customers are listed in the Confidential Exhibits and advise on how that affects the actions for revocation, without the need to disclose the personal information included in the Confidential Exhibits. Authority for the proposition that only the trade mark attorney's should view confidential documents in such a case is found in *Knutsson's and Bjork's Patents* [1996] RPC 461 at 471.

16. An alternative approach to the one which the Proprietor has taken would have been for Mr Aldea simply to have referred to the existence of the various customer lists covered by the Confidential Exhibits and made assertions as to the numbers of UK-based customers on those lists, without adducing the lists in evidence. However, the applicant for revocation would in those circumstances not have been able to verify the assertions. The Proprietor has authorised the production of the Confidential Exhibits in evidence in order that both the Registrar and the Proprietor – through its trade mark attorneys – may verify the assertions made as to the numbers of UK-based customers. It is not necessary for any officer or employee of the applicant for revocation to view the Confidential Exhibits him or herself in order to do this.

17 Weighing up the different interests of the Proprietor, the applicant for revocation and the private individuals whose details are found in the Confidential Exhibits, the Proprietor submits that this is an exceptional case in which the balance lies in favour of granting the request for confidentiality.

Consolidation

18. Inter partes proceedings in the Registry must be dealt with justly, in accordance with the overriding objective, set out in CPR rule 1.1 and followed in the Registry's Tribunal Practice Notice (TPN 1/2000). That includes, so far as is practicable:

- (a) “ensuring that the parties are on an equal footing;
- (b) saving expense;
- (c) dealing with the case in ways which are proportionate –
 - (i) to the amount of money involved;

- (ii) to the importance of the case;
- (iii) to the complexity of the issues; and
- (iv) to the financial position of each party;
- (d) ensuring that it is dealt with expeditiously and fairly; and
- (e) allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases."

19. In the nine sets of proceedings in this case:

- (i) the parties are the same;
- (ii) the Trade Marks are the same in eight classes and similar in the ninth;
- (iii) the issue is the same; has there or has there not been genuine use of the Trade Marks?
- (iv) the proceedings are at the same stage;
- (v) the Proprietor's two witnesses are the same in each case.

20. Accordingly, it would be a huge waste of the parties' time and a waste of the Registrar's time and resources for these proceedings not to be consolidated. The proper application of the overriding objective clearly favours consolidation."

The Applicant for Revocation's submissions

"Confidentiality

11. We object to the registered proprietor's request for confidentiality and dispute its claim that it would suffer irretrievable damage if the documents in question were made accessible to the applicant for revocation.

12. As the Registrar has already stated in her letter of 19 March 2003 (and affirmed in her letter of 23 April 2003), it is a basic principle of contested proceedings before the Registry that a party to the proceedings has the right to see all the evidence laid before the Registrar by the other side. This general principle was set out in the *Re K (Infants)* case quoted in Registry Practice Direction TPN 07/2000 which was referred to in our letter of 28 February 2003 and also in the Registrar's letter of 19 March 2003, and has been followed in other judgments, e.g. *VNU Business Publications B.V. v Ziff Davis (UK) Ltd* [1992] RPC 269. A similar issue was considered (in relation to a patent action) by the High Court in *The Wellcome Foundation Limited's patent* [1974] FSR 202. As also noted in TPN 07/2000, "only in exceptional circumstances and for the most transparent and compelling of reasons will the Registrar issue a Direction which denies the other side the opportunity to counter evidence in support of the pleadings against him." We submit that no such exceptional circumstances, or transparent and

compelling reasons, have been brought forward in support of the registered proprietor's case. We infer from the Registrar's letter of 23 April 2003 that this is also her considered view, and that the other party's detailed submissions dated 2 April 2003 have not led her to any different view.

13. We note that although the registered proprietor professes its "concerns about protecting the identities of the people whose information is included in the Exhibits" (letter of 2 April 2003, point 2), this appears to be inconsistent with its willingness to disclose just such information in the witness statement of Ivan Aldea, a copy of which was sent to us by the other party on 26 March 2003 (see paragraphs 12, 14, 16, 17, 20-24 and 26 of the witness statement).

14. The exhibits which the registered proprietor wishes to keep confidential are either essential to proving its case, or else they are not. If they *are* essential, then for the reasons already referred to, justice dictates that that they be fully disclosed to the applicant for revocation. If the exhibits in question are not essential, then it is suggested that they be withdrawn from the proceedings. If, as the registered proprietor indicates (letter of 2 April 2003, point 3), the exhibits contain "no information other than the names and address details of customers, or prospective customers of Homer", then it is not clear how they can be essential for proving use of the trade marks in the relevant period, e.g. without any date information.

15. As indicated earlier in our letter of 28 February 2003, in the event that the Registrar is minded to reverse its stated view on the issue of confidentiality, we would, in the alternative, ask that the terms of the confidentiality be varied from that proposed by the registered proprietor so as to avoid the inconvenience of our having to attend the Patent Office in order to view the documents. In that event, we would, if it were deemed necessary, be prepared to make a written undertaking that, if a copy of the documents were sent to us, it would not leave our firm's premises and would not be forwarded, copied or shown to the applicant for revocation.

Consolidation

16. The Registrar's preliminary view that consolidation can occur was said to have been reached "having considered the necessary criteria for consolidation and considering all possible outcomes" (Official letter of 23 April 2003). However, it was not stated which criteria and outcomes had been considered.

17. The Registry's published practice on consolidation of proceedings is found in Chapter 15 of the Trade Marks Registry Work Manual, section 7. Here it is stated (page 76): "If an application for consolidation is made by one party and objected to by the other, the parties should be informed that the Registrar intends to refuse the application for consolidation." It therefore appears that the Registry has acted contrary to its own published practice in this case.

18. It is our understanding that consolidation of proceedings is appropriate when the proceedings relate to a common question of law or fact. It is clear that these nine separate revocation actions address different use issues relating to separate classes of goods and services, and do not even all concern the identical mark. The Work Manual (page 77) states that one of the issues which should be considered in relation to a

request for consolidation is that the marks “must be the same for each case”. Such is not the case here. The applicant for revocation therefore believes that the issues in question should be kept separate.

19. On a point of procedure, it is noted from the Official letter of 23 April 2003 that “proceedings cannot be consolidated until the Form TM8 and counter-statement have been formally served.” Since the Form TM8 and counter-statement have not yet been served, the subsequent statement in the Official letter of 12 June 2003 that “at this time the proceedings are consolidated” appears to be incorrect.”

THE DECISION FOLLOWING THE INTERLOCUTORY HEARING

11. At the Hearing I made a number of decisions. These were communicated to the parties in a letter dated 24 June 2003 (addressed to Ms Carboni) the relevant portions of my letter are reproduced below:

“Having considered the parties Skeleton Arguments and authorities together with the oral submissions at the Hearing, my decisions were:

(1) The Registered Proprietors’ request that exhibits IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C) to the witness statement of Ivan Aldea dated 17 January 2003 be treated as confidential is granted. I directed that in the event that no request for written grounds against my decision is received, within the period specified below, that Frank B Dehn & Co would provide your firm with an undertaking along the lines of that mentioned in paragraph 15 of Mr Towler’s Skeleton Argument. On receipt of an acceptably worded undertaking, you agreed that you would provide Mr Towler with copies of the confidential exhibits mentioned above. I would expect Frank B Dehn & Co to provide the undertaking mentioned within 7 days of receipt of the Trade Marks Registry’s confidentiality Order. I would then expect your firm to provide Frank B Dehn & Co with copies of the confidential exhibits within 7 days of receipt of a satisfactorily worded undertaking.

At the Hearing a separate issue arose on the issue of confidentiality. You explained that in the light of the comments made in paragraph 13 of Mr Towler’s Skeleton Argument, you sought leave to have exhibits IA-14 to IA-22 to Mr Aldea’s witness statement redacted in order to delete confidential information (for example, addresses). This was a late request. However, having heard Mr Towler on the issue, it appears to me that if I was with you on the first request for confidentiality (which I am) then it was unlikely to prejudice his clients to any great extent if I were to consider the late request. Having done so, I am content that exhibits IA-14 to IA-22 of Mr Aldea’s witness statement may be redacted in the manner requested.

At the Hearing you indicated that the redacted versions of the exhibits mentioned were already available. Given that my decisions in these proceedings (absent a request for written grounds) will not become final for 1 month, it would be sensible for your firm to retain these documents until the period for appeal expires. Assuming no request for written grounds is received, copies of the redacted versions of the exhibits should be sent to both Frank B. Dehn & Co and the Trade Marks Registry within 7 days of receipt of the undertaking mentioned above; the original versions of the exhibits will then become subject to the Order for Confidentiality.

(2) In so far as the Registered Proprietors' request for consolidation is concerned, this was also granted. In my view, taking into account the overriding objective, consolidation at this early stage in the proceedings is likely to be in the interests of both parties and the Trade Marks Registry. In addition, and as I mentioned at the Hearing, it would also appear to be in keeping with the approach preferred by the Courts - see the comments of Jacob J in *Laboratoire De La Mer Trade Marks* [2002] FSR 51 when he said:

“I asked why there were two decisions rather than one. I was told that this is registry practice - as it is a requirement that evidence (largely duplicative) be separately filed in two proceedings. The registry should look at this practice again. There is no sense in requiring duplicative material. It increases costs and in fact makes cases harder to handle. It surely ought to be possible, even in the absence of any rule formally allowing for consolidation of proceedings, simply to order that evidence in one proceeding shall be treated as evidence in both, or to permit that evidence be sworn in more than one proceeding.”

Finally, I heard submissions on costs. The Registered Proprietors were successful on both of their requests. However, their request to redact exhibits IA-14 to IA-22 of Mr Aldea's Witness Statement only came to light at the Hearing itself; such a request ought to have been made much earlier. In the circumstances, I ordered the Applicants for Revocation to pay to the Registered Proprietors the sum of £100 as a contribution towards their costs in respect of this Interlocutory Hearing.

At the expiry of this period (and assuming neither party requests written grounds), the Trade Marks Registry will issue an Order for Confidentiality on the basis indicated together with an Order for costs. On receipt of the various Orders the steps indicated above will need to be taken by the respective parties in the time scales indicated”.

12. Following the issue of my letter above, Frank B. Dehn & Co on behalf of the applicant for revocation filed Form TM5 requesting a written statement of the grounds of my decision; I give this Decision below.

GROUND OF DECISION

13. At the Hearing it was necessary for me to make decisions on three issues. The first was the Registered Proprietor's request for exhibits: IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C) to the witness statement of Ivan Aldea dated January 17 2003 to remain confidential to the Trade Marks Registry and the legal advisers to the Applicant for Revocation. The second was the request made by Ms Carboni (at the Hearing), for exhibits IA-14 to IA-22 to the witness statement of Mr Aldea to be redacted to conform with the request for confidentiality already mentioned, and the third was the Registered Proprietor's request for consolidation of the proceedings. In so far as the first and third requests were concerned, the Trade Marks Registry had expressed provisional views refusing the first (the confidentiality request) and agreeing to the third (the consolidation request). Prior to the Hearing the Applicant for Revocation had objected to both the first and third requests; however, I note that both in correspondence and in their skeleton argument, the Applicant for Revocation had offered what I will refer to as a “compromise position” in the event that the Trade Marks Registry were minded to declare the contested exhibits confidential.

14. I propose to deal with the issues in the order indicated above. However before doing so, I need to consider the relevant rule relating to confidentiality and the case law that the Trade Marks Registry applies when deciding such requests.

15. Rule 51 of the Trade Marks Rules 2000 (as amended) deals with the issue of the confidentiality of documents. It reads as follows:

“Confidential documents

51. - (1) Where a document other than a form required by the registrar and published in accordance with rule 3 above is filed at the Office and the person filing it requests, at the time of filing or within fourteen days of the filing, that it or a specified part of it be treated as confidential, giving his reasons, the registrar may direct that it or part of it, as the case may be, be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the registrar.

(2) Where such direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document or part of it to which the direction relates except by leave of the registrar.

(3) The registrar shall not withdraw any direction given under this rule without prior consultation with the person at whose request the direction was given, unless the registrar is satisfied that such prior consultation is not reasonably practical.

(4) The registrar may where she considers that any document issued by the Office should be treated as confidential so direct, and upon such direction that document shall not be open to public inspection except by leave of the registrar.

(5) Where a direction is given under this rule for a document to be treated as confidential a record of the fact shall be filed with the document.”

16. Practice Direction (pdn07) issued by the Trade Marks Registry indicates how the Trade Marks Registry will approach the issue of confidentiality of evidence filed in inter partes proceedings. It reads as follows:

“Confidentiality of evidence filed in inter partes proceedings

Under the Trade Marks Act 1938, evidence filed in inter partes proceedings was not and is not available for public inspection. Any request for evidence to be treated as confidential therefore relates to the withholding of documents from the other party or parties to the proceedings but, usually, not from their legal representatives. Rule 127 of the Trade Marks and Service Marks Rules 1986 applied.

Under the provisions of the Trade Marks Act 1994, all documents filed are available for public inspection. Any request for confidentiality will therefore, prima facie, be taken to be a request for a Direction to withhold the document from inspection by the public. If it is intended to seek to withhold the document from the other party or parties to the proceedings (or made available only to their legal representatives), then the request that evidence be treated as confidential under the provisions of Rule 51 of the Trade Mark Rules 2000 must make it clear that not only is a Direction sought to

withhold the document from inspection by the public but that, in addition, access to the document is to be allowed only to a party's representative.

Practitioners should therefore note carefully the difference in emphasis as between the respective statutes on the subject of confidentiality of documents and ensure that any request to the Registrar makes clear precisely the order they seek.

Orders for confidentiality will not, however, be issued as a matter of course. Requests must continue to be supported by full and detailed reasons in each case.

In considering requests the Registrar will bear in mind the comments of Upjohn LJ in *Re K (Infants)* [1963] Ch 381; where he states:

"It seems to be fundamental to any judicial enquiry that a person or other properly interested party must have the right to see all the information put before the Judge, to comment on it, to challenge it and if needs be to combat it, and to try to establish by contrary evidence that it is wrong. It cannot be withheld from him in whole or in part. If it is so withheld and yet the Judge takes such information into account in reaching his conclusion without disclosure to those parties who are properly and naturally vitally concerned, the proceedings cannot be described as judicial."

Also the comments of Mr Justice Whitford in *Diamond Shamrock Technologies SA* [1987] RPC91; where he states:

"It is commonplace with a variety of proceedings, and patent proceedings are no exception, that the parties to the proceedings want material to be kept confidential. There are matters which they do not want to be disclosed to the public at large. What is said in these letters is that this, that or the other information contained in the declarations or exhibits should be kept confidential because "it contains sensitive commercial information".

I think it is desirable that a more exact indication should be given as to the reasons why in truth the document ought not to be disclosed because it is easy enough to talk about the material being of commercial interest and to talk of it being sensitive. That fact in itself does not necessarily mean that the material, which would otherwise become public property because it was included in the documents which are going to be open to public inspection, is to be excluded from public inspection."

The Registrar takes the view therefore that any party to proceedings before him has the right to see all the evidence laid before the Registrar by the other side. Only in exceptional circumstances and for the most transparent and compelling of reasons will the Registrar issue a Direction which denies the other side the opportunity to counter evidence filed in support of the pleadings against him."

17. Rule 51(1) of the Trade Marks Rules 2000 (as amended) indicates that in order for a request for confidentiality to be considered, it must be made either "at the time of filing" or "within fourteen days of the filing". In these proceedings, the request for confidentiality was made on 15 January 2003, which was the same date as the filing of the Registered Proprietor's Counterstatements and defence, the latter of which included the exhibits for which confidentiality is sought. In the circumstances, I conclude that the request for

confidentiality was properly made as it met the qualifying status defined in rule 51(1).

18. Having concluded that the request was properly made, I now go on to consider the substance of the request in light of the guidance provided by the Trade Marks Registry in Practice Direction pdn07. From the comments of Upjohn LJ in *Re K (Infants)* and Mr Justice Whitford in *Diamond Shamrock Technologies SA* (both of which are reproduced above) it is possible to discern a number of factors that need to be borne in mind when considering requests for confidentiality. In my view, these are:

- that a properly interested party must have the right to see all the information put before a judge;
- such information cannot be withheld from a party in whole or in part;
- that if such information is withheld and the judge takes such information into account without disclosure to those parties who are concerned the proceedings cannot be described as judicial;
- that it is commonplace for parties to proceedings to want to keep material confidential;
- that the reason provided to support such requests is often that the material contains sensitive commercial information;
- that in truth a more exact indication should be given as to why the material ought not to be disclosed.

From these principles, the Trade Marks Registry have concluded that: “only in exceptional circumstances and for the most transparent and compelling of reasons will the Registrar issue a direction which denies the other side the opportunity to counter evidence filed in support of the pleadings against him”.

19. With these principles in mind, I go on to consider the Registered Proprietor’s first request i.e. that exhibits IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C) to the witness statement of Ivan Aldea dated January 17 2003 remain confidential to the Trade Marks Registry and the legal advisers to the Applicant for Revocation.

Exhibit IA-7(C), IA-8(C) and IA-9(C)

These exhibits consist of print-outs of all the customer names and addresses which appear on the Registered Proprietor’s Export Catalogue mailing list. I note that exhibit IA-10 (which is not subject to a request for confidentiality) consists of a summary which has been prepared on the basis of the information contained in the confidential exhibits and which shows the number of customers by jurisdiction.

Exhibits IA-23(C) and IA-24(C)

These exhibits consist of (in respect of IA-23(C)) a spreadsheet showing the names and addresses of customers outside of the US who hold a Home Depot store charge card and (in respect of IA-24(C)) a spreadsheet of customers outside of the US, Canada, Mexico and Puerto Rico who have ordered products through the special services desk of a Home Depot store. I note that in relation to these exhibits Mr Aldea says he is informed by Mr Steven Levy – who has also filed evidence in these proceedings (that in relation to IA-23(C)) Mr Levy has

carried out a search on the electronic version of this spreadsheet for the terms UK, United Kingdom, England and London noting that at least 63 customers in the United Kingdom hold a Home Depot store charge card. In relation to exhibit IA-24(C) Mr Aldea notes that Mr Levy has also carried out a search on the electronic version of this spreadsheet searching for the words United Kingdom noting that approximately 415 customers with addresses in the United Kingdom have been identified.

In his witness statement dated 14 January 2003, Mr Levy comments thus:

“Since about 1994 Home Depot has also been involved in talks with several home improvement retail chains in Europe with a view to entering the European market with a European trading partner. One of the European retailers with whom Home Depot has held talks is Bauhaus AG (“Bauhaus”). The Applicant in these revocation proceedings (Demp B.V.) is Bauhaus’ intellectual property holding company.

Bauhaus operates a chain of around 170 DIY stores in Europe, the majority of which are in Germany. Towards the end of 1999 or in early 2000, executives of Bauhaus and Home Depot began talks regarding the possibility of Home Depot entering the European retail market as part of a joint venture with Bauhaus with the intention that the retail stores established would trade under the mark “The Home Depot”. The contents of these talks are commercially sensitive and confidential. However, I am aware that these negotiations got as far as the preparation of a confidential term sheet. The talks further involved reciprocal visits to the retail stores of each company by the highest levels of each company’s management during which the representatives of Bauhaus were provided with detailed information on Home Depot’s advertising and marketing strategies and methods of conducting business. Unfortunately, in the spring of 2000 the talks were abandoned without any agreement regarding a joint venture being reached.

In 2001 Homer learned that Bauhaus was using a new “The Home Store” logo which was clearly copied from Homer’s “The Home Depot” logo and that Demp had filed application in various countries for “The Home Store” logo. Furthermore, Demp filed two applications in Turkey for “THE HOME DEPOT” trade mark as a word mark. On 5 July 2002 Homer commenced trade mark infringement proceedings against Bauhaus in Germany. Around the same time Homer commenced an action in the Netherlands for nullification of three of Demp’s Benelux trade marks. In retaliation for these actions, the Applicant commenced these revocation proceedings in the UK. At the same time it also commenced actions for revocation of Homer’s trade marks for non-use in France and Sweden, and is challenging the validity of Homer’s Community trade mark registrations for THE HOME DEPOT.”

The Applicant for Revocation will, in due course, be given an opportunity to respond to these comments. However in light of the above, it is, in my view, palpably clear that the respective parties are in the same area of trade and are well known to one another. Whilst I accept that a party in adversarial proceedings should have access to all the material put before (in this case the Tribunal) by the other party, this must, in my view, be tempered by the need for parties to proceedings to keep information which is genuinely commercially sensitive confidential. In my view that is the position here. The names and addresses of customers are the lifeblood of any company’s present and future trading success; to disclose such names and addresses to a trade competitor could be extremely damaging and in this respect I am in complete agreement

with the comments made in paragraph 13 of the Registered Proprietor's skeleton argument.

However in these proceedings, the Registered Proprietor is not seeking to deny the agent's acting for the Applicant for Revocation access to the confidential exhibits, only the public at large and the Applicants for Revocation themselves; in this regard, I note in passing that the witness statement of Mr Aldea contains summaries of the confidential exhibits which would, in my view, be sufficient to satisfy both the public interest and the needs of the Applicant for Revocation. Once again I find myself agreeing with the comments made in the Registered Proprietor's skeleton argument, namely that no technical knowledge or industry know-how is required for someone to understand and interpret the information contained in the confidential exhibits (paragraph 15) and that access by the agents acting for the Applicant for Revocation will allow them to verify the conclusions drawn by Mr Aldea and Mr Levy and to present arguments as to whether such conclusions support a claim to genuine use (paragraph 5).

As a result of these conclusions, the Registered Proprietor had, in my view, satisfied the criteria mentioned by Mr Justice Whitford in *Diamond Shamrock Technologies SA* i.e. "I think it is desirable that a more exact indication should be given as to the reasons why in truth the document ought not to be disclosed..." and had also satisfied the criteria mentioned in the Trade Marks Registry's Practice Direction i.e. they had supplied compelling reasons as to why the named documents should remain confidential.

20. I now turn to consider the second request; this request was made belatedly at the Hearing by Ms Carboni in response to comments made in paragraph 13 of the Applicant for Revocation's skeleton argument. In this regard, she asked for permission for exhibits IA-14 to IA-22 to be redacted to conform with the request for confidentiality mentioned above. While strictly speaking this request did not conform with the requirement of rule 51(1) i.e. it was not made at the time of filing or within fourteen days of filing, it was clear that its omission was the result of an oversight on the part of the agents acting for the Registered Proprietor. The scope and nature of this additional request was, in my view, clearly within the scope of the original request. In the circumstances and given my decision in respect of the original request, I did not see how the redaction sought would prejudice either the agents acting for the Applicant for Revocation or the Applicant. For the same reasons indicated above, the request was allowed.

21. Finally, I turn to the question of consolidation. Consolidation is an administrative procedure designed to reduce the costs (and work) involved in dealing with two or more sets of related proceedings. In considering requests for consolidation the Trade Marks Registry apply the following general principles:

- \$ Are the parties the same?
- \$ Are the cases susceptible to having the same evidence filed: in other words, are the legal bases on which they are founded the same?
- \$ Are the marks the same for each case or do they share the same objection, eg an opposition to >Bouncybounce= could be consolidated with >Bouncybounce Bouncers= if the actions were directed at >Bouncybounce= only?
- \$ At what stage are the proceedings? Ideally they should be at the same stage or close in order to avoid suspension of one set of proceedings to enable the other

to catch up.

§ Will the issue of a single decision covering all proceedings cause complications in the event of an appeal?

In these nine revocation actions, the parties are the same, the attack on the registrations are all the same (based as they are on Section 46(1)(b) of the Act), eight of the nine trade marks are for the word only trade mark THE HOME DEPOT and the ninth revocation action is directed at THE HOME DEPOT element of the registration, six of the nine registrations were applied for on the same day i.e. 22 December 1990 and were subsequently registered from the same relevant date i.e. 29 December 1993, and all of the proceedings are the same stage. Under the provisions of the Trade Marks Act 1994, it is highly likely that the six applications mentioned would have been filed as one multiple class application. In those circumstances, the question of consolidation would never have arisen; the parties would have had to file composite evidence directed to the different categories of goods and services. In addition, consolidation of these proceedings will allow a single hearing to take place (if requested by one or more of the parties), a single decision to be issued, and will, in my view, cause no difficulties for either the Hearing Officer or an appellate body who will be required to review the composite evidence filed and make judgements as to whether there is, or is not, either genuine use or proper reasons for non-use in respect of the various trade marks and the goods or services for which they are registered.

Whilst I note that in their skeleton argument the Applicant for Revocation comment:

“The Registry’s published practice on consolidation of proceedings is found in Chapter 15 of the Trade Marks Registry Work Manual, section 7. Here it is stated (page 76): “If an application for consolidation is made by one party and objected to by the other, the parties should be informed that the Registrar intends to refuse the application for consolidation.” It therefore appears that the Registry has acted contrary to its own published practice in this case”;

it is, I think, important to bear in mind that the Law Section manual referred to was published in March 1998. Since that time Jacob J in *Laboratoire De La Mer Trade Marks* [2002] FSR 51 has commented as follows (reproduced here for the sake of convenience):

“I asked why there were two decisions rather than one. I was told that this is registry practice - as it is a requirement that evidence (largely duplicative) be separately filed in two proceedings. The registry should look at this practice again. There is no sense in requiring duplicative material. It increases costs and in fact makes cases harder to handle. It surely ought to be possible, even in the absence of any rule formally allowing for consolidation of proceedings, simply to order that evidence in one proceeding shall be treated as evidence in both, or to permit that evidence be sworn in more than one proceeding.”

In my view these comments clearly indicate that, whenever possible, the Trade Marks Registry should, whilst keeping in mind the overriding objective, consider requests for consolidation favourably. That is the approach I have adopted here.

22. In so far as costs were concerned, I ordered the Applicant for Revocation to pay to the Registered Proprietor the sum of £100. I made this award for the reasons outlined in my letter

following the interlocutory hearing, namely that:

“The Registered Proprietors were successful on both of their requests. However, their request to redact exhibits IA-14 to IA-22 of Mr Aldea’s Witness Statement only came to light at the Hearing itself; such a request ought to have been made much earlier. In the circumstances, I ordered the Applicants for Revocation to pay to the Registered Proprietors the sum of £100 as a contribution towards their costs in respect of this Interlocutory Hearing”.

CONCLUSIONS & NEXT STEPS

23. In view of my finding above I have concluded that:

(i) exhibits IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA24-(C) to the witness statement of Ivan Aldea should remain confidential to the Trade Marks Registry and the Agents acting for the Applicant for Revocation;

(ii) the Registered Proprietor be allowed to redact exhibits IA-14 to IA-22 to the witness statement of Ivan Aldea to remove references to confidential information such as names and addresses; following which, the original versions of the exhibits will be declared confidential on the same basis as the exhibits mentioned at (i) above;

AND

(iii) the nine separate revocation actions be consolidated.

In this respect, I note that the Registered Proprietor has filed evidence under the provisions of rule 31(2) of the Trade Marks Rules 2000 (as amended) in consolidated form – this is permissible. In the event that this written decision is not appealed or if appealed is upheld, it will be necessary for the agents acting for the Registered Proprietor to provide the Trade Marks Registry with a further copy of the confidential exhibits (IA-7(C), IA-8(C), IA-9(C), IA-23(C) and IA-24(C)) together with redacted copies of exhibits IA-14 to IA22 in order that they may (if the evidence provided under rule 31(2) is considered acceptable to the Trade Marks Registry) be served on the Applicant for Revocation’s agents.

Dated this 28th Day of October 2004

C J BOWEN
For the Registrar
The Comptroller General