

TRADE MARKS ACT 1994

IN THE MATTER OF:

A CONFIDENTIALITY ORDER

IN OPPOSITION No. 401000 (TWG TEA COMPANY PTE LTD)

TO TRADE MARK APPLICATION No. 3010420 (MARIAGE FRÈRES SA)

DECISION

1. TWG Tea Company Pte Ltd ('TWG') and Mariage Frères SA ('MF') are adversaries in several sets of proceedings pending in the Trade Marks Registry in which a question has arisen as to the degree to which financial information provided in witness statements filed on behalf of TWG should be kept confidential. The present appeal (brought by TWG with permission under Rule 70(2) of the Trade Marks Rules 2008) relates to a case management decision on that question made by Mr. Mark Bryant on behalf of the Registrar of Trade Marks in the context of TWG's Opposition No. 40100 to MF's Trade Mark Application No. 3010420. The decision under appeal applied equally (and it is the common intention of the parties and the Registrar that the decision made on this appeal should apply equally) to the following oppositions brought by TWG in relation to trade mark applications filed by MF: Opposition No. 401001 to Application No. 3010419; Opposition No. 401002 to Application No. 3010427; Opposition No.

401446 to Application No. 3019785; Opposition No. 401756 to Application No. 3028566; and Opposition No. 401789 to Application No. 3024670.

2. The Registrar has the power under Rules 59 and 62 of the Trade Marks Rules 2008 to make orders and give directions for the protection and preservation of confidentiality in relation to documents and parts of documents filed in Registry proceedings. The power is not exercised as a matter of course. It is exercised with circumspection and concern for the need to arrive at a just and fair determination of the proceedings, without derogating from the principle of open justice to any greater degree than necessary to give effect to legitimate claims for protection of confidentiality. In the present case, the sequence of events leading up to the making of a confidentiality order at the request of TWG was as follows:

- (i) On 29 October 2014, TWG filed a witness statement with a request for confidentiality:

You will note that the sales figures given on pages 2 and 3 of the witness statement have been redacted. The figures are confidential and given that the parties are in direct competition, our client is concerned that their disclosure could provide the Applicant with a competitive advantage which would do damage to the Opponent's business. In these circumstances, our client would disclose the figures on receipt of the following:

1. A written undertaking from the Applicant's attorneys that they will keep the sales figures confidential from any third party and in particular will not disclose those figures to their client.

2. Confirmation from the tribunal that it will treat the figures as confidential.

We look forward to hearing from you and from the Applicant's attorneys who are copied with this letter.

- (ii) MF resisted the request for confidentiality on the basis set out in a letter of 3 November 2014. It referred to the Tribunal Section of the Trade Marks Registry Work Manual (Section 4.3) and quoted from the citations of case law recorded in the Manual as the source of guiding principles. Having done so, it adopted the following position:

For these proceedings to be properly conducted, we believe that it is vital that the sales figures are provided and that actual figures be given, rather than figures pertaining to 'greater than £x'.

We respectfully request that the sales value be provided and made publicly available as we believe that this is needed to ensure that the proceedings are fair and equitable, and that the Opponent has the ability to comment on this in their evidence in reply.

Alternatively, and as a demonstration of the Opponent's reasonableness, they have suggested a compromise, namely that our firm, the French attorneys that are instructing us and the Opponent (Mariage Frères), sign an Undertaking that the sales information will be kept confidential and will not be disclosed to any third party.

- (iii) On 10 November 2014, the Registry convened a Case Management Conference under Rule 62(4) of the Trade Marks Rules 2008 to consider four matters, the fourth of which was identified as the 'issue of confidentiality of financial information contained in evidence filed by

TWG Tea Company Pte Ltd'. The Case Management Conference took place on 25 November 2014, with both sides represented at the hearing via the Registry's telephone conference link. Both sides made submissions in support of their respective positions with regard to the request for confidentiality. The Hearing Officer decided, as formally recorded in his Decision Letter issued on 26 November 2014, that:

- 3) A confidentiality order will be issued in respect of the sales figures provided in Mr Bouqdib's witness statements filed in support of TWG Tea Company Pte Ltd's case in O-40100, O-401001, O-401002, O-401446, O-401756 and O-401789. This will limit the figures to being disclosed only to Mariage Frères Sociates Anonyme's attorney in these proceedings and not to Mariage Frères Sociates Anonyme or to any third parties;
 - 4) TWG Tea Company Pte Ltd is to provide the un-redacted evidence of Mr. Bouqdib within 7 days of the date of the confidentiality order.
3. MF subsequently challenged this decision ('the First Decision') in a letter it sent to the Hearing Officer on 1 December 2014. The letter referred to the Case Management Conference held on 25 November 2014 and expressed '*concern regarding the conduct and conclusions reached at that conference*' with regard to the confidentiality of sales information. The conduct of the hearing was criticised on the basis that MF had set out its objections to the making of a confidentiality order in its letter of 3 November 2014, being one of three substantially identical letters with respect to which:

The Hearing Officer confirmed that he could see from his records that the letters had been received but that for some unexplained reason, none of the three letters had been matched with the files and had not therefore been read by him. I do not believe, therefore, that the Hearing Officer had the benefit of fully considering the position of Mariage Frères as outlined in those letters.

Could the Registry kindly explain why our letters were not placed with the relevant files.

The conclusions reached at the hearing were criticised on the basis that they went against MF's submissions, which it reiterated in the following terms:

Whilst we appreciate that the protagonists in these disputes are in direct competition, we reiterate that we do not see how and why TWG's position can be damaged by Mariage Frères being able to see historical sales figures for the particular brands in question (under the protection of a confidentiality order as our client has previously offered to supply).

What will Mariage Frères do with this historical sales information once they are in possession of it and how can it harm or damage TWG? We stress here that the information relates to historical activity for the particular brands and we and our client need, therefore, to have fully explained to us how past sales figures for a selection of brands can be harmful or damaging to TWG.

Our client is not requesting access to sensitive marketing or promotional strategy material, or customer listings, or any types of trade secret, all of which have the potential to be harmful if disclosed to a direct competitor.

As commented in our previous submissions, we request that the actual figures be supplied, rather than 'greater than' or 'in excess of' figures.

4. TWG's professional representative responded in a letter sent to the Hearing Officer on 2 December 2014:

1. I do not recollect you saying during the course of the CMC that you were unaware of any objection to TWG's 'confidentiality' requests, as suggested by Mr. Kapur. In fact the parties' dispute over this issue was one of the express reasons for which you convened the CMC.
 2. In any event, I made detailed submissions during the course of the CMC why a confidentiality order was appropriate in the circumstances of the cases in question. I also pointed out that such orders were not uncommon in registry proceedings and I referred by way of example to a case in which I was involved last year where the parties and the tribunal (Mr. Alan James) agreed the mechanism proposed in this case. (See <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o48813.pdf> at paragraph 24).
 3. In response to my submissions, Mr. Kapur on behalf of Mariage Frères made detailed submission for Mariage Frères arguing against a confidentiality order including reiterating Mariage Frères' position on the issue set out in his earlier correspondence and in Mr. Kapur's letter of yesterday.
 4. Having heard the parties' submissions you agreed to make the order for the reasons you gave during the course of the CMC. It is not appropriate for Mariage Frères to now try and reopen the matter before you. If they continue to be unhappy with your decision, their proper course is to appeal.
5. It is necessary for the purposes of the present appeal for me to expand upon the significance of these numbered points in relation to the first Decision. As to point (1), the Hearing Officer confirmed in an official letter sent to the parties on 4 December 2014 that: *'Contrary to Mr. Bartlett's recollection, I did comment at the CMC that I had not had sight of three letters submitted by Potter Clarkson dated 3 and 10 November 2014'*. Neither party disputes the accuracy of that statement. It thus appears to be the case that the Hearing Officer was aware when he made the

first Decision that he was making it without having reviewed the written submissions on confidentiality set out in letters previously sent to the Registry on behalf of MF. As to points (2) and (3), these have not been contradicted either by the Hearing Officer or by MF in any subsequent communication that I am aware of. So both sides would appear to have been given (and availed themselves of) a real and effective opportunity to make oral submissions in relation to the contested request for a confidentiality order at the hearing which took place on 25 November 2014. As to point (4), this fairly and squarely required the Hearing Officer to consider what MF was actually asking him to do in relation to the first Decision and whether he actually had the power to do it.

6. In the official letter he sent to the parties on 4 December 2014, the Hearing Officer began by stating that: *'This is a reply to the letter from Potter Clarkson, dated 1 December 2014, that raises issues regarding my decision to make a confidentiality order at the CMC of 25 November 2014'*. That, in itself, recognised that the first Decision remained in place. He then went on to say: *'I review my decision taking account of the concerns expressed by Potter Clarkson in its letters'*. That, in itself, assumed that he had the power to *'review'* the first Decision in the light of the submissions made in the letters on file at the Registry which were not, as he was aware, before him at the hearing on 25 November 2014. Having re-examined the request for confidentiality at some length, he wrote:

Whilst, I remain unconvinced by the argument that Potter Clarkson would be unable to provide submissions on the significance of the scale of use, when taking all other points into consideration, including those points contained in the

letters, I am minded to reverse my decision and decline to make a confidentiality order of the nature requested on behalf of TWG.

There are strong reasons for allowing MF to see such sales figures and it is in my view, the arguments for granting such a confidentiality order are insufficient to overcome these strong reasons. In reaching this view, I have kept in mind the guidance referred to above, the oral submissions made on behalf of both parties at the CMC, the written submissions contained in the letters and the latest communications from both sides dated the 1 December and 2 December 2014 respectively.

I note the concession made on behalf of MF that it would agree to a confidentiality order limiting disclosure of the sales figures to itself, its client and the client's French attorneys: I am minded to make such an order.

In all other respects, my directions set out in my letter of 26 November 2014 will still apply.

If either party disagrees with my amended finding then they should request a CMC within 14 days of the date of this letter (i.e. by 18 December 2014). If nothing is heard from the parties by that date, a confidentiality order will be made along the lines of MF's concession and the action points identified in my letter of 26 November 2014 will be triggered.

7. The letter notably failed to address numbered point (4) of TWG's representative's letter of 2 December 2014. It was also forthright in its expression of willingness '*to reverse my decision*' on the basis of the re-appraisal set out in the text of the letter, even though '*I remain unconvinced by the argument that Potter Clarkson would be unable to provide submissions on the scale of use*' if they received the information they were entitled to receive in accordance with the first Decision. It was quite obvious that if and when TWG exercised its right to request a hearing,

the result of doing so was likely to be a decision in which the Hearing Officer adhered to the change of position set out in his official letter of 4 December 2014.

8. TWG requested a Case Management Conference to consider the situation in a letter of 18 December 2014 which left no room for doubt as to the substance of the factual and legal contentions it was calling upon the Hearing Officer to address:

I made detailed submissions at the CMC held on 25 November in support of our position concerning the preservation of the confidentiality of the figures in question. Mr Kapur was fully aware of our position on confidentiality and put forward his client's case on the issue during the course of the CMC. If he did not put forward at the CMC every last detail of his case as set out in his letters of 3rd and 10th November, he had every opportunity of so doing. As the tribunal regularly reminds those before it written arguments in the form of skeleton arguments are not required for CMCs. However, the parties are required to be ready to deal with each of the issues active in the case one of which in the current proceedings expressly and specifically was that of my client's request and proposals for confidentiality.

You made a reasoned decision having heard the parties on the issue and the arguments they put before you at the CMC. You made a confidentiality order (and you were right to do so).

It is not in our submission in the interests of justice or the overriding objective, that our client should in these circumstances, be sent back to square one and to be required to argue its position once again.

However, given the contents of your letter we have no alternative but to ask that you convene a further case management conference on the issue during which we will explain in detail again why Mariage Frères' objections have no substance.

9. The requested Case Management Conference took place on 22 January 2015, with both sides represented at the hearing via the Registry's telephone conference link. In advance of the hearing, TWG filed a Skeleton Argument in which it reiterated that the first Decision should not be re-opened: *'Having heard the parties the Hearing Officer made an order based on a reasoned decision. That order should stand, subject to a successful appeal'*. However, the Hearing Officer did not address that submission or the inter-related factual proposition that there had already been a real and effective hearing, convened for the purpose of considering the selfsame request, on 25 November 2014. He issued a Decision Letter on 23 January 2015, annexing a copy of his official letter of 4 December 2014 and adding to the reasons given in that letter for *'concluding that ... it was appropriate to amend my direction on this point so that the confidentiality order limited disclosure of the sales figures to MF and its UK and French attorney (i.e. but not open to public inspection).'*
10. It seems from the Hearing Officer's Decision Letter of 23 January 2015 ('the second Decision') that he proceeded without any definite analysis in mind as to whether he had the power to do what he did. He adopted the position that it was open to him *'to review'* the first Decision because he had made it despite knowing of the existence of letters on file containing submissions on behalf of MF that he had not had sight of: *'I had not had sight of these beforehand. It was the existence of these written submissions and the fact that I had not reviewed these before the CMC that led me to review my direction (rather than any later submissions that my direction was not correct)'*. With regard to the nature of the *'review'* he said

'It was appropriate to reconsider the issue ...' and '... appropriate to amend my direction on this point ...', with the result that '... I decline to issue a confidentiality order in respect to these figures' and 'the directions provided under point 3) of [the Decision Letter of 26 November 2014] no longer apply'.

11. In substance and reality, the Hearing Officer issued the second Decision in response to a general application by MF for reconsideration of his first Decision, to which he acceded as if he was entitled to sit essentially by way of rehearing on appeal from his own decision. That is a power of reconsideration which, in my view, he did not possess. Moreover, his second Decision cannot, in my view, be saved from invalidity by deeming it to have been duly made pursuant to an application under Rule 74(1) of the Trade Marks Rules 2008 for *'rectification of any irregularity in procedure ... connected with any proceeding or other matter before the registrar or the Office'*.
12. The distinction between, on the one hand, purporting to decide and re-decide the same thing and, on the other hand, rectifying an irregularity in procedure was central to my decision in Andreas Stihl AG's Trade Mark Application [2001] RPC 215; BL O-379-00. In relation to the first aspect of the distinction, I observed that:

The power of administrative authorities and tribunals to revoke or modify their own determinations was examined by Michael Akehurst in an article published at [1982] Public Law 613. It is further examined in Wade and Forsyth on Administrative Law 8th Edn. (2000) at pages 235 to 238 and 915 and 916. In the light of these commentaries and in accordance with the approach adopted in recent decisions of the Court of Appeal (see Falilat Akewushola v. Secretary of State for the Home Department [1999] Imm. A.R. 594 at 599

to 601 per Sedley LJ, Peter Gibson and Laws LJJ concurring; Aparau v. Iceland Frozen Foods Plc [2000] 1 All ER 228 at 235, 236 per Moore-Bick J, Peter Gibson and Mance LJJ concurring) I think it must be recognised that the Registrar’s statutory power to determine issues arising in Registry proceedings is, in principle, “*a power to decide once and once only*” (Wade and Forsyth at p. 237) with the result that she can only revoke or modify a Registry determination, after it has been duly made and communicated in terms which are not preliminary or provisional, in cases where she is empowered to do so by the Act or the Rules cf. R v. Cripps Ex p. Muldoon [1984] 1 QB 686 (CA) at 695B per Sir John Donaldson MR.

See, now, Wade and Forsyth on Administrative Law 11th Edn (2014) at pages 191 to 193 and 784.

13. I do not need to consider whether the first Decision was made and communicated orally at the hearing on 25 November 2014 in terms which were preliminary or provisional cf CK Heating Ltd v. Doro [2010] UKEATS/0043/09/B1 at paragraphs [10] to [14]. It is sufficient for present purposes to treat the first Decision as having been made and communicated in terms which were not preliminary or provisional in the Decision Letter that the Hearing Officer sent to the parties on 26 November 2014. I take the view that this letter recording the first Decision was, for the purposes of the Registry proceedings and in accordance with Rule 69 of the 2008 Rules, the equivalent of a sealed order in civil proceedings in the High Court. The effect of a sealed order in High Court proceedings was summarised by the Supreme Court in Re L and B (Children) [2013] UKSC 8 per Lady Hale JSC at paragraph [19]:

Under the Civil Procedure Rules (rule 40.2(2)(b)), an order is now perfected by being sealed by the court. There is no jurisdiction to change one's mind thereafter unless the court has an express power to vary its own previous order. The proper route of challenge is by appeal.

I do not see how the position can be any different in relation to a decision made and communicated in terms which are not preliminary or provisional in the course of proceedings conducted within the framework of the Trade Marks Act 1994 and the Trade Marks Rules 2008. Nor do I see within that framework any express power enabling the Registrar to change his mind and on that basis revoke or vary a decision after it has been made and communicated in such terms.

14. CPR 3.1(7) provides that: 'A power of the court under these Rules to make an order includes a power to vary or revoke the order'. However, as recently confirmed by Hamblen J. in Nursing & Midwifery Council v. Harrold [2015] EWHC 2254 (QB) at paragraph [11]:

....the CPR only governs procedure in the Civil Division of the Court of Appeal, the High Court and the County Court – see section 1(1) of the Civil Procedure Act 1997. As the Claimants accept, tribunals are outside the scope of the CPR since “court” in CPR 3.11 does not include a tribunal – see Section 9(1) and Law Society of England and Wales v. Otopo [2011] EWHC 2264 (Ch) at [17].

The power conferred upon the Court by CPR 3.1(7) is therefore not available to the Registrar in proceedings under the 1994 Act and 2008 rules.

15. Rule 62(1) of the Trade Marks Rules 2008 confirms that: ‘Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit....’. I do not doubt that this enables the Registrar to give directions for the purpose of managing the implementation and operation of procedural orders that may previously have been made in the course of Registry proceedings. Nor do I doubt that as matters proceed such management might, for good reason, involve the making of orders altering or even suspending the implementation and operation of procedural orders previously made. The substantively different proposition that the administrative powers conferred upon the Registrar by Rule 62(1) for the purposes of ‘management of any proceedings’ might be taken to include a general discretionary power enabling him to change his mind and on that basis unmake procedurally regular orders appears to me to be unmaintainable.
16. I note that the Court of Appeal has decided that considerations of finality, the undesirability of allowing litigants to have two bites at the cherry and the need to avoid undermining the concept of appeal should result in a principled curtailment of the power to unmake orders conferred by the apparently broad and unfettered language of CPR 3.1(7): Tibbles v. SIG Plc [2012] EWCA Civ. 518 at paragraph [39] per Rix LJ. In paragraph 39(vii) of the Judgment in that case, it was confirmed that: ‘*such is the interest of justice in the finality of a court’s orders that it ought normally to take something out of the ordinary to lead to variation or revocation of an order, especially in the absence of a change of circumstances in an interlocutory situation.*’ In the later case of Mitchell v News Group

Newspapers Ltd [2013] EWCA Civ 1537 at paragraph [44] the Court of Appeal referred to Tibbles and summarised the effect of it as being that the discretion conferred upon the court by CPR 3.1(7) might be appropriately exercised only (i) where there had been a material change of circumstances since the order was made; (ii) where the facts on which the original decision was made had been misstated; or (iii) where there had been a manifest mistake on the part of the judge in formulating the order. The Hearing Officer did not find that the first Decision in the present case was open to review on any such basis. That leads me to conclude that he should have refused to unmake the first Decision even if (contrary to the view I have expressed above) he was the possessor of a power under the Act and the Rules equivalent to that possessed by the court under CPR 3.1(7).

17. The second aspect of the distinction upon which I based my decision in Andreas Stihl AG's Trade Mark Application (above) related to the exercise of the power conferred upon the Registrar by what is now Rule 74 of the Trade Marks Rules 2008:

Correct of irregularities in procedure

74. (1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made –

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the registrar may direct.

I decided that the Registrar's discretionary power to rectify an irregularity in procedure could be exercised in relation to a determination that would or might otherwise fall to be regarded as final.

18. My reasoning to that effect was as follows:

The principle of finality applies most strongly to determinations which have been regularly made. The Court of Appeal observed in R v. Cripps Ex parte Muldoon (above) at 695 per Sir John Donaldson MR that different considerations arise when a determination which would otherwise fall to be regarded as final "*may be said to be irregular for any of a variety of reasons*". I see no reason why the power to set aside an irregular determination should not be conferred upon the administrative authority or tribunal which made it c.f. the position with regard to courts of unlimited jurisdiction as explained by Lord Diplock in Isaacs v. Robertson [1985] 1 AC 97 (PC) at 103, 104. That is a matter for the legislature. I see no reason to look outside the Act and the Rules for limitations upon the scope of the discretionary power to correct procedural irregularities.

Section 78 of the Act enables the Secretary of State to make rules for the purposes of any provision of the Act authorising the making of rules with respect to any matter, for prescribing anything authorised or required by any provision of the Act to be prescribed and generally for regulating practice and procedure under the Act. Section 78(2)(d) specifies that provision may, in particular, be made "*authorising the rectification of irregularities of procedure*".

The Trade Marks Rules empower the Registrar to rectify "*any irregularity in procedure in or before the office or the registrar*". This is a power which the Registrar has possessed for many years. Rule 54 of the Trade Marks Rules 1890 provided that "*any irregularity in procedure which, in the opinion of the Comptroller, may be obviated without detriment to the interests of any person may be corrected if the Comptroller thinks fit, and on such terms as he may direct*": see In re Moet's Trade Mark (1890) 7 RPC 226 at 230. Similar provisions appeared in successive versions of

the Rules made under subsequent Acts. There nevertheless appears to be very little case law relating to the exercise of the power in question under the Trade Marks Acts.

...

The discretionary power is directly comparable to the power that the Registrar possesses (in her capacity as Comptroller-General of Patents) under Rule 100 of the Patents Rules 1995. That power has been used to rectify irregularities of many different kinds in proceedings in or before the Patent Office. A detailed commentary on the relevant case law can be found in the Chartered Institute of Patent Agent's Guide to the Patents Acts 4th Edn (1995) paragraphs 123.21 to 123.23 and the Supplement thereto. The fact that a determination might otherwise fall to be regarded as final does not seem to be an insuperable bar to the exercise of the relevant power provided that it is exercised consistently and compatibly with the other provisions of the Patents Act and Rules. It seems to me that the exercise of the discretionary power by the Registrar, consistently and compatibly with the other provisions of the Trade Marks Act and Rules, ought to be equally untrammelled.

I think it is open to the Registrar in the context of the Act and the Rules as a whole to rectify procedurally irregular acts of registration and procedurally irregular refusals of registration as and when they occur. I am reinforced in that view by the provisions of Sections 12(1), 21(1) and 23(1) of the Interpretation Act 1978 which make it a rule that where an Act or subordinate legislation "*confers a power ... it is implied, unless the contrary intention appears, that the power may be exercised ... from time to time as the occasion requires*". I am aware that this provision was enacted for the purpose of overcoming the inconvenience formerly caused by the doctrine that a statutory power was exhausted by its first exercise unless a contrary intention could be discovered: see Halsburys Laws of England 4th Edn. Vol. 44(1) (1995 re-issue) para. 1343. It is nonetheless sufficient, in my view, to confirm that the discretionary power should be exercised when the occasion for its exercise has in fact arisen, whether by way of a procedurally [irregular] act of registration or by way of a procedurally irregular refusal of registration or in some other way. To confine the exercise of the discretionary power to the period during which an application for registration remains pending would be to place a limitation

upon the scope of it which the legislation does not appear to me to envisage.

19. It was clear that a determination to the effect envisaged by my decision would change the Registrar's practice with regard to the rectification of procedural irregularities. I therefore directed, with the agreement of the Appellant and the Registrar, that the Appeal in that case be referred to the High Court under section 76(3) of the 1994 Act. The Appeal was subsequently resolved by consent on the terms set out in the Order of Laddie J. dated 17 May 2001, a copy of which is annexed to this decision. In the third recital to the Order, the Registrar formally confirmed that she accepted and intended to act in accordance with the decision of the Appointed Person and 'in particular that she accepts that registration of a trade mark may be withdrawn if the requirements of Sections 38 to 40 of the Trade Marks Act 1994 have been overlooked or ignored'.

20. In keeping with that approach, the first Decision in the present case was not immune from challenge under Rule 74. It was, in principle, open to MF to raise a request for rectification on the ground that the decision was tainted by an irregularity in procedure of sufficient seriousness to justify setting it aside and requiring the application for a confidentiality order be determined de novo by a different hearing officer in accordance with the usual practice. From the letter of 1 December 2014 referred to in paragraph [3] above it can be seen that any such application would have been premised upon it being procedurally irregular for the Hearing Officer to make the first Decision despite knowing of the existence of

letters on file containing submissions on behalf of MF that he had not had sight of. Whether that was, in the circumstances of the present case, sufficiently serious to justify setting the decision aside would have been an issue that raised questions for careful consideration.

21. The questions for consideration would have included these: Were the parties' professional representatives given (and did they avail themselves of) a real and effective opportunity to make oral submissions in relation to the contested request for a confidentiality order? What, if anything, additional to the oral submissions of the parties' professional representatives would the Hearing Officer have learned from reading the letters he had not had sight of? Was the Hearing Officer not, in any event, aware of the contents of the Tribunal Section of the Trade Marks Registry Work Manual referred to in those letters? Did MF's professional representative raise any objections or concerns when it became apparent that the Hearing Officer was intending to proceed despite knowing of the existence of the letters on file containing submissions on behalf of MF that he had not had sight of? Did the Hearing Officer provide the parties' professional representatives with any explanation as to why he decided to proceed despite knowing of the existence of the letters he had not had sight of? I should also add that the starting point for the Rule 74 request would have been that the first Decision had put in place an order for confidentiality that fell to be regarded as valid and effective unless and until it was either set aside for procedural irregularity at first instance or set aside for manifest error and / or procedural irregularity on appeal.

22. I can see that MF's letter of 1 December 2014 might have evolved into a Rule 74 request for rectification of procedural irregularity if the concern it expressed as to the conduct of the hearing which took place on 25 November 2014 had been analysed in terms of the power conferred upon the Registrar by the Act and the Rules that MF was actually seeking to invoke. That did not happen. And if it had happened, the matter would not have been dealt with in the way it was on route to the second Decision. For lack of any meaningful resemblance to what the decision taking process would have involved if it had been properly conducted under Rule 74, I am not willing to save the second Decision from invalidity by resorting to the fiction of deeming it to have been duly made pursuant to an application under that Rule.

23. That brings me to the Respondent's Notice in which MF contends as follows:

The Respondent contends that the decision of the Hearing Officer should not be altered, both for the reasons he gave and for the following additional reason:

- a. In respect of the ground of appeal that alleges a procedural impropriety in the Hearing Officer reviewing his own decision (before any written reasons for that decision had been issued), if, which is denied, there was any procedural impropriety in that review, the decision ought not be disturbed because, if the Hearing Officer was unable to, or would have refused to, review his own decision, the Respondent would have successfully appealed his decision on the basis that:
 - b.
 - i. he failed to hear (or read) the Respondent's written submissions of 3 and 10 November 2014; and/or
 - ii. he failed to give adequate reasons for rejecting them;

The Appointed Person on hearing that appeal would have allowed it and remitted the decision to the Hearing Officer for reconsideration taking into account all of the Respondent's submissions. The Hearing Officer would, once that issue was remitted, have reached the decision he reached on 23 January 2015.

24. This calls for the second Decision to be validated by taking it to have been legitimately made on consideration of TWG's request for a confidentiality order de novo. In order to leave the Hearing Officer free to consider the request de novo, I am asked to determine that he was entitled to write-off the first Decision. Why? Because the first Decision would supposedly have been set aside on appeal if and when MF had appealed to an Appointed Person under section 76 of the Act on the ground that it was defective for procedural irregularity and/or for failure to give adequate reasons. That looks to me like a Trojan Horse: an attempt by MF to appeal against the first Decision, embedded in a Respondent's Notice to TWG's appeal against the second Decision.
25. I decline to endorse any part of the hypothesis put forward in the Respondent's Notice. The Hearing Officer was not entitled to write-off the first Decision, still less was he free to do so upon the supposition that an appeal which had not been brought (and might never be brought) would inevitably result in it being set aside. The suggestion that the first Decision was liable to be set aside for procedural irregularity is contentious and for the reasons I have given above it cannot simply be assumed to be correct. The first Decision was also fully effective when notified to the parties in writing under Rule 69(1) with the benefit of a prescribed right to

require the Hearing Officer to provide a statement of reasons under Rule 69(2) cf Baxendale-Walker v The Law Society of England and Wales [2006] EWHC 643 (Admin) at paragraphs [27] and [28]. Further, the opportunity to require the Hearing Officer to provide a statement of reasons under Rule 69(2) in advance of an appeal complaining of failure to give adequate reasons appears to me to be what the Court of Appeal has identified as an appropriate palliative measure to apply in relation to such complaints: English v Emery Reimbold & Strick Ltd [2002] EWCA Civ 605 at paragraphs [24] and [25]. The suggestion that the first Decision was liable to be set aside for failure to give adequate reasons is contentious and it cannot simply be assumed, for the reasons I have just given, that no adequate statement of reasons could or would have been provided for the purposes of an appeal against the first Decision pursuant to a request under Rule 69(2).

26. More broadly, I do not see how it could be legitimate or appropriate for me, in the context of the present appeal against the second Decision, to determine whether an appeal that has never been brought against the first Decision might or might not have succeeded. If I attempted to write-off the first Decision on this appeal, I would not only be perpetuating the error made by the Hearing Officer, but also ignoring the following constraints on MF's ability to mount a challenge to the first Decision at the appellate level: that was an 'interim decision' which 'may only be appealed against independently of any appeal against a final decision with the leave of the registrar' under Rule 70(2); no permission to appeal the decision has been given under that Rule; it therefore remains a 'decision' with respect to which

it is 'expressly provided by rules' that no appeal shall lie under section 76(1) of the 1994 Act; and there has, in any event, been no appeal against the decision by the filing of a Form TM55 under Rule 71(1) within any period of 28 days 'beginning immediately after the date of the registrar's decision' as prescribed by Rule 71(3) in combination with Rule 69. In short, it is not open to MF to contest the first Decision at the appellate level as matters presently stand.

27. For the reasons I have given, TWG's appeal brought with permission under Rule 70(2) against the decision recorded in the Hearing Officer's letter of 23 January 2015 is allowed and the decision is in its entirety set aside. I consider that TWG should receive an award of costs under Rules 67 and 73(4) in relation to the extra work and expenditure occasioned by MF's unmaintainable application for reconsideration of the order for confidentiality recorded in the Hearing Officer's letter of 26 November 2014. The time and effort given over to dealing with that application during the period from 1 December 2014 until now seems to have been fairly substantial on both sides. Even though the basic point of difference between the parties (whether MF's in-house personnel should or should not have access to the information protected by the confidentiality order made in November 2014) could from a case management point of view be regarded as quite readily resolvable. When differences of this kind arise in High Court proceedings, they are generally resolved by providing for disclosure only to one or a few specified individuals within the receiving party's organisation, on strict terms as to confidentiality, with liberty to apply for wider dissemination of the protected information if and to the extent that it may subsequently appear to be necessary or

desirable to provide for it. I queried at the hearing whether the present dispute over the degree of access to the protected information might be resolvable by agreement from that perspective. I understood from the reaction I received that both parties are presently committed to claiming what they each respectively believe to be the full measure of their legal entitlement.

28. That being so, I think it is right to approach the question of costs on the basis that the point at issue was not unimportant to either party. Looking at matters in the round and taking account of the degree to which this has been an exceptional episode in otherwise conventional Registry proceedings, I consider that £1,500 would be a fair and proportionate sum to order MF to pay to TWG by way of contribution towards its costs of contesting the unmaintainable application for reconsideration at first instance and on appeal. That sum is to be paid within 21 days of the date of this Decision.

Geoffrey Hobbs QC

17 August 2015

Mr Ian Bartlett of Beck Greener appeared on behalf of TWG.

Ms Amanda Michaels instructed by Potter Clarkson LLP appeared on behalf of MF.

The Registrar was not represented at the hearing and took no part in the appeal.

IN THE HIGH COURT OF JUSTICE

HC 2001 No.

CHANCERY DIVISION

THE HONOURABLE MR. JUSTICE LADDIE



THURSDAY THE 17th day the MAY 2001

IN THE MATTER of THE TRADE MARKS ACT 1994

-and-

IN THE MATTER of AN APPLICATION FOR RECTIFICATION
OF THE REGISTER OF TRADE MARKS IN
RESPECT OF TRADE MARK NO. 201437 IN THE
NAME OF ANDEAS STIHL AG & CO

MINUTE OF ORDER

UPON the Appointed Person having referred the Registered Proprietor's appeal from the decision dated the 11th January 2000 of Mrs S Long (acting for the Registrar of Trade Marks) to the Court by order dated the 20th October 2000 following a written decision of the Appointed Person dated the 6th October 2000

AND UPON the parties having agreed terms of settlement of the said reference

AND UPON the Respondent the Registrar of Trade Marks indicating that she accepts and intends to act in accordance with the decision of the Appointed Person of the 6th October 2000 and in particular that she accepts that registration of a trade mark may be withdrawn in the exercise of discretionary power if the requirements of Sections 38 to 40 of the Trade Mark Act 1994 have been overlooked or ignored

AND UPON reading the documents recorded on the Court file as having being read

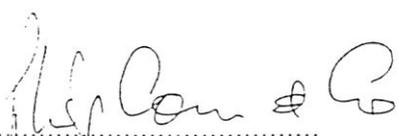
AND UPON the parties signifying their consent to this Order by their agents signing a copy of the same

AND UPON the Applicant undertaking within 28 days of the date of this Order to apply to the Registrar of Trade Marks for the withdrawal of Trade Mark Registration No. 2013437

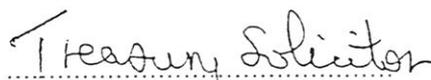
IT IS ORDERED BY CONSENT THAT:

- (1) the Applicant be at liberty to withdraw Trade Mark Registration No.2013437
- (2) a revised application for registration be advertised afresh for the purposes of opposition if the Applicant wishes to pursue the application
- (3) there be no Order as to costs.

We consent to an order being made in the terms of the above draft.


.....
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