

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION FOR RECTIFICATION  
OF PROCEDURAL IRREGULARITY  
BY NICHOLAS DYNES GRACEY  
IN RELATION TO REGISTRATION No 2024326  
IN THE NAME OF MEAT LOAF**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF AN Application for Rectification of procedural irregularity by Nicholas Dynes Gracey in relation to Registration No 2024326 in the name of Meat Loaf**

#### **BACKGROUND**

1. On 19 June 1995 Meat Loaf applied to register the trade mark BAT OUT OF HELL in Classes 9, 16, 25 and 41 of the register. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 27 June 1996 Nicholas Dynes Gracey filed a Notice of Opposition on the ground that the application contemplated unauthorised use of the relevant mark within the area of protection afforded to his earlier trade mark BAT, registration number 1335160. The applicant for registration filed a Counterstatement on 11 October 1996 denying the grounds of opposition.

2. In March 1997, the Registry came to the view that Mr Gracey's opposition should be deemed abandoned for non compliance with a requirement imposed upon him in relation to the seeking of an extension of time. The opposed application then proceeded to registration on 1 April 1997 under Section 40 of the Act.

3. Subsequently, the Trade Marks Registry decided that the decision to deem abandoned the opposition proceedings may have been in error because Mr Gracey had indicated his wish, in the absence of filing evidence, to support his opposition by means of oral submissions at a hearing to consider the substantive dispute.

4. Mr Gracey then sought the re-opening of the opposition proceedings but the Registry took the view that this was not possible and that the only action now available to him was to request a Declaration of Invalidity in respect of registration number 2024326. The Registrar was asked for a statement of reasons for the decision in writing under Section 76 of the Act and Rule 56 of the Trade Mark Rules 1994 (now Rule 62 of the Trade Mark Rules 2000). In the decision dated 16 October 2000, with a supplementary decision dated 27 November 2000 the Registrar's Hearing Officer held that

"In the circumstances it seems to me that there was an irregularity of procedure before the Office which might have been corrected by the use of Rule 60. But that is now water under the bridge. The fact that the application the subject of the opposition proceedings which were deemed abandoned is now a registered trade mark and ..... cannot be summarily removed from the Register, the Registrar having no power to do so. Mr Gracey's request for the proceedings to be re-opened must be refused."

5. Under Section 76 of the Act and Rule 57 of the 1994 Rules (now Rule 63 of the 2000

Rules) Mr Gracey appealed the decision of the Registrar's hearing officer to the Appointed Person. In his decision dated 19 September 2001 (SRIS 0/455/01) the Appointed Person, Mr Geoffrey Hobbs QC, reached the following conclusions:-

"It is now accepted on all sides that the decision to treat Mr Gracey's opposition as abandoned was procedurally irregular and that his application for the irregularity to be rectified in the exercise of the discretionary power conferred upon the Registrar by rule 60 of the Trade Marks Rules 1994 (now rule 66 of the Trade Marks Rules 2000) was wrongly rejected in the Hearing Officer's decision dated 16<sup>th</sup> October 2000. It was wrongly rejected on the basis that the Registrar was powerless to reopen the opposition proceedings because the application in question had proceeded to registration. The question of how the discretion to rectify the procedural irregularity might have been exercised if the Hearing Officer had taken the view that the Registrar had the power that Mr Gracey was inviting her to invoke was not considered in the decision.

Having listened to the submissions on either side, it appears to me that it would be inappropriate for me to exercise the relevant discretion de novo on appeal. I will therefore direct that the Hearing Officer's decision of 16<sup>th</sup> October 2000 be set aside and that the application for rectification of procedural irregularity be remitted to the Registrar for consideration and determination by a different Hearing Officer."

6. The matter now falls to me, as a different hearing officer, for consideration and decision. Both parties, Mr Gracey and Meat Loaf, have been given the opportunity to make submissions. No submissions were received by or on behalf of Meat Loaf. Mr Gracey responded by requesting an award of costs against the Registrar.

## **DECISION**

7. The powers of the Registrar in relation to the correction of irregularities of procedure are set out in Rule 66 of The Trade Mark Rules 2000, which reads as follows:-

"66. Subject to Rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct."

8. Rule 68 concerns the alteration of time limits and the relevant part for the purposes of this decision is Rule 68(7), which reads:-

"(7) Without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which-

- (a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and
- (b) is attributable wholly or in part to an error, default or omission on the part of

the Office or the registrar and which it appears to her should be rectified,

she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct."

9. In his decision of 19 September 2001, the Appointed Person directed that:-

"The consideration and determination of the application for rectification should be undertaken with appropriate regard for, first of all, the decision in **Andreas Stihl AG & Co.'s** application [2001] RPC 215; secondly, the Registrar's position as stated in the third recital to the order made by Laddie J. on 19<sup>th</sup> May 2001 on reference of the **Andreas Stihl AG & Co.** case to the High Court; and thirdly, paragraphs 53 to 55 of the decision on appeal in the matter of application number 11654 for revocation of the **Gillette Company's** trade mark number 1226339 (23 May 2001)."

10. In the present case it was accepted in the Hearing Officer's decision of 16 October 2000 that Mr Gracey's opposition was validly filed; that there had been an irregularity in procedure in the Office in that the Practice Direction in relation to the abandonment of opposition proceedings was not followed; and that the opposition was incorrectly deemed abandoned. I am in full agreement with these findings of fact. It seems to me that Mr Gracey had made it clear that he did not intend to submit evidence but wished to rely upon oral submissions at a hearing. The extension of time issue which resulted in the abandonment of the opposition proceedings can be construed as little more than a "red herring" in that it was basically irrelevant to the way in which Mr Gracey legitimately wished to pursue the opposition.

11. It is now accepted on all sides that it is open to the Registrar to rectify procedurally irregular acts of registration, as and when they occur, by virtue of the discretionary power conferred upon the Registrar by Rule 66.

12. Bearing in mind the guidance from the Appointed Person I go on to consider whether the procedural irregularity was material in its effect. Given that the abandonment of the opposition proceedings resulted in the registration of application number 2024326 and that Mr Gracey lost the right to be heard in an opposition to the application I have no doubt that the procedural irregularity had material consequences. As stated in the decision of the Appointed Person, Mr Geoffrey Hobbs QC., in the matter of Application Number 11654 for Revocation of the Gillette Company's Trade Mark Number 1226399 (SRIS 0/375/01), para 31, para 55:-

"It is clear that the denial of a right to be heard will not readily be regarded as an immaterial breach of procedure."

13. In conclusion, I have come to the finding that the abandonment of the opposition proceedings and the subsequent registration of application number 2024326 resulted from procedural irregularity within the Registry which had material consequences. The application for rectification of procedural irregularity is successful and I hereby direct that the registration of trade mark number 2024326 be withdrawn in the exercise of discretionary power. Mr Gracey's opposition to the registration will be re-instated. A notice is to be published in the Trade Marks Journal recording that the registration was made in error, as a result of

procedural irregularity, and is void. I also direct that an oral hearing be appointed to determine the substantive opposition to the application and that the determination of costs be left to the substantive hearing. However, I would note that the Registrar has no power to award costs against herself.

**Dated this 15 day of February 2002**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**