

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

D E C I S I O N

MR. HOBBS: On 19th June 1995, Meat Loaf of California applied under number 2024326 to register the words BAT OUT OF HELL as a trade mark for use in relation to various goods and services in classes 9, 16, 25 and 41. The application was opposed by Mr. Nicholas Dynes Gracey on 27th June 1996 on the ground that it contemplated unauthorised use of the relevant mark within the area of protection afforded to his earlier trade mark BAT registered under number 1335160. The applicant for registration disputed the opposition in a counterstatement filed on 11th October 1996.

In circumstances which I do not need to go into, the Registry came to the view, in March 1997, that Mr. Gracey's opposition should be deemed abandoned for non compliance with a requirement which had been imposed upon him with regard to the seeking of an extension of time. Thereafter the opposed application proceeded to registration under section 40 the Trade Marks Act 1994 on 1st April 1997.

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 16th



1           October 2000 (amended on 27th November 2000). It was wrongly  
2           rejected on the basis that the Registrar was powerless to  
3           reopen the opposition proceedings because the application in  
4           question had proceeded to registration. The question of how  
5           the discretion to rectify the procedural irregularity might  
6           have been exercised if the Hearing Officer had taken the view  
7           that the Registrar had the power that Mr. Gracey was inviting  
8           her to invoke was not considered in the decision.

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

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



1 mark number 1226399 (23rd May 2001). Since the proprietors  
2 of what is now registered trade mark 2024326 have a direct  
3 interest in the outcome of the remitted application, for  
4 rectification, I will direct that they be given notice of the  
5 further conduct of that application before the Registry and  
6 that they be permitted to participate in the proceedings if  
7 and to the extent that they see fit to do so.

8 That is my decision on this appeal.

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

-----



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

