

TRADE MARKS ACT 1994

IN THE MATTER OF:

INVALIDITY APPLICATION No. 83707

IN THE NAME OF PASS J. HOLDINGS LTD

IN RELATION TO TRADE MARK REGISTRATION No. 2512671

IN THE NAME OF BEN SPENCER

DECISION

1. Registered Trade Mark No. 2512671 standing in the name of Ben Spencer was found to have been invalidly registered for the reasons given by the Registrar's Hearing Officer in a written decision issued under reference BL O-173-11 on 20 May 2011.
2. The registered proprietor appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994 contending that the Hearing Officer's decision was wrong and should be set aside on the grounds summarised in his Notice of Appeal dated 13 July 2011.
3. The registration was declared invalid on the application of Pass J. Holdings Ltd which, as respondent to the appeal, maintained that the Hearing Officer's decision was correct for the reasons he had given.
4. The appeal came on for hearing before me on 27 October 2011. The registered proprietor was represented by trade mark attorneys and Counsel. The applicant for

invalidity did not attend and was not represented. Its trade mark attorneys of record filed written observations on its behalf.

5. It was apparent from the Skeleton Argument filed on behalf of the registered proprietor that he wished to raise a case of serious procedural irregularity which was not foreshadowed by his Grounds of Appeal dated 13 July 2011. This was raised upon the footing that text had been copied into the decision in the present case from a decision which the Hearing Officer had issued under reference BL O-105-11 on 17 March 2011 in a case between different parties. As a result of the transposition of text from the other decision, the decision in the present case was rendered factually and legally erroneous in several significant respects.

6. The hearing of the appeal was adjourned on the basis that:

- (1) I would send a copy of the registered proprietor's Skeleton Argument to the Head of Trade Mark Tribunal at the Registry;
- (2) the shorthandwriters would send copies of the Transcript of the adjourned hearing to the parties and to the Registry when it became available;
- (3) the registered proprietor would within 7 days thereafter file and serve Amended Grounds of Appeal to cover the matters raised in its Skeleton Argument which were not covered by its existing Grounds of Appeal;
- (4) at the expiration of 21 days thereafter arrangements would be made through the usual channels to set a date for the resumed hearing of the appeal;

(5) the costs of the adjourned hearing were reserved.

7. By letter dated 8 November 2011 the Head of Trade Mark Tribunal, Mr. Allan James, accepted that the Hearing Officer's decision could not stand. He proposed that it should be set aside, with the application for invalidity being remitted to the Registrar for determination by a different hearing officer.

8. By letter dated 18 November 2011 the applicant for invalidity indicated through its trade mark attorneys that it would not oppose an order to the effect envisaged by Mr. James on behalf of the Registrar.

9. By letter dated 24 November 2011 the registered proprietor indicated through his trade mark attorneys that he would not oppose an order to the effect envisaged by Mr. James on behalf of the Registrar if I thought it would be inappropriate for me to determine his appeal on the merits in circumstances where the decision under appeal was acknowledged on all sides to be tainted by serious procedural irregularity.

10. It is clear to me that the issues arising for determination on the substance of the application for invalidity were not adequately addressed in the decision under appeal. Unfortunately the stage has not yet been reached at which I could fully address them in a decision delivered on appeal under Section 76 of the Act without usurping the role reserved to the Registrar in the first instance. If I embarked on a process of decision taking which ought to have been undertaken by the Registrar, I would effectively be depriving the parties of one of the levels of adjudication built into the two-tier framework which Section 76(4) is intended to maintain. I consider that the right course in the present

case is to treat the Hearing Officer's decision as vitiated by serious procedural irregularity and remit the application for invalidity to the Registrar for determination anew.

11. I therefore determine and direct that:

- (1) the Hearing Officer's decision and his order as to costs be set aside;
- (2) the application for a declaration of invalidity be remitted to the Registrar for determination by a different hearing officer, to proceed upon the footing that the evidence is complete and the case is ready for hearing subject to the outcome of any procedural applications which either party might propose to make;
- (3) the costs of the present appeal are to be treated as costs incurred in connection with the proceedings in the Registry;
- (4) the question of how and by whom the costs incurred in connection with the proceedings in the Registry are to be borne and paid is reserved for determination by the Registrar at the conclusion of those proceedings.

12. If it had been open to me to do so, I would have made an order requiring the Registrar to pay the parties their reasonable and proper costs of participating in the fruitless hearing below and their reasonable and proper costs of this appeal. I note that in PNEUVEYOR Trade Mark [1967] FSR 542 Megarry J. ordered the Registrar to pay the costs of all parties to an application for rectification which failed in the context of what were described in subsequent editions of Kerly's Law of Trade Marks and Trade Names as '*extraordinary administrative errors*' in the Registry. However, my powers with regard to costs under the applicable provisions of the 1994 Act and the Trade Marks

Rules 2008 do not appear to me to include the power to make an award of costs against a non-party (see ADRENALIN Trade Mark BL O-379-02, 23 September 2002; at paragraphs [29] to [35]) and therefore do not include the power to make an award of costs against the Registrar in proceedings to which the Registrar is not a party (see BAT OUT OF HELL Trade Mark BL O-398-02, 23 September 2002; at paragraph [30]).

13. I therefore confine myself to the observation that the outcome of this appeal is in substance the correction of a serious procedural irregularity on the part of the Registrar which, if it had been a correction made in the exercise of the power conferred upon the Registrar by rule 74 of the Trade Marks Rules 2008 rather than by this tribunal on appeal under Section 76 of the Act, would have been appropriate for correction on terms which provided for the Registrar to accept responsibility in a reasonable and proportionate amount for the increment of the parties' costs and expenses occasioned and thrown away by the irregularity in question of BAT OUT OF HELL Trade Mark (above) at paragraphs [31] and [32].

Geoffrey Hobbs Q.C.

28 November 2011

The registered proprietor was represented by Mr. Thomas Elias instructed by Joshi and Welch Ltd.

The applicant for invalidity was represented by Mr. Bill Tennant of Tennant IP Ltd.

Written observations were submitted by Mr. Allan James on behalf of the Registrar.