

**O-038-17**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 106 809 FOR THE  
TRADE MARK (AS A SERIES OF TWO):



IN THE NAME OF RETROTOUCH (UK) LTD

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 405 051  
IN THE NAME OF O2 HOLDINGS LIMITED

## Background

1. In an interim decision dated 23<sup>rd</sup> November 2016 under BL O/552/16<sup>1</sup>, I found that the opposition failed in respect of the following goods in Class 09: *electric light switches, touch switches, dimmer switches; temperature switches; shaver sockets; parts and fittings in relation to the aforesaid.*
2. In respect of the remaining goods in Class 09, namely *electric current switches; electric switches; data switches; mechanical contact switches; push switches (electrical); rotary switches (electric); rotary switches; speaker switches; electrical switches; switches electric; electrical sockets; electric sockets; aerial sockets; connector sockets (electrical); sockets for electric plugs; plugs, sockets and other contacts (electrical); parts and fittings in relation to all the aforesaid goods in this class*, in the absence of any workable limitation, the opposition succeeded.
3. On perusal of the evidence filed by the applicant, it was noted that the respective parties appear to operate in distinct fields. As such, and as the Tribunal does not have the required specialist knowledge, the applicant was granted a further opportunity to consider an appropriate specification that could overcome the opposition.
4. The wording submitted by the applicant is as follows (proposed limitation emphasised in bold): ***electric switches; data switches; mechanical contact switches; push switches (electrical); rotary switches (electric); rotary switches;***

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<sup>1</sup> A corrected decision was issued, dated 13<sup>th</sup> December 2016 to reflect the full range of goods and services relied upon by the opponent which was inadvertently omitted from the original decision. Nothing turns on this point.

*speaker switches; electrical switches; switches electric; electrical sockets; electric sockets; aerial sockets; connector sockets (electrical); sockets for electric plugs; plugs, sockets and other contacts (electrical), **save for mobile telecommunications equipment and/or the sale of telecommunications equipment**; parts and fittings in relation to all the aforesaid goods.*

5. In assessing the proposal from the applicant, the following is borne in mind: In *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. provided the following guidance on the application of the *POSTKANTOOR* principle.

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the nature, function or purpose of the specified goods”. Mr Hobbs QC made the

same distinction in *WISI Trade Mark* [2007] E.T.M.R. 5; [2006] R.P.C. 22 at [16].

47. In *Oska's Ltd's Trade Mark Application* [2005] R.P.C. 20 at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant's intended target market.

48. In *MERLIN Trade Mark (BL O/043/05)* [1997] R.P.C. 871 at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent's registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in

this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd's Community Trade Mark Application (R746/2005-4)* [2007] E.T.M.R. 3 at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN* [1997] R.P.C. 871 that is a matter of form, not substance, and so should not have been determinative.”

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom's Trade Mark Application* [2005] R.P.C. 2 and *WISI Trade Mark* [2007] E.T.M.R. 5; [2006] R.P.C. 22.”

6. It is noted that the applicant, in composing its specification wording, attempted to mirror the comments made during the narrative of the original interim decision which indicated that there was potential for a way forward for the applicant. However, it is clear that such a narrative does not translate into a clear, unambiguous limitation which overcomes the opposition. This is precisely why the applicant, with its specialist knowledge was provided with an opportunity to propose a suitable wording. Bearing in mind the guidance outlined above, it is considered that the limitation proposed seeks to exclude characteristics of the goods rather than a definable sub category. As such, it is unacceptable and does not overcome the opposition.

7. The sum of all this is that the opposition succeeds in respect of:

Class 09:

*Electric current switches; electric switches; data switches; mechanical contact switches; push switches (electrical); rotary switches (electric); rotary switches; speaker switches; electrical switches; switches electric; electrical sockets; electric sockets; aerial sockets; connector sockets (electrical); sockets for electric plugs; plugs, sockets and other contacts (electrical); parts and fittings in relation to all the aforesaid goods in this class.*

8. However, it fails in respect of:

Class 09:

*Electric light switches, touch switches, dimmer switches; temperature switches; shaver sockets; parts and fittings in relation to the aforesaid.*

9. As such, these goods should proceed to registration.

## **COSTS**

10. Both parties have had the opportunity to make submissions regarding costs and these have been taken into account in reaching this decision. It is worth explicitly mentioning that the applicant has taken issue with the opponent initially opposing this trade mark application on the grounds of Section 5(3) as well as Section 5(2)(b), the former being withdrawn prior to the filing of the opponent's evidence. According to the applicant, this should specifically be taken into account in considering a costs award against the opponent. It is considered that the actions of the opponent in withdrawing the Section 5(3) ground were sensible and proportional and did not materially disadvantage the applicant from a cost perspective in these proceedings.

11. It is noted that each of the parties has achieved a measure of success in these proceedings, though the opponent is proportionally more successful than the applicant. As such, it is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement - £500 (includes statutory fee)

Considering statement of case in reply - £200

Preparing and filing evidence and considering evidence - £300

Preparation for and attendance at a Hearing - £500

TOTAL - £1500

12. I therefore order Retrotouch (UK) Ltd to pay O2 Holdings Limited the sum of £1500. The above sum should be paid within fourteen days of the expiry of

the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 31<sup>st</sup> day of February 2017**

A handwritten signature in black ink, appearing to be 'Louise White', written in a cursive style.

**Louise White**

**For the Registrar,**