

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 51381**

**IN THE NAME OF NETBIZ LTD**

**TO TRADE MARK APPLICATION No. 2229248**

**IN THE NAME OF AUNTY G LTD**

**AND IN THE MATTER OF:**

**OPPOSITION No. 52154**

**IN THE NAME OF AUNTY G LTD**

**TO TRADE MARK APPLICATION No. 2211183A**

**IN THE NAME OF NETBIZ LTD**

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**DECISION**

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**Application 2229248/Opposition No. 51381**

1. On 12<sup>th</sup> April 2000 Aunty G Limited (“AGL”) applied to register the designation **AUNTY G’s JOLLY GOOD MEALS** as a trade mark for use in relation to the following goods in Classes 29 and 30:

*Class 29: Meat, fish, poultry and game; seafoods; fruit and vegetables, all being preserved, dried, cooked, processed or frozen; preparations made from all the aforesaid goods; dairy products; cheeses; curds; sweetened curds; savoury curds; frozen curds; frozen yoghurt; fruit yoghurt; savoury yoghurt; vegetable yoghurt; savoury vegetable yoghurt; mousses, chilled desserts, desserts made from dairy products; soups; sweet spreads, savoury spreads; salads; drinks, fillings, snack foods, prepared meals and*

*constituents for meals; proteinaceous substances; dips; lentils, beans, pulses; all included in Class 29.*

***Class 30:** Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; spiced tea, herbal tea; drinking chocolate, coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery; pastries, cakes, biscuits; ices, ice-cream, ice-cream products, frozen confections; chilled desserts, mousses, sorbets; bread; pastry; drinks, fillings; sweet spreads, savoury spreads, condiments, sweet chutney, savoury chutney; spices; snack foods, prepared meals and constituents for meals; chocolate; pizzas; pizza bases; sauces and toppings for pizza; sauces for pasta, rice and curry; salad dressings; mayonnaise, sauces; dips; all included in Class 30.*

2. The application was subsequently opposed by Netbiz Limited (“**NL**”) in Opposition No. 51381 on the ground that use of the mark in question for goods of the kind specified in the opposed application would conflict with the rights to which **NL** was entitled under section 5(2)(b) of the Trade Marks Act 1994 as proprietor of earlier Application 2211183A to register the designation **auntie G** as a trade mark for use in relation to a wide range of goods in Classes 29, 30 and 31 (see paragraph 11 below).

3. The opposition proceeded to a substantive hearing before Mr. John MacGillivray acting on behalf of the Registrar of Trade Marks on 18<sup>th</sup> February 2003. In a written decision issued on 2<sup>nd</sup> April 2003 the Hearing Officer upheld the objection to registration, refused the application and ordered **AGL** to pay **NL** £1,000 as a contribution to its costs of the Registry proceedings.

4. He took the view that **auntie G** was an inherently distinctive mark which deserved a good penumbra of protection. His assessment of the objection to registration was as follows:

21. Turning to a visual comparison of the marks it seems to me that, despite the alternate spellings AUNTY/AUNTIE, there is obvious visual similarity. While I do not overlook the fact that the applicant's mark contains the words JOLLY GOOD MEALS this is a mere laudatory descriptor or claim and in totality the visual similarity between the marks is clear.

22. In relation to aural considerations, it once again seems to me that the words JOLLY GOOD MEALS do little to distinguish the marks. Furthermore, in oral use the different spellings of AUNTIE and AUNTY will not be a factor as these words would be spoken and heard in an identical manner. In my view the respective marks, in their totality, are aurally similar.

23. On a conceptual comparison of the marks it seems to me that the words AUNTY G's/AUNTIE G elements will, on a relative basis, lend themselves to retention or recollection in the customer's mind. This concept would probably be of an aunt whose name begins with the letter G. In my view there is a close conceptual similarity between the respective marks as a whole.

24. My own knowledge and experience tells me that the customer for foodstuffs is the public at large and in the case of foodstuffs supplied by e-commerce means, those members of the public who possess or who have access to a personal computer. The goods at issue are not specialised and even when purchased via the internet (a not uncommon method of buying groceries in current trading conditions) such goods are not invariably bought with great care and consideration.

25. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective marks are visually, aurally and conceptually similar;
- (ii) the respective specifications cover identical goods;
- (iii) the customer for the goods is not necessarily a specialised or sophisticated consumer and the goods are not necessarily purchased with great care of consideration.

26. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public.

In reaching this decision I have borne in mind the comments of the European Court of Justice in Canon:

‘Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive(see SABEL paragraphs 16 to 18)’

27. The opposition is successful under Section 5(2)(b).

5. AGL gave notice of appeal to an Appointed Person under section 76 of the Act contending, in substance, that the objection to registration should have been rejected because Application 2211183A could not validly be taken to have provided NL with rights of the scope required to render the objection sustainable.

6. This argument had been raised before the Hearing Officer. He had rejected it for the reasons given in his decision in the parallel proceedings to which I now turn.

#### **Application 2211183/Opposition No.52154**

7. On 13<sup>th</sup> October 1999 NL applied, without professional assistance, to register the designation **auntie G** as a trade mark for use in relation to the following goods and services in Classes 9, 35, 38, 41 and 42:

*Class 9: Transmission and reproduction of video, cinema and music on the Internet.*

*Class 35: Help U.K. businesses to advertise and manage business undertaking and affairs on the Internet including promotions, hosting and partnerships.*

*Class 38 Allow individuals, businesses and other organisations to communicate with each other by:- transmission of words, messages, voice, and visual means e.g. email/and other technologies, chat.*

**Clause 41:** Provide web content/lifestyle online content or the Internet covering: 1. Entertainments:- what's on guides, reviews, online games, food and drink data, mens, beauty, travel information; 2. Sporting:- information on a wide range of sports interactive games; 3. Cultural Activities:- community information, classifieds, wedding information; religious information; 4. Education:- online courses, course information, health child education development information.

**Class 42:** Provision of:- 1. Internet development services; 2. E-commerce of online goods covering - jewellery, fashion items and clothing; cards, furniture, audio/visual products eg. CD's, videos etc, food, appliances, perfumes, medicines, travel products, arts and crafts; tickets. 3. Services:- Pharmacy and medical advice; legal advice, accountancy services; banking and financial advice services.

8. On 9<sup>th</sup> November 1999 the Registry wrote to NL enclosing an Examination Report which raised multiple objections to the application as filed:

### **Absolute Grounds for Refusal (Section 3)**

The application fails to comply with Section 3(1)(a) of the Act **in respect of Class 42** because the following *statement of services* describes services in which no trade can be carried on by the applicant:

E-commerce

Section 3(1)(a) refers to signs which do not satisfy the requirement of Section 1(1) that signs should be capable of distinguishing goods or services of one undertaking from those of other undertakings. It is implicit in this definition that undertakings are trading in goods or services.

### **Class 09 - Specification**

The specification is not acceptable because the class description refers to services rather than goods. The services have therefore been transferred to Class 41, specification as follows:-

“Transmission and reproduction of video, cinema and music via the Internet.”

### **Class 35 - Specification**

The specification is not acceptable because the following terms are not understood, or are too imprecise for classification purposes:-

“...hosting and partnerships”

Please confirm your agreement to the amended specification shown below - changes are highlighted - or advise us of whatever other specification you require.

**Services which assist** UK businesses to advertise and manage business undertaking and affairs, including promotions **all such services being provided** on the Internet.

### **Class 38 - Relative Grounds for Refusal (Section 5) and Specification**

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier marks, which are listed below....

The specification is not acceptable because the following terms are not understood, or are too imprecise for classification purposes:-

“... other technologies, chat”

Please confirm your agreement to the amended specification shown below - changes are highlighted - or advise us of whatever other specification you require.

**Services which** allow individuals, businesses and other organisations to communicate with each other by transmission of words, messages, voice, and visual means, **electronic mail services**.

### **Class 41 - Specification**

The specification is not acceptable because the following terms are not understood, or are too imprecise for classification purposes:-

“Mens entertainment; wedding information; online courses; course information”.

The specification is not acceptable because the following services are not proper to this class, but they have been transferred to the other class shown:-

“Information relating to: food and drink services, child health and development, religion and beauty, all being provided via the Internet” - Class 42.

The specification is not acceptable because the following services are not proper to this class and your application does not include the appropriate classes for them. If you wish to proceed with these services please send an “Application for additional classes” (Form TM3A), accompanied by the appropriate number of class fees, to this Office.

“Travel information”, (if advisory services related to travel) is proper to Class 39.

“Travel information”, (if of a financial nature) is proper to Class 36.

Please confirm your agreement to the amended specification shown below - changes are highlighted - or advise us of whatever other specification you require.

**Transmission and reproduction of video, cinema and music; entertainment services relating to: what’s on guides, reviews, online games; information relation to sports interactive games, cultural activities, child education development and information; all being provided via the Internet.**

#### **Class 42 - Relative Grounds for Refusal (Section 5) and Specification**

There is an objection under Section 5(2) because there is a likelihood of confusion with the earlier mark, which is listed below.....

The specification is not acceptable because the following terms are not understood, or are too imprecise for classification purposes:-

“Internet development services”.

The specification is not acceptable because the following services are not proper to this class and your application does not include the appropriate class for them. If you wish to proceed with these services please send an “Application for additional classes” (Form TM3A), accompanied by the appropriate number of class fees, to this Office.

“Accountancy services; banking and financial advice services” are proper to Class 36.

Also some of the listings in this class appear to relate to goods rather than services. If you wish to proceed with these goods you will need to send an “Application for additional classes” (Form TM3A) accompanied by the appropriate fee. Please see the attached class listing for your reference.

Please confirm your agreement to the amended specification shown below or advise us of whatever other specification you require. Please note that amending the specification will [not] overcome the objection raised earlier in this report under Section 3(1)(a).

“Pharmacy and medical advice; legal advice; information services relating to: religion; child health development; beauty and food and drink services all being provided via the Internet.”

9. NL endeavoured, with professional assistance, to overcome these objections. Negotiations with the Registry continued until October 2000. They resulted in the filing of a reformulated application in which the goods and services of the original application were intended to be reduced to clearly defined and correctly classified itemisations: the coverage of the original application in Classes 9, 35, 38, 41 and 42 was cut down by amendment; fresh listings in 17 additional classes were added to the application. These changes were made by way of a request filed on Form TM3A under rule 8(4) of the Trade Marks Rules 2000 on 26<sup>th</sup> October 2000.

10. In an enclosure to an official letter dated 14<sup>th</sup> July 2000, the Registry had adopted the position that the following wording in the application filed on 13<sup>th</sup> October 1999:

*Provision of: 1..... 2. E-commerce of online goods covering - jewellery, fashion items and clothing; cards,*

*furniture, audio/visual products eg. CD's, videos etc, food, appliances, perfumes, medicines, travel products, arts and crafts; tickets. 3.....*

referred to the activity of selling such goods by way of e-commerce. That seems to have been considered sufficient to enable NL to request registration of the designation **auntie G** in respect of any particular goods within the wording of the original specification.

11. On the basis of the unparticularised reference to 'food' in the Application as originally filed, NL sought registration in respect of a wide range of foodstuffs in Classes 29, 30 and 31. These, as listed in the Form TM3A filed on 26<sup>th</sup> October 2000, were as follows:

***Class 29:** Meat, fish, poultry, game; meat extracts; seafoods; fruit and vegetables, all being preserved, dried, cooked or processed; preparations made from all the aforesaid goods; jellies; jams; egg products; milk foods; dairy products (foods); cheeses; curds; sweetened curds; savoury curds; fruit yoghurt; savoury yoghurt; vegetable yoghurt, savoury vegetable yoghurt; desserts made from dairy products; soups; sweet spreads; savoury spreads; salads; fillings, snack foods, proteinaceous substances; dips; lentils; beans, pulses; edible oils and fats; preserves; pickles; food preparations made from the aforesaid goods; prepared meals and constituents for meals; all supplied by e-commerce means.*

***Class 30:** Coffee, tea, cocoa, and coffee substitutes; spiced tea, herbal tea; drinking chocolate; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as coffee substitutes; all being foods; sugar, rice, pasta, tapioca, sago, flour, cereals and cereal preparations; bread, biscuits; cakes, pastries, pastry and confectionery; fillings; sweet spreads, savoury spreads, condiments, sweet chutney, savoury chutney; honey; treacle, yeast, baking powder, salt, mustard, pepper, vinegar, spices; snack foods, prepared meals and constituents for meals; chocolate; sauces for pasta, rice and curry; salad dressings; mayonnaise, sauces; dips; all supplied by e-commerce means.*

***Class 31:** Fruits, vegetables and herbs; extracts and other preparations made from these; all supplied by e-commerce means.*

12. In August and September 2000 there had been correspondence between the agents of record for NL and AGL concerning their clients' intentions with regard to use of the designations **auntie G** and **AUNTY G**. On 6<sup>th</sup> September 2000 the agent for NL had written under the reference **AUNTIE G/Infr** noting that "*My clients have only just become aware of your clients' existence and trade marks*". The letter drew attention to "*my clients' UK trade mark application 2211183 for **AUNTIE G**, dated 13<sup>th</sup> October 1999, that includes 'e-commerce of ... food', which is 'goods or services similar to' food the subject of your clients' UK application.....*" and made it clear that "*My clients will oppose your clients' UK trade mark application 2229248....in the absence of undertakings as originally requested*". The wording of the specification of goods in Classes 29 and 30 of AGL's Application 2229248 (see paragraph 1 above) appears to have been transposed (with additions and minor variations) into the wording of the specification of goods in Classes 29, 30 and 31 put forward on behalf of NL in the Form TM3A filed on 26<sup>th</sup> October 2000 (see paragraph 11 above). On 26<sup>th</sup> October 2000 NL also filed a request on Form TM12 for division of its Application 2211183 into: (i) Application 2211183A for the goods listed in Classes 29, 30 and 31 of the reformulated specification; and (ii) Application 2211183B for the goods and services listed in Classes 3, 5, 6, 7, 8, 9, 14, 16, 18, 19, 20, 21, 25, 35, 36, 38, 39, 41 and 42 of the reformulated specification. The sequence, nature and timing of these events clearly indicates that the specification of divisional Application 2211183A was framed with a view to assisting NL to prevent or inhibit AGL from registering or using the designation **AUNTY G** as a trade mark for goods of the kind specified in its Application 2229248.

13. On 15<sup>th</sup> February 2001 NL's divisional Application 2211183A was opposed by AGL in Opposition No. 52154:

- (1) under section 39(2) of the Act, on the ground that the coverage of Application 2211183 had been extended by subsequent inclusion of the goods listed in Classes 29, 30 and 31;
- (2) under sections 3(6) and 32(3) of the Act, on the ground that it could not truthfully be said to have been intended, at the date of Application 2211183, that the designation **auntie G** would be used by or with the consent of NL as a trade mark for the numerous goods listed in those Classes.

The opposition was heard together with NL's opposition to AGL's Application 2229248.

14. In a written decision issued on 2<sup>nd</sup> April 2003 the Hearing Officer dismissed AGL's objections, allowed NL's divisional application to proceed to registration and ordered AGL to pay £1,500 as a contribution to NL's costs of the Registry proceedings.

15. His findings, as summarised by me, were as follows:

- (1) The wording quoted in paragraph 10 above should be interpreted as meaning that NL was seeking a monopoly for business transactions relating to goods of the kind it had described, including food.
- (2) That wording clearly conflicted with the identification of Class 42 as the appropriate class and there was accordingly an '*obvious mistake*' in the application within the meaning of section 39(2)(c) that could be corrected

under rule 8(4) by inclusion of the appropriate classes: see Altecnic Ltd v Reliance Water Controls Ltd [2001] EWCA Civ 1928 at paragraph 41(e) per Mummery LJ.

- (3) In correcting the '*obvious mistake*' NL had not only added the appropriate classes, but narrowed and more precisely defined the goods and services of interest to it as permitted by section 39(1).
- (4) There was no evidence to suggest that the statement made on behalf of NL under section 32(3) misrepresented its intentions as to use of the designation **auntie G** in relation to goods of the kind covered by the divisional Application and therefore no basis for a finding of bad faith under section 3(6).

16. AGL gave notice of appeal to an Appointed Person under section 76 of the Act contending, in substance, that there had been no "*obvious mistake*" to correct, alternatively that the only "*obvious mistake*" had been a mistake as to the appropriate classification of services and a mistake of that kind could not validly be corrected within the limits prescribed by section 39(2) by adding goods classes to an application under rule 8(4). No appeal was brought in respect of the Hearing Officer's rejection of the ground of opposition that had been raised under sections 3(6) and 32(3) of the Act.

### **Inter-relationship between the appeals**

17. The two appeals were heard together. It was accepted that the appeal in relation to Application 2229248/Opposition No. 51381 could not succeed if the appeal in relation to Application 2211183/Opposition No. 52154 was rejected.

## **Analysis**

18. The 1994 Act and the Rules made under it provide a detailed scheme for the filing and examination of applications for registration. A central feature of the scheme is the use of prescribed forms requiring detailed and accurate information as to the scope of the request for protection. Section 66 enables the Registrar to require the use of prescribed forms for any purpose relating to the registration of a trade mark or any other proceedings under the Act. Rule 3 of the Trade Marks Rules 2000 supplements the obligation to adhere to the forms prescribed.

19. Sections 32 and 33 of the Act provide as follows:

### **Application for registration**

32.(1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain -

- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

### **Date of filing**

33.(1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 32(2) are furnished to the registrar by the applicant.

If the documents are furnished on different days, the date of filing is the last of those days.

(2) References in this Act to the date of application for registration are to the date of filing of the application.

The application for registration “*shall be filed on Form TM3 and shall be subject to the payment of the application fee and such class fees as may be appropriate*” under rule 5(1).

20. It can be seen that section 32(2)(c) of the Act requires “*a statement of the goods or services in relation to which it is sought to register the trade mark*”. This requirement is amplified by rules 8(2) and 8(3) in the following terms:

(2) Every application shall specify the class in Schedule 3 to which it relates and shall list the goods or services appropriate to that class.

(3) If the application relates to more than one class in Schedule 3 the specification contained in it shall set out the classes in consecutive numerical order.

All versions of Form TM3 prescribed for use under the 1994 Act have required applicants to list the goods or services of interest to them by reference to the appropriate class(es) of the prescribed system of classification. The use of the prescribed system of classification is mandatory under section 34(1) of the Act.

21. The combined effect of section 32(2)(c) and rule 8 is to require applicants for registration to identify the goods or services of interest to them: (i) linguistically by

means of a list; and (ii) numerically by reference to the number of the class in the prescribed classification to which they belong. If, as in the Altecnic case, the linguistic description of the goods or services is compatible with the numerical identification of the class to which they have been allocated by the applicant, the application must be regarded as duly filed under section 32(2)(c) and rule 8. Otherwise it will be necessary to regularise the application within the latitude allowed by the Act and the Rules.

22. If the application for registration is unacceptable for lack of a statement of the goods or services in relation to which it is sought to register the trade mark, the situation is covered by rule 11(a) and continuing default in the face of a notice to fulfil the requirements of section 32(2)(c) will lead to a determination by the Registrar that *“the application shall be deemed never to have been made”*.

23. If the application for registration is irregular because it does not specify the class(es) to which it relates and list the goods or services appropriate thereto, the situation is covered by rule 11(b) and continuing default in the face of a notice to fulfil the requirements of rule 8(2) will lead to a determination by the Registrar that *“the application shall be treated as abandoned”*.

24. If the application for registration is irregular because the linguistic description of the goods or services is incompatible with the numerical identification of the class to which they have been allocated by the applicant, the situation is covered by rule 8(4) and the conflict between the linguistic description and the numerical identification will need to be rectified by the filing of an acceptable Form TM3A if the consequences of a default notice under rule 11(b) are to be avoided.

25. Rule 8(4) provides as follows:

(4) If the specification contained in the application lists items by reference to a class in Schedule 3 in which they do not fall, the applicant may request, by filing Form TM3A, that his application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend his application accordingly.

The guiding principle is that in the event of conflict between the linguistic description and the numerical identification, the linguistic description prevails.

26. The rule is subordinate to the provisions of section 39 of the Act. Section 39 provides (with emphasis added) as follows:

**Withdrawal, restriction or amendment of application**

(1) The applicant may at any time withdraw his application **or restrict the goods or services covered by the application.**

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, **only** by correcting:

- (a) the name or address of the applicant;
- (b) errors of wording or of copying, or
- (c) **obvious mistakes**

**and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.**

(3) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

The power to allow amendment of an application under rule 8(4) appears to be a particular manifestation of the power to allow the correction of “*obvious mistakes*” under section 39(2)(c): see Altecnic (above) at paragraph 41(e) per Mummery LJ.

27. In relation to an application which contains a linguistic description of goods or services which is incompatible with the numerical identification of the class to which they have been allocated by the applicant, the cumulative effect of rule 8(4) and section 39 is as follows:

- (i) the application can be amended under rule 8(4), but only so as “*to include the appropriate class*” for the incorrectly classified items;
- (ii) the application cannot be amended so as to allocate incorrectly classified items to a class other than the one in which they would have been included if they had been correctly classified in the first place: to do so would “*extend the goods or services covered by the application*” in breach of section 39(2);
- (iii) the linguistic description cannot be amended under rule 8(4), but may be amended within the limits prescribed by section 39 so as to reduce the coverage of the application within the class(es) in which the relevant goods or services would have been included if they had been correctly classified in the first place.

The steps in the process of amendment should therefore be: [A] identify the items in the linguistic description which the applicant has numerically allocated “*to a class in which they do not fall*”; [B] identify the class(es) to which those items would have been numerically allocated if they had been correctly classified in the first place; [C]

ensure that any amendments to the linguistic descriptions of those items serve only to reduce the coverage of the application within the class(es) identified at step [B].

28. The process depends from beginning to end upon the existence of a properly itemised statement of the goods or services covered by the applicant's declaration of use or intended use under section 32(3) of the Act. In the absence of sufficient itemisation in the statement on file, it would appear to be necessary for the Registrar to require clarification of the declaration of use or intended use before allowing the applicant to move forward. The Registrar's determination as to the class within which any particular goods or services fall will be final under section 34(2) of the Act.

#### **Assessment**

29. The wording of the specification of Application 2211183 as originally filed (see paragraph 7 above) was in varying degrees vague and obscure. Hence the many objections raised in relation to it in the Examination Report issued on 9<sup>th</sup> November 1999 (see paragraph 8 above). The statement presently in issue is '*E-commerce of online goods covering - ... food .....*'. This was so uninformative that the process of classification required by section 34(1) of the Act could not be completed unless and until the Registrar was provided with a properly itemised list of the goods or services that NL was thereby proposing to include within the scope of its declaration of use or intended use under section 32(3). In the meantime there was considerable uncertainty as to the scope of at least that part of the application for registration.

30. So far as I can see, the parties and the Registrar have at all stages proceeded upon the assumption that the problem posed by the wording of the statement in dispute was essentially one of interpretation.

31. The Examination Report pointed out that the expression '*E-commerce*' failed to describe any services which might be provided by way of trade. The subsequent decision to allow NL to amend its application in October 2000 so as to specify the goods listed in Classes 29, 30 and 31 was the subject of an official letter sent to the parties' agents of record on 31<sup>st</sup> October 2002. With reference to the wording of the statement I have described as uninformative, the Registry stated:

Clearly, this specification did not fall into Class 42. In the Registrar's view the appropriate class was open to some interpretation in that the specification could have fallen into Class 35, ie the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods etc..... or into the classes of the goods specified ie the specification related to the sale of those goods. Given the ambiguity, I take the view that the amendment to add extra classes was allowable.

Despite the perceived ambiguity of the statement in question, it was regarded as an acceptable basis for a claim to registration in respect of goods specifiable in Classes 29, 30 and 31 by amendment at a later date, but not for services of any description.

32. AGL contended that the statement in question was acceptable as the basis for a claim to registration in respect of services, but not for goods of any description. The services covered by the relevant wording were said to be 'electronic shopping' or 'e-tailing' services specifiable in Class 35 if not in Class 42. Such services could, in principle, be the focus of an application for registration c.f. Practice Amendment Circular PAC 13/00 relating to the Registrar's change of practice on 'Retail Services'. The identification of Class 42 as the relevant Class and the contents of the web pages on NL's website at [www.auntieg.com](http://www.auntieg.com) were said to support the view that NL had intended to apply for registration in respect of services, not goods. It was accordingly

submitted that the coverage of NL's application for registration had been extended by amendment so as to include goods in Classes 29, 30 and 31 in breach of section 39(2).

33. NL supported the reasoning and conclusions of the Hearing Officer in Opposition No. 52154. It emphasised that applications for registration in respect of 'electronic shopping' or 'e-tailing' were not accepted in the United Kingdom prior to adoption of the practice formally notified in Practice Amendment Circular PAC 13/00 in October 2000.

34. On the point of interpretation which divides the parties, I think that the statement '*E-commerce of online goods covering - ..... food .....*' refers to trading online in anything describable as food and that the sum and substance of the activity thus specified was trading in goods of the given description. It follows, in my view, that Class 42 and Class 35 were not appropriate for the goods of interest to NL.

35. But what actually were the goods of interest to NL? Herein lies the principal difficulty confronting the parties and the Registrar. As I have endeavoured to explain in paragraphs 27 and 28 above, the process of amendment under rule 8(4) and section 39 must begin and end with a properly itemised statement of the goods covered by the declaration of use or intended use under section 32(3). The statement '*E-commerce of online goods covering - ..... food .....*' was inadequate for that purpose. Clarification of the linguistic description of the relevant goods was required before NL could move forward. The degree of clarification required was substantial. Was it so great as to disqualify the unclarified statement from acceptance under sections 32(2)(c) and 33(1) of the Act pending further and better itemisation?

36. I think it must be necessary for a linguistic description to satisfy a minimum standard of clarity and specificity in order to be acceptable as a statement of goods or

services under sections 32(2)(c) and 33(1) of the Act. The Act: (i) confers protection with effect from the date of filing; (ii) centres the protection thus conferred upon use of the identified mark in relation to goods or services of the kind identified in the application; and (iii) forbids any amendment after the date of filing that would substantially affect the identity of the trade mark or extend the goods or services originally identified. It stands to reason that the statement of goods or services required by section 32(2)(c) must, from the outset, be in a form that will enable these basic features of the system to be implemented with due regard for the principle of legal certainty. And on that view of the matter it cannot be right that any verbalisation, no matter how vague or obscure, is sufficient to qualify for a filing date under sections 32(2)(c) and 33(1). It seems to me that rules 8(2) and 11(b) cannot properly be taken to provide otherwise.

37. The question whether an application for registration qualifies for a filing date under section 33(1) logically precedes the question whether the application can be said to have been validly and effectively amended under rule 8(4) and section 39: the provisions relating to amendment assume the existence of a duly filed application. However, the focus of attention in the present proceedings has been the legitimacy of the amendments allowed in October 2000. The Registrar's acceptance of 13<sup>th</sup> October 1999 as the filing date for Application 2211183 has not been challenged under sections 32(2)(c) and 33(1) of the Act, either in relation to the Application as a whole or in relation to the particular elements of it that were taken to provide a basis for the amended specification carried forward into divisional Application 2211183A. I am accordingly required, as an appellate tribunal in adversarial proceedings, to proceed on the basis that the filing date of the Application from which divisional Application

2211183A was derived is not in issue between the parties or between either of them and the Registrar.

38. In relation to the bona fides of the request for amendment, I have already noted in paragraph 12 above that the amendments in issue were apparently framed with a view to assisting NL to prevent or inhibit AGL from registering or using the designation **AUNTY G** as a trade mark for goods of the kind specified in its Application 2229248. That prompted the following question: could it truthfully be said to have been intended at the date of Application 2211183 that the designation **auntie G** would be used by or with the consent of NL as a trade mark for the range of goods subsequently listed in Classes 29, 30 and 31? If and to the extent that the answer to this question was no, the Application as amended and divided on 26<sup>th</sup> October 2000 would not have been valid under sections 3(6) and 32(3) of the Act. However, I am bound to assume that the correct answer to the question is yes in the absence of any appeal against the Hearing Officer's rejection of the attack mounted under those sections in Opposition No. 52154. I therefore accept that NL included the goods listed in Classes 29, 30 and 31 in Application 2211183 in good faith.

### **Conclusion**

39. For the reasons I have given above, the appeal in respect of AGL's Opposition No. 52154 to NL's Application 2211183A is dismissed. It follows on the basis noted in paragraph 17 above that the appeal in respect of NL's Opposition No. 51381 to AGL's Application 2229248 must also be dismissed. I direct AGL to pay NL £1,200

as a contribution towards its costs of the unsuccessful appeals. That sum is to be paid within 14 days of the date of this Decision. It is payable in addition to the costs awarded by the Hearing Officer in respect of the proceedings in the Registry.

Geoffrey Hobbs Q.C.

20<sup>th</sup> January 2004

Mr. Simon Malynicz instructed by Trade Mark Consultants Company appeared as counsel on behalf of AGL.

Mr. Guy Tritton instructed by Mr. M. Dean appeared as counsel on behalf of NL.

The Registrar was not represented.