

BL O/1033/23

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3766499

IN THE NAME OF JULIE ANN BEAUME & PATRICK BEAUME (PARTNERS IN

THE CARTFORD INN)

TO REGISTER

TOTI

AS A TRADE MARK IN CLASSES 32 & 33

AND

OPPOSITION THERETO (UNDER NO. 434659)

BY

GIOVANNI BOSCA TOSTI I.V.I S.P.A

RELEVANT BACKGROUND

1) On 11 October 2023, I issued a provisional decision in these proceedings in which I made the following findings:

“32) The opposition fails in respect of:

Class 32: Beer; fruit juices; mineral, aerated and other waters; syrups; other preparations for making beverages; grenadine.

33) The opposition succeeds in respect of:

Class 32: non-alcoholic beverages; other non-alcoholic drinks; soft drinks.

Class 33: Gin; wine; cider; alcoholic beverages; spirits; sweet liqueurs.”

2) In my provisional decision, I then went on to say this:

“REVISED SPECIFICATION

35) In my conclusions above, I have upheld the opposition against “non-alcoholic beverages; other non-alcoholic drinks; soft drinks” on the basis that these broad terms cover goods which are similar to a medium-high degree to the opponent’s goods and for which a likelihood of confusion exists. However, if those broad terms within the applicant’s specification were to be limited, then it may be possible to register the mark for other kinds of beverages, falling within those broad terms in class 32, for which no likelihood of confusion exists. In this connection, I note that Tribunal Practice Notice 1/2012, entitled “Partial Refusal” states:

“3.2.2. Defended Proceedings

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing

Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered “men’s and boys’ clothing”, thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the “blue pencilling” approach or the “save for” type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. “

36) My conclusions in this case cannot easily be reflected by “blue pencilling” insofar as the applicant’s broad terms ‘non-alcoholic beverages; other non-alcoholic drinks; soft drinks’ are concerned. I also do not consider it appropriate to add a “save-for” or “none of the aforesaid being...” type exclusion without providing the parties with an opportunity to comment on whether they consider such an exclusion would be appropriate. I will, therefore, allow the applicant 14 days from the date of this decision to provide me, if it so wishes, with a precise list of goods it wishes to register which would fall within the terms ‘non-alcoholic beverages; other non-alcoholic drinks; soft drinks’ but for which no likelihood of confusion would exist and/or

to put forward an appropriate exclusion for my consideration. The applicant's proposed list of goods and/or exclusion should be copied to the opponent who will be allowed 14 days, from receipt by it, to comment. Thereafter, I will issue a supplementary decision in which I will decide whether any proposed terms put forward by the applicant are free from a likelihood of confusion and I will also deal with the matter of costs.

37) If the applicant puts forward no revised terms and/or exclusion in the period allowed then my supplementary decision will simply confirm the outcome as it stands in paragraphs 32 & 33 above i.e. the application will be refused in respect of the goods listed at paragraph 33 and will proceed to registration solely in respect of the goods listed in paragraph 32.

38) The appeal period for this decision and the supplementary decision will run from the date of the latter.”

3) On 24 October 2023, the applicant filed a limited specification for my consideration. The official letter of 25 October 2023 reminded the opponent of its right to file comments on the proposed specification by the deadline of 7 November 2023. The opponent confirmed, in a letter dated 26 October 2023, that it did not wish to make any comments.

4) The limited specification put forward by the applicant consists of the single term, 'Kombucha'. However, 'Kombucha', being a fermented tea drink, is not proper to class 32. Rather, it falls within class 30¹ (with other tea-type beverages). It is therefore not possible for the broad terms 'non-alcoholic beverages; other non-alcoholic drinks; soft drinks' in class 32 to be limited to 'kombucha' because the former terms do not cover the latter term in that class. In any event, I note that the applicant already has cover for 'kombucha' because it has the broad term 'beverages' in class 30 which includes 'Kombucha' and which was not opposed.

¹ As per the TMclass classification system.

5) As the applicant has put forward no other terms for my consideration, the application is refused, in respect of the terms 'non-alcoholic beverages; other non-alcoholic drinks; soft drinks' in class 32.

FINAL OUTCOME

6) The opposition fails in respect of:

Class 32: Beer; fruit juices; mineral, aerated and other waters; syrups; other preparations for making beverages; grenadine.

7) The opposition succeeds in respect of:

Class 32: non-alcoholic beverages; other non-alcoholic drinks; soft drinks.

Class 33: Gin; wine; cider; alcoholic beverages; spirits; sweet liqueurs.”

8) As the opposition was not directed against any of the goods and services in classes 29, 30, 35 and 43, the application may proceed to registration for all those goods and services.

COSTS

9) The opponent has been only marginally more successful than the applicant. In my view, the degree of success enjoyed by both parties means that each should bear their own costs.

10) The appeal period for this supplementary decision and the provisional decision runs from the date below.

Dated this 2nd day of November 2023

Beverley Hedley

For the Registrar, the Comptroller-General