

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2341223
BY ICELAND FOODS LIMITED
TO REGISTER IN CLASSES 3, 4, 5, 6, 7, 8, 9, 11, 16, 20, 21, 29, 30, 31, 32, 33,
34, 35, 41, 42, 43 THE SERIES OF THREE TRADE MARKS:**



ICELAND

AND

OPPOSITIONS THERETO BY:

- i) ICELAND SPRING IN ICELAND (No 94461)**
- ii) ICELANDIC GROUP PLC (No 94462)**
- iii) BLUE LAGOON LIMITED (BLAA IONID H.F) (No 94463)**
- iv) ICELANDAIR EHF (No 94464)**
- v) ALFESCA LTD (No 94465)**
- vi) THE MINISTRY OF FOREIGN AFFAIRS (AND OTHERS) (No 94466)**

1) On 8 August 2012 I issued a decision in relation to these proceedings in which I dismissed the opposition in relation to certain of the goods and services sought to be registered, but upheld it in relation to others. However, I held that two of the products in the specification were free from objection, but only in limited scope. In paragraph 83 of my decision I stated:

“83) In relation to “food for babies” in class 5 and “prepared meals and constituents therefor, snack foods” in class 29, these terms must be amended with an appropriate exclusion. The parties are permitted one month from the date of this decision to provide written submissions on what it considers to be a suitable exclusion having regard to the scope of success I have outlined in paragraph 65 above.”

2) Earlier in my initial decision (paragraph 65) I suggested that an exclusion along the lines of: “none consisting wholly or principally of fish” would be an appropriate form of wording.

3) Both parties provided written submissions in response to my invitation. The applicant submitted that an appropriate form of wording would be: “none of the aforesaid goods consisting wholly or principally of fish”. The opponent indicated that they had no objection to this form of wording.

4) Given that the applicant’s suggestion is in line with what I initially considered to be appropriate, and given that the opponent has no objection to this, then I am content that this is the correct way forward. In view of this, and having regard to the scope of my earlier decision, the outcome of the opposition is as follows:

5) The opposition fails (and thus the marks may be registered) for the following goods and services¹:

Class 03: Anti-perspirants; perfumes; shampoos; dentifrices; cleansing, polishing and scouring preparations and substances; detergents; all included in Class 3.

Class 04: Firelighters; candles; night lights; charcoal; coke; coal; wood for burning; briquettes.

Class 05: Disinfectants; food for babies, none of the aforesaid goods consisting wholly or principally of fish; all included in Class 5.

Class 06: Goods of common metal; small items of metal hardware; kitchen foil; all included in Class 6.

¹ The punctuation has been amended slightly to ensure that the exclusion applies only to the two products indicated in paragraph 1 above.

Class 07: Dishwashers; washing machines; domestic machines; parts and fittings for all the aforesaid goods.

Class 08: Cutlery, knives, forks, spoons; all included in Class 8.

Class 09: Downloadable electronic publications, namely catalogues and directories relating to retail supermarket services; batteries; lighters

Class 11: Apparatus for heating, cooking, (domestic) refrigerating, drying or ventilating; freezers, refrigerators, combined freezers and refrigerators, for domestic use; microwave ovens; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard, paper articles, cardboard articles, wrapping and packaging materials; bags of paper or plastics, all for packaging; toilet paper, paper tissues, carrier bags, plastic bags, paper and plastic sacks; closures for bags; labels; pens and pencils; transfers; price tags and tickets and holders in the nature of envelopes; stationery.

Class 20: Drinking straws.

Class 21: Dishcloths, stockinet rolls, dusters, floor cloths, sponge cloths, household gloves; household or kitchen utensils and containers (not of precious metal or coated therewith); cookware; storage containers and container lids; jugs and measuring jugs; glassware, porcelain and earthenware not included in other classes; eating and drinking utensils; tableware; tray and tray covers; roasting dishes; oven trays, pizza pans, loaf pans and sandwich pans, all made of metal; combs and sponges; brushes (except paint brushes); electric and non-electric toothbrushes; toothpicks; articles for cleaning purposes; steel wool.

Class 29: Meat extracts; fruits and vegetables, all being preserved, dried, cooked, canned or frozen; jellies and dairy products, all for food; jams, marmalade, eggs, edible oils, edible fats; food preserves; potato crisps and potato products (for food); prepared meals and constituents therefor, snack foods, none of the aforesaid goods consisting wholly or principally of fish; all included in Class 29.

Class 30: Coffee, tea, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery; edible ices; refreshing ice; honey, treacle; yeast, baking-powder, salt (for food), mustard, vinegar, pepper, sauces, salad sauces; spices (other than poultry

spice); prepared meals and constituents therefor, snack foods, all included in Class 30.

Class 31: Agricultural, horticultural and forestry and grain products, not included in other classes; fresh fruits and vegetables; seeds; natural plants and flowers; animal feeds, malt.

Class 32: Beers; non-alcoholic beverages other than water, mineral and carbonated water; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33: Alcoholic beverages; wines, spirits and liqueurs.

Class 34: Smokers articles.

Class 35: Retail supermarket services connected with the sale of toiletries, household products including cleaners, polishers, scourers, soaps, hardware, kitchen foil, electrical goods including white goods, publications and stationery, household utensils, glassware and kitchenware, foodstuffs and drinks; shop window dressing; telesales services; ordering services; advertising, marketing and promotion of goods and services; direct mail advertising services; distribution of samples; operation of in-store self-service schemes; cost and payment calculation, monitoring, recordal and processing; organisation, operation and supervision of sales and promotional incentive schemes to consumers and/or the wholesale trade; customer advisory and consultancy services; the provision of promotional, incentive and loyalty schemes by means of customer club membership schemes; business management advice and assistance, business appraisals; business administration services; market research; personnel management advice; procurement of goods on behalf of business; business advisory services relating to franchising; information and advisory services relating to all the aforesaid.

Class 41: Providing online catalogues and directories.

Class 42: Website hosting; computer services related to computerised on-line searching for, ordering, delivery and transporting of foods, drinks and consumer goods.

Class 43: Cafe, cafeteria, catering and restaurant services.

6) The opposition succeeds in relation to everything else.

7) It should be noted that the applicant also provided submissions in relation to costs. However, I did not (as the opponent highlights) invite such submissions in my decision, my decision in relation to costs having already been made. It

appears that the covering letter to my initial decision erroneously referred to submissions on costs – but, given that this was not my intention and given that my decision has been made, it is not therefore appropriate to give further consideration to the costs issue. My decision stands as previously indicated.

8) This supplementary decision triggers the appeal period for my substantive findings. The costs award previously made should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of November 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**