

O-443-19

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3319945  
BY GEMMA BRAY TO REGISTER:

**THE ORGANISED MUM**

AND

THE OPPOSITION THERETO UNDER NO 600001000 BY  
BOXCLEVER PRESS LTD.

1. On 6 June 2019 I issued a provisional decision in relation to this opposition, in which I stated the following:

“Printed matter’

86. I have identified that the broad term, ‘printed matter’ includes the opponent’s goods which will lead to a likelihood of confusion. However, there are other types of printed matter which will not. In the circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:

- a) Fall within the ambit of “printed matter”;
- b) Fall within the scope of this decision in that the goods so specified have no similarity to ‘diaries, planners, calendars and organisers’;
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor*<sup>1</sup> decision;

87. The applicant’s written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, the opponent will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If the applicant puts forward no revised terms then I will issue a supplementary decision confirming that the broad term ‘printed matter’ may include goods which are the same or similar as those contained in the opponent’s specification. Consequently, there will be a likelihood of confusion.”

2. The applicant filed submissions, by email, on 11 June 2019 in which it stated the following:

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<sup>1</sup> CJEU case C-363/99

*“We refer to the decision issued by Ms Al Skilton on 6 June 2019 in relation to the above opposition. In particular, we refer to the last few paragraphs of the decision (83 onwards) which invited the applicant to make submissions in relation to certain terms within the application before a final decision in first instance was issued...”*

*By way of response, the applicant hereby request the removal of the terms "stationery" and "printed matter" from the application.”*

3. In an email dated 14 June 2019 the opponent responded in the following terms:

*“We note that the applicant has not chosen under paragraph 86 of the decision to file a revised specification with accompanying specifications in relation to printed matter (as the applicant has agreed to remove printed matter). Obviously, our client agrees with removal of "printed matter" and "stationery" from the applicant’s application in class 16...”*

## **Conclusion**

4. The provisional finding at paragraph 81 of my earlier decision was that there is a likelihood of confusion between the opponent’s earlier mark and the application in respect of ‘exercise books; lever arch files; document folders and wallets’ in class 16. That finding is confirmed.

5. At paragraph 83 of my provisional decision I found that the opposition succeeded in respect of ‘stationery’ in class 16. That finding is confirmed.

6. The applicant has elected to remove ‘printed matter’ from class 16 of the application.<sup>2</sup>

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<sup>2</sup> It should be noted that whilst the applicant also elected to remove ‘stationery’ from class 16, the opposition was successful with regard to those goods and no fall back position was offered to the applicant.

7. The opposition has been partially successful under section 5(2)(b) of the Trade Marks Act 1994. The application can proceed to registration for the following goods in class 16:

Printed publications; instructional and teaching materials; newspapers; periodicals; journals; newsletters; bulletins; magazines; books; directories; handbooks; manuals; brochures; pamphlets; leaflets; guides; publicity materials; posters; postcards; certificates; gazettes; advertising materials and display materials; photographs; packaging materials; printers' type; printing blocks; parts and fittings for all the aforesaid.

## **COSTS**

8. Both parties have achieved a measure of success and I consider each should bear its own costs.

9. The appeal period begins from the date of this supplementary decision.

**Dated 31 July 2019**

**Al Skilton**

**For the Registrar**