

# O-184-17

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**AND IN THE MATTER OF TRADE MARK APPLICATION NO. 3096716  
IN THE NAME OF WORLD OF FASHION (MCR) LTD**

**AND IN THE MATTER OF OPPOSITION (NO. 404512) BY  
eBAY INC**

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF  
MR OLIVER MORRIS DATED 29 JULY 2016**

## **SUPPLEMENTAL DECISION**

1. On 27 January 2017 I handed down my decision on the appeal by World of Fashion (MCR) Ltd, trading as giftobay.com, (“the Applicant”) from a decision of Mr Oliver Morris, the Hearing Officer for the Registrar, in which he rejected an opposition by eBay Inc to an application to register a stylised “Giftobay” trade mark (“the Mark”).
2. I decided that the appeal should succeed in part and invited the parties to provide me with submissions as to the appropriate form of wording of an alternative specification which would be unobjectionable. Following the provision of those submissions, a short hearing was held by telephone at which both sides took a helpfully pragmatic approach to the issue of amending the specification.
3. The proposal made by the Applicant was for the amended specification set out in Annex 1 to this decision. The Opponent made some comments upon that proposal and objected to some parts of it. Its version is at Annex 2 below.
4. A trade mark applicant or owner may raise the possibility of narrowing the specification of its mark on appeal even if it was not raised before the Hearing Officer, and of course the issue of a narrower specification flowed from my decision of 27 January. Whether the proposal is accepted will depend on a number of factors: see for example *Advanced Perimeter Systems v*

*Keycorp ("Multisys")* [2012] RPC 14 especially at [73]-[90] and [2012] RPC 15, and *YouView v Total* [2012] EWHC 3158 [2013] E.C.C. 17 especially at [14]-[17], both of which were appeals in oppositions. Amendment of a specification following a partially successful opposition will be limited in the usual way by section 39 of the Act. In addition, it is necessary for the amended specification to satisfy the requirement for clarity and precision envisaged by the CJEU in Case C-307/10 *Chartered Institute of Patent Attorneys* EU:C:2012:361 at paragraphs [40] to [49] and the *Postkantoor* principle discussed below.

5. The Opponent here did not raise any objection of principle to the amended specification, but concentrated upon two points, namely the need to keep within the terms of the original specification and the terminology appropriate to giving effect to my decision.
6. At the hearing, Ms Razzaq told me that the Applicant was prepared to forego the advertising services included in its proposed amended specification.
7. There were a number of issues arising out of the proposed amended specification of retail services. The Applicant had suggested that in light of my judgment the specification should refer to "retail services enabling customers to conveniently view and purchase [*goods*] ..." The Opponent instead suggested it should refer to "retail services provided through a physical store only connected with the sale of [*goods*]" and have the additional proviso "none of the aforesaid retail services provided electronically or via the internet." In the course of the hearing, both parties helpfully indicated that they were happy to describe the retail services as being provided "through a physical retail store." The Opponent considered that the whole phrase should be "through a physical retail store only" and this seems to me potentially a helpful clarification of the limited scope of an unobjectionable specification.
8. I heard submissions as to whether the specification should also be circumscribed by the 'proviso' suggested by the Opponent, bearing in mind in particular the guidance of the CJEU in Case C-363/99, *Postkantoor* and of Arnold J in *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch), [213] F.S.R. 25. In *Postkantoor*, the CJEU held that:

"114 ... where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only insofar 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 the 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 were indications of which the book consists in which a descriptive of that characteristic the purpose of describing their own goods."

In *Omega*, Arnold J commented that this guidance had caused some difficulty in subsequent cases. In *Merlin* [1997] RPC 871, when sitting as the Appointed Person, he had permitted a specification which read "but not including the provision of venture capital" because (he explained at paragraph 48 of *Omega*), "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." Its effect was to excise a particular service from the specification. If that was what it did, it did not matter whether the wording used was expressed in negative or positive terms. Similarly, in BL O/414/16, *Rangers FC's application* Mr Geoffrey Hobbs QC, sitting as the Appointed Person said at [19] that

"The limitations which the Applicant sought to introduce by means of the additional wording depended for their validity and effectiveness upon satisfying the applicable legal requirement for clarity and precision to the standard envisaged by the CJEU in Case C-307/10 *Chartered Institute of Patent Attorneys* EU:C:2012:361 at paragraphs [40] to [49]. Moreover, they were liable to be regarded as deficient for that purpose on the basis of 'the POSTKANTOOR principle' if all they did was identify characteristics which may be present or absent without changing the nature, function or purpose of the specified goods: see *Omega Engineering Incorporated v Omega S.A.* [2012] EWHC 3440 (Ch) at paragraphs [43] to [57]."

9. In this case, I am inclined to think that the proviso sought by the Opponent would seek to limit the services by reference to their characteristics. However, I do not need to decide that point, as it seems to me that limiting the services to those provided "through a physical retail store only" will suffice to exclude from the specification services delivered on-line or electronically, so that there is no need to add the proposed proviso to the specification.
10. There was also an issue as to the goods to which the retail services related. The Opponent objected to certain of the terms included in the proposed amended specification on the basis that they had not been included in the original specification (set out in Appendix A to my decision of 27 January). Ms Razzaq sensibly conceded that this objection was correct for most

of those items, namely, candles, novelty furniture, jewellery, and oil paintings. The Opponent objected to “serving stands” on the same basis, but Ms Razzaq suggested that serving stands were a kind of kitchen appliance. She suggested that the Applicant would instead wish to maintain a reference to kitchen appliances. Whilst I am not convinced that a “serving stand” is a kitchen appliance, Mr Webb did not object to the inclusion of kitchen appliances in the specification, so I do not consider it necessary to decide the point.

11. A further difficulty with the Applicant's proposed wording lies in its use of the expression “gift items including lamps [etc].” The original specification listed items by category but did not include a category identified as “gift items.” Furthermore, it identified individual items within categories by phrases such as “household items namely ...” rather than “gift items including.” It appears to me that the expression “gift items” is of indeterminate scope. In my view it would not satisfy the requirement for clarity and precision set out by the CJEU in *IP Translator* (above) and as the term was not present in the original specification, adding it to the amended specification would not be permitted in light of section 39. The difficulty with the expression would only be exacerbated by adding to it a non-exhaustive list of a wide variety of items covered by the specification. I do not think that this was the Applicant’s intention. On the contrary, the discussion at the hearing about the individual items to be included in the specification suggested to me that it was common ground that the list in the specification was, rightly in the light of *IP Translator*, intended to be exhaustive. In my judgment, therefore, the specification should not include any reference to “gift items” nor use the word “including” but it should simply identify the particular kinds of goods in relation to which the retail services are to be provided.
12. The application may therefore proceed to registration in relation to the following services:

“Retail services provided through a physical store only connected with the sale of lamps, ornaments, candle holders, clocks, vases, ceramics and porcelain figurines, pictures and frames, mirrors, mugs, trinket boxes and kitchen appliances.”
13. Both parties have had some measure of success in relation to the amendment of the specification. However, a number of points were conceded by the Applicant only at the hearing itself and the specification set out above is narrower than for which it contended. On balance it seems to me that the Applicant ought to make a modest contribution towards the Opponent's costs of this further hearing. The Applicant shall pay the Opponent the sum

of £350 which, for the avoidance of doubt, is in addition to the costs awarded in my decision dated 27 January 2017, and is to be paid by 5 PM on 25 April.

Amanda Michaels  
The Appointed Person  
11 April 2017

**MS MARIUM RAZZAQ (of JMR Solicitors LLP) appeared for the Applicant**

**MR. OSCAR WEBB (of NABARRO LLP) appeared for the Opponent**

#### **ANNEX 1**

*Applicant's proposal:*

Advertisement promotion and marketing of gift items including lamps, ornaments, candle holders, candles, novelty furniture such as sofas, armchairs and beds, clocks, vases, ceramics and porcelain figurines, pictures and frames, mirrors, mugs, trinket boxes, jewellery, serving stands and oil paintings by printed matter, banners, television, radio, the Internet and similar media; retail services enabling customers to conveniently view and purchase goods connected with the sale of gift items including lamps, ornaments, candle holders, candles, novelty furniture such as sofas, armchairs and beds, clocks, vases, ceramics and porcelain figurines, pictures and frames, mirrors, mugs, trinket boxes, jewellery, serving stands and oil paintings.

#### **ANNEX 2**

*Opponent's proposal:*

Advertising services provided via the Internet in relation to gift items including lamps, ornaments, candle holders, clocks, vases, ceramics and porcelain figurines, pictures and frames, mirrors, mugs, trinket boxes; retail services provided through a physical store only connected with the sale of gift items including lamps, ornaments, candle holders, clocks, vases, ceramics and porcelain figurines, pictures and frames, mirrors, mugs, trinket boxes, none of the aforesaid retail services provided electronically or via the Internet.