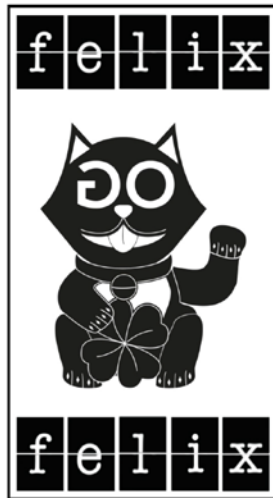


O-029-18

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3180957 BY
FELIX GO FELIX LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 9 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408034 BY DREAMWORKS ANIMATION LLC**

BACKGROUND & PLEADINGS

1. On 1 December 2017, I issued an interim decision in these proceedings (BL O-614-17). In that decision, I stated:

“38. The opposition against “computer application software featuring games and gaming” in class 9 and “fashion design” in class 42 succeeds regardless. As matters stand, the application also succeeds in relation to the applicant’s “Application software”, “Application software for mobile phones” and “Computer application software”. Earlier in this decision, I mentioned that in its submissions, the opponent stated:

“34...Where the application software of the applicant embraces functions not specific to gaming, the goods should therefore be classed as highly similar to the opponent’s class 9 goods i.e. all being types of software...”

39. However, in *Mercury Communications* (1995) FSR 850 Laddie J, stated:

“In my view it is thoroughly undesirable that a trader who is in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those far removed from his own area of interest. If he does he runs the risk of his registration being attacked on the grounds of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

40. Applying the guidance in *Mercury*, if the applicant were to offer a revised specification which positively limited its remaining goods in class 9 to a purpose

completely unrelated to the opponent's goods, it may be possible for the application to proceed to registration for a limited specification.

Next steps

41. With the above in mind, the applicant is allowed 14 days from the date of this interim decision to offer a revised specification in class 9. Any such revised specification offered should be copied to the opponent who will then be allowed a period of 14 days from the date that it receives a copy of the revised specification to provide comments. At the conclusion of that period, I will review any submissions the parties may make and issue a supplementary decision, deal with costs and in which a period will be set for appeal.”

2. As the applicant did not react to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the issuing of this decision), the conclusion I reached in paragraph 38 of my interim decision applies (when read in context, the phrase “the application also succeeds” in the third line of paragraph 38 should, of course, have read “the opposition also succeeds”). The consequence of that conclusion is that the totality of the application for registration will be refused.

3. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using the TPN mentioned as a guide, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Written submissions:	£300
Official fee:	£100

Total:

£600

4. I order Felix Go Felix Ltd to pay to DreamWorks Animation LLC the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of January 2018

C J BOWEN

For the Registrar