

1 MR. THORLEY: This is an appeal to the Appointed Person from a
2 decision of Mr. Pike dated 23rd August 2001. The decision
3 arose in an application made on 19th April 1996 by Gratnells
4 Ltd. for registration of a series of two trade marks in Class
5 20 for the following goods: trays; storage trays; trays of
6 plastic for storage; stackable trays; nestable trays;
7 shelving; shelves; storage apparatus; storage frames;
8 cabinets; storage trolleys; racks and racking; furniture;
9 parts and fittings for all the aforesaid goods; all included
10 in Class 20.

11 The marks for which registration is sought were set out
12 in Annex A to the decision and consist of the shape of the
13 end of a tray. In the case of the first of the series of
14 marks, the tray is a relatively shallow tray and, in the case
15 of the second, it is a deeper tray. The application form
16 states that the trade mark consists of the shape of the end
17 of the tray shown in the representations.

18 Following a hearing and the filing of evidence,
19 Mr. Pike concluded that the trade mark could not be
20 registered having regard both to the provisions of
21 section 3(2)(a) of the Act and of the provisions of
22 section 3(1)(c) of the Act and the proviso to section 3(1).
23 It is against this decision that Gratnells appeal.

24 Subsequent to the giving of the decision on 23rd
25 August, on 31st August, Gratnells applied to the Registrar to

1 limit the specification of the goods from the category set
2 out above to what they contended was a narrower category as
3 follows: trays for use in educational establishments. On
4 17th September, they filed their notice of appeal which
5 states on page 2 of the statement of case: "The
6 applicants/appellants have amended the specification of goods
7 of this application so as to read 'storage trays for use in
8 educational establishments.'".

9 It transpired at the hearing before me that whilst an
10 application had been made to amend the specification, after
11 the giving of Mr. Pike's decision it had not been acted upon
12 by the Registry, either by accepting it or by refusing it.

13 The first question that therefore arises is whether, on
14 this appeal, I can consider a more limited specification of
15 goods which was not the specification the subject of the
16 decision and which has not been approved by the Registry.

17 In my judgment, on giving a decision to refuse the
18 application, the Registrar becomes functus. She can
19 thereafter not prosecute the application further in any
20 respect. The only way in which the application can be
21 revived is by a successful appeal. Accordingly, it was not
22 within the power of the Registrar to accept or reject the
23 request to amend the specification of goods.

24 The next question is whether I have the power on an
25 appeal to allow an alteration in the specification of goods.

1 I am not prepared to rule that I do not have the power since
2 I have not heard full argument on this, but I very much doubt
3 that if there is a power, it is a power which will be
4 exercised on frequent occasions. The whole purpose of the
5 application process is that the Registrar should be in a
6 position to rule on an application which is in the final
7 state that the applicant wishes to have registered.

8 Turning to the present case, on the assumption that I
9 have the power to do so, I am wholly satisfied that it would
10 be wrong for me to allow any amendment of the specification
11 of goods in the form for which registration is now proposed.
12 I see great difficulties in a specification of goods which is
13 limited in the way now sought.

14 During the course of argument, a question arose as to
15 whether the mark would be infringed by a retailer offering
16 for sale trays which were quite plainly stackable trays and
17 were suitable for use in educational establishments, but
18 without indicating that that was their intended purpose.
19 Mr. Morgan, who appeared on behalf of the Registrar,
20 suggested that there would be infringement; Mr. Lynd, who
21 appeared on behalf of the applicant, suggested that there
22 would not be. Mr. Morgan was unable to assist me as to
23 whether or not the Registrar, in accordance with the
24 Registrar's practice, would accept such a specification of
25 goods.

1 I think the problem is exacerbated by reference to a
2 catalogue which was shown to me by Mr. Lynd, without
3 objection from Mr. Morgan, which shows the applicant's trays
4 being offered for sale in a trade catalogue carrying an
5 extensive number of stackable trays. Again, there is no
6 suggestion that those are for use in educational
7 establishments although no doubt that is the way in which
8 they could be used.

9 I therefore have grave doubts as to whether it would be
10 proper to allow this specification of goods and I certainly
11 would not be prepared to allow an amendment without remitting
12 this matter back to the Registrar for her views on whether or
13 not that was appropriate. In the circumstances, therefore, I
14 am not prepared to allow this amendment. I do not think it
15 is appropriate, when the trade mark has been in the course of
16 prosecution since 19th April 1996, to refer the matter back
17 to the Registry for them to decide whether or not the
18 specification of goods is right or wrong. I therefore
19 propose to reject the application to amend the specification
20 of goods. If that is the specification of goods which the
21 applicants require, they must make a further application and
22 allow the Registrar to adjudicate upon whether or not that
23 specification of goods is allowable.

24 Mr. Lynd, do you wish to proceed with your appeal in
25 the light of that decision?

1 MR. LYND: No.

2 MR. THORLEY: Following on from that decision, Mr. Lynd has
3 indicated to me that he does not wish to proceed with his
4 appeal and the appeal will accordingly be dismissed.

5 MR. LYND: Thank you very much.

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