

O-503-19

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3358042  
BY HUNTAPAC PRODUCE LTD TO REGISTER:



AND

THE OPPOSITION THERETO UNDER NO 600001056 BY  
WHISKY AUCTIONEER LTD.

## Background

1. On 11 July 2019 I issued a provisional decision in relation to this opposition, in which I stated the following:

“57. The opposition succeeds prima facie, under section 5(2)(b) of the Act, against non-alcoholic drinks where I have found there to be some similarity between these goods and the opponent’s. However, there are some non-alcoholic beverages included within the broad term where there will not be any similarity with goods contained in class 33 of the opponent’s specification. 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 “non-alcoholic drinks”;
- b) Fall within the scope of this decision in that the goods so specified have no similarity to ‘Alcoholic beverages; Gin; Spirits’.
- c) Do not fall foul of the guidance issued by the CJEU in the Postkantoor decision.

58. 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 ‘non-alcoholic drinks’ 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 25 July 2019 in which it stated the following:

*“We confirm that the non-alcoholic beverages of interest to the Applicant are "fruit drinks and juices" and that this part of the class 32 specification may be amended accordingly. The remaining goods in class 32 are unchanged.”*

3. On 8 August 2019 the applicant filed forms TM21b to amend its specification to the following:

*Non Alcoholic drinks namely fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.*

4. In an email dated 9 August 2019 the opponent responded in the following terms:

*“We refer to the above opposition. We understand that the attached Form TM21bs have been filed by the applicant today.*

*Unfortunately, these were filed without the opponent having the opportunity to review or approve the wording of the amended specification. The opponent is happy in principle that the specification is restricted so that it covers ‘fruit drinks and juices; vegetable juices [beverages]; vegetable juice; vegetable based beverages; vegetable smoothies; carrot juice; carrot juice drinks and beverages; water’.*

*However, the amended specification in the Form TM21b reads ‘Non Alcoholic drinks namely fruit drinks and juices; vegetable juices [beverages]; vegetable juice; vegetable based beverages; vegetable smoothies; carrot juice; carrot juice drinks and beverages; water’. The opponent is concerned that this could be ambiguous/open to interpretation as it still includes the generic term ‘non alcoholic drinks’. The concern is that the word ‘namely’ could be interpreted as ‘specifically’ and that the list*

*of goods which follows might therefore not be interpreted as an exhaustive list. The purpose of the opposition was to ensure that the broad term “non-alcoholic drinks” was removed from the application.”*

### **Supplementary decision**

5. Before I make a finding regarding the revised specification filed by the applicant it is necessary to point out that where a fallback specification is offered by the hearing officer as part of a decision, the parties should file their amendments and comments in response, which are then be considered by the hearing officer and confirmed in a supplementary decision. Consequently, it is my finding in this decision which will determine the applicant’s specification and not the TM21b forms filed by the applicant.

6. I note the opponent’s comments concerning the term ‘namely’ in the applicant’s suggested amendment to its specification. The term ‘namely’ is not ambiguous or open to interpretation. The Classification Addendum to the Manual of Trade Marks Practice deals with this construction as follows:

“Note that specifications including ‘namely’ should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above ‘dairy products namely cheese and butter’ would only be interpreted as meaning ‘cheese and butter’ and not ‘dairy products’ at large. This is consistent with the definitions provided in Collins English Dictionary which states ‘namely’ to mean ‘that is to say’ and the Cambridge International Dictionary of English which states ‘which is or are’.”

7. Clearly, the interpretation guidance above means that the applicant’s ‘*Non Alcoholic drinks namely fruit drinks and juices*’ means that the scope of its protection is limited to fruit drinks and juices. However, since specifications should be expressed as clearly as possible, I see no reason to add the words, ‘Non alcoholic drinks namely...’, before the goods ‘fruit juices and drinks’ which the applicant has clearly stated are the goods in which it is interested.

## **Conclusion**

8. 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 32:

Fruit drinks and juices; Vegetable juices [beverages]; Vegetable juice; Vegetable drinks; Vegetable based beverages; Vegetable smoothies; Carrot juice; Carrot juice drinks and beverages; water.

## **Costs**

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

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

**Dated this 28<sup>th</sup> day of August 2019**

**Al Skilton  
For the Registrar**