O-368-04

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2333704
BY CAPOCO DESIGN LIMITED
TO REGISTER THE TRADE MARK:

mobilicity

IN CLASSES 12 AND 39

AND

THE OPPOSITION THERETO
UNDER NO 92075
BY EXXONMOBIL OIL CORPORATION

Trade Marks Act 1994

In the matter of application no 2333704
by Capoco Design Limited
to register the trade mark:
mobilicity
in classes 12 and 39
and the opposition thereto
under no 92075
by ExxonMobil Oil Corporation

BACKGROUND

1) On 31 May 2003 Capoco Design Limited, which I will refer to as Capoco, applied to register the trade mark **mobilicity**, the trade mark, in classes 12 and 39. On 27 October 2003 ExxonMobil Oil Corporation, which I will refer to as Exxon, filed a notice of opposition to the application. A hearing took place on 25 November 2004. Ms Ponsford of Capoco represented Capoco. Mr Harris of Gill Jennings & Every appeared for Exxon.

2) At the hearing I brought the extent of the objection under section 5(2)(b) of the Trade Marks Act 1994 (the Act) into question. In my view the grounds of opposition under section 5(2)(b) of the Act did not encompass the class 12 goods of the application. Mr Harris requested that I allow an amendment to the grounds of opposition, in the event that I was correct in my interpretation. I refused to allow such an amendment. I did, however, state, that I would deal with the issue in the full decision. Nonetheless, a form TM5 was filed on 29 November 2004 requesting a separate statement of grounds on this issue. I am, therefore dealing with this issue in this decision. The substantive decision which is being issued at the same time deals with all other matters and also, as is the norm in these cases, deals with the section 5(2)(b) issue in the event that I am wrong in my interpretation of the grounds of opposition and refusal to amend the grounds.

3) Paragraphs 3 – 6 (inclusive) of the statement of grounds of opposition read as follows:

> "3 It is the view of the Opponent that the Applicant's MOBILICITY mark is confusingly similar to the aforementioned marks of the Opponent and further that the goods and services to be covered thereby in classes 39 are the same as or similar to those covered by the Opponent's registrations Nos. 165415 and 79806; as a result the Opponent believes there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the Opponent's earlier trade marks
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> 4 To the extent that the Registrar, upon hearing the submissions and evidence of the Opponent, agrees with the Opponent's view, or otherwise determines that any goods and services covered by the Applicant's mark are the same as or confusingly similar to the aforesaid rights of the Opponent, then registration of the Applicant's mark would be contrary to

the provisions of Section 5(2)(b) Trade Marks Act 1994 and must be refused in respect of all of the goods and services for which it is proposed to be registered and which the Registrar holds to be the same as or similar to those of interest to the Opponent.

5 Further or in the alternative, the Opponent's trade marks having been used within the United Kingdom in the manner referred to in paragraph 3 hereof of the Opponent believes that it has a significant reputation associated with and symbolised by the trade mark

6 As regards the other goods and services to be covered in class 12 of the Applicant's application, and additionally to any extent the Registrar shall determine that any goods or services covered by the Applicant's application are dissimilar to those for which the Opponent's earlier well known trade marks are protected then the Opponent will say that the earlier marks having a reputation in the UK, the use of the Applicant's mark would be without due cause and would take unfair advantage of and be detrimental to the distinctive character or the repute of the Opponent's earlier trade marks and that the registration should therefore be refused pursuant to Section 5(3) Trade Marks Act 1994."

4) The skeleton argument for Exxon included an attack on the class 12 goods of the application under section 5(2)(b) of the Act. I advised at the hearing that I did not consider that the grounds of opposition included an attack on the class 12 goods under section 5(2)(b) of the Act. Mr Harris was of the view that paragraph 4 of the statement of grounds included an attack upon all the goods and services of the application. This is not a view that I share. I read this as just stating that any goods or services that the registrar finds similar should be refused. The goods and/or services which Exxon consider similar are explicitly stated in paragraph 3. So paragraph 4 is subservient to the identification of the similar goods/services in paragraph 3. I am fortified in my view by paragraph 6 of the grounds of opposition which specifically relates class 12 goods to section 5(3), being non-similar. I do not see that anything turns upon the presence of the phrase "goods and services" in paragraph 4. In the event that I was correct, it was requested that the grounds of opposition should be amended to include an attack against class 12 goods under section 5(2)(b) of the Act. Mr Harris commented that in its counterstatement Capoco had denied that the goods and services of its application are similar or the same as those of Exxon's registrations. I have to firstly consider the statement of grounds filed by Exxon, not the reaction to it by Capoco. The counterstatement bears all the hall marks of being drafted by an applicant without expert legal advice. I doubt that Capoco speak the language of trade mark legalese and so will not be fully aware of the nuances and subtleties of grounds of opposition. I do not consider that Capoco should be disadvantaged because of this. It is my inherent jurisdiction to allow the amendments of grounds of opposition. However, I refused the amendment.

5) If Exxon had wished to change the basis of its opposition it could have made a request so to do before the hearing. I consider that a request during the hearing is neither timeous

nor reasonable. Capoco is not legally represented and so would not necessarily realise the full implications of such an amendment, or the policy in allowing such an amendment. In the light of an amendment to a statement of grounds Capoco would have the right to have three months to file an amended counterstatement (see *George Lowden v The Lowden Guitar Company Limited* [2004] EWHC 2531). This would have brought about further delay and it is difficult to compensate for delay. No reasons were given for the request to amend, no explanation as to why the attack on class 12 was included in the skeleton argument but not in the statement of grounds.

6) In refusing any amendment I was also bearing in mind other factors in this case. In its skeleton argument Exxon also tried to change the basis of the claim under section 5(3) of the Act so that it encompassed similar goods as well as non-similar goods. I pointed this out later in the hearing and refused any amendment (this is dealt with in the substantive decision). Consequently, through the means of the skeleton argument, Exxon was fundamentally changing the nature of its opposition; it was trying to bring in the class 12 goods under section 5(2)(b) and the class 39 services under section 5(3).

8) Fundamental to my decision is that the amendment was asked for on the hoof when I pointed out the contradictory position between the statement of grounds and the skeleton argument. I am of the view that good practice and the fair application of the law demands that if a side wishes to amend its grounds of opposition it should do so clearly and in advance; allowing the other side the time to consider, without pressure, the request. It would set a dangerous precedent to allow the skeleton argument and subsequent submissions to become an addendum to the statement of grounds.

9) As I have stated above, the substantive decision includes a consideration of an attack against the class 12 goods of the application, in the event that I am wrong, and so no additional delay should occur in relation to any resolution of this matter.

Dated this 14th day of December 2004

David Landau
For the Registrar
the Comptroller-General