

O/351/09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 2462601A and B
BY KLEENEZE LTD TO REGISTER TWO SERIES OF TWO TRADE MARKS**



IN CLASSES 3, 5, 8, 9, 11, 16, 18, 21, 26, 28, 35, 38, and 41

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos 96879 and 96881
BY ROY THOMAS**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos. 2462601A and 2462601B
By Kleeneze Ltd to register two series of two marks**



In classes 3, 5, 8, 9, 11, 16, 18, 21, 26, 28, 35, 38, and 41

And

IN THE MATTER OF Consolidated Oppositions thereto under Nos. 96879 and 96881 by Roy Thomas

SUPPLEMENTARY DECISION

1. On 9th October 2009 I issued a decision (BL O-313-09) in these proceedings on behalf of the Registrar and this supplementary decision corrects irregularities in procedure in that decision.
2. In that decision I omitted in certain paragraphs to take into account that “briefs and underpants” are part of the applicant’s specification in relation to their retail services in class 35. The terms are amongst other listed items which were put forward by the applicants on Form TM21 filed on 13th August 2008 to replace the term “clothing” in class 35. I also included “discs” in the applicant’s class 35 specification for which the opposition was successful when these items had been deleted as requested on the same Form TM21. Finally, I have noticed that on the same Form TM21 the applicant deleted “plugs sockets and other contacts” from their class 9 specification but omitted to do so from their class 35 specification. Had those items remained in the class 9 specification they would have been found to be identical to “electric apparatus and instruments” in the opponent’s class 9 specification. On that basis and given my findings in the decision I consider that the opposition should also succeed against the retailing of the same in class 35.
3. Under rule 77 of the Trade Marks Rules 2008 (“the rules”), I correct these errors by amendment to the lists of goods that appear in the *original* paragraphs 30, 32 and

47 of my decision. I have also noticed that the paragraph numbering needs to be corrected, commencing at paragraph 8 and concluding at the original paragraph 30. The second paragraph 8 should be renumbered paragraph 9 and so forth, up to the original paragraph 30 which is renumbered paragraph 31. Paragraphs 32- 35 stay the same, but the second paragraph 35 is renumbered 36 and so forth, up to the end of the decision. In total there are 51 paragraphs. The corrected passages, with the corrected paragraph numbering, should read as follows (with corrections emphasised):

~~“30)~~ **31)** There is nothing in the case before me which suggests I should not adopt the guidance provided in either *Praktiker* or *Oakley*. Accordingly, and reflecting my earlier findings in respect of the goods classes, I find the following retail services in class 35 similar to Mr Thomas’s goods:

The bringing together, for the benefit of others, of a variety of goods, namely alarms, security alarms and anti-theft warning devices, extinguishers, smoke detectors, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes and discs; **plugs, sockets and other contacts**; batteries and battery chargers, life saving apparatus and instruments, parts and fittings for all the aforesaid goods; bed socks; robes; pyjamas; nightshirts; rain ware; gloves; mittens; loungewear; underwear; **briefs; underpants**; boxer shorts and belts; enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

32) I need to mention specifically, the retail services in respect of “bed socks; robes; pyjamas; nightshirts; rain ware; gloves; mittens; loungewear; underwear; **briefs; underpants**; boxer shorts and belts”. Kleeneze replaced the general term “clothing” with these specific items in class 35, presumably on the basis that Mr Thomas had expressly excluded them from his ‘ 783 class 25 specification . However, given the punctuation in Mr Thomas’s specification, this is not true. It is only “bed socks” that are excluded from the broader term “sleepwear”; the phrase reading “sleepwear, but not including bed socks”. All the remaining items listed, starting with “robes”, are separated from “sleepwear” by semi-colons, thus indicating that they are *included* rather than excluded. Plainly, given the punctuation in Mr Thomas’s specification, the items:- “robes; pyjamas; nightshirts; rain ware; gloves; mittens; loungewear; underwear; **briefs; underpants**; boxer shorts and belts” in class 35 of Kleeneze’s specifications are all identical to those items listed in Mr Thomas’s class 25 specification and therefore retail services in relation to the same must be treated as similar to the goods themselves. In relation to “bed

socks”, although these have been expressly excluded (and therefore cannot be identical to Mr Thomas’s goods), they nonetheless must be regarded as highly similar to other forms of sleepwear.

47) **48)** I need now to bring my respective findings together in a global assessment of likelihood of confusion. Taking account of imperfect recollection, my finding in relation to moderate to average distinctiveness, my findings in relation to the similarities of goods and services and the average consumer and the comparison of marks themselves, my overall conclusion is that the opposition succeeds only in relation to the goods I have found to be identical and the services I have found to be similar. These goods and services are:

Class 9

Alarms, security alarms and anti-theft warning devices; smoke detectors; extinguishers; thermostats; protective clothing; earplugs; teeth protectors; photographic apparatus and instruments; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes, discs; batteries and battery chargers; life saving apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 35

The bringing together, for the benefit of others, of a variety of goods, namely: alarms, security alarms and anti-theft warning devices, extinguishers, smoke detectors, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes and discs; **plugs, sockets and other contacts**; batteries and battery chargers, life saving apparatus and instruments, parts and fittings for all the aforesaid goods; **bed socks; robes; pyjamas; nightshirts; rain ware; gloves; mittens; loungewear; underwear; briefs; underpants**; boxer shorts and belts; enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.”

4. The appeal period will be reset and will now start from the date of this supplementary decision.

Dated this 10th day of November 2009

Edward Smith
For the Registrar,
The Comptroller-General