

O-052-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 106 809 FOR THE
TRADE MARK (AS A SERIES OF TWO):



IN THE NAME OF RETROTOUCH (UK) LTD

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 405 051
IN THE NAME OF O2 HOLDINGS LIMITED

CORRECTION OF DECISION DATED 31ST JANUARY 2017

1. It has been drawn to my attention that the decision issued in this matter, dated 31st January 2017, contained an error in paragraph 4 of the decision. This paragraph referred to a suggested specification from the applicant, but presented this incorrectly. The correct version is as follows:

“electric current light switches; mechanical contact light switches; push light switches (electrical); rotary light switches (electric); rotary light switches; electrical light switches; light switches electric; parts and fittings in relation to all the aforesaid goods; speaker switches, data switches, switches electric, electrical sockets, electric sockets, aerial sockets, connector sockets (electrical), sockets for electric plugs, plugs, plug sockets and other contacts (electrical), save for mobile telecommunications equipment and/or the sale of telecommunications equipment; parts and fittings for all the aforesaid.”

2. The error is plainly an irregularity in procedure and capable of correction under Rule 74. Consequently, I give the parties notice that the suggested specification in paragraph 4 of the decision will be amended to the version shown above and apply as though this paragraph had appeared in the original version of the decision.
3. In the light of this error, I must consider afresh the specification submitted. In doing so, it is found that the following goods can proceed to registration:
“electric current light switches; mechanical contact light switches; push light switches (electrical); rotary light switches (electric); rotary light switches; electrical light switches; light switches electric; parts and fittings in relation to all the aforesaid goods. This is because they clearly define the goods in question and succeed in distinguishing them from those of the earlier trade mark as they are expressed in a manner which defines them as a sub

category rather than according to a particular characteristic¹. This is in addition to those already found to have survived the opposition. As such, the complete list of goods that can proceed to registration is as follows:

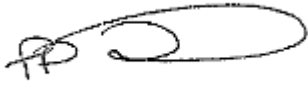
Electric light switches, touch switches, dimmer switches; temperature switches; shaver sockets; electric current light switches; mechanical contact light switches; push light switches (electrical); rotary light switches (electric); rotary light switches; electrical light switches; light switches electric; parts and fittings in relation to the aforesaid.

4. However, the opposition succeeds in respect of: *speaker switches, data switches, switches electric, electrical sockets, electric sockets, aerial sockets, connector sockets (electrical), sockets for electric plugs, plugs, plug sockets and other contacts (electrical).*²
5. The original final decision of 31st January 2017 considered the costs award to fall in favour of the opponent as having been proportionally more successful. However bearing in mind the aforesaid and in assessing the degree of success achieved by both parties, this is considered to be fairly even. As such, I order both parties to bear its own costs.
6. As the original error impacted directly on the substantive outcome and has led to a revised costs award, the parties should note that the appeal period has been reset. As such, any appeal should be received within 28 days of the date of this decision.

¹ See *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), where Arnold J. provided guidance (from paragraph 43 onwards) on the application of the *POSTKANTOOR* principle.

² For reasoning, see that provided in the decision dated 31st January 2017, from paragraph 5 onwards.

Dated this 10th day of February 2017

A handwritten signature in black ink, appearing to be 'L White', written in a cursive style.

Louise White

For the Registrar.