

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2150775B
BY MR. & MRS. ALDRIDGE TO REGISTER
A TRADE MARK IN CLASS 18**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 50039
BY MAX MARA FASHION GROUP S.R.L**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR. A. JAMES
DATED 25 SEPTEMBER 2001**

DECISION

Background to the appeal

1. By an application dated 14 November 1997 and filed as 2150775, Mr. and Mrs. Aldridge of Harborne, Birmingham (“the applicants”) applied to register the trade mark PENNY BLACK and logo for the following goods;

Class 9

Manufacture, production, distribution, sales/marketing of compact discs, tape cassettes or vinyl recording material

Class 25

Clothing, headgear, footwear, accessories; bags, belts, wallets, keyrings, watches.

2. The applicants’ PENNY BLACK and logo trade mark is represented as shown below:



3. In his Examination Report of 30 December 1997, the examiner proposed changes to both specifications. Regarding Class 25 the examiner stated:

“The specification is not acceptable because the following goods/services are not proper to this class and your application does not include the appropriate class(es) for them. If you wish to proceed with these goods/services please send an “Application for additional classes” (Form TM3A), accompanied by the appropriate number of class fees, to this Office.

Keyrings and watches proper to Class 14
Bags, belts and wallets proper to Class 18”

4. As a result of citations in the Examination Report and following further correspondence with the applicants, the examiner confirmed on 17 September 1998 that the application would proceed only in Classes 9 and 18 (in respect of “bags, belts and wallets”). The application was published in Trade Marks Journal No. 6252 dated 18 November 1998.
5. Max Mara S.r.l. (“the opponent”) filed notice of opposition against the application on 17 February 1999. The opposition concerned solely goods in Class 18 of the application and was based on the opponent’s earlier UK trade marks PENNYBLACK and PENNYPLUS registered in Class 25 and Classes 18 and 25 respectively. The applicants divided the application and 2150775A in Class 9 proceeded to registration while 2150775B in Class 18 remained subject to opposition.
6. The opposition was heard by Mr. Allan James, Principal Hearing Officer, acting on behalf of the Registrar on 21 August 2001. In his written decision of 25 September 2001, Mr. James held:
- (a) The opponent’s earlier UK registration for PENNYBLACK in Class 25 wholly prevented acceptance of the applicants’ PENNY BLACK and logo trade mark for belts and wallets.
- (b) Although the opponent’s earlier UK registration for PENNYBLACK in Class 25 prevented acceptance of the applicants’ PENNY BLACK and logo trade mark for “certain bags (in particular, handbags) [that] are commonly sold through the same channels as articles of clothing” the application would be allowed to proceed if the specification was limited to: “Toiletry bags, make-up bags, fragrance pouches, beach bags, sports bags and travel bags”.
7. On 23 October 2001, the opponent gave notice to appeal to an Appointed Person under section 76 of the Trade Marks Act 1994 (“TMA”). Before the hearing of the appeal on 3 May 2002, I forwarded to the parties through the Treasury Solicitor the Court of Appeal’s decision in *Reliance Water Controls Ltd v. Altecnic Ltd* [2001] EWCA Civ. 1928, 12 December 2001. I requested that the parties address me at the appeal hearing on classification issues in the light of the *Reliance v. Altecnic* decision. The Registrar was unable to be

represented at the hearing on 3 May 2002. I therefore adjourned the appeal part-heard so that the Registrar's guidance on classification could be provided at the reconvened hearing on 30 August 2002.

Reliance Water Controls Ltd v. Altecnic Ltd

8. The facts insofar as relevant were that Altecnic applied in Class 7 for trade mark registration in respect of: "Valves; valves for use in water circulation; blending valves". They subsequently requested a transfer from Class 7 to Class 11 stating that the goods were incorrectly classified. Valves can be registered in Class 7 or Class 11 although it was accepted that Altecnic's products fitted better in Class 11. The Court of Appeal held that the statement of the class number in the appropriate column on Form TM3 is part of the application for trade mark registration, which can only be amended in accordance with the TMA and the Trade Marks Rules. Since valves do fall within Class 7, Altecnic's request for transfer to Class 11 was an impermissible amendment within the meaning of section 39(2) of the TMA. Section 39(2) of the TMA permits amendment of the application only by correcting the name or address of the applicant, errors of wording or of copying, or obvious mistakes and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application. The Court of Appeal added:

"The position might well be different if none of the particular goods expressly described in the "Specification of goods" column fell within goods contained in the Class number given in the "Class number" column of Form TM3. Such a case might reasonably be described as one of an "obvious mistake" in the selection of the Class number and the Class number could accordingly be corrected".

Classification issues in the present appeal

9. The hearing officer's decision the subject of the present appeal concerned "bags, belts and wallets" in Class 18. The applicants originally applied for "bags, belts and wallets" in Class 25. According to Trade Marks Registry practice at the time of application on 14 November 1997, as indeed today, bags and belts fell within Class 25 or Class 18 (*Avnet Incorporated v. Isoact Limited* [1998] FSR 16 per Jacob J. at 19 following *GE Trade Mark* [1969] RPC 418 at 458). The bags identified by the applicants during the opposition hearing as being of particular interest to them generally fitted better within Class 18 than Class 25, which covered and covers bags specifically adapted to contain clothing, footwear and headgear. Conversely, belts of interest to the applicants probably fitted better within Class 25 than Class 18, which covered and covers leather shoulder belts. Nevertheless, a specification that listed the products as "bags" and/or "belts" could then and can now properly be classified either in Class 25 or Class 18.
- 10 I am, of course, bound by the Court of Appeal decision in *Reliance Water Controls Ltd v. Altecnic Ltd*, supra. In my view, the examiner acted ultra vires when he indicated to the applicants that they should amend their application

by moving bags and belts from Class 25 to Class 18. Such an amendment would be (and in the event was) in breach of section 39(2) of the TMA. Accordingly, insofar as it concerns bags and belts in Class 18, Mr. James' decision of 25 September 2001 must be set aside and the application remitted to the Registrar for further consideration in Class 25 as at the application date of 14 November 1997. I would add that the 1996 edition of the Trade Marks Registry Work Manual at Chapter 5, paras. 5.6 and 5.8 supplemented by Practice Amendment Circular 2/99 confirms that the Registrar's practice at the time did not permit the addition of a class or classes to an application in circumstances similar to those of the present appeal.

11. The hearing officer's decision also concerned wallets in Class 18. Wallets were on 14 November 1997 (and remain today) proper to Class 18 and not to Class 25. That part of the Examination Report dated 30 December 1997 was correct and the circumstances fall within the instance of permissible amendment under section 39(2) of the TMA given by the Court of Appeal in *Reliance Water Controls Ltd v. Altecnic Ltd*, supra. (quoted at para.8 above). However, since no appeal has been lodged against Mr. James' decision in respect of wallets, it must stand.

Conclusion

12. Mr. James' decision of 25 September 2001 is set aside insofar as it relates to bags and belts in Class 18. The application in respect of bags and belts is remitted to the Registrar for further consideration in Class 25 as at the application date of 14 November 1997. In view of the above circumstances, I consider it neither appropriate nor right to make any order for the costs of this appeal.

Professor Ruth Annand, 6 September 2002

Ms. Lindsay Lane of Counsel instructed by Marks & Clerk represented the opponent at the adjourned hearing on 3 May 2002. At the reconvened hearing on 30 August 2002, the opponent was represented by Mr. J. Slater, Marks & Clerk.

The applicants appeared in person and were not represented at the adjourned hearing on 3 May 2002 and the reconvened hearing on 30 August 2002.

Messrs. Mike Knight and Charles Hamilton attended on behalf of the Registrar at the reconvened hearing on 30 August 2002.