

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2360952
BY O2 HOLDINGS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 9, 16, 38 AND 41**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST THE DECISION OF MR A J PIKE
DATED 1 JUNE 2006**

DECISION

1. This is an appeal against the decision of Mr. A. J. Pike, the Hearing Officer acting for the Registrar, in which he refused UK Trade Mark Application number 2360952 under the terms of section 37(4) of the Trade Marks Act 1994 because it failed to qualify under section 5(2) of the Act.
2. The Application dated 15 April 2004 was originally in the name of O2 Limited but O2 Holdings Limited was recorded in the Register as the Applicant on 5 February 2005. Registration was sought in Classes 9, 16, 38 and 41 for the following trade mark:



The colour blue was claimed as an element of the trade mark.

3. During relative ground examination, the Registry cited two earlier Community trade mark registrations against the Application under section 5(2) of the Act. The second was E2857092 for the mark O2 CAN DO registered in Classes 9, 38 and 42 by O2 Holdings Limited with a priority date of 3 April 2002. The citation was a “technical citation”, which the Hearing Officer explains is used by the Registry to identify citations where the marks are, or appear to be, in

common ownership. The Hearing Officer decided that this technical citation covered the goods and services applied for in Classes 9, 38 and 41.

4. On the face of the registers, E2857092 and the Application are in common ownership. Mr. Allan James, appearing for the Registrar before me on appeal, confirmed that as regards E2857092, any section 5(2) objections fall away.
5. The other Community trade mark registration cited against the Application was E427484. E427484 concerns the mark O2 registered with priority from 19 September 1996 for computer hardware and computer system software in Class 9 and instruction manuals in Class 16. It belongs to Silicon Graphics Inc. The Hearing Officer decided that based on E427484, section 5(2) objections existed against the Application in Classes 9 and 16.
6. At the appeal hearing, Mr. Julius Stobbs, Messrs. Boulton Wade Tennant, appeared on behalf of O2 Holdings Limited. Mr. Stobbs informed me that negotiation with Silicon Graphics Inc. had failed and that his client no longer sought registration of the mark in suit (or pursued the appeal) in Classes 9 and 16.
7. Mr. James signified that in those circumstances, the Registrar agreed that the Application should be allowed to proceed in Classes 38 and 41.
8. Mr. Stobbs undertook that his client would make a formal application to withdraw the Application in Classes 9 and 16. However, it seems to me that the Registrar's practice on Partial Refusals issued on 28 July 2006 (PAN 14/06 and TPN 2/2006) means that mere deletion can be performed.
9. To conclude, I direct that the Application be referred back to the Registry for further processing in Classes 38 and 41.
10. In accordance with normal practice, I make no order as to the costs of this appeal.

Professor Ruth Annand, 2 February 2007

Mr. Julius Stobbs, Messrs. Boulton Wade Tennant, appeared on behalf of O2 Holdings Limited

Mr. Allan James appeared on behalf of the Registrar