

O-047-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 82654**

**BY VANILLA GORILLA LP FOR REVOCATION OF**

**REGISTRATION NO 2128996:**



**STANDING IN THE NAME OF**

**FINE WHITE LINE LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 82654  
By Vanilla Gorilla LP  
For revocation of registration 2128996  
Standing in the name of Fine White Line Limited**

### **BACKGROUND**

1. Trade mark registration 2128996 (“the mark”) stands in the name of Fine White Line Limited (“FWL”); a representation of the mark and the goods for which it is registered are shown below:



Class 12: Motor cycles, motor scooters; parts and fittings for all the aforesaid goods.

Class 18: Articles of luggage, bags, handbags, holdalls, rucksacks, purses and wallets proper to Class 18.

Class 25: Clothing, footwear and headgear, all for leisure wear proper to Class 25.

2. On 11 October 2006 Vanilla Gorilla LP applied for revocation of the registration under the provisions of Section 46(1) (a) & (b) of the Trade Marks Act 1994 (“the Act”). Revocation is sought in relation to all of the goods for which the mark is registered or, alternatively, to those goods for which grounds for revocation exist.

3. The registered proprietor filed a counterstatement denying these claims; the counterstatement was accompanied by evidence. No other evidence was filed by the registered proprietor. The applicant for revocation filed no evidence. Both sides request an award of costs.

4. Neither party requested a hearing, but both filed written submissions, the submissions were made by their respective trade mark attorneys. These will be taken into account and referred to in this decision but will not be summarised separately. Acting on behalf of the Registrar, and after a careful study of the papers, I give this decision.

### **Registered proprietor’s evidence**

5. The evidence comes from Mr Nicholas James Muir Culton. He states that his evidence comes from his own personal knowledge, publicly available information, the records of

FWL, or have been confirmed to him by Mr Derry Kunman of FWL. To explain Mr Culton's relationship with the mark, I have summarised below the chronological events relating to the businesses that are detailed in his evidence:

- Mr Culton began trading as "West Coast Motorcycles" in 1983. He subsequently transferred the business to CC International Limited ("CCI"). Mr Culton was a director of CCI.
- The mark was first used in 1994 by Mr Culton in respect of the CCI business.
- The mark was registered on 28 November 1997 and was, at that point, in the ownership of CCI.
- CCI went into liquidation on 21 December 2000 following which the mark was assigned to West Coast Motorcycles Limited ("WCM"). Mr Culton was a director of WCM.
- WCM assigned the mark to Mr Kunman on 25 October 2005.
- WCM went into liquidation on 26 September 2006. However, Mr Culton states that until its liquidation, Mr Kunman gave WCM permission to continue using the mark.
- Mr Culton understands from Mr Kunman that the mark was assigned from Mr Kunman's personal ownership to his company, FWL, on 12 January 2007.

6. Official records confirm the chain of ownership from CCI onwards. However, it should be noted that there is gap in the assignment chain prior to this. At the time of filing the mark stood (according to official records) in the name of Chaos Clothing who then assigned it to CCI. Mr Culton's evidence does not reflect this, however, this is unlikely to be significant given that this occurred prior to the registration of the mark. There is also a question regarding the use by WCM with the consent of Mr Kunman (no evidence of this consent has been filed) to whom the mark was assigned in October 2005. The period of use with consent therefore being 25 October 2005 to 26 September 2006. However, as this is after the expiry of both periods of alleged non-use, this will only be relevant if there has been a resumption or commencement of use<sup>1</sup>.

7. Mr Culton states that the mark was used throughout the periods of alleged non-use by either CCI or WCM. His first exhibit, NJMC1, consists of an advertisement placed in *Bike Trader* magazine in May 2000. The advertisement has a picture of a business premises, the premises clearly displays the mark. The advertisement also features the details of a number of motorcycles that are sold there. An invoice relating to the placing of this advertisement is also provided.

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<sup>1</sup> See the provisions of Section 46(3) of the Act.

8. Exhibit NJMC2 consists of copies of invoices relating to the sale of clothing, motorcycles and spare parts; all the invoices display the mark. I will analyse this evidence further when assessing whether genuine use has been shown. Exhibit NJMC3 consists of a copy of an invoice for what Mr Culton describes as a screen print of the mark which, he states, would have been used in the production of clothing such as t-shirts, sweatshirts and hooded tops. The invoice is dated 11 June 2001. The mark itself is not shown.

9. Exhibit NJMC4 is an invoice for “logo transfers” that Mr Culton states were used on race bikes for sponsorship purposes. The mark is not shown on the invoice, but I note that it does refer to the “West Coast Shield”. The invoice is dated 7 May 1999. The exhibit also contains an article from the magazine *Streetfighters* showing use of the mark on such a race bike. This article is dated August/September 1994, which I note is from before either of the periods of alleged non-use.

10. Exhibit NJMC5 is a photograph of the mark applied to what Mr Culton states to be a bag. I should say that whilst the mark is clearly discernable, the bag is not. Mr Coulton states that these bags were first sold in 1996 and continued to be sold until 2006.

11. Mr Culton states that all the goods have been sold or offered for sale on the world wide web. Exhibit NJMC6 consists of “Whois” information for two domain names under which, Mr Coulton says, these sales have taken place – Mr Culton is listed as the registrant for both domain names. Exhibit NJMC7 consists of archive copies of various web-pages under these domain names. I will analyse this evidence further when assessing whether genuine use has been shown.

12. Approximate annual profit figures are then provided for CCI & WCM. These are taken from the annual accounts of the two companies that are exhibited under NJMC8 & NJMC9 respectively. The figures are said to relate to profit under or by reference to the mark. The figures are:

CCI		WCM	
<u>Year ending</u>	<u>Profit</u>	<u>Year ending</u>	<u>Profit</u>
31/10/96	£316,679	31/10/98	£21,485
31/10/97	£415,361	31/10/99	£521,856
31/10/98	£363,485	31/10/00	£499,099
		31/10/01	£518,318
		31/10/02	£284,075
		31/10/03	£322,467
		31/10/04	£263,238

13. Advertising and promotional spend (combined for the two companies) is then given. This is stated as being:

<u>Year ending</u>	<u>Expenditure</u>
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31/10/96	£70,000
31/10/97	£65,000
31/10/98	£75,000
31/10/99	£100,000
31/10/00	£60,000
31/10/01	£50,000
31/10/02	£50,000
31/10/03	£30,000
31/10/04	£25,000

14. In relation to this promotional and advertising expenditure, Mr Culton states that this is in the form of sponsorship of race bikes and the placing of advertisements in biking magazines. Exhibit NJMC10 consists of material relating to these placed advertisements. I will analyse this evidence further when assessing whether genuine use has been shown.

15. The final exhibit, NJMC11, contains invoices for an exhibition at which the mark is said to have been displayed in 1999 & 2000. Mr Culton states that the display stands included display motorcycles and also offered clothing for sale.

### **The Law**

16. Section 46 reads as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the Registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

17. Section 100 of the Act is also relevant as this reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. The two leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. I do not intend to summarise these cases in full, but taking them in the round, it is clear that the test for

genuine use is a qualitative one and not a quantitative one. Genuine use should be found when the trade mark has been used in such a way so as to create or maintain a share in the market for the goods and services for which it is registered. In relation to this market share, this should not be construed as imposing a requirement that a significant market share has been achieved (*Laboratoire de la Mer*, paragraph 44). Genuine use should not be found if use is mere “token” use or if it is merely internal to the registered proprietor’s business (*Ansul*, paragraph 36 & 37 respectively).

### **Relevant five year period**

19. The application for revocation is based on Section 46(1)(a) and Section 46(1)(b) of the Act. The (amended) claims and the relevant five year periods are detailed below:

Sections 46(1)(a) – The registration procedures were completed on 28 November 1997, the five year period therefore begins on 29 November 1997 and ends on 28 November 2002. Revocation is sought with effect from 29 November 2002.

Section 46(1)(b) – Revocation is sought with effect from 17 October 2003. The five year period therefore begins on 17 October 1998 (not 16 October 1998 as the applicant has claimed) and ends on 16 October 2003.

### **DECISION**

20. The applicant submits that little can be inferred from the registered proprietor’s evidence (much of what has been filed has been criticised) and therefore genuine use has not been shown. The registered proprietor submits that the evidence “without question” establishes genuine use. Before analysing the evidence and submissions in further detail and drawing my conclusions, it is useful to note that the mark is registered in three distinct classes covering motorcycles and motor scooters (and their parts and fittings) in Class 12, luggage and bags etc in Class 18 and articles of clothing in class 25. I propose to examine the position firstly in relation to the Class 12 goods and secondly in relation to the goods in classes 18 and 25.

#### **Motorcycles, motorscooters and their parts and fittings.**

21. Mr Culton explains in his evidence that when the business was started its focus was on the importation and sale of motorcycles. Much of the evidence relates to the business activity of selling motorcycles and related items such as clothing (the evidence on this will be analysed later). The primary concern I have in relation to this first set of goods is whether the mark has been used as a trade mark in relation to the actual goods themselves.

22. The evidence shows that the motorcycles being sold (many, but not all, are second hand) come from well known manufacturers such as Suzuki, Yamaha and Honda. Exhibit NJMC1 clearly shows this. One of the invoices in NJMC2 relates to the sale of a Yamaha XS400 and another relates to spare parts for a Yamaha motorcycle. A similar pattern

emerges from exhibit NJMC7 which consists of various web-pages, most of which detail various motorcycles for sale that are, again, branded with these well known third party names or, alternatively, to specific model names or numbers. It could be argued that these model names and numbers are not third party brands as the manufacturer name is absent. I note this, however, from the totality of the evidence, it seems that these model names and numbers do relate to third party manufacturers. I say this because the advertisements at NJMC1 & NJMC10 feature the manufacturer and the model name or number together – some of these designations can then be cross-referenced to the non-manufacturer designated motorcycles in NJMC7. For example, model numbers beginning GPZ relate to Kawasaki and those beginning with CBR to Honda. On this basis, I can only infer that the motorcycles sold with reference to the model numbers or names are likely to be third party branded motorcycles.

23. In relation to motor scooters, one of the advertisements in NJMC10 shows a scooter branded as a “Malaguti Fire Fox” and another in NJMC7 shows an “ECO-GLIDE” brand. In relation to spare parts, they are again referred to by third party manufacturer name (as in the invoice in NJMC2). The web pages in NJMC7 have a navigational button on the left hand side relating to salvage – this would appear to be a reference to the sale of spare parts taken from used motorcycles. The pages further detail that the spare parts are, again, from third party motorcycles such as Yamaha, Suzuki etc.

24. The evidence does show an example of the mark physically applied to a motorcycle (see exhibit MJM4), however, Mr Culton explains in his evidence that this is for promotional purposes by way of sponsorship of a race bike – this cannot, in my view, assist the registered proprietor in demonstrating trade mark use for motorcycles.

25. It is worth recalling what the essential function of a trade mark is in order to decide if the type of use the mark has been put to constitutes use as a trade mark in relation to the goods in question. In *The Gillette Company, Gillette Group Finland Oy v LA-Laboratories Ltd Oy* C-228/03 [2005] ETMR 67 it was stated at paragraph 26:

“In that context, the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, Case 102/77 *Hoffman-La Roche* [1978] ECR 1139, paragraph 7, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30, and *Arsenal Football Club*, paragraph 48).”

26. I also bear in mind what Jacob J stated in *Euromarket Designs Incorporated v Peters and Another* [2001] F.S.R 288.:

“57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods.” There is a list of what may *inter alia* be specified as infringement (Art.5(3), corresponding to s.10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Art. 10(2), equivalent to s.46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation W [to]” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel US shops to the UK in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

27. Taking these cases into account it seems to me that to qualify as use, the use must be of the nature so that the consumer will see the mark as a guarantee of the origin of the goods themselves (motorcycles, motor scooters and parts and fittings). If the mark is seen only as a guarantee of origin in relation to the business that is retailing the goods in question (as per the Boots example given in the *Euromarket* case) then this is unlikely to qualify. I acknowledge that it may be possible for a trade mark to perform both these guaranteeing functions, but this is a matter for the evidence.

28. The registered proprietor has not made any detailed submissions on the distinction between retailing and the goods being retailed. The applicant for revocation has made some reference to this, for example, in relation to the registered proprietor’s evidence at NJMC1 (consisting of the picture of the business premises), it is submitted that this is evidence of mere retailing and not use as a trade mark in relation to goods.

29. My view is that the use of the mark as shown in the evidence will only inform the consumer about the origin of the business that is bringing the motorcycles together for sale. The consumer is equally informed by the evidence that the actual goods are the economic origin of other manufactures – the goods are Suzuki, Yamaha and Honda etc. motorcycles and parts thereof. I can see no evidence where the motorcycles themselves carry anything other than third party branding (save for the sponsorship use which I have already commented on) and that this branding is what the consumer will take to be the sign of origin for the goods.

30. In view of the foregoing, I do not need to consider the genuineness, or otherwise, of the use because I conclude that the evidence does not show use in relation to the goods themselves. **The application for revocation, in so far as it relates to the goods in Class12, will therefore succeed.**

**Luggage, bags, handbags, holdalls, rucksacks, purses and wallets, clothing, footwear and headgear.**

31. The position may be different in relation to these goods as, from an initial assessment of the evidence, it does not so obviously relate to third party branded goods. However, I must of course analyse the evidence to see if genuine use has been made of the mark and if so, in relation to what. Before doing so, I must comment on some of the submissions made by the applicant for revocation. I am asked to disregard whole tranches of the evidence because the individual pieces do not demonstrate evidence of genuine use or that they have other inadequacies such as lack of date information. I do not intend to adopt this dismissive approach. In my view, it is necessary to have regard to all the available evidence and to decide if the evidence as a whole indicates whether genuine use has been made within the relevant periods. For example, whilst a proprietor can only rely on trade within the relevant periods to establish use, evidence of activity outside the periods may serve to shed light on the genuineness of what has been done within the periods (see to that effect *Laboratoire De La Mer Trade Marks* in the High Court, [2002] F.S.R. 51 at paragraph 35). It is therefore not appropriate to entirely discount or disregard such evidence. I will, however, take the applicant's submissions (and those of the registered proprietor) into account when deciding what can and cannot be inferred from the evidence.

32. It is clear from the evidence that some form of business has been operated under the mark. The signage on the business premises in NJMC1, the invoices depicting the mark in NJMC2, the web-prints at NJMC7, and at least some of the advertisements in NJM10, all feature the mark as registered. The genuineness of this business operation is supported by some of the other exhibits, for example the financial information provided in Mr Culton's witness statement. However, I must extrapolate from this information whether or not the mark has been used in relation to this second set of goods.

33. Exhibit NJMC1 does not help to answer this question relating, as it does, to the business premises and to the sale of motorcycles. However, NJMC2 and the invoices it contains, do at least refer to items of clothing. The applicant criticises this evidence on a number of fronts. Firstly because some of the invoices are not dated, secondly because they do not identify the products covered, and, thirdly that the goods may not have carried the mark.

34. In relation to the dates of these invoices, of the 14 that relate to items of clothing, I have been able to ascertain the dates on all but five. The dates range from April 2000 to October 2000 (a date range that is relevant to both periods of alleged non-use). Mr Culton has stated in his evidence that all of the invoices are from the date range 22 April 1999-October 2000. No challenge has been made to Mr Culton's evidence prior to receipt of the applicant's submissions, and whilst I cannot automatically take everything a witness has to say as fact, I am reluctant to disbelieve such evidence unless it appears incredulous (which it does not to me).

35. In relation to the products that relate to these invoices, they cover fleeces, shirts (including denim shirts), sweatshirts and jackets. Most cover a single item per invoice. The invoices for jackets carry the product code MA1 or MA2 rather than the word "Jacket" but evidence in NJMC7 demonstrates that these codes relate to jackets; Mr Culton also states as much in his witness statement. There is no suggestion in these invoices that the items of clothing are third party brands. Whilst this is not absolute proof that the mark is used as a trade mark in relation to these goods, the invoices do not point away from this proposition.

36. I also add that, in my view, it is not necessary for the actual goods themselves to physically carry the mark. If further evidence shows that the goods are either unbranded, or that they carry some alternative version of the mark, then use of the mark on the invoices could be taken as use in relation to the goods. The mark will, in this context, be taken as a guaranteeing sign of origin of the goods and not simply as a guaranteeing sign of origin of the business selling the goods.

37. Exhibits NJMC3 & NJMC4 relate to orders for screen printing and signage. The applicant observes that the mark is not actually depicted and, furthermore, it is not known on what goods the screen prints were used or what the signs were used for. Whilst I understand the point being made, this does not mean that the evidence should be disregarded altogether. The evidence at least corroborates the genuineness of the business being operated, and, in relation to NJM3, Mr Culton does state that the screen print will have been used in the production of clothing.

38. NJMC7 consist of web-pages from the registered proprietor's web-site. They have various dates between September 2001 and October 2003; the pages thus straddle both periods of alleged non-use. Most of the web pages provide details on the motorcycles available for purchase. However, I note that a large number of these pages have navigational buttons on the left hand side which read "Clothing" or "WC Clothing". It is reasonable to infer from the totality of the evidence that the reference to "WC Clothing" is a reference to "West Coast Clothing"; examples of this "WC Clothing" navigational button can be seen on prints dated in 2001, 2002 and October 2003 (all again from within the periods of alleged non-use). The use of this designation gives further support to the proposition that the clothing being sold is branded at least West Coast, as opposed to third party branding.

39. A web-page from 2 October 2003 shows various items for sale - "MA1" jackets, baseball caps, t-shirts, fleeces, hooded tops, hooded sweatshirts, belts and denim jackets. Unfortunately, only two of these items have images displayed (one for a baseball cap featuring the mark, the other is a jacket featuring the mark but with the added words "motor cycles"), the other items have blank spaces where images should appear. Other prints provide information on what could possibly be the sale of clothing - one of them (dated 3 April 2003) relates to unidentified products (the pictures are again missing) but can be purchased in different sizes. Another comes from 8 May 2003 with similar deficiencies save that one item is described in words as a denim jacket. All of these

feature the mark in the top left hand corner of the page, even if it is not possible to discern whether the mark was affixed to the goods.

40. Other web pages depicting clothing are present, but the clothing is of a more protective nature. However, these feature what seem to be the third party brand names “Craft” and “Arlen Ness”. Even though the mark may appear on the web page (again in the top left hand corner), this would not be taken to be use of the mark in relation to these products for similar reasons as I have expressed in relation to the Class 12 goods.

41. The submissions from the applicant highlight some of the deficiencies I have identified and additionally observes that in the depiction of the jacket, the mark has the additional words “motor cycles” appearing thereon. This is a claim that such use is use in a form differing in elements which alter its distinctive character as registered and consequently cannot be relied upon under the provisions of Section 47(2) of the Act; I will address this point in more detail later.

42. Also of relevance to the question of use are the contents of exhibit NJMC10. I have summarised the contents (where relevant to the Class 18 & 25 goods) below:

- A) Front page of issue 64 of *100% Biker* magazine and accompanying advertisement. The magazine is undated. The full page advertisement offers for sale various articles of clothing (t-shirts, jackets, caps, hoodies, fleeces) which depict the mark, albeit, where the mark is clearly depicted the word “motor cycles” forms part of it. The advertisement has the mark (again with the word “motor cycles”) on the top right hand corner of the page.
- B) Front page of issue 59 of *100% Biker* magazine and accompanying advertisement. The magazine is undated. The same advertisement as shown in issue 64 is included.
- C) Front page of the January 1997 issue of *Streetfighters* magazine and accompanying advertisement. The advertisement lists various items of clothing (jackets, sweats, t-shirts) for sale. The items are not depicted but various variations of the mark are (including its exact form). The customer is able to choose which form to put on the garments. The “standard” version of the mark (the exact form as registered) will appear on all jackets and t-shirts. The advertisement has the mark prominently displayed within it, albeit, together with what appears to be a telephone number.
- D) Front page of March 1997 issue of *Streetfighters* magazine. This features an editorial highlighting the clothing that West Coast Motorcycles are offering for sale which is referred to as the “Chaos Crew Clothing” range. One example is provided of a person wearing a jacket with the mark (together with the word “motor cycles”) appearing on it. Also featured is an advertisement similar in nature to the one in the January 1997 issue of *Streetfighters*.

E) Front page of Feb/Mar 1998 edition of *GreyBike* magazine and accompanying advertisement. The advertisement features various items of clothing for sale (t-shirts, jackets, jeans, sweatshirts, belts, denim shirts, hats). Some of the items have the mark on them, others have the mark with the word “motor cycles”. The advertisement is headed with the mark but, again, with the telephone number.

43. The extracts from 100%Biker (A & B above) are criticised by the applicant because they are undated. From further information provided in the evidence it is clear that this particular publication was established in 1999 and that 13 issues are published per annum. This places the specific issues somewhere between June 2003 and June 2004 for issue 59 and November 2003 and November 2004 for issue 64. Mr Culton’s witness statement does not give these dates any greater degree of accuracy. The advertisements therefore may or may not be from within the alleged periods of non-use. The extracts at C, D are criticised as they are from before the relevant period. Whilst the applicant is right to make these criticisms (they tell me little about what occurred during the relevant period) and whilst alone they would be unlikely to prove the registered proprietor’s case, they at least tell me something about the business that has occurred or has continued to occur, namely a business in the sale not of third party branded goods but of goods carrying or sold under the mark or some variant of it.

44. This leaves extract E, whilst the applicant concedes that this shows use on some goods, further observation is made that the date of this extract relates only to the period under section 46(1)(a) and not the period under section 46(1)(b). It is further submitted that some forms of use in this advertisement have the telephone number included or the word “motor cycles”. I shall deal with this point next:

**Should all the forms of use be taken into account under the provisions of Section 47(2).**

45. Section 47(2) provides that use for the purposes of Section 46(1) includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. The applicant submits that some forms of use shown in the evidence do not fall within this definition because the differences alter the distinctive character of the mark. The registered proprietor takes the opposite view on the basis that the differing elements are either descriptive or non-distinctive. For ease of reference, the various versions of the mark under discussion are replicated below:

The mark as registered:



With telephone number:



With “motor cycles”:



46. It is clear that all three versions of the mark are made up of an outline of a shield containing the words WEST COAST and a picture reminiscent of a skull and crossbones. However, the skull appears to be sporting a motorcycle helmet and the crossbones formed of what could be taken to be a part of a motorcycle (they are certainly not traditional crossbones). This is all the mark as registered consists of, whereas, one of the alternative versions has what would appear to be a telephone number beneath the crossbones and the other the words MOTOR CYCLES beneath them. Both these elements are less prominent than either the picture or the words WEST COAST.

47. In considering this issue I take into account the decision of the Court of Appeal in *Bud/Budweiser Budbrau* [2003] RPC 25. In particular, Lord Walker stated:

“43. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin’d choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse the ‘visual, aural and conceptual’ qualities of a mark and make a ‘global appreciation’ of its likely impact on the average consumer, who:

‘Normally perceives a mark as a whole and does not proceed to analyse its various details.’

The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

48. In the same case Sir Martin Nourse stated at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said

that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements.”

49. Having already identified the differences between the mark as registered and the other forms of use, the question is whether or not these differences alter the distinctive character of the mark as registered? In relation to the form of use with the telephone number, I am of the clear view that this difference does not alter the distinctive character of the mark as registered. The likely impact on the average consumer is that they will see the telephone number for what it is (or is likely to be), namely, the business telephone number of the undertaking providing the goods. This will be seen as a non-distinctive element of information. The distinctive character of the mark (what makes it striking and memorable) in this form still resides in the words WEST COAST and the skull and crossbones picture; the presence of the telephone number does not alter this. **The form of use with the telephone number will be taken into account.**

50. In relation to the form of use with the words “motor cycles”, I take the view that the likely impact on the average consumer is that the additional wording is simply descriptive. The words will be seen as describing that the business operating under the mark has a relationship to motorcycles or that the goods are targeted at customers who have an interest in motorcycles. This likely impact is supported by the fact that the words are smaller in the overall impression of the mark and would, therefore, be seen as a secondary merely descriptive element. The additional words will not be seen as contributing to the distinctive character of the mark in this form of use. What makes it striking and memorable are the words WEST COAST and the skull and crossbones picture; the additional wording does not alter this position. **The form of use with the words “motor cycles” will be taken into account.**

### **Genuine use**

51. Having analysed the evidence in relation to these goods and having considered the forms of use that may be taken into account, I must decide whether all this comes together to demonstrate that the mark has been put to genuine use during the relevant periods. The principles outlined in *Ansul BV v Ajax Brandbeveiliging BV* and *Laboratoire de la Mer Trade Mark* are borne in mind when I make this assessment.

52. Having considered the evidence as whole, I am prepared to accept that the invoices at NJMC2 constitutes, at the least, examples of use of the mark, and that this use covers both periods of alleged non-use. Although it is not clear from the invoices themselves whether the goods are third party branded products or not, other evidence such as the web pages in NJMC7 and the advertisements in NJMC10 clearly demonstrate the trade of West Coast clothing and such clothing is of a similar nature to that described in the invoices. This evidence also informs me that the goods are likely to have carried the mark

or the mark in a form which does not alter the distinctive character as registered. However, even if they did not carry the mark then the use of the mark on the invoices themselves, for what I have taken to be some form of West Coast clothing, would also count as use in relation to the goods. The mark in these circumstances (essentially “own brand goods”) will be seen by the consumer as indicating not only the retailer of the goods, but also as a sign of origin of the goods themselves.

53. The web-pages at NJMC7 also shows the mark in use for similar reasons as I have found in relation to the invoices. The web-pages show the mark as registered and the rest of the evidence informs that the products were likely to have been, at the least, West Coast clothing or, more likely, to have carried the mark (or the mark in a form not altering its distinctive character).

54. Use within the alleged periods of non-use can also be seen in relation to at least one of the advertisements in NJMC10 (I have referred to this above as extract E). Whilst the other advertisements cannot be accurately placed within the relevant periods (indeed extract E only relates to the period under Section 46(1)(a)), they at least show that the examples of use are not one-offs and that similar advertisements have been placed outside of the relevant periods.

55. I am content that the forms of use on the front of garments do more than merely promote the registered proprietor’s business and therefore such use does not suffer from the problems of mere promotional activity identified by Pumfrey J in *Daimler Chrysler v Alavi* [2001] RPC 42. I say this for a number of reasons. Firstly, that the manner of use demonstrated in the evidence supports the proposition that the clothing part of the business is an important and independent aspect of the business as a whole. Also, it is not uncommon for traders in the clothing field to place their trade marks on the front of the garments that they are selling.

56. In terms of the actual goods to which this use relates, there are a number of items shown in the invoices, the web-pages and/or the advertisements. The goods in question being: fleeces, shirts, sweatshirts, jackets, t-shirts, hooded tops, jeans, belts, caps and hats. Mr Culton states in his evidence that the mark has also been used on bags and in exhibit NJMC5 he refers to a photograph that is said to be a bag with the mark appearing thereon. However, it is not possible to tell whether this is a bag or not or, if it is a bag, what sort of bag it is. None of the invoices, web-pages or advertisements shows bags. The position is clearly weaker here.

57. The applicant has observed that no sales figures have been provided to demonstrate whether the use (if there is any) is sufficient to have established or to have maintained a share in the market. Whilst this information would have been helpful, its absence does not deal a fatal blow to the registered proprietor’s case. The financial figures provided in Mr Culton’s evidence demonstrate the operation of a business of a reasonable size. Even if the sale of the goods under consideration is secondary to the sale of motorcycles, it still strikes me as an important aspect of the business given the type of advertising that has taken place and also the presence of the sale of these goods on the businesses’ web-sites.

Whilst I cannot say that the use equates to a significant market share, this is not, however, the test. The nature of the use supports the proposition that it is more than token use of the mark and therefore it must qualify as genuine use for the purpose of these proceedings at least in relation to the items of clothing identified in the preceding paragraph.

58. The position is different in relation to bags as the pattern of use is not built up in the evidence as a whole. Before concluding, it is also worth noting that I would have likely come to the same conclusion even if the different forms of use (with the words “motor cycles” or the telephone number) could not have been taken into account under the provision of Section 47(2) given the clear use of the mark in relation to the goods (even if not upon them) in the invoices and web-pages (and some examples of use in the advertisement). **In summary, I find that genuine use of the mark has been made in relation to fleeces, shirts, sweatshirts, jackets, t-shirts, hooded tops, jeans, belts, caps and hats.**

#### **A fair specification**

59. This is not the end of it. Having concluded that there is genuine use, I must assess what would be a fair specification for the use shown. In determining this, I take into account the helpful guidance provided in a number of cases. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 Aldous LJ stated at paragraph 31:

“Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

60. In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the CFI stated:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

.....

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

61. In *Animal Trade Mark* [2004] FSR 19 Jacob J held:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

62. The cumulative approach I have adopted has found genuine use in relation to a range of goods in Class 25, namely fleeces, shirts, sweatshirts, jackets, t-shirts, hooded tops, jeans, belts, caps and hats. All are items of outerwear (including hats and caps), and from the evidence all are casual (as opposed to formal) in nature. This latter point is also reflected in the specification as registered which is limited to items of clothing being for leisure wear. Taking these factors into account, I consider that a fair description of the goods, that is neither pedantic nor overly broad, would be:

*“Casual outer clothing, hats, caps and belts; all for leisure wear”*

## **Conclusion**

63. In view of the above, I find that there has been genuine use of the trade mark within the periods of alleged non-use, but only in relation to:

Class 25 - *Casual outer clothing, hats, caps and belts; all for leisure wear*

64. The remainder of the specification in Class 25, and the whole of the specifications in Classes 12 and 18, is hereby revoked under the provisions of Section 46(6)(b) of the Act with effect from 29 November 2002.

## **COSTS**

65. Both sides have won and lost certain aspects of their case. In the circumstances, I do not intend to award costs to either party.

**Dated this 19<sup>th</sup> day of February 2008**

**Oliver Morris  
For the Registrar  
The Comptroller-General**