

**O-315-16**

**TRADE MARKS ACT 1994**

**APPLICATION No. 3092191 BY COTTON WORLD (INTERNATIONAL) LTD**

**TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**OPPOSITION No. 404488 BY TEMPTING BRANDS AG**

**AND**

**TRADE MARK REGISTRATION 2446862 IN THE NAME OF TEMPTING BRANDS  
AG**

**AND**

**APPLICATION No. 500820 BY COTTON WORLD (INTERNATIONAL) LTD**

**TO REVOKE THE TRADE MARK FOR NON-USE**

## Background and pleadings

1. On 2<sup>nd</sup> February 2015, Cotton World (International) Ltd (“Cotton World”) applied to register the trade mark shown below in relation to clothing in class 25.



2. The application was published in the Trade Marks Journal on 10<sup>th</sup> April 2015.

3. The application is opposed by Tempting Brands AG, (“Tempting”) which is the owner or holder of four earlier trade marks protected in the UK, or EU, in class 25. Two of these marks, International registrations 931710 and 1155918, are for the word and numeral **ROUTE 66**. The other two marks, UK registration 2446862 and International registration 1155917, are for the figurative mark shown below.



4. All of Tempting’s marks are registered or protected for clothing, footwear and headgear in class 25.

5. The grounds of opposition are based on s.5(2)(b) and s.3(6) of the Trade Marks Act 1994 (“the Act”). Essentially, Tempting claims that Cotton World’s mark is highly similar to its earlier marks, is proposed to be registered for identical goods, and there is therefore a likelihood of confusion on the part of the public. Additionally, Tempting claims that before making the application, Cotton World approached it for a licence and only filed the trade mark application after Tempting declined to provide one. Therefore, Cotton World was aware of Tempting’s trade mark rights when it applied to register a very similar mark. According to Tempting, this means that the application was filed in bad faith.

6. Cotton World filed a counterstatement denying the grounds of opposition. I note the following points:

- It is claimed that the original Route 66 device (as shown in paragraph 3 above) was created by the American Highways Agency in 1926 and used as a road sign to denote a particular highway in the USA.
- It is claimed that Cotton World's mark (as shown in paragraph 1 above) was created by the American Highways Agency in 1985 and was thereafter used instead of the original Route 66 device.
- Cotton World says that both signs are in the public domain in the USA and there has been no public confusion between them.
- It is claimed that Cotton World has sold goods in class 25 under both signs for 25 years.
- Cotton World required proof of use of Tempting's earlier marks.
- There is no denial of Tempting's claim that the parties had pre-contractual negotiations about Cotton World obtaining a licence to use Route 66 prior to the filing of the contested trade mark application.

7. In addition, Cotton World applied on 7<sup>th</sup> April 2015 for Tempting's UK registration 2446862 to be revoked under s.46 of the Act for "*Class 25, namely, clothing*" because of non-use.

8. Tempting filed a counterstatement denying that UK 2446862 was liable to revocation for lack of genuine use.

9. The proceedings were consolidated.

## **Evidence**

10. Tempting's evidence consists of two witness statements by Dr Johan Lanen, who is the Managing Director of Tempting. It is convenient to start with Dr Lanen's second statement.

11. Dr Lanen's evidence is that Tempting was approached by Cotton World on 9<sup>th</sup> September 2014 when it received an email from Mr Gary Holley<sup>1</sup>. The email said that Cotton World "*would like to become involved with selling your Route 66 licensed clothing here in the UK*".

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<sup>1</sup> See exhibit DJL2

12. There then followed email exchanges, telephone conversations and a meeting between representatives of the parties<sup>2</sup>. This led to a draft licence agreement, but on 21<sup>st</sup> January 2015 Tempting told Cotton World that, for commercial reasons, it no longer intended to grant it a licence<sup>3</sup>.

13. Cotton World filed a statement dated 14<sup>th</sup> September 2015 by Mr Gary Holley, who describes himself as the owner of Cotton World. According to Mr Holley, the contested trade mark application was initially objected to by the IPO's examiner on the grounds that 'Historic Route 66' was devoid of any distinctive character for clothing. This was because clothing is often adorned with the names of famous places or destinations. Therefore, the name at issue would be seen as a reference to the famous North American Highway, and was "*origin neutral*" in trade mark terms. Mr Holley states that "*it is equally clear and obvious that the [the examiner's] comments are equally relevant to Route 66...*".

14. Cotton World did not accept the examiner's rejection of the application. Instead Mr Holley attended an *ex parte* hearing in March 2015 where he succeeded in persuading the Hearing Officer that the contested mark was capable of distinguishing the goods of one undertaking. Despite this, Mr Holley now claims that the examiner was right and that the mark is non-distinctive for clothing. He cites two USA legal cases in which US courts refused protection for highway names, in the one case as a trade mark, and in the other as a design, on the grounds that the signs were in the public domain<sup>4</sup>.

15. Mr Holley also asserts that he and his company have used the Route 66 shield design for over 25 years in relation to class 25 goods. However, there is no particularisation of this claim in terms of the number of goods sold under the sign, where, when, or to whom, they were sold, and no documentary evidence supporting the claim or illustrating how the Route 66 shield device was used.

## **The hearing**

16. A hearing took place on 18<sup>th</sup> May 2016, with Tempting represented by Mr Sanjay Kapur of Potter Clarkson LLP. Cotton World was not represented, but I received written submissions in lieu from Mr Holley.

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<sup>2</sup> See exhibits DJL3-28

<sup>3</sup> See exhibit DJL29

<sup>4</sup> The design case is *Dastar Corp. v Twentieth Century Fox Film Corp.* The trade mark cases is not identified, but a quotation from the Attorney General of Michigan is provided, perhaps suggesting that this was a matter of State law.

## Proof of use and validity of earlier marks

17. Only UK registration 2446862 had been registered or protected in the EU or UK for 5 years or more at the date of publication of the contested trade mark.

Consequently, Tempting's other three earlier marks are not subject to proof of use under s.6A of the Act. Therefore, for the purposes of my assessment of the s.5(2)(b) ground of opposition, it is necessary to consider these earlier marks to have been used in relation to all the goods/services covered by the registered specifications in class 25 (or at least those goods which Tempting relies upon). As Kitchen L.J. stated in *Roger Maier and Another v ASOS*<sup>5</sup>:

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the [applicant's] use is such as to give rise to a likelihood of confusion.” (emphasis added)

18. The justification for this legal fiction is as follows. A trade mark registration is essentially a piece of legal property, i.e. the registered trade mark itself. Although the rights that flow from registration may depend on use of the mark to sustain them, the act of registration itself creates a legal right to the exclusive use of the mark in relation to the goods and services for which it is registered. Every registered mark is therefore entitled to legal protection against the later use or registration by third parties of the same or similar trade mark for the same or similar goods/services, if there is a likelihood of confusion when the marks are used normally and fairly.

19. Section 72 of the Act and article 99 of Community Trade Mark Regulation 207/2009 state that registration shall be *prima facie* evidence of validity.

Consequently, in the absence of applications to invalidate Tempting's earlier marks, they must be treated as valid. It follows that I must reject the argument made by Mr Holley on behalf of Cotton World, which is essentially that Tempting's marks, and indeed his company's own mark, are non-distinctive and therefore not entitled to protection. I note in passing that this argument is also inconsistent with Cotton World's stance in these proceedings, which appears to be that its mark should be registered. If the contested mark is non-distinctive, as Cotton World appears to contend, then it should be refused or withdrawn.

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<sup>5</sup> [2015] EWCA Civ 220

20. Taking the above observations into account, it is sufficient to assess Tempting's opposition based purely on earlier International registration 1155917, which is not subject to proof of use. This is the same trade mark as registered under UK 2446862. Consequently, for the purposes of Tempting's opposition to Cotton World's application, there is no point in considering whether Tempting has shown genuine use of the UK mark. I will, however, return to that question below in the context of Cotton World's application to revoke the UK mark for non-use.

### **Section 5(2)(b)**

21. Section 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

### Case law

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods and services

22. The goods covered by the contested mark are clothing. Tempting's International registration is protected in the EU for clothing. Therefore the goods are self-evidently identical.

### Comparison of marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>6</sup>, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

25. From a visual perspective, both marks are dominated by the word and numeral ROUTE 66. The devices of similar shields play a secondary role, but contribute significantly to the overall visual impression created by the marks. I recognise that there are differences between the shields, and in the positioning of the word ROUTE (above the line in the earlier mark, below the line in the contested mark). However, in the context of the marks as wholes, these differences are points of detail which will make only a negligible contribution towards the overall visual impressions created by the marks. I accept that the additional word ‘HISTORIC’ at the top and bottom of the contested mark makes a more-than-negligible contribution towards the impression created by that mark. Nevertheless, the impact of the visual similarities between the marks far outweigh the impact of the differences between them. I find that the marks are highly similar from a visual perspective.

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<sup>6</sup> Case C-591/12P

26. The earlier mark is likely to be verbalised as 'ROUTE 66'. The contested mark as 'HISTORIC ROUTE 66'. I find that there is a medium degree of similarity between the aural impressions created by the marks.

27. Conceptually, both marks strongly call to mind the famous US highway known as Route 66. The addition of the word 'historic' may have some specific significance in the USA, but to UK consumers it is likely to be seen as merely confirming the 'historic' nature of Route 66 rather than having any conceptually distinct meaning. I find that the marks are conceptually identical.

#### Average consumer and the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

29. I find that consumers of clothing are likely to pay an average degree of attention when selecting the goods. The goods are likely to be selected primarily by visual means through inspection of websites, brochures and retail displays. However, word of mouth recommendations and oral orders may also play some part in the selection process, so the level of aural similarity is also relevant, albeit to a lesser degree than the level of visual similarity.

#### Distinctive character of the earlier trade mark

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>7</sup>, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant

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<sup>7</sup> Case C-342/97

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31. ROUTE 66 is not descriptive of clothing or any characteristic of clothing. Further, the shield device in the earlier mark is also distinctive as a trade mark for clothing. Cotton World makes two points in this regard. Firstly, that Tempting did not create the composite mark. Secondly, that it could appear as decorative when used on clothing.

32. The first point is misconceived. Unlike some other forms of intellectual property, such as designs, there is no requirement for a sign to be new before it can be used and registered as a trade mark. There are plenty of well known marks, such VIRGIN and SKY, which were not newly created when registered.

33. The second point is potentially relevant, but there is no evidence that consumers will see the contested mark as decorative. If used as a trade mark (which is how Tempting’s evidence shows ROUTE 66 being used) I see no reason why the composite mark should be afforded less than a normal level of distinctiveness.

#### Likelihood of Confusion

34. Cotton World argues that as the public in the USA have been able to distinguish between the marks when used as road signs, then there can be no likelihood of confusion amongst the public in the UK.

35. The logic of this submission is obviously flawed. Firstly, the marks will be used as trade marks for clothing in the UK, not as road signs. Secondly, the UK public are unlikely to be as familiar with US road signs as the US public. So experience in the USA would not be a good guide as to the likelihood of confusion amongst the UK public, even if the use of the signs in the USA was in a relevant context. In any event, there is no evidence to support Mr Holley’s assertion of use in the USA without confusion (even as road signs). Further still, his evidence indicates that the signs were used sequentially, not concurrently, as road signs in the USA. If so, the previous use of the signs in the USA is different in this respect too, compared to the proposed concurrent use of the parties’ trade marks in the UK.

36. I pause at this point to note that, beyond Mr Holley’s bare assertion, there is no evidence that Cotton World has used the mark applied for as a trade mark (or at all). And as Mr Kapur pointed out at the hearing, the contents of the email sent by Mr Holley to Tempting in September 2014 spoke of a desire to start using Tempting’s mark(s) not of an established trade under such a mark. In any event, as no application has been made to invalidate the earlier marks because of any prior rights

held by Cotton World or Mr Holley, the argument based on Cotton World's supposed prior use of ROUTE 66 is irrelevant.

37. I return then to the relevant facts. The marks are highly similar to the eye, aurally similar to a medium degree, and conceptually identical. The respective goods are identical. The most visually dominant and distinctive part of the earlier mark (ROUTE 66) is common to the contested mark. Both marks also contain a similar shield device. Average consumers are likely to pay an average degree of attention when selecting the goods. Taking these and all other relevant factors into account, I have no hesitation in finding that there is a likelihood of confusion. Unusually in this case, this could even occur where consumers have both marks before them, but it is even more likely to occur when, as is more usual, the consumer has one mark before him or her and has to rely on an imperfect picture of the other mark that he or she has kept in his or her mind.

38. The s.5(2)(b) ground therefore succeeds in full. For the record, I would have reached the same finding even if I had found that the earlier mark had a below average degree of distinctive character, as Cotton World contends.

Bad faith

39. The outcome of the opposition under s.5(2) is very clear cut in this case. In these circumstances I see little point in considering the further ground of opposition under s.3(6). Therefore, despite the apparent strength of the s.3(6) ground, I decline to make a finding on it.

Partial revocation of UK 2446862

40. Section 46 of the Act states that:

“(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).....

(d).....

(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 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.”

41. Cotton World asks for the UK 2446862 mark to be revoked with effect from 1<sup>st</sup> March 2013 in respect of “*Class 25, namely, clothing*”. The mark at issue completed the registration procedure on 29<sup>th</sup> February 2008. Therefore, the relevant 5 year period is 1<sup>st</sup> March 2008 to 28<sup>th</sup> February 2013. However, under s.46(3) of the Act genuine use of the mark occurring after the end of the relevant period, but before the filing of the application for revocation (7<sup>th</sup> April 2015), may also be taken into account.

## Case law

42. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*<sup>8</sup>, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of

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<sup>8</sup> [2016] EWHC 52

the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

43. Dr Lanen’s first witness statement sets out the use claimed of the UK 2446862 mark. According to Dr Lanen, the mark was used by Debenhams, with Tempting’s consent, in 2013 and 2014. Dr Lanen exhibits a witness statement by Shani Delargy of Debenhams Retail plc. This states that ROUTE 66 was used by Debenhams between July 2013 and August 2014 pursuant to a licence from Tempting<sup>9</sup>.

44. Shani Delargy says that the mark was used in relation to T-shirts, sweatshirts and hooded sweatshirts. Around £52k worth of goods were sold under the mark during this period. Sales were made online as well as through Debenhams’ retail stores.

45. Dr Lanen exhibits various print outs from Debenham’s website showing use of ROUTE 66 as a trade mark for the goods mentioned in the previous paragraph<sup>10</sup>. Some of these pages postdate the application for revocation, but most predate it. The earliest page is dated 17<sup>th</sup> November 2014. Dr Lanen also exhibits an article taken from a website called [intheplayroom.co.uk](http://intheplayroom.co.uk)<sup>11</sup>. The article is dated October 2013 and it mentions a Route 66 boys t-shirt that was available at Debenhams.

46. Exhibit JL4 to Dr Lanen’s statement consists of more extracts from various websites which he says shows licensed use of the ROUTE 66 mark “*in relation to a range of goods throughout the EU*”. These are dated December 2014. A few of them show use of the ROUTE 66 shield device registered under UK 2446862, but none of the use appears to be in the UK.

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<sup>9</sup> See exhibit JL1

<sup>10</sup> See exhibit JL2

<sup>11</sup> See exhibit JL3

47. Dr Lanen provides further information about the ROUTE 66 mark<sup>12</sup>, but nothing which shows any use of the 2446862 mark in the UK.

48. Cotton World called into question the veracity of the evidence of use of ROUTE 66 shown by Debenhams. However, it had no proper reasons for doing so. I accept that Debenhams used ROUTE 66 in 2013 and 2014, as claimed. Although the use is relatively modest in extent, particularly when measured against the size of the clothing market, I see nothing token about it. In my view, the use was warranted in the economic sector concerned to create a market for the goods in the UK under the mark ROUTE 66. It was therefore genuine use of ROUTE 66 as a trade mark. However, it was not genuine use of the 2446862 mark because the shield device is absent from the mark used by Debenhams. Mr Kapur drew my attention to an instance of use of a shield device on a t-shirt sold by Debenhams<sup>13</sup>. However, this shield device bore the word and numeral 'US 66', not ROUTE 66. Consequently, this was not use of the UK 2446862 mark either.

49. I must therefore consider whether use of ROUTE 66 constitutes use of the composite mark registered under UK 2446862 by virtue of s.46(3). I note that the case law in *Colloseum Holdings AG v Levi Strauss & Co.*<sup>14</sup> does not apply because that case concerned the use of [the whole of] a mark as part of another mark, whereas this case concerns use of only part of a registered mark. In *Nirvana Trade Mark*<sup>15</sup>, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

50. I do not consider that the presence or absence of the shield device affects the distinctive character of the UK 2446862 mark from an aural or conceptual perspective. Further, when comparing Tempting's composite mark for the purpose of

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<sup>12</sup> See exhibits JL5 and JL6

<sup>13</sup> See exhibit JL2, page 6

<sup>14</sup> CJEU, Case C-12/12

<sup>15</sup> BL O/262/06

comparing it with Cotton World's mark, I noted that, from a visual perspective, both marks are dominated by the word and numeral ROUTE 66. However, I also noted that the device of a shield plays a secondary role which contributes significantly to the overall visual impression created by the composite mark. Therefore, although the word and numeral ROUTE 66 is the most dominant element of UK 2446862, this is not the only distinctive element of the composite mark. Tempting appears to rely on the use of similar shield devices as part of its case for saying that its composite mark is highly similar to Cotton World's mark. And I have no doubt that if Cotton World's mark had included a different word or numeral, such as (say) 'US 66', Tempting would have relied even more on the use of similar distinctive shield devices as a material factor in the assessment of the likelihood of confusion. In my judgment, the omission of the distinctive shield device from the ROUTE 66 mark used by Debenhams alters the distinctive character of the used mark compared to that of the composite mark registered under UK 2446862. Therefore the use does not count as use of the registered mark.

51. There is no other evidence of use in the UK of the mark registered under 2446862. Consequently, I find that no use of that mark has been shown and the application for revocation under s.46(1)(a) succeeds accordingly.

52. In case I am wrong about that, I will briefly consider what an appropriate specification would have been if I had found that the use of ROUTE 66 by Debenhams counted as use of the 2446862 mark. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*<sup>16</sup>, Mr Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

53. Mr Kapur submitted that the use shown was sufficient to justify the retention of a specification of 'clothing' at large. Alternatively, he submitted that the following specification was appropriate:

Outerwear; underwear; leisurewear; casualwear; shirts, T-shirts, sweatshirts, hooded sweatshirts, jerseys.

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<sup>16</sup> BL O/345/10. I believe that this is consistent with the later judgment of the Court of Appeal in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, per Kitchen L.J. at paragraphs 63 – 65 (with whom Underhill L.J. agreed)

54. The inclusion of 'underwear' was justified on the basis that T-shirts may be worn as underwear.

55. In my view, the goods for which use has been shown are much too limited to justify retention of the broad categories of clothing, or outerwear and underwear. The same applies, albeit to a lesser degree, to leisurewear and casualwear. I also have some doubts as to whether these terms are sufficiently precise to form the basis of part of a trade mark registration. No use of the mark has been shown for 'jerseys'. The fact that jerseys are similar to sweatshirts does not justify retaining jerseys. I therefore find that an appropriate specification in lieu of "*clothing*" would have been:

Shirts, T-shirts, sweatshirts, hooded sweatshirts.

56. However, in the light of my primary findings, the 2446862 mark must be revoked for non-use to the extent that it is registered for "clothing". The mark will remain registered for the goods and services which were not covered by the application for revocation; namely, the registered goods and services in classes 3, 21, 22, 24, 28, 29, 33 and 38, and also 'footwear and headgear' in class 25.

#### Date of partial revocation

57. Cotton World asked for revocation with effect from 1<sup>st</sup> March 2013. I see no reason to do anything different, so the registration will be partially revoked from this date.

#### Costs

58. Neither party asked for costs to be assessed on anything other than the Registrar's published scale.

59. The opposition and the application for revocation have succeeded. Both parties have therefore had a measure of success. However, the opposition was the main issue between the parties and most of the evidence and arguments were directed accordingly. Therefore, I find that Cotton World should make a contribution towards Tempting's costs. This should be reduced to take account of the fact that Cotton World was successful in the revocation proceedings.

60. I order Cotton World (International) Ltd to pay Tempting Brands AG the sum of £750. This should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the end of the appeal proceedings.

**Dated this 30th day of June 2016**

**Allan James  
For the Registrar**