

O/535/19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3235873 BY
WOODSTOCK ROOTS, LLC
TO REGISTER:**

WOODSTOCK

AS A TRADE MARK IN CLASSES 3, 5 AND 34

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 410819 BY
WOODSTOCK VENTURES LC**

Background and pleadings

1. Woodstock Roots, LLC (“the applicant”) applied to register **WOODSTOCK** as a trade mark in the United Kingdom on 7 June 2017. It was accepted and published in the Trade Marks Journal on 18 August 2017 in respect of the following goods:

Class 3

Essential oils; terpenes.

Class 5


Herbs for medicinal purposes; plants or plant extracts for medical purposes; essential oils for medical purposes; terpenes for medical purposes; tobacco free cigarettes for medical purposes.


Class 34

Smoking accessories, namely vaporizer pens, vaporizers, vaporizer cartridges, pipes, water pipes, rolling papers, grinders, rollers, weighing scales, electronic cigarettes, lighters, storage containers, security containers.

2. The application was opposed by Woodstock Ventures LC (“the opponent”). The opposition is based upon sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition concerns all the goods listed in the application.
3. With regards to its claim based upon section 5(3) of the Act, the opponent is relying upon the following EU (formerly Community) Trade Marks:

Mark	Goods and Services Relied Upon
EUTM 13860408 (“the 408 mark”) WOODSTOCK Application date: 20 March 2015 Registration date: 7 August 2015	<u>Class 30</u> <i>Cookies; desserts; bakery goods.</i>

Mark	Goods and Services Relied Upon
<p data-bbox="263 253 655 282">EUTM 1037233 ("the 233 mark")</p>  <p data-bbox="263 651 703 723">Colours claimed: Blue, green, yellow, red.</p> <p data-bbox="263 741 655 770">Application date: 7 January 1999</p> <p data-bbox="263 788 671 817">Registration date: 16 August 2000</p>	<p data-bbox="774 253 884 282"><u>Class 14</u></p> <p data-bbox="774 300 1390 465"><i>Precious metals and their alloys and goods or precious metals or coated therewith (included in class 14); jewellery; precious stones; horological and chronometric instruments.</i></p> <p data-bbox="774 528 884 557"><u>Class 15</u></p> <p data-bbox="774 575 1018 604"><i>Musical instruments.</i></p> <p data-bbox="774 667 884 696"><u>Class 16</u></p> <p data-bbox="774 714 1390 1061"><i>Paper, cardboard and goods made from these materials (included in class 16), namely hand towels of paper, napkins of paper, handkerchiefs of paper, toilet paper, writing paper, packaging containers, magazines, pamphlets, programmes; calendars, books, posters, tickets, postcards, office requisites, playing cards; plastic materials for packaging (included in class 16); paint brushes; printing blocks.</i></p> <p data-bbox="774 1124 884 1153"><u>Class 18</u></p> <p data-bbox="774 1171 1390 1337"><i>Leather and imitations of leather, and goods made of these materials (included in class 18); trunks and travelling bags; umbrellas, parasols and walking sticks.</i></p> <p data-bbox="774 1400 884 1429"><u>Class 25</u></p> <p data-bbox="774 1447 1390 1612"><i>Clothing, including sportwear and leisurewear; footwear, boots; stockings, tights, socks; headgear, including headbands and sweatbands; belts and braces.</i></p> <p data-bbox="774 1675 884 1704"><u>Class 28</u></p> <p data-bbox="774 1722 1050 1751"><i>Games and playthings.</i></p> <p data-bbox="774 1814 884 1843"><u>Class 32</u></p> <p data-bbox="774 1861 1390 1980"><i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juice; syrups and other preparations for making beverages.</i></p>

Mark	Goods and Services Relied Upon
	<p><u>Class 41</u> <i>Arranging video and television shows; film, audio, video and television production; development and design of digital sound and image carriers; musical performances, publication of text, graphics, image and sound data which can be transmitted electrically and which is accessible via data networks; publishing printed matter; conducting of concerts, theatre and entertainment events, concerts, conferences, seminars, classes, symposiums, exhibitions and lectures, arranging sporting competitions.</i></p>
<p>EUTM 3927373 ("the 373 mark")</p>  <p>Application date: 9 July 2004 Registration date: 9 March 2006</p>	<p><u>Class 25</u> <i>Clothing, footwear, headgear.</i></p> <p><u>Class 29</u> <i>Prepared or pre-cooked ready-to-eat preparations (vegetable-based and/or meat-based and/or fish-based); vegetable salads; soups.</i></p> <p><u>Class 30</u> <i>Preparations made from cereals, bread, pastry, yeast and baking-powder; precooked cereals, couscous (semolina), pasta, ravioli, precooked ready-to-eat preparations (pasta-based), pizzas, meat pies, tarts, pies; confectionery, edible ices.</i></p>

- The opponent claims that the applicant's mark is identical to its 408 mark and similar to the remaining earlier marks. It claims further that it has acquired a reputation in these earlier marks in respect of the goods and services for which they stand registered and that use without due cause of the applicant's mark for all the goods of the application would take unfair advantage of the reputation of the earlier marks and/or cause detriment to the distinctive character or repute of those marks. Therefore, registration of the contested mark should be refused under section 5(3) of the Act.

5. Further or alternatively, the opponent claims that its 408 mark is a famous mark under Article 6bis of the Paris Convention and that it has acquired goodwill and a reputation in this mark in member states of the European Union, including the UK.
6. It also claims that registration of the contested mark should be refused under section 5(4)(a) because use of the applicant's mark for all the goods of the application is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign **WOODSTOCK**, which it claims to have used throughout the UK since 1969, in respect of all the goods and services for which the marks relied upon are protected, and the following goods and services:

Video recordings, audio recordings, and promotional merchandise including posters, tapestries, notebooks, glassware, mugs, stickers, magnets, bags, toys, writing instruments, clothing, aprons, belts, jewellery, leather goods, mobile phone covers and other promotional goods, and entertainment services including the organisation and staging of music and art festivals.

7. The applicant filed a defence and counterstatement, denying all the grounds. It also requested that the opponent provide evidence of proof of use of the 233 and 373 marks.
8. The opponent filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.
9. The opponent and applicant also filed written submissions on 19 December 2018 and 18 February 2019 respectively. These will not be summarised but will be referred to as and where appropriate during this decision.
10. A Hearing took place on 28 June 2019, with the opponent represented by Angela Fox and Mark Webster of Maucher Jenkins and the applicant by Paul Sweeden of Locke Lord (UK) LLP.

Preliminary issues

Evidence

11. Along with its skeleton argument, the opponent submitted a brief from a dispute between the same parties in the US District Court for the Southern District of New York.¹ Those proceedings are cross-actions based on trade mark infringement and false designation of origin under federal, state and common law. The brief was filed at the US court on 27 February 2019. The opponent submitted that it contained facts that were material to the present proceedings and had not been able to submit it earlier as they had only recently been made aware of its existence.

12. I admitted the document to the proceedings and, in view of its length, gave the applicant fourteen days to file any comments on it, that is by 12 July 2019. The applicant's comments were received on 15 July 2019. The opponent submitted that they should not be admitted to the proceedings, as they were late, and the applicant responded that it had misunderstood the deadline and believed it had been four weeks, rather than fourteen days. As the comments were late by only one working day and I considered their admittance not to be prejudicial to the interests of the opponent, I admitted the applicant's comments. In the interests of not unduly prolonging these proceedings, I did not admit the opponent's further comments, which in any case repeated submissions that it had already made.

Article 6bis of the Paris Convention

13. The applicant made the following submission in its skeleton argument:

“We also note that the Opponent attempts to rely on Section 56 of the Act/Article 6bis within its written submissions. However, the Opponent did not tick the box labeled [sic] ‘Section E’ in its TM7, which corresponds to Section 56 of the Act. As such, as a procedural point the Opponent should not be able to rely on this ground.”²

¹ Case No. 18-cv-01840 (RWS).

² Paragraph 19.

At the hearing, the opponent confirmed that it was not seeking to rely on that ground.

Evidence

14. The opponent's evidence comes from Mr Doug Roberts, Managing Member at Woodstock Ventures LC, a position he has held since 2012. His witness statement is dated 19 December 2018.
15. The opponent is the organiser and rights holder of the Woodstock Music & Art Fair, which took place in upstate New York in August 1969, and of a series of WOODSTOCK-branded music festivals that took place since then, including in 1994 and 1999. Performers at the 1969 festival included musicians Mr Roberts describes as "some of the most famous ... of the 1960s and '70s", such as Jimi Hendrix, The Who, Crosby Stills Nash and Young, Santana, and Joe Cocker.³ The opponent has provided a large volume of evidence on the place of the Woodstock music festival in the 1960s counterculture. In particular, the festival was strongly associated with the recreational use of cannabis. Much of the evidence is directed towards demonstrating this link.
16. Mr Roberts explains that the opponent sells goods through its own website (Woodstock General Store)⁴ and licenses its rights to third parties.⁵ Among its licensing deals is an agreement with cannabis firm MedMen

"granting MedMen rights to use the Earlier Marks on cannabis products manufactured and sold in six U.S. states; California, Nevada, Massachusetts, Florida, Illinois and Arizona."⁶

17. The additional evidence adduced by the opponent gives information on proceedings between the parties in the US courts and is directed towards showing

³ Paragraph 3.

⁴ Exhibits DR2 and DR3.

⁵ Exhibits DR4-DR6.

⁶ Paragraph 18.

that consumers (admittedly in the US) make a connection between Woodstock and cannabis use, and that the applicant is attempting to ride on the coat tails of the opponent's reputation and trade on its goodwill.

18. I shall conclude my summary here, but will return to the evidence in more detail later in my decision, where appropriate.

Proof of Use

19. At the hearing, the opponent said that it was now seeking to rely only on the 408 mark and the 233 mark, the latter in respect of the following goods and services:

Class 16

Journals, posters, books, calendars

Class 18

Leather and imitations of leather and goods made of these materials; travelling bags.

Class 25

Clothing and headgear.

Class 41

Film, audio, video and television production.

The 408 mark had been registered for less than five years on the date on which the contested application was published and is therefore not subject to the proof of use provisions under section 6A of the Act. The 233 mark was registered more than five years before this date, and so the proof of use provisions apply.

20. Section 6A of the Act states that:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) 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

(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

21. The opponent states that it has made genuine use in the EU, including the UK, in the relevant period of the 233 mark in relation to the goods and services listed in paragraph 19. The relevant period is the five years prior to and ending on the date of publication of the contested application: 19 August 2012 to 18 August 2017.
22. The case law on genuine use was summarised by Arnold J in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (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] and [22]. 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]; *Reber* at [29].
- (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 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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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 [132].”

23. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“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.”

24. The applicant submits that the opponent has not shown that it has used the 233 mark in connection with the goods upon which it seeks to rely. It notes that these goods are what it terms “mass-produced products” and that any sales that have been shown are commercially insignificant in the context of the relevant markets and that, furthermore, a large part of the evidence is US-facing. The applicant also draws attention to the absence of internal paperwork such as invoices. The opponent, in its skeleton argument, responds that the unavailability of invoices did not indicate that sales were not made.

25. The 233 mark is an EUTM, so the relevant territory in which use must be shown is the EU. Depending on the facts of the case, it is possible that use in one Member State may qualify as use within the territory of the EU: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 50. The opponent submits that the UK is the most significant EU market for goods and services associated with an English-language music festival.
26. Exhibit DR2 contains a series of print-outs from the opponent's online store. The prices of the goods are in US dollars, although Mr Roberts states that goods are also shipped to the UK. In *Pammer v Reederei Karl Schlüter GmbH & Co KG and Hotel Alpenhof GesmbH v Heller*, Joined Cases C-585/08 and C-144/09, the Court of Justice of the European Union (CJEU) considered the basis on which an internet trader can be said to be "directing" its activity to a particular Member State. The principles set out in this and subsequent case law were conveniently summarised by Kitchen LJ in *Merck KGaA v Merck Sharp & Dohme Corp & Others* [2017] EWCA Civ 1834:

"167. First, in determining whether an advertisement of goods bearing a trade mark on the website of a foreign trader constitutes use of the trade mark in the UK, it is necessary to assess whether the advertisement is targeted at consumers in the UK and in that way constitutes use of the mark in relation to goods in the course of trade in the UK.

168. Secondly, the mere fact that a website is accessible from the UK is not a sufficient basis for concluding that an advertisement displayed there is targeted at consumers in the UK.

169. Thirdly, the issue of targeting is to be considered objectively from the perspective of average consumers in the UK. The question is whether those average consumers would consider that the advertisement is targeted at them. Conversely, however, evidence that a trader does in fact intend to target consumers in the UK may be relevant in assessing whether its advertisement has that effect.

170. Fourthly, the court must carry out an evaluation of all the relevant circumstances. These may include any clear expressions of an intention to solicit custom in the UK by, for example, in the case of a website promoting trade-marked products, including the UK in a list or map of the geographic areas to which the trader is willing to dispatch its products. But a finding that an advertisement is directed at consumers in the UK does not depend upon there being any such clear evidence. The court may decide that an advertisement is directed at the UK in light of some of the non-exhaustive list of matters referred to by the Court of Justice in *Pammer* at paragraph [93]. Obviously the appearance and content of the website will be of particular significance, including whether it is possible to buy goods or services from it. However, the relevant circumstances may extend beyond the website itself and include, for example, the nature and size of the trader's business, the characteristics of the goods or services in issue and the number of visits made to the website by consumers in the UK."

27. The factors listed in paragraph 93 of *Pammer* are as follows:

"... the international nature of the activity, mention of itineraries from other member states for going to the place where the trader is established, use of a language or currency other than the language or currency generally used in the member state in which the trader is established with the possibility of marking and confirming that reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other member states, use of a top-level domain name other than that of the member state in which the trader is established, and mention of an international clientele composed of customers domiciled in various member states. It is for the national courts to ascertain whether such evidence exists."

28. The only evidence I can see that suggests that the “Woodstock General Store” is targeted at consumers in any jurisdiction other than the US is a specific phone number for international customers. However, there is no indication that the EU is targeted and, in my view, the lower value goods (such as notebooks, notecards and postcards) are unlikely to be purchased internationally. I therefore take no further account of the evidence contained in Exhibit DR2. However, even had I found it to have been targeted at the EU, there are no dates on the screenshots, so they cannot, in themselves, prove that the 233 mark was used in connection with those particular goods during the relevant period. Although the screenshots in Exhibit DR3 have been retrieved via the Wayback Machine, they are taken from the same Woodstock General Store website that I found not to be targeted to the EU.

29. Exhibit DR4 contains screenshots from amazon.co.uk, with prices in sterling. The goods shown here are two T-shirts, a Blu-Ray disc, and a CD box set. The dates when the products were first available confirm that they were on sale during the relevant period. The opponent drew my attention to the Amazon Bestsellers rankings. For example, the T-shirt on page 1 of the exhibit was the 234,618th best-selling product in Clothing and the 10,089th top seller in Men’s T-shirts. The opponent was, however, unable to answer my questions about the period covered by these figures, so I cannot reasonably infer anything from this information, beyond the fact that there is likely to have been at least one sale of each item. On each of these items, the logo from the 233 mark is shown, only sometimes in the same colours, with the word “WOODSTOCK” placed somewhere other than beneath the logo. Both T-shirts are described as “Officially licensed merchandise”.

30. Exhibit DR5 consists of the table below which shows sales made between 2014 and 2018 within the EU, including the UK, by some of the opponent’s licensees:⁷

Licensee	Sales (\$)	Products
Absolute Cult	723	T-shirts, Vests, Camiseta [sic]
Brands In	605	T-shirts

⁷ All these figures are taken directly from the exhibit. If the figures for each licensee are added together, the total is 1,254,629.

Licensee	Sales (\$)	Products
Euro Prosem	46,301	T-shirts
Fipo Group	411,354	T-shirts
GLD Group	16,193	Apparel
Nylon UK	893	T-shirts
Plastic Head Distribution	212,784	T-shirts
Pyramid	2,344	Poster
Razamataz	754	Bandanas, Patches, Beanies
Rock Off	25,815	Poster
Sicem	137,110	T-shirts
Universal Music	399,753	T-shirts
TOTAL	1,254,628	

Mr Roberts notes that these licensees were entitled to use “some or all of the Earlier Marks”.⁸ Exhibit DR6 contains screenshots from two of these licensees. However, they both have a copyright marking of 2018, so fall outside the relevant period, as do some of the sales shown in the above table.

31. Of the goods and services on which the opponent seeks to rely, the only items where there may be evidence of the 233 mark being used on goods marketed in the EU within the relevant period are T-shirts. In my view, the Blu-Ray and CD set are not evidence of supply of *Film, audio, video and television production*. This term refers to the services that go into the process of creating a film, audio or video recording, or television programme. I see no evidence that the opponent has had any involvement in these services.
32. I have said that there **may be** evidence of use on T-shirts, as, first, the evidence is very slight and, secondly, the mark shown is not exactly as registered. I recall that even minimal use may be genuine, if this level of use is “justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services”.⁹ Nowhere does the Court of Justice of the European Union (“the CJEU”) set a theoretical level of market share that must be

⁸ Witness Statement, paragraph 11.

⁹ See Arnold J’s 7th point in his summary of the case-law on genuine use, quoted in paragraph [18] above.

achieved for the purpose of showing genuine use. Instead the decision-maker is enjoined to make an assessment of all the relevant factors: see *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02:

“22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.”

33. At the hearing, Ms Fox submitted that the market concerned is not general clothing, but promotional merchandise, and that the level of sales of the opponent’s licensed products cannot be compared to those of a High Street clothing retailer. The table reproduced in paragraph 30 above shows \$1.25 million of sales in the EU and UK. Admittedly, the period covered by this table extends beyond the relevant period. It is likely, though, that a reasonable proportion of the goods were sold within the relevant period. I note that the table covers goods other than T-shirts, but they account for by far the largest proportion of the sales (at least \$1.2 million). I accept that the opponent has shown genuine use of a mark in relation to T-shirts. In making this finding, I have taken account of Carr J’s guidance on framing a fair specification in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of

the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance

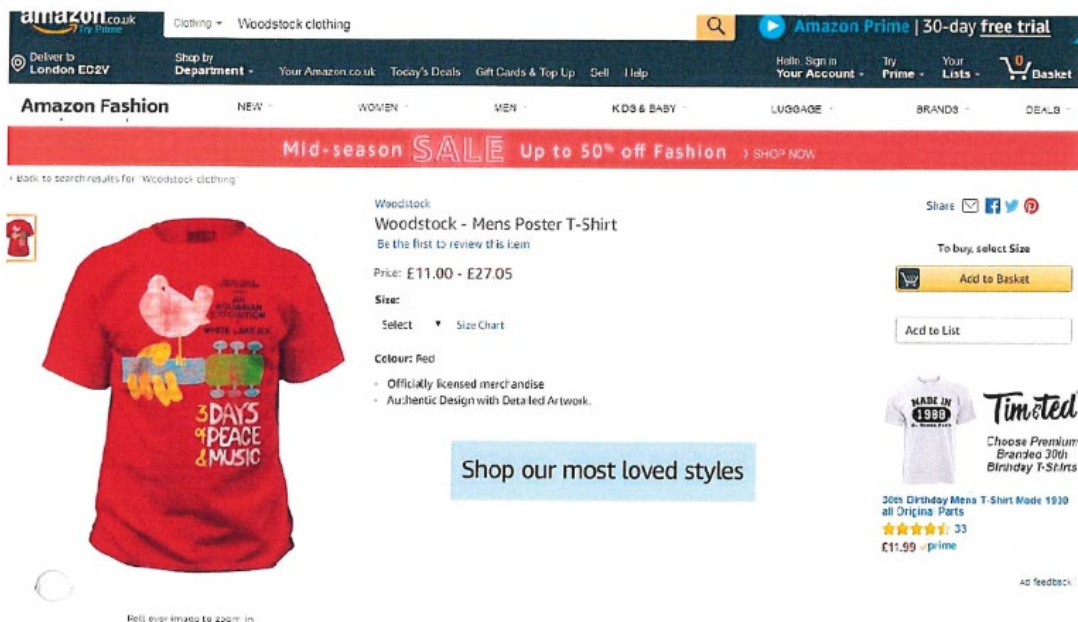
different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

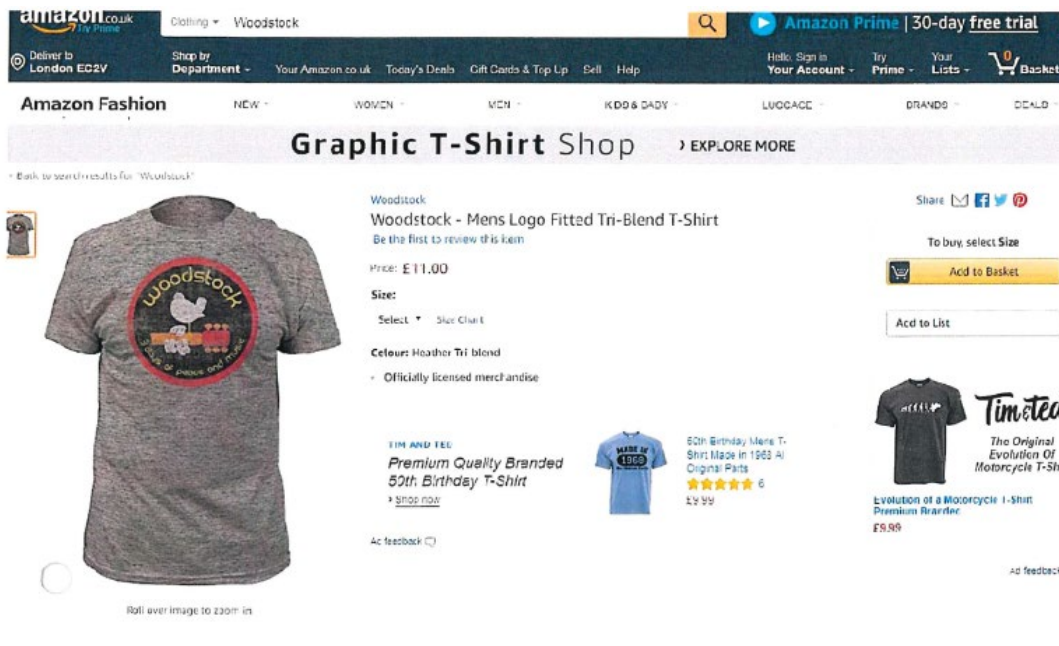
The term used in the specification is *Clothing*. In my view, acceptance of use of the mark in relation to this general term would enable the opponent to rely on too wide a monopoly of its mark, when all the evidence is weighed. T-shirts, however, represent a subcategory of clothing that is capable of being viewed independently.

34. I now turn to the mark that has been used in connection with the T-shirts. The 233 mark is shown below, for ease of comparison.



The only images that relate to the relevant period and are labelled “officially licensed merchandise” are shown below.





35. The logo in the 233 mark appears as decoration on the T-shirts. First, I must decide whether this is use as a trade mark. The question is whether the consumer would see it as an indication of origin. In my view, the consumer is likely to be familiar with the concept of merchandise and assume that the logo has been used with the consent of the owner. Consequently, it is likely to be perceived as a trade mark indicating the origin of the goods

36. I shall now consider the marks in use. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, said:

“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.”

Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

37. In my view, the image of a white bird sitting on the neck of a guitar is the most striking element of the 233 mark. It takes up the major part of the space in the red rectangle. However, the word element, at the bottom of the rectangle, also makes a contribution to the overall impression of the mark.
38. On the T-shirts, the device element of the mark is reproduced, in the first instance in the colours claimed in the registration, and in the second in different colours (although the bird remains white). The word “WOODSTOCK” appears in a different place on the second T-shirt and it is not clear whether it appears on the first. It should be noted that if this is indeed a reproduction of the poster, the words “WOODSTOCK MUSIC & ART FAIR” appear at the very top. The poster can be seen in Exhibit DR7. Also on the second T-shirt, the image and text are surrounded by a red circle.
39. In *Hypen GmbH v EU Intellectual Property Office*, Case T-146/15, the General Court (GC) set out the following approach to the assessment of whether the presence of additional components is likely to alter the distinctiveness of the registered mark to a material extent:

“28. ... a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS*

TRANSPORT, T-482/03, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM – Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is in itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM – Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM – Frutas Solana (KIT, EL SABOR DE NAVARRA)*, T-46/13. Not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM – Blueshore Management (FRUIT)*, T-514/10, not published: EU:T:2012:316, paragraph 38).

32. It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No. 207/2009.”

40. The distinctive character of the mark on the first T-shirt depends on the bird device. It is this that draws the eye and the words have a much lower level of visual impact. It is not even clear from the image exhibited that the word “WOODSTOCK” appears on the T-shirt at all, and, if it does, it does not make the same contribution to the overall impression of the mark as it does in the registered mark. Consequently, I find that this is not an acceptable variant of the 233 mark.
41. Turning to the second T-shirt, it seems to me that the distinctive character of the mark as used here depends on the word “WOODSTOCK” as well as the device. The word is above the device, rather than below as in the 233 mark and it is presented differently from the block capitals of the registered mark. As I have already mentioned, the colour scheme is different from that used in the 233 mark. In my view, these are minor changes that do not alter the distinctive character of the mark. I must also consider the additional elements: the phrase “3 days of peace and music” and the red circle surrounding the device and words on a black background. The *Hypen* test requires me to assess the intrinsic distinctiveness of these additional elements and their relative position in the mark as used. To my mind, the red circle is a banal surrounding and so does not alter the distinctive character of the mark. The additional phrase is presented in smaller letters than the word “WOODSTOCK” and plays a subordinate role. I find that the mark on the second T-shirt qualifies as an acceptable variant of the 233 mark.
42. I have already noted that the majority of the sales shown in paragraph 30 relate to T-shirts. Of this \$1.2 million, it is not possible to ascertain what proportion fell within the relevant period or what proportion bore the acceptable variant use of the 233

mark. Section 100 of the Act states that the onus is on the proprietor to prove use. In my view, the opponent has failed to demonstrate genuine use of the 233 mark.

43. Consequently, the opponent is unable to rely on the 233 mark in relation to T-shirts, and may only rely on the goods in respect of which the 408 mark is registered (*cookies; desserts; bakery goods*).

Decision

Section 5(3) ground

44. Section 5(3) of the Act states that a trade mark which is identical with or similar to an earlier trade mark

“shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community/European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

45. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (C-487/07), *L'Oréal SA and others v Bellure NV and others* (C-487/07) and *Marks and Spencer v Interflora* (C-323/09). The law appears to be as follows:

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered: *General Motors*, paragraph 24.
- b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26.

- c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.
- d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods or services, the extent of the overlap between the relevant consumers for those goods or services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.
- e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future: *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79.
- f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark is registered, or a serious risk that this will happen in the future: *Intel*, paragraphs 76 and 77.
- g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74.
- h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark: *L'Oréal*, paragraph 40.

- i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation: *Marks and Spencer*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

46. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

47. At the hearing, Ms Fox submitted that the opponent has a significant reputation, and this reputation lies in the original music festival and transcends that of an “ordinary trade mark” to reach the highest level of cultural awareness: “Everyone knows about the Woodstock Music Festival”. There was, she continued, nothing that required a reputation under section 5(3) to be in the goods or services covered

by the registered trade mark. This position was challenged by the applicant, who referred to paragraphs 47-50 of *Intel* as authority for the view that the goods and services in the registration were relevant to the assessment of reputation:

“47. The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48. It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49. Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50. Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.”

48. I also take account of the decision of the GC in *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16. Here the court considered whether a UK trade mark (BURLINGTON ARCADE) registered for, inter alia, *the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores*, was entitled to

benefit from the reputation of BURLINGTON ARCADE as the name of a well-known shopping arcade in London. The court held that:

“It is apparent also from the file that the applicant’s earlier trade marks, which designate services in Classes 35 and 36, are known to a significant part of the public of the relevant market as being the name of a very well-known shopping arcade in the United Kingdom, located in central London, bringing together luxury boutiques within the arcade. Since that reputation of the applicant’s earlier trade marks is not disputed by the parties, the question which arises, in the present case, is ultimately whether that reputation corresponds in fact to the services in Class 35 for which the earlier trade marks have been registered, so that the applicant is properly entitled to benefit from the protection of the reputation in question.”¹⁰ (my emphasis)

Here the GC is saying that the reputation has to rest in goods or services for which the trade mark is registered

49. In the light of this case-law, I find that the goods that the opponent may rely on are as follows:

The 408 mark

Class 30: Cookies; desserts; bakery goods.

As the courts of the EU have made clear that the reputation has to rest in the goods or services for which the trade mark is registered, it is these goods that are relevant here. The questions are whether the word mark has a reputation for the Class 30 baked goods., No evidence has been adduced of any sale or marketing of the Class 30 goods. I find that the opponent has not shown that the above mark has a reputation for the goods on which it may rely for the purposes of section 5(3). I found no genuine use of the 233 mark in relation to any of the goods or services on which the opponent sought to rely. As the test for establishing reputation is a

¹⁰ Paragraph 27.

higher hurdle than the test for genuine use, it follows that there cannot be a reputation.

50. The section 5(3) ground fails.

Section 5(4)(a) ground

51. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.

52. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited Trading as the Discount Outlet v Clarke-Coles Limited Trading as Feel Good UK* [2017] EWHC 1400 IPEC:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether ‘a *substantial number*’ of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

53. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

54. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others* [2015] UKSC 31, Lord Neuberger (with whom the rest of the Supreme Court agreed) stated that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question.”¹¹

55. For the purposes of this section of the Act, I must assess whether use of the applicant’s mark would amount to a misrepresentation, from the perception of the opponent’s UK customers and potential customers. While the opponent has provided evidence of licensed products on sale on the amazon.co.uk platform, the only sales figures in the whole evidence bundle do not differentiate between EU

¹¹ Paragraph 47.

and UK sales, and, as I have already noted, I am unable to assess the significance of the Amazon Bestsellers rankings. On the basis of the evidence I have before me, I find that the opponent has not demonstrated protectable goodwill associated with the sign WOODSTOCK.

56. The section 5(4)(a) ground fails.

Conclusion

57. The opposition has failed. The application by Woodstock Roots, LLC may proceed to registration in respect of all the following goods specified in the application.

Costs

58. The applicant has been successful and is entitled to a contribution towards its costs. At the hearing, the applicant requested on-scale costs; in its response to the opponent's additional evidence, it requested that any subsequent costs be compensated in full. Section 5.6 of the Trade Marks Manual concerns off-scale costs:

“It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In *Rizla Ltd's application* [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derive from section 107 of the Patent Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in *Rizla's application* apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes, it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the

extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This 'extra costs' principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour.

Any claim for costs approaching full compensation or for 'extra costs' will need to be supported by a bill itemising the actual costs incurred."

59. I am not persuaded that the opponent's very late submission of additional evidence represents unreasonable behaviour. The opponent stated that it had only recently become aware of the document and the court brief dealt with matters relevant to the argument that the opponent's representatives chose to pursue. However, in view of the large amount of evidence submitted by the opponent, I will award the applicant a sum towards the upper end of the scale as a contribution towards its costs in considering and commenting on the opponent's evidence. I take account of the fact that the applicant did not itself file any evidence.

60. In the circumstances, I award the applicant the sum of £3000 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £300

Considering and commenting on the other side's evidence: £1700

Preparation for and attending a hearing: £1000.

Total: £3000

61. I therefore order Woodstock Ventures LC to pay Woodstock Roots, LLC the sum of £3000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of September 2019

**Clare Boucher
For the Registrar,
Comptroller-General**