

O/0667/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NUMBER UK00900250779

IN THE NAME OF MATALAN LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

EASY

IN CLASS 25

AND

AN APPLICATION FOR REVOCATION THEREOF

ON GROUNDS OF NON-USE

UNDER NUMBER CA000507671

BY KILBURN & STRODE LLP

Background and pleadings

1. Matalan Limited (“***the Proprietor***”) is the registered proprietor of trade mark number UK00900250779 for the mark shown on the front page of this decision (“***the Contested Mark***”). The Contested Mark is a comparable trade mark (EU)¹ with a filing date of 1 May 1996 and it was registered on 1 June 1999 for the following goods:

Class 25 Denim clothing, jeans, jackets, shirts, T-shirts, sweatshirts, belts.

2. On 15 August 2024, Kilburn & Strode LLP, (“***the Applicant***”) filed the revocation action number CA000507671 against the Contested Mark in its entirety, for non-use under section 46(1)(a) and section 46(1)(b) of the Trade Marks Act 1994 (“***the Act***”). The Applicant alleges that the Proprietor has not used the Contested Mark in the United Kingdom within the five-year periods set out below:

Section 46(1)(a): following the date of completion of the registration process, i.e. 2 June 1999 – 1 June 2004 (“***the first relevant period***”). The earliest possible revocation date is 2 June 2004.

Section 46(1)(b):

Start dates	End dates	The earliest possible revocation dates	
02 June 2009	01 June 2014	02 June 2014	<i>“the second relevant period”</i>
02 June 2014	01 June 2019	02 June 2014	<i>“the third relevant period”</i>

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) and registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark’ retains the same filing date, priority date (if applicable) and registration date of the EU trade mark from which it derives.

15 August 2019	14 August 2024	15 August 2024	<i>“the fourth relevant period”</i>
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3. The Applicant did not file a statement of grounds.
4. The Proprietor filed a defence and counterstatement² denying the claims made in relation to all its goods and requesting that the revocation action be refused and an award of costs to be made in their favour.
5. The Applicant is self-represented. The Proprietor is represented by Groom Wilkes & Wright LLP.

Evidence and submissions

6. During the evidence rounds, only the Proprietor filed evidence in the form of a witness statement of William George Lodder, dated 21 January 2025, with exhibits WGL1 – WGL8 and a witness statement by Katy Helen Adams with exhibits KHA – KHA2. Mr Lodder is a solicitor and Head of Legal & Risk Services for the Proprietor, Matalan Limited, and he has held the position of Head of Legal and Company Secretary of the Proprietor respectively since July 2012 and July 2013. Ms Adams is a Chartered Trade Mark Attorney and Partner at Groom Wilkes & Wright LLP (the Proprietor’s representative) since 3 May 2011. Mr Lodder and Ms Adams are duly authorised to make submissions on behalf of the Proprietor.
7. A hearing took place before me, by videoconference, on 20 July 2026. The Proprietor was represented by Charlotte Blythe of Hogarth Chambers. The Applicant did not take part at the hearing. Prior to the hearing, the Proprietor filed skeleton arguments.
8. The evidence and submissions will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful consideration of the papers and of the submissions both presented in writing and at the hearing.

² Dated 11 November 2024.

Decision

Statutory provisions

9. The relevant provisions of section 46 of the Act are as follows:

“(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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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) [...]

(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 existing at an earlier date, that date.”

10. Section 100 of the Act is also relevant, which reads:

“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.”

11. As the Contested Mark is a comparable trade mark (EU), pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, the Proprietor may rely upon use of the mark in the EU for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

Relevant case law

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

13. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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 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]; *Ferrari* at [33].

(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].”

14. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25].

15. What I take from the relevant case law is also that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.³

Assessment of the sufficiency of use

16. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK (or the EU) during the relevant periods. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods/services for which use has been shown;

³ *Awareness Limited v Plymouth City Council*, Case BL O/236/13; *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13.

- the nature of those goods/services and the market(s) for them; and
- the geographical extent of the use shown.

17. Although different periods were identified as relevant, Ms Blythe clarified, at the hearing, that the evidence exclusively relates to the fourth relevant period (i.e., 15 August 2019 - 14 August 2024). I will focus on this relevant period for my assessment of the evidence. It follows that only evidence relating to the UK will be relevant.

18. The Proprietor is a fashion retailer with 236 stores across the UK counting tens of stores in the North-West, North-East, West-Midlands, Scotland, South-East and Greater London and a few more stores in London, Newport, Hampshire and Herefordshire.⁴

19. Between 2019 and 2024 the Proprietor registered total revenues of around £114 million for t-shirts, £70 million for sweatshirts, £52 million for jeans, £48 million for shirts and £27 million for jackets (including denim jackets).⁵ Although the evidence does not clarify which part of 2024 the evidence refers to, the revenues for this year refer to the “Spring/Summer” collection (generally sold between March and August). Thus, the revenue figures for 2024 are mostly (if not completely) contained within the relevant period.

20. The Proprietor provided examples of advertising material intended for in-store advertising relating to “EASY” garments (i.e., shirts, denim shirts, trousers, shorts, denim shorts, t-shirts, polo shirts, shackets (namely, a shirt-jacket hybrid), jeans, jumpers, parkas, jackets, hoodies, sweatshirts)⁶ as well as one example of how such promotional material is displayed in the Proprietor’s stores.⁷ Although part of this evidence is undated, Mr Lodder states that it is dated between 2023 and 2024.⁸ It is therefore contained within the relevant period.

21. The Proprietor has also used the Contested Mark on printed advertising material, dated within the relevant period, relating to clothing for men, women and children

⁴ See table in Mr Lodder’s witness statement at [3].

⁵ Exhibit WGL1.

⁶ Exhibit WGL5.

⁷ Exhibit WGL3, page 12.

⁸ Mr Lodder’s witness statement at [9].

(e.g., shirts, long/short-sleeved polos, jackets, jeans, jumpers, overcoats).⁹ The 2019 advertising material features the English television personality, entertainment reporter and former professional footballer Mark Wright as the Proprietor's endorser.¹⁰ The Proprietor has also offered for sale, on its website, some of its goods under the "EASY" mark (namely, jackets, trousers, shorts, t-shirts, and shirts) between September 2021 and July 2024.¹¹

22. I recognise that the evidence is not without its shortcomings: part of Mr Lodder's evidence,¹² as well as all of Ms Adams' evidence,¹³ is dated outside the relevant period (i.e., January 2025), some of the evidence relates to the Proprietor's internal use (i.e., the printing of clothing tags and labels)¹⁴ and no advertising expenditure has been provided. Nonetheless, the Proprietor operates stores across various parts of the UK, and the revenues generated under the Contested Mark range, depending on the type of clothing retailed, from tens of millions to over a hundred million (in the case of t-shirts), within the relevant period. The Proprietor also uses the Contested Mark to retail its goods online and to promote them through printed marketing materials and in-store advertising signage. As regards the revenue figures, although Mr Lodder did not indicate the market share occupied by the Proprietor, I can reasonably assume that the clothing market is worth millions, if not billions, of pounds. Accordingly, I find the Proprietor's revenue figures to be relevant.

23. Following from the above considerations, although I recognise the evidence presents some gaps, taking the evidence as a whole, on balance, I consider that it sufficiently establishes that the Contested Mark has been put to genuine use in the UK for different pieces of clothing. Below in this decision I will detail which goods I consider there to have been genuine use for and what constitutes a fair specification.

⁹ Exhibit WGL6.

¹⁰ Mr Lodder's witness statement at [10].

¹¹ Exhibit WGL7.

¹² Exhibit WGL8.

¹³ Exhibits KHA1 – KHA2.

¹⁴ Exhibits WGL2 and WGL4.

24. In the evidence the word-only registered mark “EASY” is mostly used independently in standard font. These are clearly acceptable uses of the mark upon which the Proprietor may rely.

25. For the sake of completeness, I note that in some instances the “EASY” mark is used along the Proprietor’s company name “MATALAN” as shown in the examples below (Figure 1 and Figure 2):

24. In the evidence the word-only registered mark “EASY” is mostly used independently in standard font. These are clearly acceptable uses of the mark upon which the Proprietor may rely.

25. For the sake of completeness, I note that in some instances the “EASY” mark is used along the Proprietor’s company name “MATALAN” as shown in the examples below (Figure 1 and Figure 2):



Figure 1 – Exhibit WGL6, page 55

01 Sept 2021

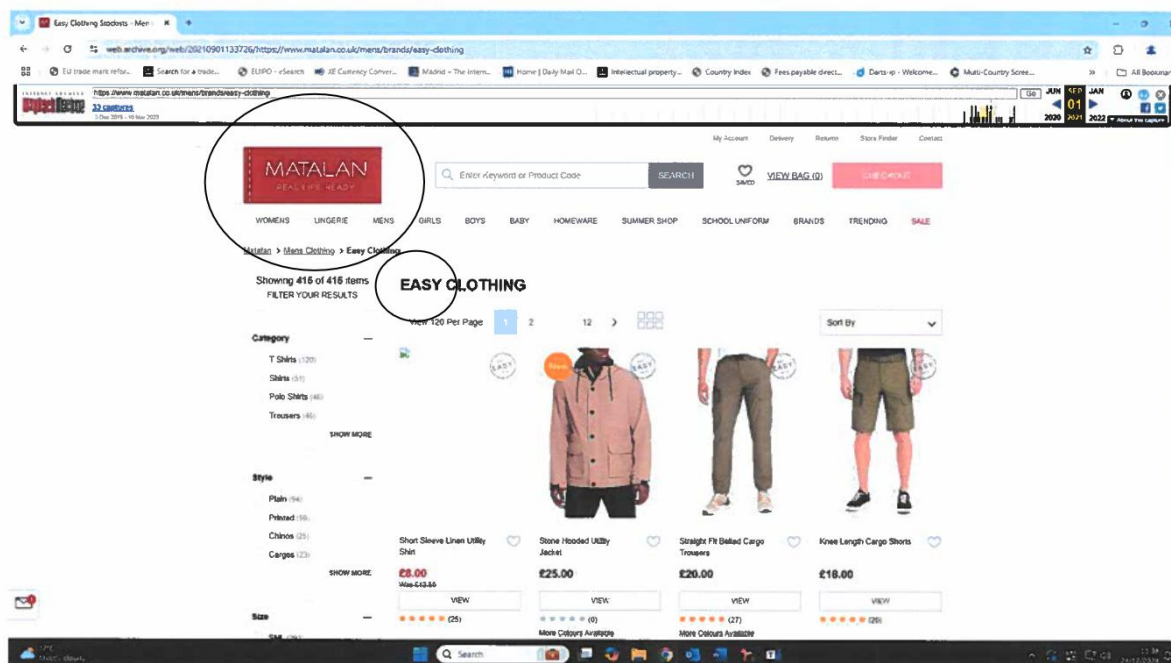


Figure 2 – Exhibit WGL7, page 58

26. I consider that the use of “EASY” along with “MATALAN” does not prevent the “EASY” mark from being viewed independently to indicate the origin of the goods at hand.¹⁵ Therefore, I also find that these uses of the “EASY” mark consist of acceptable uses of the Contested Mark by the Proprietor.

Fair specification

27. Having found use of the Contested Mark, I must determine a fair specification upon which the Proprietor is entitled to rely, bearing in mind the use that has been demonstrated.

28. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchen LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the

¹⁵ As per *Collosum Holdings AG v Levi Strauss & Co.*, Case C-12/12

Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

29. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) 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.”

31. Ms Blythe submitted, in writing and at the hearing, that the evidence provided does not show use of the Proprietor’s “belts”.¹⁶ I agree that the evidence does not sufficiently show use for this type of goods.

32. Turning to the remaining “*Denim clothing, jeans, jackets, shirts, T-shirts, sweatshirts*”, the revenues have been broken down in relation to t-shirts, sweatshirts, jeans, shirts and jackets. The evidence also clarifies that the revenue category for “jackets” also includes “denim jackets”. The advertising material (printed and for in-store use) also clearly shows that the Contested Mark has been used in relation to jeans, jackets, shirts, T-shirts, sweatshirts. With regard to “*Denim clothing*”, Ms Blythe submitted that this term should be retained in that the evidence shows use of the Contested Mark for jeans, denim jackets, denim shirts and denim shorts.¹⁷ I agree with Ms Blythe and according to the test outlined in *Merck*, I find that also “*denim clothing*” forms part of the Proprietor’s fair specification.

¹⁶ Ms Blythe’s skeleton arguments at [8].

¹⁷ Ms Blythe’s skeleton arguments at [10].

33. From the above considerations, I believe that a fair specification for the Contested Mark would be:

Class 25 “*Denim clothing, jeans, jackets, shirts, T-shirts, sweatshirts.*”

Outcome

34. The application for revocation on the grounds of non-use under section 46(1)(a) and section 46(1)(b) has mostly failed although it has partly succeeded insofar as the contested application has been revoked for “*belts*”.

35. As a result, the Contested Mark, subject to any successful appeal, may remain registered for all of the following goods, being those for which I have found there to be genuine use:

Class 25 “*Denim clothing, jeans, jackets, shirts, T-shirts, sweatshirts.*”

36. The Contested Mark is hereby revoked in part for the following goods:

Class 25 “*belts*”

37. The effective date of revocation for the Contested Mark is 2 June 2004.

Costs

38. The Proprietor has had a higher degree of success and is, therefore, entitled to a contribution towards its costs. I appreciate that the Proprietor had to gather the evidence at hand and present it to the Tribunal, however, the volume of the evidence and the related considerations were not such as to justify an award of costs above the minimum. The same reasoning applies to the cost award for the hearing.

39. Based upon the scale published in Tribunal Practice Notice 1/2023, I award the following as a contribution towards the Proprietor’s costs:

Filing the defence and counterstatement	£250
Preparing evidence	£600

Preparing for, and attending the hearing	£400
Total	£1,250

40. I therefore order Kilburn & Strobe LLP to pay Matalan Limited the sum of **£1,250**.

This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 28th day of July 2026

For the Registrar

Andrea Rossi