

O/0287/26

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS**

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3848907

BY ZDS LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 35 AND 39



AND OPPOSITION THERETO UNDER NUMBER 439448

BY OCADO INNOVATION LIMITED

AND

IN THE MATTER OF REGISTRATION NUMBER 3760080

IN THE NAME OF OCADO INNOVATION LIMITED

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NUMBER 506887 BY ZDS LTD

## Background and Pleadings

1. On 14 November 2022, ZDS Ltd (“ZDS”) applied to register in the UK the trade mark set out on the cover page of this decision (“the contested mark”) under application no. 384890. Priority is claimed from 1 September 2022 from an earlier EUTM, namely 018755008. The application for the contested mark was published for opposition purposes in the Trade Marks Journal on 2 December 2022. Registration is sought for the following services:

Class 35: Retail and wholesale services in relation to alcoholic drinks, including beer, wine and spirits, conducted by means of telecommunications, including apps and the internet.

Class 39: Delivery of alcoholic drinks, including beer, wine and spirits.

2. On 28 February 2023, Ocado Innovation Limited (“Ocado”) opposed the contested mark in full. Ocado relies upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) of the Act, Ocado relies on the following trade marks:

(i) UKTM 3760080 (series of two)

**Zoom**                      **Zoom**

Filing date 28 February 2022 and registered on 14 April 2023.

The mark stands registered for goods and services in classes 9, 35 and 39 as set out in full in the Annex to this decision. For the purposes of the opposition, it only relies on its services in classes 35 and 39.

(“the 080 Mark”)

(ii) UKTM 3771872 (series of two)

**Zoom**                      **Zoom**  
by Ocado                      by Ocado

Filed on 30 March 2022 and registered on 14 April 2023.

Whilst registered for goods and services in classes 9, 16, 35 and 39 it relies on the same services in classes 35 and 39 as the 080 Mark as set out in the Annex to this decision.

("the 872 Mark")

(iii) UKTM 3760079 (series of two)



Filed on 28 February 2022 and registered on 19 August 2022 for goods and services in classes 9, 12, 35 and 39. For the purposes of this opposition it relies only on those services as set out in classes 35 and 39 as set out in the Annex hereto.<sup>1</sup>

("the 079 Mark")

(iv) UKTM 3307948

**OCADO ZOOM**

Filed on 1 May 2018 and registered on 20 July 2018. Whilst registered in classes 9, 11, 12, 16, 20, 35 and 39, for the purposes of this opposition it relies only on its services in classes 35 and 39 as aforesaid.<sup>2</sup>

("the 948 Mark")

3. Due to their earlier filing dates, the marks upon which Ocado relies qualify as earlier marks within the meaning of section 6 of the Act. Their registration process was

<sup>1</sup> The wording of the 079 mark's specification differs slightly to the other marks relied upon but this will not make any material difference to the decision.

<sup>2</sup> Whilst the wording of the 948 mark's specification differs slightly to the other marks relied upon this will not make any material difference to the decision.

completed less than five years before the priority date of the contested mark and therefore they are not subject to the proof of use provisions. Consequently, Ocado may rely upon all the services identified without having to demonstrate genuine use.

4. Under section 5(2)(b) Ocado claims that the marks are similar and that the services are identical or similar leading to a likelihood of confusion.

5. Under section 5(3) Ocado relies upon the 080 Mark and the 872 Mark as set out above claiming a reputation in respect of those same services in classes 35 and 39 as aforesaid. Ocado claims that use of the contested mark is likely to mislead and/or confuse the consumer into believing that the respective marks are connected or in some way associated i.e. that they are part of the same family or range of marks/brands from a common origin. Ocado claims that use of ZDS's mark would without due cause take unfair advantage of and/or be detrimental to the repute of the earlier marks.

6. ZDS filed a defence and counterstatement denying the grounds of opposition.

7. On 12 January 2024, ZDS filed an application for a declaration of invalidity against the 080 Mark and all the goods and services of its registration, as set out in the Annex, relying on sections 47 and 3(1)(b) and (c) of the Act. ZDS claims that the 080 Mark:

(i) is in essence the word 'zoom' with the particular font, stylisation and colour applied to the mark not being inventive, eye catching or unusual. These features are therefore not sufficient for consumers to exclusively associate the mark with a particular undertaking;

(ii) simply and solely conveys to the average consumer that the goods and services will be provided quickly, such that it lacks any capability to distinguish the goods or services of one undertaking from another;<sup>3</sup>

(iii) simply and solely informs the average consumer of the characteristics of the goods and services namely that they will be provided quickly, particularly with respect to those services as set out in class 39 being delivery and transportation services;<sup>4</sup>

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<sup>3</sup> contrary to section 3(1)(b).

<sup>4</sup> contrary to section 3(1)(c).

(iv) is composed of a generic word which informs the public of a characteristic of the goods and services such that it is devoid of distinctive character. The dominant element of the mark will convey a clear and descriptive meaning to the relevant public with no ability to indicate trade origin.

8. Ocado filed a defence and counterstatement denying that its 080 Mark is descriptive or devoid of distinctive character, putting ZDS to strict proof of its claims.

### **Representation**

9. ZDS is represented by Harper Macleod LLP and Ocado is represented by Impetus IP Ltd. Both parties filed evidence and submissions during the evidence rounds. A hearing was requested that being held on 7 November 2024 via video conference. Jamie Watt of Harper Macleod LLP appeared for ZDS and Louisa Fielding instructed by Impetus IP Ltd appeared for Ocado. Both parties filed skeleton arguments and authorities prior to the hearing, which I have considered fully in reaching my decision.

### **Consolidation**

10. The proceedings were consolidated on 10 May 2024 following a Case Management Conference (“CMC”) that took place as a result of a challenge to the consolidation process by Ocado. The reasons for consolidation were communicated by letter to the parties shortly after the CMC and I adopt those reasons here.

### **Evidence**

11. Ocado’s evidence in support of its opposition and in defence of the invalidation action consists of:

(i) the witness statement of George Dean dated 26 July 2023 accompanied by 34 exhibits marked Annex 1 to Annex 24. Mr Dean is the Director of ‘Zoom by Ocado’ having been employed by Ocado Retail Ltd (the exclusive licensee of Ocado) since January 2019.

(ii) the witness statement of Louisa Fielding dated 17 April 2024 together with exhibits marked LF1 and LF2. Ms Fielding is a trade mark attorney at Fielding IP Limited, Ocado’s consultant in these proceedings.

12. Ocado’s evidence was accompanied by submissions/ ‘arguments in reply’ dated 19 July 2023, 21 November 2023 and 17 April 2024.

13. ZDS's evidence in the opposition consists of the witness of statement of Jamie Watt dated 9 October 2023 accompanied by 4 exhibits marked Annex JW1 to Annex JW4. Mr Watt is ZDS's representative in these proceedings.

14. ZDS's evidence in support of its invalidation action consists of the second witness statement of Jamie Watt dated 25 March 2024 accompanied by four exhibits marked JWCA1 to JAWC4.

15. Whilst I have considered all the evidence and submissions in full in reaching my decision, I shall not summarise them here but rather shall refer to the salient points to the extent that they are relevant at the appropriate stages of my decision.

### **Relevance of EU Law**

16. 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.

## **DECISION**

### **My Approach**

17. As the 080 Mark is subject to challenge by way of an invalidation action, I will assess the merits of the invalidation first. I will then proceed to deal with the opposition.

### **The Invalidation**

18. The relevant parts of section 47 which gives application to section 3 are as follows:

“47(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

19. Section 3 states:

“3. Absolute grounds for refusal of registration

(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

.....

### **Section 3(1)(c)**

20. Section 3(1)(c) prevents the registration of marks which designate the kind, quality, quantity, intended purpose, or other characteristics of the goods and services. I bear in mind when undertaking the assessment that the purpose of this section is to ensure signs designating a characteristic of the goods/services remain free for use by traders.

21. The case law under section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation, formerly Article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. zo.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for

the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has

pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

22. More recently, Zacaroli J summarised the key question in *Puma SE v Nike Innovate C.V.*, [2021] EWHC 1438 (Ch):

“Ultimately, as Ms Himsworth Q.C. submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration ‘only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of [the characteristics in section 3(1)(c)]’: *Technopol* (above), at [50]. Moreover, a sign will be descriptive ‘if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question’: Case T-234/06 *Giampetro Torresan* (above) at [25].”<sup>5</sup>

23. ZDS submits that the word ‘zoom’ simply and solely informs the average consumer of the characteristics of the goods/services, namely that they will be provided quickly. In support ZDS filed evidence of various dictionary definitions of the word ‘zoom’ taken from the following sources:<sup>6</sup>

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<sup>5</sup> Para 21

<sup>6</sup> Annex JWC4 of Mr Watt’s second statement.

Cambridge dictionary<sup>7</sup>

Zoom (verb MOVE)

to move very quickly:

*e.g. they got into the car and zoomed off*

*In the last few metres of the race she suddenly zoomed ahead*

If prices or sales zoom, they increase suddenly and quickly:

*House prices suddenly zoomed up last year*

Dictionary.com

Zoom

*verb* (used without object)

1. to move quickly or suddenly with loud humming or buzzing sound:

*e.g. cars zooming by on the freeway*

2. to fly an airplane suddenly and sharply upward at great speed for a short distance, as in regaining altitude, clearing an obstacle, or signaling. [sic]

*verb* (used with object)

5. to cause (an airplane) to zoom.

6. to fly over (an obstacle) by zooming.

*noun*

7. the act or process of zooming.

8. a zooming sound.

The Collins Dictionary

zoom

**1. VERB**

If you **zoom** somewhere, you go there very quickly.

*[informal]*

*We zoomed through the gallery.*

*A police car zoomed by very close to them.*

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<sup>7</sup> www.dictionary.cambridge.org

**Synonyms:** speed, shoot, fly, tear

The Oxford Dictionary – Oxford Learner’s Dictionaries

**zoom**

1. (*informal*) to move or go somewhere very fast

SYNONYM **rush, whizz**

- Traffic zoomed past us.
- For five weeks they zoomed around Europe.
- She spends her time zooming around the country.

2. zoom (up) (to...) (*informal*) (of prices, costs etc..) to increase a lot quickly and suddenly

- House prices have zoomed up this year.
- Shares zoomed from 1567p to 1700p.

Google

*verb* **zoom**

1. move or travel very quickly.

*“he jumped in the car and zoomed off”*

- (of a figure or level) rise sharply.

2. (of a camera or user) change smoothly from a long shot to a close up or vice versa.

- enlarge or decrease the size of part of an electronic image on a screen  
*“you can enlarge a region of the screen by zooming in”*
- cause (a lens or camera) to zoom in or out

*noun:* zoom

- a camera shot that changes smoothly from a long shot to a close up or vice versa.
- short for zoom lens

*exclamation:* to express sudden fast movement

*“then suddenly zoom! he’s off”*

24. Further Mr Watt's evidence<sup>8</sup> serves to introduce the use of the word 'zoom' in relation to various sectors where in each instance it is said that the word is used to allude/evoke or refer to the speed of the provision of the services or goods. Evidence is produced of the use of 'zoom' in relation to inter alia various types of software, clothing and retailing services, videoconferencing, vape products, telecommunications, drug testing services, the provision of food and drink and delivery services. Mr Watt provides examples of the following:

(i) A reference to the videoconferencing business Zoom (taken from Wikipedia) which had approx. 300 million daily users in 2020 and where the use of the word zoom is said to refer to the speed and ease of the meeting.<sup>9</sup>

(ii) Details regarding the 'Castrol Zoom' app. Mr Watt states that the app allows for 'instant rewards' and therefore the use of 'zoom' is said to refer to the speed of the provision.

(iii) A reference to a UK provider of commerce software under the name Zoom Buzz, with the app's aim of simplifying and expediting e-commerce activities.<sup>10</sup>

(iv) Use in relation to e-commerce and the joint venture between Arcadia (the leading UK retail group) and the Daily Mail newspaper concerning the online retail sale of clothing. The word zoom is said to have been used to describe the venture and to allude to the speed of choice and delivery.<sup>11</sup>

(v) Examples of use of use of 'zoom' in relation to various products said to illustrate the use of the word to evoke speed alongside aspects relating to vision. In relation to use of the word for vaping products since they are stimulants it is said by Mr Watt that the word will evoke the allusion of alertness, speed and focus.<sup>12</sup>

(vi) Examples of use of 'zoom' in the marketplace which are directly linked to speed, transport and/or delivery said by Mr Watt to show that the term 'zoom' is in common use in relation to product delivery.<sup>13</sup>

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<sup>8</sup> Witness statement dated 25 March 2024.

<sup>9</sup> Exhibit JWCA1.

<sup>10</sup> Para 8 and Exhibit JWCA1.

<sup>11</sup> Para 5 and Exhibit JWCA1.

<sup>12</sup> Para 9 and Exhibit JWCA2.

<sup>13</sup> Para 10 and Exhibit JWCA3.

(vii) Use of the word 'zoom' in relation to inter alia high speed telecommunications, car, coffee and parcel deliveries, same day drug testing and 1 hour/same day/express deliveries,<sup>14</sup> again said to evoke the speed of the product or service.<sup>15</sup>

25. In support of ZDS's case, Mr Watt relies, in particular, upon the judgment of the Court of First instance (Fourth chamber) in *Quick Restaurants SA v OHIM: Case T-348/02*, where it upheld the decision of the examiner in refusing registration of the mark Quick. In that decision it was found that the mark consisted exclusively of a word which could be used in trade to describe a quality of some of the goods in classes 29, 30, and 31, in particular in relation to foodstuff, pre-prepared dishes and beverages, since when applied to them it was likely to suggest immediately to the English speaking consumer that the products can be prepared and served quickly. It was held that the word 'quick' designated an important quality, namely of speed with which the goods can be prepared and served. Mr Watt submitted that parallels should be drawn between the respective cases and that I should take an analogous approach to the word 'zoom'.

26. In response Ms Fielding's evidence outlined details of trade mark searches conducted of the UKIPO trade mark register for live marks consisting of the word Zoom in all classes.<sup>16</sup> These results show various Zoom marks as word only and figurative marks with or without devices, registered in relation to a range of classes. They also include the marks registered/filed by the parties. It is submitted that this supports the contention that the word 'zoom' is used and is capable of operating as a trade mark by various businesses.

27. Ms Fielding also produces copies of the UKIPO examination report and correspondence issued in relation to the registration of the 080 Mark showing that no objections were raised by the UKIPO as to the inherent registrability of the mark.<sup>17</sup> This evidence is said to have been produced to show that Zoom as a word is distinctive and is inherently registrable as a mark.

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<sup>14</sup> By 'Zoom 1 hour Delivery', 'Zoom Box Business' and 'Zoom Baby'.

<sup>15</sup> Para 12 and Exhibit JWCA3.

<sup>16</sup> Exhibit LF1

<sup>17</sup> Exhibit LF2

28. I say at the outset that the fact that the examiner raised no objection to the registrability of the mark is not a consideration which is determinative given that a challenge has been now raised. I shall say no more about this.

29. Ocado submits that whilst the word 'zoom' is shown to mean 'to move quickly' by ZDS this does not mean it should simply be refused because it is an English word. The question to be determined it was argued is whether there is a sufficiently direct and specific link between the sign and goods/services to enable to relevant public to immediately perceive without further thought process a description of one of the characteristics of the goods/services concerned. In so far as the services in class 39 it is submitted that the word 'zoom' simply alludes as to the nature of the services and on its own has no direct meaning. It was argued by Ms Fielding that for the word 'zoom' to be perceived in the way alleged by ZDS it would "need to be formed into a sentence to have any real meaning and explanation as to what the services may be or what characteristics they may possess".

30. In this regard it was submitted that the word 'zoom' is not an expression that is used in ordinary language or common parlance to suggest quickness. Consumers would not naturally describe, in particular, retail deliveries as being "zoomed" to them. This it is said is not a typical or a natural way for consumers to refer to the speed of such services; they would more commonly use terms such as "fast" or "quick" deliveries, rather than "zoom" deliveries. Accordingly, it was submitted that the term 'zoom' is sufficiently unusual in the context of the goods and services and does not operate as a descriptive term with any immediate or direct meaning in relation to in particular retail delivery services, although it was accepted as being somewhat allusive. It was said that the word does not describe the kind, quality, or nature of the goods/services themselves.

31. I start by noting that the average consumers of the goods and services at issue will be members of the general public, although I accept that for the software goods some of these may be directed at the business user.

32. Further the relevant date for the assessment is the filing date of the 080 Mark namely 28 February 2022.

33. Given the limited nature of the stylisation and colour used, the distinctiveness of the 080 Mark lies in the word 'zoom' itself and therefore if I find that the word is

descriptive, the stylisation whilst contributing will make little impact to the distinctiveness of the mark beyond the word itself to counter the section 3(1)(c) claim.

34. Turning to the dictionary definitions as produced in evidence by ZDS, these meanings accord with my own understanding of the word. Whilst the definitions include a number of meanings, this does not prevent a term being regarded as descriptive. As Mr Simon Clark, sitting as the Appointed Person, affirmed in O/0235/25:

“39. .. a mark can fall within s.3(1)(c) even if it has more than one meaning (see Arnold J (as he then was) at [92] in Starbucks), provided that it

“may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought” (Procter & Gamble v OHIM [2001] Case C-383/99 P).

40. It is ... important to assess the meaning of the word in the context of the mark and in relation to the goods and services covered by it.”

35. The important factor to note is that if a mark has several meanings this will impact on whether or not the alleged descriptive meaning was one which the consumer would reach immediately and directly without further thought. In the context of the goods and services at issue the only likely meaning that could apply in terms of descriptiveness are those in relation to speed and moving or travelling quickly as opposed to any of the other meanings outlined.

36. The word ‘zoom’ is shown in the dictionary definitions produced by Mr Watt to be an ‘informal’ noun or verb, which supports the suggestion advanced by Ocado that it is not in common use to describe something that travels or moves quickly. I agree with the argument therefore that the average consumer is unlikely to naturally use the word ‘zoom’ in a sentence when describing the speed of say delivery services. Ms Fielding drew my attention to the fact that Mr Watt himself and ZDS referred to “fast deliveries” and “quick deliveries” in their submissions rather than ‘zoom deliveries’ which adds weight to the argument that the word ‘zoom’ is not a word which would immediately and naturally be used in common parlance. To my mind the word ‘zoom’ is an unusual word alluding to the speed of the provision of the goods and services but does not describe a characteristic or quality of them.

37. In so far as the evidence filed by Mr Watt, I note that, on the whole, this is unhelpful given that he himself uses terminology such as ‘evoke’ and ‘allude’ rather than describe. Further his evidence shows the word Zoom being used as the name of a product, brand or company name and as an indicator of origin rather than showing that the word is used descriptively by third parties. Showing allusive use is not the same as demonstrating that a word is or could be used descriptively. Further the evidence itself of use by these third parties is limited and does not show what Mr Watt purports it to show. For example, the evidence relating to the collaboration between Arcadia and the Daily Mail is presented as follows:



Pascoe said that in the late 1990s, Arcadia had been in the vanguard of ecommerce thanks to Zoom, a joint venture with the publishers of the Daily Mail.

38. This screenshot to my mind does not “allude to the speed of choice and delivery” to the relevant public as alleged.

39. Further in so far as the reference to goods such as the Nike Zoom trainers or the Steve Madden Zoomz Trainers for example the word Zoom/Zoomz is clearly being used as the name of the range of products on offer rather than describing a characteristic of the goods, which are again examples of trade mark use and a secondary indicator of origin. Whilst the names perhaps give the impression that if the shoes are worn, they would enable you to run fast, the goods have not been shown to be promoted by the respective third parties on this basis and therefore the meaning behind the name would not be clear and obvious to the average consumer in these circumstances. Further, in so far as Mr Watt's references to consumer products, I see no connection to speed from the use of the word 'Z-Zoom by Travel Blue Butterfly' for sunglasses or the 'Zoom' e-liquids as alleged. The sunglasses are described as stylish, comfortable and ultra light. These goods do not appear to be ones capable of falling within the dictionary definitions as provided by Mr Watt such that the use of 'zoom' in relation to them would be perceived as being descriptive or designating a characteristic of the goods. Whilst some limited evidence has been produced which may allude to the speed of the delivery of services in class 39, for example in relation to 'Zoom testing' the provision of same day drug testing and 'Zoom! 1hour Delivery', the evidence on the whole is mostly undated and would not in my view be perceived by the average consumer as descriptive of a characteristic of the services as opposed to being allusive of them.

40. I am satisfied that on the whole the 080 Mark falls on the right side of being capable of acting as an indicator of origin rather than being descriptive, alluding to the manner in which the goods/services are delivered i.e. at speed. Consumers would understand that the mark gives the notion of speed without being directly descriptive of a quality or characteristic of the goods and services.

41. Consequently, the section 3(1)(c) claim fails.

### **Section 3(1)(b)**

42. Sections 3(1)(b) and (c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b) of the Act.<sup>18</sup> However, I can deal with this ground

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<sup>18</sup> *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, at paragraph 25.

relatively swiftly. In my view ZDS' claim under section 3(1)(b) is no stronger under its ground of attack than section 3(1)(c). The lack of distinctive character is advanced on the basis that "the [080 mark] lacks any capability to distinguish the goods or services of one undertaking from another ...as it will simply and solely convey to the average consumer that the goods and services will be provided quickly". I have already found that the 080 Mark is not descriptive of a characteristic of the goods and services at issue. ZDS's claim under section 3(1)(b) is on a similar basis to that under section 3(1)(c), namely that the mark consists of a generic word informing the public of a characteristic of the goods/services meaning that it would be devoid of distinctive character. It was argued that the stylisation and colour used are insufficient to distinguish the word between undertakings. ZDS has not indicated any further reason as to why the mark should be considered devoid of distinctive character. However, I found that the 080 Mark does not fall foul of section 3(1)(c) so its claim under this ground is also dismissed.

43. In so far as ZDS' claim of deceptiveness regarding the source of the goods and services, on the basis that the use of the 080 Mark is being undertaken by Ocado Retail Ltd under licence as opposed to Ocado, whilst Mr Watt submitted during the hearing that this argument was more relevant to its cancellation action than the opposition, he did not expand and explain how. In any event I see no merit in the claim under either set of proceedings. These arguments are more applicable to claims brought under sections 46(1)(d) or 3(3)(b) of the Act, which have not been pleaded. Even if they had, any claim as to deceptiveness on the basis that the mark can no longer be distinctive of the proprietor would have failed in any event. This is because the House of Lords has long found that the public have become used to marks being used under licence, even bare licences, and that provided a mark is used by only one trader at a time, it serves the proper function of a trade mark, and is not deceptive.<sup>19</sup> Mr Dean has given evidence that Ocado Retail limited is Ocado's licensee and there is no suggestion that any other third party is using the mark with Ocado's consent. I shall deal with ZDS's submissions regarding the status of the licenses in so far as Ocado's claim to a reputation later in my decision.

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<sup>19</sup> *Scandecor Development AB v Scandecor Marketing AB* [1998] 1 WLUK 390; [1998] F.S.R. 500 (Ch); [1998] 7 WLUK 470; [1999] F.S.R. 26 CA; and [2001] UKHL 21; [2002] F.S.R. 7.

44. For completeness, given that I do not find the 080 Mark is descriptive or non-distinctive of the services in class 39 i.e. delivery services it stands to reason that it would also not be so for goods and services in classes 9 and 35. Further, Ocado did not make a claim of acquired distinctiveness of its 080 Mark and therefore I need not consider this issue further. ZDS' application for a declaration of invalidity fails against all the goods and services challenged. I shall, therefore, move on to consider the opposition brought by Ocado.

### **The Opposition**

45. Given the overlap in issues in relation to the opposition proceedings, I shall summarise the respective parties' evidence at this point to the extent that it is relevant to the opposition.

### **Evidence**

#### **Witness statement of George Dean dated 26 July 2023**

46. Mr Dean's witness statement provides detailed background on the history and development of Ocado's business, including the development of its various predecessors and subsidiaries. He explains that Ocado holds the relevant intellectual property rights, which it licenses to Ocado Retail Limited. Both the Ocado and Ocado Retail Limited are wholly owned subsidiaries of Ocado Group Plc. Certificates of incorporation and group structure documents are exhibited to demonstrate the development of the Ocado group of companies and its ownership structure.<sup>20</sup>

47. Mr Dean's evidence serves to show the development of the OCADO and ZOOM brands, relying primarily on use of the house brand OCADO to establish the significant reputation enjoyed by Ocado. It is said that the evidence demonstrates an extensive reputation in the OCADO trade mark across a wide range of goods and services, particularly in connection with its well-known online supermarket and grocery delivery service.

48. The ZOOM brand, according to Mr Dean, was developed as the Ocado's rapid-delivery service (operating exclusively in and around London). He states that it is known to Ocado's existing customer base as well as to the wider public through

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<sup>20</sup> Annex 1

advertising, social-media activity, and other promotional activities. Screenshots of its website homepage dated 28 November 2002 are produced via the “Wayback Machine” archive tool showing the launch of the Ocado.com website in 2002<sup>21</sup> and the launch of the Ocado grocery app for iPhone and Android in 2009/2010.<sup>22</sup> Website traffic analytics for Ocado.com are also filed showing that in 2021 the website attracted on average 921,000 monthly users generating over 131 million page views.<sup>23</sup> Ocado’s website was ranked seventh in UK groceries by ‘Similarweb’ (said to be the leading traffic analytics service provider).

49. Examples of Ocado’s own-brand product range are exhibited,<sup>24</sup> together with media coverage of its longstanding commercial partnerships with Waitrose, Morrisons, and Marks & Spencer.<sup>25</sup> In 2020 Ocado made sales of £228.7 million of its own brand goods.

50. Mr Dean further provides extracts from Ocado’s annual reports between 2009 and 2020,<sup>26</sup> showing that it had revenue of £2.3 billion in 2019/2020 and earnings (before interest taxes depreciation and amortization) of £73 million. It employs over 21,000 employees across the UK. Additional evidence is filed regarding Ocado’s market share, brand value, and its listing on the London Stock Exchange as a FTSE 100 company.<sup>27</sup> It is said to be the highest valued UK technology company as at the date the statement was drafted. Market share data relating to the UK grocery sector is also provided, with the value of the grocery market within the UK being said to be £205 billion in 2020 of which 14% was online. Mr Dean states that Ocado held 15% of that online grocery market share.<sup>28</sup>

51. Mr Dean states that Ocado and its parent company have invested heavily in promoting and advertising the OCADO brand, increasing its visibility nationwide through branded delivery vans,<sup>29</sup> national marketing campaigns, print and digital advertising, as well as television and radio promotions.<sup>30</sup> Screenshots of promotional

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<sup>21</sup> Annex 3

<sup>22</sup> Annex 4

<sup>23</sup> Annex 12

<sup>24</sup> Annex 5

<sup>25</sup> Annexes 2, 6 and 7

<sup>26</sup> Annex 9

<sup>27</sup> Annexes 8 and 10

<sup>28</sup> Annex 10.

<sup>29</sup> Annex 16

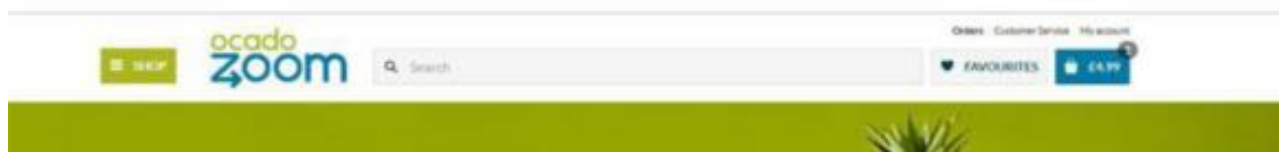
<sup>30</sup> Annexes 17 and 18 (mostly undated)

materials from Ocado’s website and other publications are included. Mr Dean outlines Ocado’s role during the COVID-19 pandemic, including deliveries to NHS staff and vulnerable individuals, which he says enhanced the company’s public profile.<sup>31</sup> 51. Ocado’s advertising spend between 2016 and 2020 is provided which exceeded £173 million and various extracts showing its activities across all mediums are produced,<sup>32</sup> to include the awards received by Ocado,<sup>33</sup> media reviews of Ocado.com,<sup>34</sup> images of the visibility of its brand on vans (which by 2021 amounted to 5137 branded vehicles), uniforms, and carrier bags, and press releases showing the expansion of Ocado’s delivery network across the UK.<sup>35</sup> It is notable that the majority of this evidence relates solely to the OCADO brand.

52. Turning specifically to the mark/s at issue, the “Zoom by Ocado” / “Zoom” service was launched in 2019. Extracts from license agreements between Ocado and Ocado Retail Limited are provided to demonstrate authorised use under license of both the OCADO and ZOOM marks.<sup>36</sup> It is said that any goodwill created from the use of the marks under license accrues directly to Ocado. A press release dated 1 March 2019, from an unknown source, covers the launch. The article refers to Ocado Zoom’s rapid delivery service going live in London and that orders can be placed on its new website [ocadozoom.com](http://ocadozoom.com) and via the iOS mobile app.<sup>37</sup> The mark was presented as follows:

## Ocado Zoom rapid delivery service goes live in London

By Steve Farrell | 1 March 2019



53. An undated screenshot taken from Ocado.com’s website shows how the ZOOM service is marketed to include a link to the platform.<sup>38</sup>

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<sup>31</sup> Annex 19

<sup>32</sup> Annex 13

<sup>33</sup> Annex 14

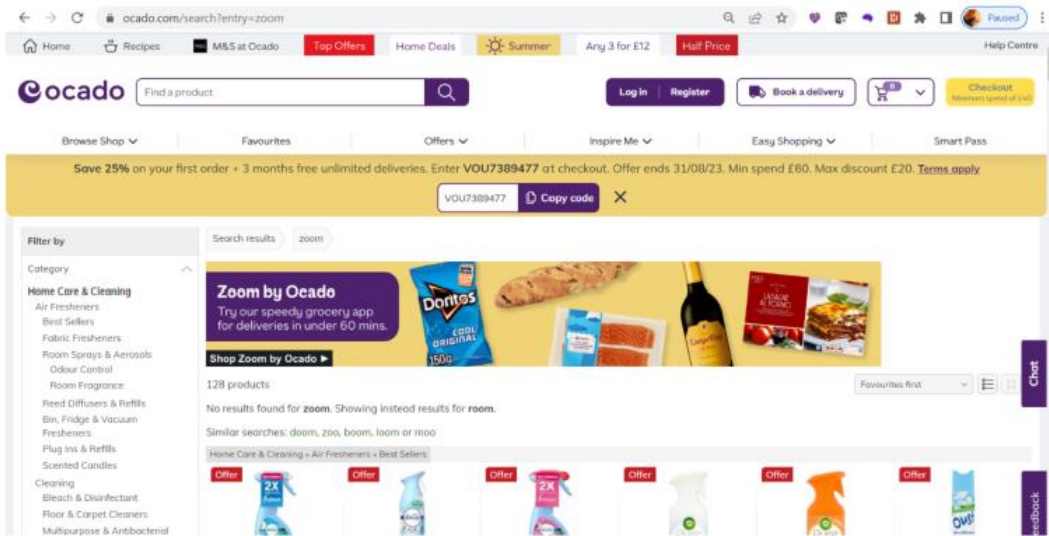
<sup>34</sup> Annex 15

<sup>35</sup> Annex 16

<sup>36</sup> Annex 11

<sup>37</sup> Annex 20

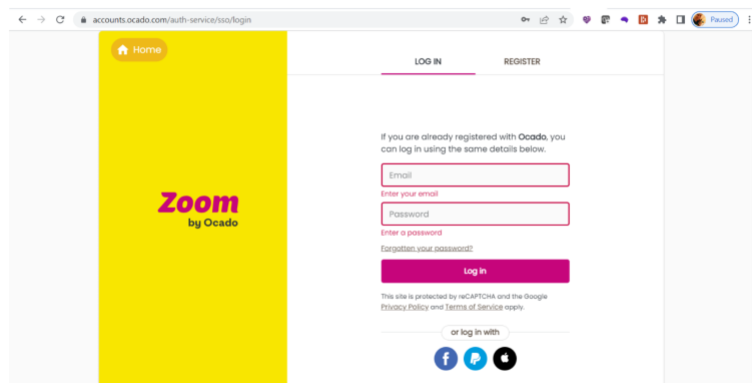
<sup>38</sup> Annex 21



54. Mr Dean states that the ZOOM brand was built directly on the reputation and customer base of the established OCADO brand.

55. An undated screenshot is provided taken from ocado.com to show that Zoom account holders share the same login credentials as Ocado customers.<sup>39</sup> Given that the rebrand as reproduced below is said to have only occurred after 2022 then the screenshot can only have been printed after this date. The mark is shown as follows:

Login details for existing Ocado customers is the same for Zoom login

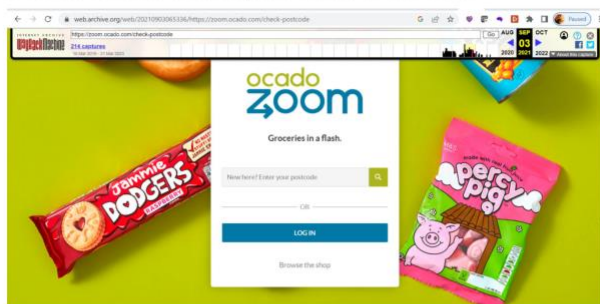


56. Mr Dean explains that Zoom offers rapid delivery of groceries, including alcoholic beverages, through its website and mobile app, and he supplies undated screenshots (save for a copyright date of 2023) taken from zoom.ocado.com showing the nature of

<sup>39</sup> Annex 22

the goods available to purchase.<sup>40</sup> Customers are able to purchase goods from the zoom.ocado.com website or via its ZOOM app. It is said that the iOS app has been downloaded over 4,500 times and is rated with 4.8 stars by consumers. The Zoom Android app is shown to have 50,000 downloads and a 4.6 rating from 627 reviews and was released on 6 August 2019. The screenshot however shows that it was updated on 24 May 2023 and therefore the information can only have been obtained after this date. It is said that as at the date the screenshot was taken “Zoom by Ocado is currently available in Leeds and selected parts of London”. App-store listings containing customer ratings, download numbers, and release dates are supplied.<sup>41</sup> The Zoom brand is said to have been updated in February and March 2022, and images/details of the new logos are produced.<sup>42</sup> Archive screenshots using the wayback machine archive tool from 2021 and 2022 show use of both the old and new branding as follows:<sup>43</sup>

Screenshot of Ocado Zoom website 3 September 2021 with old colour scheme:



Screenshot of Zoom by Ocado website 6 July 2022 with new colour scheme:



57. The old version of the logos relate to completely different marks under numbers 3307948, 3307950 and 3307957 and are shown as follows:

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<sup>40</sup> Annex 23

<sup>41</sup> Annex 24

<sup>42</sup> Annex 26

<sup>43</sup> Annex 27

UK00003307948	OCADO ZOOM	1 May 2018
UK00003307950		1 May 2018
UK00003307957		1 May 2018

58. Evidence dated from December 2022 to March 2023 is produced regarding the launch of the delivery service in Leeds, but this is after the relevant date. Evidence, largely in the form of undated screenshots, is provided regarding an advertising campaign said to be from June 2022, including use of the ZOOM mark across the London transport network system such as on posters/billboards at tube stations, bus stops and on the side of buses,<sup>44</sup> and on digital and social-media platforms.<sup>45</sup> The Ocado Zoom Instagram account was created in October 2018 and various posts are produced for 2022. Consumer engagement to these posts is, however, limited with only 299 and 281 views to two of its posts in April and May 2022 and 17 and 11 likes to posts in May and June of the same year. No details are provided as to the number of followers it has. Details of its presence on Facebook is equally as limited with confirmation that the account was launched in June 2020 and a small selection of posts in April and June 2022 are produced but with no details regarding the number of followers it has. The engagement to its Facebook posts is equally limited with only 2-4 likes. Further images are produced of branded delivery bikes, motorcycles, and uniforms but these are undated.<sup>46</sup> Marketing flyers are said to have been distributed to customers by post with each postal drop reaching approx. 415,000 households in West and East London prior to September 2022. It is said that the first distribution was sent in February 2022 and that further drops are made every 2-3 months thereafter. Photographs of the flyers are as follows:<sup>47</sup>

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<sup>44</sup> Annex 28

<sup>45</sup> Annexes 29 and 30

<sup>46</sup> Annex 31

<sup>47</sup> Annex 32

Zoom  
Acton  
28/2/22



Zoom  
Relaunch  
Acton  
18/04/22



59. No evidence is provided however showing how many households were converted into customers as a result of the flyers.

60. Details of its streamed content connected TV advertisements across various platforms are provided as well as across mainstream press articles which are said to feature the ZOOM mark. It is said that these adverts were first used in June 2022 and

“have been distributed on various services including Sky Adsmart and ITV Hub with a significant consumer reach”.<sup>48</sup> I note in particular one article of an interview with Mr George Dean, dated November 2022, in which he admits that the roll out of the Zoom delivery service has been “slow over the first few years”. The article refers to the roll out as “sluggish” and “stuttering”.

### **Witness statement of Jamie Watt dated 9 October 2023**

61. Mr Watt’s witness statement consists of the following:

- Confirmation that ZDS is a Cypriot company formed in December 2018.<sup>49</sup>
- Details of ZDS ‘s company profile on the website CrunchBase including that it started trading in 2018. I note that the company is described as ‘Cyprus’ First Online Drinks Delivery Service’ and its email address is listed as [www.zoomdelivery.eu](http://www.zoomdelivery.eu).<sup>50</sup>
- Details regarding ZDS’s Facebook page it having been set up in 2019 showing that the account has had 1400 likes and has 1500 followers as at the date the screenshot was printed and an archive screenshot dated 2020 of the landing page of its website [www.zoomdelivery.eu](http://www.zoomdelivery.eu).
- Examples of other marks taken from the UKIPO’s register that use the word ZOOM registered in the same or similar classes.<sup>51</sup>
- Examples of other marks using the word ZOOM in the course of trade in sectors similar to those of Ocado. The screenshots are said to have been taken as at the date of the witness statement. <sup>52</sup>

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

62. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –  
(a)...

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<sup>48</sup> Annexes 33 and 34

<sup>49</sup> Exhibit JW1

<sup>50</sup> Exhibit JW2

<sup>51</sup> Exhibit JW 3

<sup>52</sup> Exhibit JW4

(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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

63. Section 5A of the Act reads as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### **The principles**

64. The standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25 and are as follows:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.

### **Preliminary issue**

65. Before I deal with the substantive issues, in its TM8 and submissions ZDS takes issue with Ocado's reliance on the earlier marks claiming that as they have been exclusively licensed to Ocado Retail Limited under licenses effective on and from 17 May 2019 and 1 May 2018 these do not refer to the 080 mark dated 28 February 2022, the 172 mark dated 30 March 2022 and the 079 Mark dated 28 February 2022. It is said that in the event that goodwill is held separately from the registered mark then it is considered to be held in bad faith as the mark in question cannot be indicative of

source, as the source of goods and services provided under the mark is the holder of the goodwill and the licensor should not be entitled to the benefits normally afforded by the relevant registration, as in essence it relates to a different business.

66. It was argued that Ocado is not permitted to continue to rely on these earlier marks as the licenses are not sole or non-exclusive. Further given that the licenses (except the license in relation to the 948 Mark) pre-date the dates of the earlier marks then goodwill relating to them can only have been generated when these licenses were in effect by the Licensee. In relation to the 948 Mark, ZDS claims that since no use occurred prior to at least March 2019 then any goodwill could only have been generated by the Licensee.

67. In response Ocado filed evidence exhibiting details of the license agreements showing that Ocado licenses use of its marks to Ocado Retail Ltd with its consent. At the hearing Ms Fielding clarified the matter further, submitting that the original licenses were made in 2016, which she accepted pre dated the filing and registration dates of the earlier 'zoom' marks, however, these licenses are said to be updated periodically to include updated marks within its portfolio and include terms which cover any future marks. Each time additional marks are added the license is updated accordingly. Consequently, Ocado Retail Limited uses the marks with Ocado's consent and any goodwill or reputation from the use made of the marks accrues to it.

68. It did not assist that Mr Watt's skeletons referred to submissions in relation to a claim of passing off which was not a ground being relied upon by Ocado. At the hearing when questioned Mr Watt did not push the matter with any degree of conviction accepting that a third party can use a mark with consent from a Proprietor whilst still retaining the goodwill and reputation acquired. Further whilst accepting this position he stated his arguments were more relevant to ZDS's cancellation action which I have already addressed.

69. It is an established principle that the reputation generated through use of a mark by a licensee can be properly attributed to the proprietor of a trade mark if it was made by the proprietor's consent or under their control. Given that Mr Dean has given evidence to this effect that Ocado is the proprietor but that the use is made by Ocado Retail Ltd via license and provided extract copies of the licence agreements I am not entirely clear as to the point Mr Watt's was making in this regard.

70. As I have already set out when dealing with the invalidation action, I saw no merit in Mr Watt's argument and accept the position as set out by Ocado in its evidence and shall therefore say no more regarding the matter.

### **Comparison of the services**

71. When conducting a goods/services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, where the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

72. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat* [1996] R.P.C. 281, namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

73. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

74. Given my earlier finding, the services to be compared in classes 35 and 39 are as set out in the Annex to this decision.

75. I shall go through ZDS’s terms in turn grouping terms together where appropriate.<sup>53</sup>

#### **Class 35**

*Retail and wholesale services in relation to alcoholic drinks, including beer, wine and spirits, conducted by means of telecommunications, including apps and the internet.*

76. Ocado has the following term within all its specifications in class 35 ‘*bringing together for the benefit of others of a variety of goods all connected with.... alcoholic beverages....enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site/and downloadable software application*’ which is put simply a description of an online shop offering a broad range of products in one place such as via an app or through a website. Ocado’s term clearly encompasses ZDS’ aforementioned services, thus making them identical according to the principles outlined in *Meric*.

#### **Class 39**

*Delivery of alcoholic drinks, including beer, wine and spirits.*

77. Each of Ocado’s earlier marks as relied upon has the term *delivery of goods* in class 39 which is a broad term again encompassing all of ZDS’ services. The services are identical in accordance with *Meric*.

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<sup>53</sup> *Separode* Trade Mark BL O-399-10 (AP)

## Average Consumer and the purchasing process

78. When considering the opposing marks, the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of services in question.<sup>54</sup>

79. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

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<sup>54</sup> *Lloyd Schuhfabrik Meyer*, case c-342/97.

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

80. Ocado submitted that the services (and goods to which they relate) are directed at and used by the general public likely to display a moderate to low degree of attention given the everyday nature of the goods/services at issue. Given the nature of the services, which in general terms can be described as services in relation to the delivery of goods and retail services, the average consumer will be a member of the general public and in so far as those that relate to the purchase of goods that are alcoholic in nature the general public who has attained the age of 18 years. Notwithstanding that the consideration relates to services, the goods to which the services relate are consumable goods and whilst there may be variations in the price the selection will be on a fairly frequent basis. Considerations such as quality, cost, availability and reputation will play a part in the selection process leading to an average (medium) level of attention being undertaken when selecting the services, no higher or lower than the norm.

81. The services are by their nature online retail/wholesale delivery services and delivery services which may be purchased online but not exclusively, selected through mobile applications and the internet. The services will therefore be selected via the various app stores and scrolling through search engines over the internet or from promotional material or signage displayed in various forms to include for example billboards and magazine advertising. Visual considerations will dominate, therefore. I do not discount the possibility of aural considerations, however, through word of mouth recommendations or radio advertising.

### **Comparison of the marks**




82. 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 Case C-591/12P, *Bimbo SA v OHIM*, 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.”

83. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

84. The respective trade marks are shown below:

ZDS's mark	Ocado's marks
	<p><u>(i) The 080 Mark (series of two)</u></p> <p><b>Zoom</b>                      <b>Zoom</b></p>
	<p><u>(ii) The 872 Mark (series of two)</u></p> <p><b>Zoom</b>                      <b>Zoom</b> by Ocado                      by Ocado</p>
	<p><u>(iii) The 079 Mark (series of two)</u></p> <p>                      </p>
	<p><u>(iv) The 948 Mark</u></p> <p><b>OCADO ZOOM</b></p>

85. ZDS submits that the respective marks each contain the word ZOOM (“the common element”) but otherwise they have nothing in common. The common element is said to be inherently descriptive and non-distinctive and refers to either the speed of service provision or to move quickly through a place and is used commonly throughout the UK in this respect. As such the respective marks would be easily recognised as simply designating that the goods or services in question are delivered at speed – that they are zoomed to the consumer. Consequently, the common element would not be capable of registration alone and the comparison of the marks must be undertaken upon their other elements. Further Mr Watt argued that ZDS’ evidence demonstrated the wide registration and use of the word ‘zoom’ by multiple persons showing a crowded market, significantly lessening the scope for a likelihood of confusion. To support his argument, he relied on the decision in *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd*.<sup>55</sup>

86. Ocado submits that the marks are highly similar visually, aurally and conceptually with the font used in the application being highly similar to that used by Ocado in their stylised marks. It was submitted that there is nothing significantly distinctive in the font used by ZDS in its mark that would distinguish it from the earlier marks. Further the logo element of the contested mark, consisting of a delivery van is non distinctive in relation to the services covered. Given that the application is a composite mark consisting of a non distinctive device, the dominant and distinctive element of the mark lies in the word, which would lead to a likelihood of confusion. As pleaded the earlier marks are said to possess a high level of distinctiveness, inherently and through significant use, as shown by the evidence filed.

### **Overall Impression**

87. ZDS’ mark includes the word ZOOM presented in a slightly stylised emboldened black font slanted to the right. Above the word is a device which consists of a graphical representation of a van type vehicle within which are five bottles stacked one above the other. There are series of lines behind the vehicle to give the impression of movement and that the vehicle is moving at pace. The word ZOOM relative to the device is much larger and draws the eye. The device is not an integral part of the mark

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<sup>55</sup> [2024] E.C.C.20

overall, rather the word and graphical element are entirely separate from each other. Consequently, given the size and position of the word relative to the device, it is the word ZOOM that dominates the mark and in which the overall impression resides. Consequently, the device whilst contributing plays a lesser role in the overall impression of the mark.

88. Ocado's 080 Mark is for the word Zoom presented in a slightly stylised emboldened font, one presented in pink and the other in black. I do not consider that the colour or stylisation plays any significant role in the mark as a whole and therefore the overall impression of this mark is dominated by the word Zoom. The same applies to the 872 Mark, which includes the same presentation of the word Zoom. Underneath are the words 'by Ocado' presented in a much smaller black font. Given the position and the size of the word Zoom relative to the other words, it is this word that dominates the mark, with the words 'by Ocado' playing a lesser role, the mark as a whole giving the impression of a sub brand and house brand. The 079 Mark includes the same elements as the 872 Mark but also includes a circular device within which is a stylised letter Z presented in white. I consider that whilst the device contributes, it will do so to a much lesser degree merely reinforcing the first letter 'z' of the word zoom. Consequently, I consider that the overall impression of the 079 Mark is dominated by the word zoom as with the 872 Mark, for the same reasons. In so far as the 948 Mark it is a word only mark consisting of the two words OCADO and ZOOM presented in upper case. I consider that the overall impression resides in these two words but weighted in favour of the word OCADO given that this word appears first and will therefore have more impact in the mark as a whole.

### **Visual comparison**

89. I start by saying that given that Ocado's first three marks are presented as a series of two, one in colour and one in black and white, I shall consider the marks in black and white, as the use of colour will not make any material difference to the assessment. Further I do not consider that the difference between the casing used in the respective marks will impact materially on the assessment.

90. All of the marks overlap in so far as each contain the word Zoom/ZOOM, which is the dominant element in the 080, 872 and 079 marks and ZDS'. These marks differ in

so far as the contested mark includes a device depicting a vehicle, and Ocado's 872 and 079 marks include the additional words 'by Ocado' which are absent from the contested mark and the stylisation in each is different. The 079 Mark also includes a circular roundel device. Overall, weighing up the similarities and the differences the 080 Mark is visually similar to a high degree to the contested mark as a result of the common dominant element Zoom, with the 872 and 079 marks being similar to a lesser degree (to between a medium and high degree) as a result of the additional words and device present in each. With regards the 948 Mark, this overlaps with the contested mark visually only in relation to the word ZOOM but given that this word is not the first word that will be read, it will have less impact visually in the mark as a whole. Consequently, I consider that the visual similarities between the contested mark and the 948 Mark will be lower, that is to a medium degree.

### **Aural comparison**

91. Given that no pronunciation/articulation will be given to the device in ZDS' mark then the word 'zoom' will be given its ordinary dictionary pronunciation which will apply equally to the earlier marks. Consequently, the contested mark and the 080 Mark are aurally identical. In so far as the 872 and 079 marks they will either be pronounced in their entirety as 'Zoom by Ocado' or given my earlier findings in relation to the overall impression of these marks as just 'Zoom'. (I do not consider that any articulation will be given to the letter Z within the device of the 079 mark). In the former scenario the respective marks will be aurally similar to between a medium and high degree and in the latter scenario, aurally identical as before. Comparing the 948 Mark with the contested mark, given my earlier findings in terms of the visual similarity, the same would apply equally to the aural comparison for the same reasons. The contested mark and the 948 Mark are aurally similar to a medium degree.

### **Conceptual comparison**

92. I have outlined the dictionary definitions for the word 'zoom' earlier in my decision and whichever meaning is given to the word within each of the marks it will be the same for each. Whilst I appreciate that conceptual comparisons are usually done without reference to the goods/services at issue,<sup>56</sup> the consumer does look to the

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<sup>56</sup> EMILIANA, Case BL O/052/22.

goods or services, however, to give context to the meaning of marks, particularly where the conceptual meaning of the mark alludes to the services to which they relate.<sup>57</sup> In my view given the nature of the services at issue I consider that consumers are more likely to perceive the meaning of the element Zoom to ‘doing something very quickly’. The device in ZDS’ mark merely reinforces this meaning that it alludes to deliveries being made quickly. Consequently, the 080 mark and the contested mark are nigh on identical conceptually or if not at least highly similar. The use of the additional words ‘by Ocado’/ ‘OCADO’ in the remainder of the earlier marks creates a conceptual distinction, but since this element has no known meaning this element will be conceptually neutral, other than being perceived by the average consumer as denoting the house brand ultimately responsible for the services.

### **Distinctive character**

93. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the services will possess a low degree of distinctiveness. Conversely invented words with no association to the services are highly distinctive. The more distinctive the earlier marks (either per se or by the use that has been made of them) the greater the likelihood of confusion.<sup>58</sup>

94. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, 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).

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<sup>57</sup> LIGHT VITAMIN, Case BL O/1174/25.

<sup>58</sup> *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

## **Crowded market argument**

95. In so far as ZDS' claim that the market is crowded with Zoom marks such that the distinctiveness of this element is weakened, the evidence produced by Mr Watt relates to marks listed on the UKIPO register. However, it does not demonstrate that the majority of those marks are in use, nor that they operate in the same commercial fields as the parties. Although some evidence of use of zoom formative marks was produced, much of it was undated or dated after the relevant period when Mr Watt completed his statement. The engagement by consumers to these entities was also limited, and therefore the evidence is of limited probative value in establishing that the distinctive character of the common element zoom has been weakened.

96. Further, as Ms Fielding suggested, it is impossible to determine from the material provided whether any third-party commercial agreements are in place between the respective third parties which enables them to coexist on the market. Very little evidence was produced to show that the shared element "ZOOM" has become weak or descriptive through widespread third-party use.

97. The mere existence of other marks, therefore, whether on the register or in limited use does not negate the similarities between the parties' marks or the overlap in their respective services as aforementioned. Consequently, I reject ZDS's contention regarding its crowded market argument.

98. Moving on to deal with the inherent position first. As outlined, the 080 Mark consists of the stylised word Zoom. I have already found that the stylisation and colour are not particularly distinctive and therefore the mark is dominated by the word Zoom itself. Being an ordinary English dictionary word whilst I found that it was not descriptive, it is nevertheless allusive of the services in that they will be regarded as being provided quickly/at speed. Consequently, I consider that the 080 Mark is inherently distinctive to between a low and medium degree. In so far as the 079, 872 and 948 marks are concerned, the word zoom is presented with the element OCADO/ 'by Ocado' which gives the impression of a sub brand and house brand. However, the element Ocado is a word which has no known meaning in and of itself and is not descriptive or allusive of the services. Consequently, when seen as a whole, these marks will be inherently distinctive to a high degree. The additional device in the 079 Mark is not particularly

distinctive in itself and therefore does not enhance the inherent distinctive character of this mark to any greater degree than that which I have already found.

### **Enhanced Distinctive Character**

99. In so far as Ocado's claim to enhanced distinctive character it filed evidence from Mr Dean to support this claim, which I have outlined at paragraphs 46 to 60. At the hearing Ms Fielding limited Ocado's claim to enhanced distinctive character only to the 872 Mark, namely the figurative 'Zoom by Ocado' mark.

### **Assessment of the Evidence**

100. Ocado contends that the evidence demonstrates longstanding, extensive, and nationwide use of the Zoom by Ocado mark, establishing strong goodwill, widespread consumer recognition, and continuous brand promotion. While I accept that the evidence clearly supports such a finding in relation to the OCADO brand solus, I am not persuaded that the same conclusion can be drawn in respect of the Zoom by Ocado mark or the Zoom element solus.

101. The services provided under the zoom marks are limited geographically to London. Whilst it is said to have expanded to Leeds, the evidence relating to this is dated from December 2022 to March 2023, after the relevant date. No turnover figures or sales data have been provided specifically for the Zoom sub-brand and only generic global figures for the Ocado group overall have been provided. Although it is reasonable to assume that some portion of Ocado's overall turnover, which runs into billions of pounds, can be attributed to its Zoom delivery service, the absence of any breakdown together with the launch only having taken place in 2019, makes it impossible for me to assess with any degree of certainty, as to the size and commercial significance of the Zoom operation within the wider Ocado business. Mr Dean himself in an interview in November 2022 admitted that "it's been a slow first few years for the rapid grocer, but now launching in Leeds hopes that's about to change". The article also comments that "it has struggled to grow". This does not suggest to me that its zoom brand has the extent of recognition as claimed (either solus or as part of Zoom by Ocado). Whilst I note that the zoom app has been downloaded over 50,000 times, this information was captured as at 24 May 2023 and is not indicative of the position as at the relevant date. I cannot be certain as to when those downloads had occurred,

they may have been downloaded after the relevant date and this would seem to accord with the launch of the new logo. No details are provided as to how many of the flyers, which were circulated to households in and around London to promote the launch, resulted in actual zoom customers as opposed to Ocado's. I have no details regarding the number of actual zoom customers Ocado has, details as to the number of deliveries that were made, or the turnover or sales figures relating specifically to the zoom brand as opposed to the Ocado brand.

102. If, as Mr Dean asserts, the Zoom by Ocado brand enjoyed the extensive reputation claimed, it would have been straightforward to produce evidence clearly demonstrating that reputation. As Phillip Johnson, sitting as the Appointed Person, observed in SACURE (BL O/360/20):

*“31. It is important to remember that the burden of establishing a reputation for the purposes of section 5(3) falls on the proprietor of the earlier mark. For a mark with an established reputation this may not be ‘a particularly onerous requirement’ to satisfy [...]. However, this does not mean that the proprietor of an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the applicant. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time-consuming) where a mark has the necessary reputation.”*

103. The lack of such evidence suggests that its reputation and recognition is not as widespread as contended. I therefore conclude that, whilst Ocado has clearly demonstrated a substantial reputation in the OCADO brand, I am not satisfied that this extends to its ‘Zoom by Ocado’ mark as a whole or the zoom brand itself, absent Ocado. The evidence does not show that zoom has become independently distinctive or recognised beyond its use in combination with Ocado. In light of this I do not find that Ocado holds a reputation in the Zoom by Ocado mark which would apply equally to the requisite enhanced distinctive character claim because the evidence used to prove reputation is the same as for enhanced distinctiveness [CX02 Trade Mark, BL O/393/19 at paragraph 39]. Enhanced distinctiveness requires recognition of the mark by the relevant public. A party who is unable to show that the earlier mark is known to

a significant proportion of the relevant public is unlikely to be able to show that the distinctiveness of the mark has been materially enhanced through use.

104. Consequently, in so far as Ocado's claim to an enhanced distinctive character, the evidence does not support this contention and if it does then it is only in respect of the element Ocado and not in the Zoom element independently or when used in combination.

105. I remind myself that the assessment of a likelihood of confusion is made based on the common element and the distinctiveness of that element relative to the mark when seen as a whole, which in this case, in relation to the element Zoom solus I have found to be inherently distinctive to between a low and medium degree. I shall bear this in mind as one of the global factors to be taken into account when undertaking the assessment as to whether there is a likelihood of confusion.

### **Likelihood of confusion**

106. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective services originate from the same or a related source.

107. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind. Mr James Mellor, as the Appointed Person, directed that a common sense approach should be undertaken in any assessment where "every comparison must be conducted according to the approach laid down in the CJEU case

law and every comparison will depend on its own facts” applying “the well-established propositions for assessing the visual, aural and conceptual similarities.”<sup>59</sup>

108. The difference between the two types of confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*<sup>60</sup>

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

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<sup>59</sup> *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20.

<sup>60</sup> BL O/375/10.

or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

109. I bear in mind that the examples as set out by Mr Purvis in *L.A. Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.<sup>61</sup> Furthermore, in *Liverpool Gin*, Arnold L.J. pointed out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. A finding of indirect confusion should not be made merely because two marks share a common element; it is not enough that one mark merely calls to mind another, this is mere association, not indirect confusion.<sup>62</sup>

110. Earlier in my decision I found that the 080 Mark and the contested mark were visually similar to a high degree and aurally and conceptually identical. In terms of the other earlier marks I found the degree of visual, aural and conceptual similarity to be reduced primarily as a result of the presence of the element OCADO/ ‘by Ocado’. I found the respective services to be identical on the principles in *Meric* and the selection process was primarily visual with an average degree of attention undertaken although I did not discount aural considerations. I found that the 080 Mark and the common element ‘Zoom’ within the other marks enjoyed between a low and medium degree of inherent distinctive character but did not find that the 872 Mark enjoyed an enhanced degree of distinctive character - any reputation/enhanced distinctiveness was held in the element OCADO solus.

111. Taking account of these conclusions, I remind myself that I must assess the matter as to how the marks are perceived on first impressions and from the perspective of the consumer’s immediate and instinctive reaction to the marks on first encounter.<sup>63</sup>

112. Dealing with the comparison between the contested mark and the 080 Mark first. Taking into account my conclusions, I consider that as a result of the word Zoom being

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<sup>61</sup> *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

<sup>62</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>63</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

the identical and dominant element of both marks, combined with identical services and consumers paying an average (medium) level of attention they are likely to mistake or imperfectly recall the marks one for the other. Given that the respective marks are unlikely to be compared side by side this would mean that the differences that I have identified (the stylisation and the device) are unlikely to be accurately recalled or remembered. I have reached this conclusion despite the 080 Mark being inherently distinctive only to between a low and medium degree. The marks will be identified by the average consumer by the word 'zoom' as an indicator of trade origin. This in my view will lead the average consumer to directly confuse the marks one for the other.

113. If the device in the contested mark and the stylisation in the 080 Mark are noticed by consumers, then in my view they will put this down to a different mark being used by the same or related entity or an adaptation or new version following a rebrand. The differences are in my view insufficient to distinguish between the marks, given that it is the word zoom that dominates throughout. Consequently, I find that there would also be a likelihood of indirect confusion.

114. In so far as the other marks under consideration the marks share the same common element 'zoom' but also include additional words and a device. In this regard I remind myself that it is the distinctiveness of the common element which is key. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

115. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

116. Whilst I have found that the element ‘Ocado’ has enhanced the inherent distinctive character of the earlier marks when regarded as a whole, I do not accept that this has been extended to the zoom element solus or the use of this element in combination with ‘by Ocado’/OCADO. It is the Ocado element if anything that has been shown to have enhanced its distinctive character and not the common element. Consequently, the evidence and my findings in this regard do not help Ocado since the enhanced distinctiveness is provided by an aspect of the mark which has no counterpart in the contested mark. However, as will become clear this finding in reality is not material to the conclusion I have reached, in light of the other global factors.

117. In so far as the other marks under consideration particularly the 872 and 079 marks, I found that the similarities between the respective marks were further away due to the presence of the additional elements. However, the inclusion of ‘by Ocado’ creates an impression of a sub brand used alongside a house brand. Consequently, whilst the differences created by the ‘by Ocado’ element may be noticed, the element ‘Zoom’ itself is likely to be mistakenly recalled for the reasons already given. As a result, consumers when coming across the respective marks are likely to believe that the services originate from the same or economically linked undertaking, leading to a likelihood of indirect confusion. This conclusion applies notwithstanding that it is the ‘Ocado’ element which has gained recognition amongst the public and it is the distinctiveness of this element which has been enhanced. This is because when the 872 and 079 marks are considered as wholes, the element Zoom dominates the overall impression of these earlier marks due to its size and position. Therefore, despite the element Zoom only being inherently distinctive to between a low and medium degree it will have the greatest impact on consumers, particularly for those who encounter the marks visually. Moving on to consider the contested mark and the 948 Mark. I found the degree of similarity was further away still, because the common

element ZOOM in the 948 Mark is presented as the second word, and it is therefore the less dominant element relative to the word OCADO in the overall impression of the mark. However, given that the word ZOOM qualifies the word OCADO and the word ZOOM is the dominant element in the contested mark I still would find indirect confusion for the same reasons, as I have already outlined.

118. Consequently, for those consumers already familiar with the 'Zoom by Ocado' /OCADO ZOOM marks, they will believe that the services provided under the contested mark, are from one and the same undertaking or a related entity. For example, Ocado's marks will be perceived as use of the sub brand used in conjunction with the house brand, and the contested mark as use of the sub brand solus.

### **Section 5(3)**

119. Section 5(3) of the Act states:

"A trade mark which-

(a) 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 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

120. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, Ocado must show that the earlier marks are similar to ZDS' mark. Secondly, Ocado must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in

the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. I note for the purposes of its 5(3) ground that Ocado relied solely on its 080 and 872 marks. For the purposes of section 5(3) the relevant date for the assessment is 1 September 2022.

### **Similarity between the marks**

121. In light of my earlier findings this first condition is satisfied. I found the marks to be similar overall visually, aurally and conceptually.

### **Reputation**

122. In *General Motors*, Case C-375/97, 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 required 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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

123. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the

market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”<sup>64</sup>

124. Before turning to consider whether Ocado has shown to hold a reputation I need to consider Ocado’s claim, only advanced under section 5(3), that it operates a family of marks, and that use by ZDS of the contested mark would mislead the public that it is part of the same family.

125. In the present case, I do not accept the argument that the earlier rights relied upon constitute a family of marks. To establish a family, the marks must share a distinctive common element that forms a recognisable pattern, enabling consumers to perceive them as coming from the same undertaking. The mere presence of a common element, configured in different ways does not automatically create a family of marks. A family of marks requires more than the shared use of a particular component: it requires a regular and consistent pattern in which the common element is combined with additional elements in a way that consumers would recognise the pattern and associate it with a single source.

126. It is not enough for a proprietor simply to own a number of similar-looking marks incorporating the same common element. To succeed a proprietor must show that they have marketed the marks in a way that educates consumers to see them as related and also demonstrate that the relevant public actually perceives that the marks form part of a wider family deriving from a common root denoting commercial origin. Based on the evidence and submissions before me, I do not accept Ocado’s pleaded case that the earlier marks constitute a family of marks. In my view, the average consumer would merely regard the marks as the same ZOOM mark but presented in different guises, namely with or without the words ‘by Ocado’ indicative of a house brand. The family of marks’ argument therefore takes Ocado’s claim no further.

127. I note that the assessment of whether Ocado holds a reputation for the services claimed is a different test to the one undertaken for an enhanced level of distinctive character, but in reality they rarely produce different outcomes. I have summarised Ocado’s evidence at paragraphs 46 to 60, in relation to its claim to enhanced distinctiveness, which in light of my findings will apply equally to the assessment of

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<sup>64</sup> *General Motors* para 27

whether it holds a reputation. For the same reasons, I do not find that Ocado has shown that as at the relevant date it has demonstrated it holds a reputation in its services under its Zoom/Zoom by Ocado marks as opposed to the reputation it holds in the element Ocado solus. Consequently, Ocado's claim under section 5(3) falls at the first hurdle. Without being able to show a reputation in the marks at issue then no link or damage can be found. Ocado's section 5(3) claim fails.

### **Overall conclusion**

128. ZDS' invalidation action has failed in its entirety. Ocado's 3760080 Mark shall remain registered.

129. Ocado's claim has succeeded in full but only in relation to its claim brought under section 5(2)(b). The consequence of which is that application no. 3848907 shall be refused registration.

### **Costs**

130. Having succeeded Ocado is entitled to a contribution towards its costs, in accordance with the scale as set out in TPN 1/2023.<sup>65</sup> I note however that whilst it succeeded in defending against the invalidation action it only succeeded in the opposition under its section 5(2)(b) claim. I have therefore taken these matters into account when making my assessment. Consequently, I award as follows:

Preparing an opposition and defence/counterstatement and considering the other side's pleadings:	£500
Preparing evidence and considering ZDS' evidence:	£800
Preparing and attending a hearing:	£800
Official fee:	£100

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<sup>65</sup> The new scale applies to proceedings commenced on or after 1 February 2023.

**Total**

**£2,200**

131. I order ZDS Ltd to pay Ocado Innovation Limited the sum of £2,200 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 31<sup>st</sup> day of March 2026**

**Leisa Davies**

**For the Registrar**

## Annex

UKTM 3760080

Class 9: Computer software; network software; computer operating programs; mobile apps; mobile and online applications; downloadable applications for use with mobile devices; downloadable computer software applications; application software for mobile phones; none of the aforesaid goods relating to electric locks and helmets and their parts; all of the aforesaid relating to online supermarket delivery services; all of the aforementioned goods not relating to the field of automotives.

Class 35: The bringing together, for the benefit of others, of a variety of goods all connected with the sale of foodstuffs, meat, fish, meat extracts, fresh fruits and vegetables, preserved fruits and vegetables, dried fruits and vegetables, cooked fruits and vegetables, dairy products, bread and pastry products, sweets and confectionery, pasta and noodle products, cereals, prepared meals and puddings, ingredients for making prepared meals and puddings, baby food, snack foods, foodstuff for pet animals, flowers, condiments, herbs, grains, nuts, preserves, eggs, edible oils, edible fats, beverages, alcoholic beverages, coffee, tea, milk, tobacco products, beauty products, cosmetics, soaps, creams, toiletries, cleaning and laundry products, bleaching preparations and other substances for laundry use, cleaning, detergent, disinfectant, stain removers, over-the-counter pharmaceutical preparations, sanitary preparations for medical purposes, plasters, balms, absorbent cotton, absorbent wadding, baby products, disposable diapers, napkins, towels of paper, vitamins and minerals, machines for household use, hand tools, photographic films, batteries, domestic electrical and electronic equipment, domestic appliances, stationery and books, leather pet collars, leather pet leads, leather pet harnesses, leather bags, leather purses, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, haberdashery, toys and games enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site and downloadable software application; provision of information to customers and advice and assistance in the selection of goods brought together as above; organisation, operation and management of customer loyalty and incentive schemes; operation and supervision of sales

incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; online advertising on a computer network; market research and marketing services; business information; advisory services for business management; computerised file management; compilation, storage, analysis and retrieval of information and data; compilation and systemisation of information into computer databases; compilation and arranging of statistical information; price comparison services; price analysis services; compilation and provision of price, feature and suitability information relating to goods and services; dissemination of statistical information; rental of advertising space; presentation of goods on communication media, for retail purposes; commercial information and advice for consumers; sales promotion for others; distribution of samples; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; processing of data and of information by electronic means; all of the aforementioned services not relating to the field of automotives.

Class 39: Delivery of goods; transportation of goods; transportation logistics; distribution of goods; packaging and storage of goods; information about journeys, tariffs, timetables and methods of transport; tracking services relating to transportation and delivery of goods; reservation and arrangement services relating to the transportation of goods; packaging of goods and arranging the collection of goods; click and collect services for the collection of goods; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; all of the aforesaid for commercial delivery services.

UKTM 3771872

Class 9: Computer software; network software; computer operating programs; mobile apps; mobile and online applications; downloadable applications for use with mobile devices; downloadable computer software applications; application software for mobile phones; none of the aforesaid goods relating to electric locks and helmets and their parts; all of the aforesaid relating to online supermarket delivery services; all of the aforementioned goods not relating to the field of automotives.

Class 16: Printed matter; printed publications; magazines; journals; containers, cartons, boxes, packaging, wrapping, tubes, tags, labels, badges, wine carriers made of paper or cardboard; plastic shopping bags; paper shopping bags; all of the aforementioned goods not relating to the field of automotive.

Class 35: The bringing together, for the benefit of others, of a variety of goods all connected with the sale of foodstuffs, meat, fish, meat extracts, fresh fruits and vegetables, preserved fruits and vegetables, dried fruits and vegetables, cooked fruits and vegetables, dairy products, bread and pastry products, sweets and confectionery, pasta and noodle products, cereals, prepared meals and puddings, ingredients for making prepared meals and puddings, baby food, snack foods, foodstuff for pet animals, flowers, condiments, herbs, grains, nuts, preserves, eggs, edible oils, edible fats, beverages, alcoholic beverages, coffee, tea, milk, tobacco products, beauty products, cosmetics, soaps, creams, toiletries, cleaning and laundry products, bleaching preparations and other substances for laundry use, cleaning, detergent, disinfectant, stain removers, over-the-counter pharmaceutical preparations, sanitary preparations for medical purposes, plasters, balms, absorbent cotton, absorbent wadding, baby products, disposable diapers, napkins, towels of paper, vitamins and minerals, machines for household use, hand tools, photographic films, batteries, domestic electrical and electronic equipment, domestic appliances, stationery and books, leather pet collars, leather pet leads, leather pet harnesses, leather bags, leather purses, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, haberdashery, toys and games enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site and downloadable software application; provision of information to customers and advice and assistance in the selection of goods brought together as above; organisation, operation and management of

customer loyalty and incentive schemes; operation and supervision of sales incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; online advertising on a computer network; market research and marketing services; business information; advisory services for business management; computerised file management; compilation, storage, analysis and retrieval of information and data; compilation and systemisation of information into computer databases; compilation and arranging of statistical information; price comparison services; price analysis services; compilation and provision of price, feature and suitability information relating to goods and services; dissemination of statistical information; rental of advertising space; presentation of goods on communication media, for retail purposes; commercial information and advice for consumers; sales promotion for others; distribution of samples; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; processing of data and of information by electronic means; all of the aforementioned services not relating to the field of automotives.

Class 39: Delivery of goods; transportation of goods; transportation logistics; distribution of goods; packaging and storage of goods; information about journeys, tariffs, timetables and methods of transport; tracking services relating to transportation and delivery of goods; reservation and arrangement services relating to the transportation of goods; packaging of goods and arranging the collection of goods; click and collect services for the collection of goods; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; all of the aforesaid for commercial delivery services.

UKTM 3760079

Class 9: Computer software; network software; computer operating programs; mobile apps; mobile and online applications; downloadable applications for use with mobile devices; downloadable computer software applications; application software for mobile phones; none of the aforesaid goods relating to electric locks and helmets and their parts; all of the aforesaid relating to online supermarket delivery services.

Class 12: Vehicles; cars; vans; delivery vans for commercial delivery services; motor bikes for commercial delivery services; bicycles for commercial delivery services; electric bicycles for commercial delivery services.

Class 35: The bringing together, for the benefit of others, of a variety of goods all connected with the sale of foodstuffs, meat, fish, meat extracts, fresh fruits and vegetables, preserved fruits and vegetables, dried fruits and vegetables, cooked fruits and vegetables, dairy products, bread and pastry products, sweets and confectionery; pasta and noodle products, cereals, prepared meals and puddings, ingredients for making prepared meals and puddings, baby food, snack foods, foodstuff for pet animals, flowers, condiments, herbs, grains, nuts, preserves, eggs, edible oils, edible fats, beverages, alcoholic beverages, coffee, tea, milk, tobacco products, beauty products, cosmetics, soaps, creams, toiletries, cleaning and laundry products, bleaching preparations and other substances for laundry use, cleaning, detergent, disinfectant, stain removers, over-the-counter pharmaceutical preparations, sanitary preparations for medical purposes, plasters, balms, absorbent cotton, absorbent wadding, baby products, disposable diapers, napkins, towels of paper, vitamins and minerals, machines for household use, hand tools, photographic films, batteries, domestic electrical and electronic equipment, domestic appliances, stationery and books, leather pet collars, leather pet leads, leather pet harnesses, leather bags, leather purses, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, haberdashery, toys and games enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site and downloadable software application; provision of information to customers and advice and assistance in the selection of goods brought together as above; organisation, operation and management of customer loyalty and incentive schemes; operation and supervision of sales

incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; online advertising on a computer network; market research and marketing services; business information; advisory services for business management; computerised file management; compilation, storage, analysis and retrieval of information and data; compilation and systemisation of information into computer databases; compilation and arranging of statistical information; price comparison services; price analysis services; compilation and provision of price, feature and suitability information relating to goods and services; dissemination of statistical information; rental of advertising space; presentation of goods on communication media, for retail purposes; commercial information and advice for consumers; sales promotion for others; distribution of samples; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; processing of data and of information by electronic means.

Class 39: Delivery of goods; transportation of goods; transportation logistics; distribution of goods; packaging and storage of goods; information about journeys, tariffs, timetables and methods of transport; tracking services relating to transportation and delivery of goods; reservation and arrangement services relating to the transportation of goods; packaging of goods and arranging the collection of goods; click and collect services for the collection of goods; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets.

UKTM 3307948

Class 9: Computer software; network software; computer operating programs; mobile apps; mobile and online applications; downloadable applications for use with mobile devices; downloadable computer software applications; application software

for mobile phones; all of the aforesaid relating to online supermarket delivery services.

Class 11: Refrigerated containers, units, bins, pallets, boxes and storage systems; freezer containers, units, bins, pallets, boxes and storage systems; parts and fittings for all the aforementioned goods.

Class 12: Vehicles; cars; vans; delivery vans; parts and fittings for all the aforementioned goods.

Class 16: Printed matter; printed publications; magazines; journals; containers, cartons, boxes, packaging, wrapping, tubes, tags, labels, badges, wine carriers made of paper or cardboard; plastic shopping bags.

Class 20: Bins, boxes and containers made of plastic or predominantly made of plastic; bins, boxes and containers made of plastic or predominantly made of plastic for storage and retrieval by conveying machines in warehousing; parts and fittings for all the aforementioned goods.

Class 35: The bringing together, for the benefit of others, of a variety of goods all connected with the sale of foodstuffs, meat, fish, meat extracts, fresh fruits and vegetables, preserved fruits and vegetables, dried fruits and vegetables, cooked fruits and vegetables, dairy products, bread and pastry products, sweets and confectionery; pasta and noodle products, cereals, prepared meals and puddings, ingredients for making prepared meals and puddings, baby food, snack foods, foodstuff for pet animals, flowers, condiments, herbs, grains, nuts, preserves, eggs, edible oils, edible fats, beverages, alcoholic beverages, coffee, tea, milk, tobacco products, beauty products, cosmetics, soaps, creams, toiletries, cleaning and laundry products, bleaching preparations and other substances for laundry use, cleaning, detergent, disinfectant, stain removers, over-the-counter pharmaceutical preparations, sanitary preparations for medical purposes, plasters, balms, absorbent cotton, absorbent wadding, baby products, disposable diapers, napkins, towels of paper, vitamins and minerals, machines for household use, hand tools, photographic films, batteries, domestic electrical and electronic equipment,

domestic appliances, stationery and books, leather pet collars, leather pet leads, leather pet harnesses, leather bags, leather purses, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, haberdashery, toys and games enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site; provision of information to customers and advice and assistance in the selection of goods brought together as above; organisation, operation and management of customer loyalty and incentive schemes; operation and supervision of sales incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; online advertising on a computer network; market research and marketing services; business information; advisory services for business management; computerised file management; compilation, storage, analysis and retrieval of information and data; compilation and systemisation of information into computer databases; compilation and arranging of statistical information; price comparison services; price analysis services; compilation and provision of price, feature and suitability information relating to goods and services; dissemination of statistical information; rental of advertising space; presentation of goods on communication media, for retail purposes; commercial information and advice for consumers; sales promotion for others; distribution of samples; information, advisory and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets; processing of data and of information by electronic means.

Class 39: Delivery of goods; transportation of goods; transportation logistics; distribution of goods; packaging and storage of goods; information about journeys, tariffs, timetables and methods of transport; tracking services relating to transportation and delivery of goods; reservation and arrangement services relating to the transportation of goods; packaging of goods and arranging the collection of goods; click and collect services for the collection of goods; information, advisory

and consultancy services relating to the aforesaid services including the provision of such services on line from a computer database or via the Internet or extranets.