

o/0345/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 1589096
IN THE NAME OF TUBEWAY (SALES) LIMITED
FOR THE TRADE MARK:

EASYFIX

IN CLASS 20

— AND —

AN APPLICATION FOR THE REVOCATION THEREOF UNDER NO. 507818

BY

BY KILBURN & STRODE LLP

Background and pleadings

1. Tubeway (Sales) Limited (“**TSL**”) is the registered proprietor of the UK trade mark shown on the cover page of this decision. The trade mark was filed on 26 October 1994 and completed its registration procedure on 9 August 1996. It is registered in respect of the following goods in Class 20:

“Goods of extruded plastics, all for home improvements or DIY purposes; all included in Class 20.”

2. On 20 September 2024, Kilburn & Strode LLP (“**KSL**”) sought revocation of TSL’s trade mark registration on the grounds of non-use based upon sections 46(1)(a) and 46(1)(b) the Trade Marks Act 1994 (“**the Act**”).¹ KSL did not notify TSL of its intention to seek revocation of the mark prior to 20 September 2024.

3. Under section 46(1)(a) of the Act, KSL claims non-use in the five-year period following the date on which TSL’s mark was registered i.e. 10 August 1996 to 9 August 2001, with an effective date of revocation of 10 August 2001 (“**the First Relevant Period**”).

4. Under section 46(1)(b) of the Act, KSL claims non-use in respect of TSL’s mark for three consecutive five-year periods as follows:

	Start date	End date	Effective date of revocation
“Second Relevant Period”	20 September 2009	19 September 2014	20 September 2014
“Third Relevant Period”	20 September 2014	19 September 2019	20 September 2019
“Fourth Relevant Period”	20 September 2019	19 September 2024	20 September 2024

¹ 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.

5. TSL filed a counterstatement denying the grounds of revocation, noting that KSL “made no attempt at contact prior to filing the TM26(N).” In its counterstatement TSL makes the following submission and related request for off-scale costs:

“the Applicant for Revocation has, we submit, effectively speculated by specifying so large a range of years, including years which will cause maximum inconvenience for the Holder in terms of evidence collection - i.e. the years furthest back where records of some companies may be patchy and there is little electronic storage of data. In addition, given that (as we will file evidence of) it would have been very simple for the Applicant for Revocation to at least spot that the registered mark is currently in genuine use, the Holder questions whether this Revocation Action has been filed in a genuine belief that the mark was not in genuine use for all the specified time periods, or to cause maximum inconvenience and expense for the Holder.

With this in mind, the Holder requests that if a decision is rendered in its favour, an award of costs is made in its favour above and beyond the standard scale and/or an award is made in respect of each time period specified in the TM26(N).”

6. Only TSL filed evidence. Neither side filed submissions during the evidence rounds. No hearing was requested and neither party elected to file submissions in lieu of a hearing. This decision is therefore taken following careful consideration of the papers before me.

7. In these proceedings KSL represents itself and TSL is represented by Dummett Copp LLP.

EVIDENCE FILED

8. TSL’s evidence is provided in the witness statement of Oliver Duncan, dated 7 February 2025 and has ten accompanying exhibits labelled OD1 to OD10. Mr Duncan is a director of TSL; his evidence is provided to support TSL’s contention that genuine use of the contested trade mark has been made throughout the relevant periods. I shall refer to TSL’s evidence where necessary in my decision.

DECISION

Legislation and Case Law

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

Section 46

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

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

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

(c) [...];

(d) [...].

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(4) [...]

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

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

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

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

Section 100²

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

10. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*³ as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market*

² Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C-721/18, at paragraphs 73 to 83.

³ [2023] EWCA Civ 1247.

(*Trade Marks and Designs*) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

“106. [...] the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

107. [...] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of

effective and sufficient use of the trade mark on the market concerned: see e.g. *Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

11. In *Awareness Ltd*, the Appointed Person goes on to say that:

“28. [...] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].”

12. The genuine use provision is not there to assess economic success or large-scale commercial use (*MFE Marienfelde GmbH v OHIM*, Case T-334/01). An assessment of genuine use is a global assessment, which includes looking at the evidential picture

as a whole, not whether each individual piece of evidence shows use by itself (*New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, at [53]).

13. I keep the above case law principles in mind when reaching my decision.

Approach

14. TSL's evidence extends across multiple time periods, including material much earlier than the First Relevant Period (dating back to the 1960s and covering each decade through to the registration of the mark in the 1990s, as well as evidence falling within the four relevant periods). However, I will begin by considering the evidence relating to the Fourth Relevant Period, as use proved during that period is sufficient, under section 46(3) of the Act, to avoid revocation. I will return to the other relevant periods only if it becomes necessary to do so.

Interpretation

15. Trade mark applications are classified by reference to the edition of the International Nice Classification in force at the date of application. The contested trade mark was filed on 26 October 1994 and proceeded to registration on 9 August 1996, it was therefore classified by reference to the 6th edition of the Nice Classification, published in 1992 (NCL (6-1992)). Although the Nice Classification has since been revised, changes introduced by later editions are not applied retrospectively to existing registrations. This settled practice, confirmed in *Australian Wine Importers* (6 RPC 311), *Cal-U-Test* (1967 FSR 39), *GE Trade Mark* (1969 RPC 418) and *Avnet Incorporated v Isoact Limited* (1998 FSR 16), requires trade mark registrations to be assessed by reference to Registry practice and classification at the date of their registration.⁴ That approach governs my assessment of the evidence below.

16. For clarity, the Class 20 heading and explanatory note under NCL (6-1992) are set out below. This class includes plastic goods not included in other classes and, this edition expressly includes “*window fittings, not of metal*”⁵):

⁴ See the Classification Guide in the Registry's Manual of Trade Marks Practice (published 23 August 2018; current version updated 15 October 2025), at [3.4].

⁵ Basic no. 200123, in accordance with NCL (6-1992).

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Explanatory Note

This class includes mainly furniture and its parts and plastic goods, not included in other classes.

This Class includes, in particular:

- metal furniture and furniture for camping;
- bedding (for example: mattresses, spring mattresses, pillows);
- looking glasses and furnishing or toilet mirrors;
- registration number plates not of metal;
- letter boxes not of metal or masonry.

This Class does not include, in particular:

- certain special types of mirrors, classified according to their function or purpose (consult the Alphabetical List of Goods);
- special furniture for laboratories (Cl. 9);
- special furniture for medical use (Cl. 10);
- bedding linen (Cl. 24);
- eiderdowns (Cl. 24).

17. Plastics in extruded form “*for use in manufacture*” fell within Class 17 under NCL (6-1992). By way of comparison, the Class 17 heading and explanatory note under NCL (6-1992) are set out below. This class includes, among other things, “*flexible pipes, not of metal*” and, it expressly includes “*weatherstripping / draught excluder strips*”.⁶

Class 17

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

Explanatory Note

This class includes mainly electrical, thermal and acoustic insulating materials and plastics, being for use in manufacture in the form of sheets, blocks and rods.

This Class includes, in particular:

- rubber material for recapping tyres;
- padding and stuffing materials of rubber or plastics;
- floating anti-pollution barriers.

Evidence

18. Before I proceed to assess the evidence relating to the Fourth Relevant Period, I note the following by way of background:

- (1) TSL was formed in 1957 and is a family-run business, now into its fourth generation. It specialises in the manufacture and stock of plastic extrusions in

⁶ Basic no. 170013, in accordance with NCL (6-1992).

PVC. Over the years, the range of products stocked expanded from PVC extrusions into hardware and DIY products, marketed under the Easyfix DIY brand. Its products are manufactured in its factory in Ipswich, Suffolk.⁷

- (2) Archived content from TSL's website describes its products as enabling a wide range of home DIY projects, such as secondary glazing, draught proofing, constructing plastic drawers, and decorating cabinets and wardrobes, "*and many other applications using the comprehensive range of PVC and aluminium sections.*"⁸ It further states that EASYFIX products are sold through independent shopkeepers across the UK, with most ranges supported by point-of-sale dispensers and showcards.⁹
- (3) Mr Duncan's narrative evidence provides the following information (reference to "My Company" is reference to TSL):

"10. With regards to 'goods of extruded plastics', these consist of any of our products (as we also offer additional product categories and products not made of plastic) which are formed through the extrusion production method, namely melting of plastic and forming it into one continuous profile.

11. My Company offers a range of 'standard' sized and angled products for use by consumers in a 'DIY' (Do It Yourself) fashion. My Company also offers products under different brand names which provide more 'bespoke' options, including for B2B purposes.

12. Examples of the relevant goods offered by My Company include (but are not limited to) -

- PVC angled profiles.
- Carpet and flooring edges.
- Draught excluders.
- Furniture components.
- Channels for fixing DIY secondary glazing in place.

⁷ OD4, page 5, dated 28 March 2023.

⁸ OD5, page 24, dated 6 August 2002.

⁹ OD5, page 26, dated 20 October 2011.

- Pipe covers.
- Plastic angles, channels, corner joints, capping, edgings, H Sections, T sections, sliding door tracks, electrical conduit, binding bars, flexible hose.

(4) Further archived website evidence from 2006 breaks down TSL's offerings under the 'TSL Extrusions' brand and the 'EASYFIX' brand as follows:



TUBEWAY (SALES) LIMITED
 Elton Park Business Centre, Hadleigh Road, Ipswich, IP2 0HN, UK.
 Tel: 01473 251051 Fax: 01473 236044 email: sales@tubeway.co.uk



Tubeway Sales Limited are a UK based manufacturing company specialising in PVC extruded profiles and PVC extrusions.	
Please select a Division: TSL Extrusions Easyfix DIY Products Contact Us	
 PVC Excellence with TSL Extrusions	<p>PVC extruded profiles produced to your specification</p> <p>TSL extrusions has a long history of making PVC extruded profiles and PVC extrusions over the forty seven years the Company has been in business in the UK.</p> <p>This experience in PVC extrusion puts TSL out in front when it comes to Customer's own designed profiles.</p> <p>Core values of Quality, Service, Reliability, Flexibility are earned - We've got them!</p>
 Easyfix Products for Outstanding DIY Results	<p>DIY products available from stock</p> <p>Tubeway (Sales) Limited also manufacture and distribute DIY ranges of products under the Easyfix banner.</p> <p>Easyfix products cater for the DIY and hardware market throughout the UK. Apart from PVC extrusions we sell products such as draught seals, tile edge, aluminium, carpet & laminate floor edges, secondary glazing systems and many more.</p>

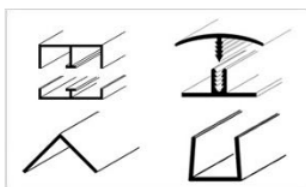
19. Focusing on the Fourth Relevant Period, I note the following from TSL's evidence:

(1) TSL's website evidence dated 7 February 2025 (but with a copyright notice of 1997-2022) provides a comprehensive list of the various product ranges available under the EASYFIX brand, namely (my emphasis for clarity):¹⁰

- EASYFIX ALUMINIUM PROFILES (e.g. extruded aluminium angles, T sections etc.)
- EASYFIX BATHROOM PRODUCTS (e.g. bath seals and shower seals)

¹⁰ OD 2, page 4. Notwithstanding this evidence was obtained outside the relevant period, it bears a copyright notice dated within that period. In any event, it remains relevant in clearly identifying the EASYFIX product ranges. In this regard I note that in general, later evidence still has relevance, particularly if it casts light backwards on the position during the relevant period (see *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*, [2012] EWHC 1929 (Ch)).

- EASYFIX CARPET and FLOORING EDGES (i.e. metal products which edge or join flooring)
- EASYFIX CURTAIN HOOKS and WIRE
- EASYFIX DRAUGHT EXCLUDERS (e.g. products that can be fixed to doors, windows, letterboxes etc. to prevent heat loss)
- EASYFIX FURNITURE COMPONENTS
- EASYFIX GLAZING and ROOFING (e.g. plastic glazing sheets for secondary glazing; polycarbonate and corrugated roofing sheets)
- EASYFIX SECONDARY GLAZING
- EASYFIX PIPE COVER (e.g. trunking to cover copper pipes)
- **EASYFIX PLASTIC EXTRUSIONS** (details and illustrations of this range are provided below):¹¹



EASYFIX PLASTIC EXTRUSIONS

Tubeway manufacture and stock a superb range of Plastic Extrusions, made from rigid and flexible PVC, in many different profiles, colours, sizes and lengths. Plastic Angles, Channels, Corner Joints, Capping, Edgings, H Sections, T Sections, Sliding Door Tracks, Electrical Conduit, Binding Bars Flexible Hose and much more, with pack details and prices all listed. Because of the size of the Easyfix Plastic Extrusion range, these are on a separate website, TubewayExtrusions.com, which includes comprehensive details of production tooling.

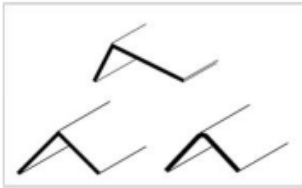
Click through for [Easyfix Plastic Extrusion Product details](#).

- (2) The 'EASYFIX PLASTIC EXTRUSIONS' are detailed further in TSL's website evidence dated 7 February 2025,¹² and the same webpage is also provided with an archive date of 30 January 2021 (within the Fourth Relevant Period).¹³ The products displayed under this range are divided into 11 categories with accompanying images as follows:

¹¹ OD2, page 4.

¹² OD2, page 5 - (again with a copyright notice of 1997-2022)

¹³ OD2, page 12.



Equal, Unequal and External Plastic Angle, Corner Protection, Heavy Duty Angle and Corner Trim

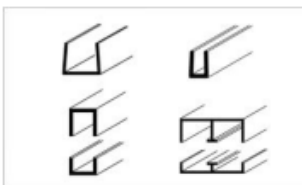
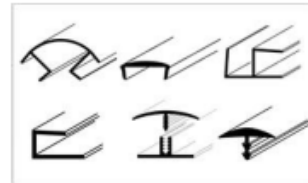


Product Range video on this page

Plastic Capping, Plinth Seal, Clip On Edging, H Section Jointing Strip, Division Bar and Butt Joint, 2 Part H Section Wallboard Jointing, Rigid and Flexible T Barb, Plain Equal T Section, 90 Degree Corner Joint and L Section



Product Range video on this page

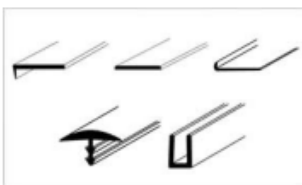
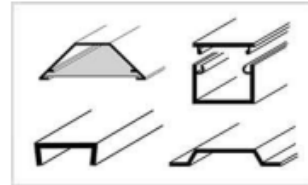


C Section and J Section Capping, Plinth Seal Co-extrusion, Round and Square Plastic Clip On Edging, Double Door Track, Plastic Channel, Sliding Track, Glass and Vivarium Door Runner



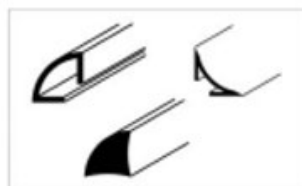
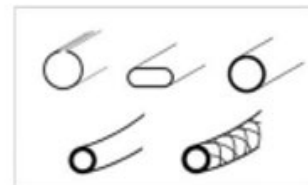
Product Range video on this page

LED Housing, LED Mounting, LED Channel, Electrical Mini Trunking, Micro Trunking, Cable Cover, Electrical Conduit, Round Tube, Oval Tube



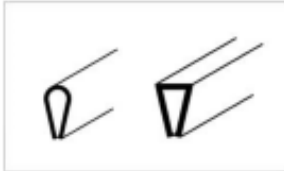
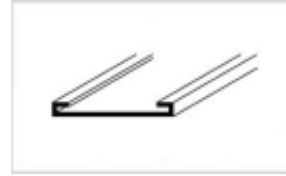
Rigid Flat Plastic Edging, Lipped Edging, Hockey Stick, Flexible Channel, Flexible Flat Edging, Flexible Barbed T Section, Rigid Flat Bar, Flat Strip, Packing Strip

Rigid Round Tube, Rigid Oval Tube, Split Plastic Tube, Flexible PVC Hose, Flexible Tube, Braided PVC Hose, Reinforced PVC Tube, Box Section, Rectangular Tube, Ribbed Tube, Corrugated Tube



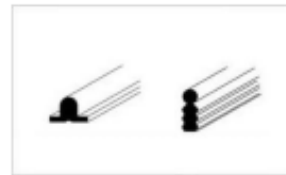
Plastic Scotia, Floor Edge Trim, Hollow Quadrant, Decorative Edge Trim, Solid Quadrant, Edge Beading

Ticket Strip, Label Holder, Data Strip



Binding Bar, Plastic Binder Bar, Poster Hanger, Slide Binder

Miscellaneous Production Technical Drawings, Unusual Extruded Plastic Profiles, T Track, Drawer Track, Insert Track



Double Sided Tape, Self Adhesive Tape, Acrylic Foam Tape, Polyester Clear Tape, High Mass Tape



- (3) The aforementioned archived webpage (dated 30 January 2021) collectively refers to the above products as ‘EASYFIX DIY PLASTIC EXTRUSIONS’ and ‘EASYFIX PLASTIC EXTRUSIONS’, and the webpage displays the following sign in its banner:



- (4) The products referred to as “*plastic extrusions*” are detailed in TSL’s trade price lists, with product codes identifying colour, size and shape (as illustrated by the trade price list effective from 2 January 2024).¹⁴ While the price lists also include goods outside the scope of the registration, which are not relevant to my assessment, such as products made of aluminium, and products proper to Class 17 (for example, flexible pipes and draught excluder strips), the relevant goods of extruded plastics proper to Class 20 are predominantly identifiable by product codes prefixed ‘ER’ (see below by way of example),¹⁵ or, in the case of LED housing and electrical trunking, by the

¹⁴ OD10, pages 8-19.

¹⁵ Ibid., page 8.

prefixes 'LE' and 'MT' respectively. These product codes appear in the invoices, evidencing sales of those "plastic extrusions" during the Fourth Relevant Period.



PVC ANGLES				
EQUAL ANGLES				
Code	Description	Colour	Pack	Trade Price (£)
ER305B1	100mm Angle	Black	3 x 1.00m	37.60
ER305B3	100mm Angle	Black	3 x 3.00m	112.80
ER305W1	100mm Angle	White	3 x 1.00m	37.60
ER305W3	100mm Angle	White	3 x 3.00m	112.80
ER300B1	70mm Angle	Black	5 x 1.00m	26.20
ER300B8	70mm Angle	Black	6 x 2.44m	78.40
ER300B3	70mm Angle	Black	5 x 3.00m	78.40
ER300W1	70mm Angle	White	5 x 1.00m	26.20
ER300W8	70mm Angle	White	6 x 2.44m	78.40
ER300W3	70mm Angle	White	5 x 3.00m	78.40

- (5) Among the EASYFIX trade price lists are products from the EASYFIX 'secondary glazing systems' / 'double glazing systems' ranges. Assessing the evidence as a whole, across all relevant periods, it is apparent that these systems constitute an original and continuing product range sold under the EASYFIX brand. Although distinguished in the evidence from the EASYFIX 'plastic extrusions' range, the secondary glazing systems (aside from the metal 'magnetglaze' variant) are "window fittings, not of metal" and consist of strips of plastic having channels with specific profiles, which, based on Mr Duncan's narrative evidence, I understand to be extruded plastics. These plastic products (identified by the prefixes 'DG', 'SG' and 'EG' in the trade price lists) enable the DIY construction of secondary glazing frames, which are fitted to existing windows to provide additional home insulation. To understand the scope of the range, it has been necessary for me to look at evidence from earlier periods; however, the invoices, when cross-referenced with the product codes, confirm sales during the Fourth Relevant Period.¹⁶ Example product images are shown below:¹⁷



¹⁶ For example, see pages 4 and 5 of OD10.

¹⁷ OD10, page 4.

- (6) Global sales figures for products sold under the EASYFIX brand are provided in Mr Duncan’s witness statement,¹⁸ and show an upward trend throughout the Fourth Relevant Period.¹⁹ Although not broken down by product type, the figures demonstrate significant revenue, averaging in excess of £1 million per year during the Fourth Relevant Period, when considered alongside the price points shown in the trade price lists.
- (7) No evidence is provided as to marketing expenditure. Mr Duncan provides screenshots from TSL’s online instructional videos posted on ‘YouTube’ as examples of marketing activity – they relate to TSL’s ‘EASYFIX’ secondary glazing systems and draught excluder products.
- (8) As to other marketing or promotional activities, Mr Duncan states that TSL uses “a combination of full catalogues, simple price lists, sales representatives, and offer sheets/leaflets”,²⁰ limited examples of which are provided in Exhibit OD10. These include (*inter alia*) the 2 January 2024 price list and promotional material for a new line (see below), although no details are provided as to the extent or dissemination of such materials.



- (9) Mr Duncan notes that the EASYFIX mark has not only been used in plain text format, but also in various other forms throughout the years as follows (I have labelled them A - E for ease of reference):²¹

¹⁸ Paragraph 19 of his witness statement.

¹⁹ See the graphs included in paragraphs 20 and 21 of the witness statement.

²⁰ Paragraph 25 of his witness statement.

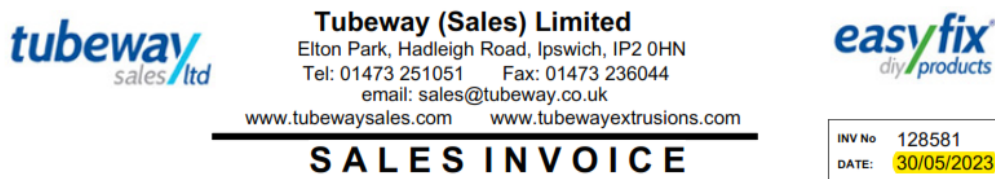
²¹ Paragraph 3 of his witness statement.



(10) Evidence for the Fourth Relevant Period shows: (i) use of the EASYFIX sign in plain text; and (ii) use of sign E shown above, predominantly in that same blue, green and grey colourway, but also in the following colourways:



(11) The evidence shows that within the Fourth Relevant Period, sign E (or a colour variant thereof) is applied to product packaging and labelling as well as point of sale displays. It also appears on TSL's website, product trade price lists, and on invoices. In regard to sales invoices, it appears as a header and is used alongside the 'Tubeway Sales Ltd' logo as follows:



Form of the mark

20. The purpose of the statutory provision on 'variant form' under section 46(2) of the Act, is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing

and promotion requirements of the goods or services concerned. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the aforementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.²²

21. During the Fourth Relevant Period, the evidence shows use of the mark in plain font, this is use of the mark as registered and is clearly use upon which TSL may rely. As noted above, the word 'EASYFIX' is also used in a stylised form (as in sign E). This stylisation falls within the scope of notional and fair use of a word-only mark, since a word mark may be used in any form, in any colour or font type.²³ The addition of the descriptive words 'diy products' does not alter the distinctive character of the registration,²⁴ accordingly, use of sign E (and the other colour variations thereof) constitutes acceptable variant use of the mark upon which TSL may rely. Although the evidence also shows use of EASYFIX and variant E in conjunction with 'TUBEWAY' and/or the 'TUBEWAY' logo shown above, EASYFIX continues to indicate trade origin and such use therefore constitutes use upon which TSL may rely.²⁵

Conclusions on the evidence

22. The evidence is not without shortcomings. The marketing evidence is extremely limited and includes materials relating to draught excluder products that fall outside the scope of the registration. Further, although the global sales figures for products sold under the EASYFIX brand show significant revenue and a continuing increase, they are not broken down by product type. As aluminium products are also sold under the EASYFIX brand, it is not possible to determine precisely the level of sales attributable to goods of extruded plastics. Nevertheless, the invoice evidence demonstrates sales of the relevant goods during the Fourth Relevant Period.

23. Even leaving aside the secondary glazing products which I have interpreted as extruded plastics within the scope of Class 20, my overall assessment of the evidence

²² See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

²³ *La Superquimica v EUIPO*, T-24/17 at [39].

²⁴ See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

²⁵ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

is that it shows genuine use of the contested mark during the Fourth Relevant Period in relation to a selection of extruded plastic goods included in Class 20.

24. I have considered whether it is necessary to apply a fair specification to reflect the use that has been shown. A fair specification limits a registration to reflect the proven use, while still covering goods that are essentially the same, striking a balance between avoiding unjustifiably broad protection and ensuring closely related goods are not excluded.

25. In making that assessment, I have regard to the principles laid down by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, at [245] to [249] when considering partial revocation, and the subsequent proviso to that approach articulated by the Supreme Court in *SkyKick UK Ltd v Sky Ltd* [2024] UKSC 36 at [261].²⁶

26. One of those principles I must bear in mind is that a proprietor cannot reasonably be required to prove use in relation to every possible variation of the goods covered by the registration.²⁷ In that context, although the invoice evidence does not demonstrate sales of every variation of TSL's goods of extruded plastics listed in the trade price lists, requiring such evidence would impose a disproportionate evidential burden and go beyond what can reasonably be expected of a proprietor. The evidence demonstrates use in relation to a selection of extruded plastic goods.

27. In *Titanic Spa*,²⁸ Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. By way of example, Carr J referred to *Pan*

²⁶ The Court of Appeal set out the proper approach to partial revocation in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, at [245]–[249] per Kitchin LJ (as he then was). That approach was subsequently approved by the Supreme Court in *SkyKick UK Ltd v Sky Ltd* [2024] UKSC 36. At [261], Lord Kitchin (as he had by then become) explained that the approach he had set out in *Merck* must be read in light of later CJEU authority, which establishes that the essential criterion for identifying a coherent and independently viewable sub-category of goods or services is their purpose and intended use (see, for example, *Ferrari Spa v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at [36]–[53]). Also see related case law in relation to 'fair specification': *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10; *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47].

²⁷ As explained by Carr J in *Titanic Spa* at [47(vi)], applying the principles set out in *Maier v ASOS Plc* [2015] EWCA Civ 220 at [56] and [60], a principle later affirmed in *Merck* at [247].

²⁸ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47].

World Brands v Tripp Ltd (EXTREME Trade Mark),²⁹ which held that use in relation to holdalls justified a registration for luggage generally.

28. Against that legal background, I do not consider that partial revocation through the framing of a fair specification is appropriate in the circumstances. Moreover, the registered term is not so broad that it can be coherently divided into several independent sub-categories; rather, it already constitutes a specific and coherent category of plastic goods within Class 20, and TSL's genuine use appropriately covers the registered term. To narrow TSL's specification would risk stripping TSL of protection for goods which the average consumer would regard as belonging to the same category as those for which use has been shown and which are not in substance different from them, such that any distinction would be essentially arbitrary.³⁰

29. Accordingly, having regard to the evidence as a whole, I am satisfied that TSL has demonstrated genuine use of the mark in relation to "*goods of extruded plastics, for home improvements or DIY purposes; all included in Class 20*", and therefore retains registration for that specification.

30. Although I have assessed the evidence of use only in relation to the Fourth Relevant Period, the use described above is sufficient to maintain the specification for the other relevant periods by operation of section 46(3) of the Act.

OUTCOME

31. The application to revoke UK trade mark registration number 1589096 is unsuccessful. Subject to any successful appeal, the trade mark shall remain registered.

COSTS

32. TSL has been successful and is entitled to a contribution towards its costs. At the outset of these proceedings, TSL indicated that it would seek an award of off-scale costs if the decision were issued in its favour, and further requested that any award be made by reference to each of the time periods specified in KSL's revocation claim.

²⁹ [2008] RPC 2

³⁰ *Titanic Spa* at [47(vii)], applying the principles set out in *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46, a principle later affirmed in *Merck* at [247].

33. I draw attention to Tribunal Practice Notice (“TPN”) 1/2005, which states that where a revocation applicant relies on more than one five-year period and seeks more than one date of revocation, the registered proprietor is not required to provide proof of use for all periods relied upon. Rather, it need only address the most recent relevant five-year period, as this is likely to reflect the current state of the marketplace or, at the very least, demonstrate use in the most recent period.

34. While TSL did file evidence covering all four relevant periods, it was entitled to focus its case on the most recent period, and to streamline its evidence accordingly. As it transpired, I was able to determine the application on the basis of the evidence relating to the most recent period. I also bear in mind that a portion of the evidence filed was unnecessary, as it related to a period preceding the filing date of the contested registration.

35. There is nothing before me that warrants a departure from the standard scale of costs set out in TPN 1/2023. Costs under that scale are contributory, not compensatory. In all the circumstances, I consider it appropriate to make an award of costs in favour of TSL, calculated on the published scale, as follows:

Considering the notice of revocation and preparing a counterstatement	£300
Preparing evidence	£1,500
TOTAL	£1,800

9. I therefore order Kilburn & Strode LLP to pay Tubeway (Sales) Limited the sum of **£1,800**. This sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of April 2026

Daniela Ferrari
For the Registrar