

O/0394/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3443220

IN THE NAME OF EDUARD TINCU

IN RESPECT OF THE FOLLOWING TRADE MARK

Crittall Style Doors

AND

**AN APPLICATION FOR A DECLARATION OF THE INVALIDITY
THEREOF UNDER NO 505942**

BY

CRITTALL WINDOWS LIMITED

BACKGROUND AND PLEADINGS

1. Trade mark No. 3443220 shown on the cover page of this decision stands registered in the name of Eduard Tincu (“the registered proprietor”). It was applied for by Doors 4 UK Ltd on 11 November 2019 and registered on 31 January 2020 for the following services:

Class 35

Online advertising.

2. On 13 December 2023, the Registry recorded the assignment of the mark from Doors 4 UK Ltd to Nicoleta Tincu as of 21 November 2023. On 18 September 2025, the Registry recorded the assignment of the mark from Ms Tincu to Eduard Tincu as of 10 September 2025. Mr Tincu was formerly a director of Doors 4 UK Ltd.

3. In this decision, I shall refer throughout to “the registered proprietor” except where I am referring to past events involving Doors 4 UK Ltd, when I shall use the term “the first registered proprietor”.

4. On 24 March 2023, Crittall Windows Limited (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) which are relevant in invalidation proceedings under section 47 of the Act.

5. Under sections 5(2)(b) and 5(3), the applicant relies on UKTM No. 902141992, **CRITTALL**, which has an application date of 13 March 2001 and was registered on 25 September 2002. The mark is a UK comparable mark and seniority is claimed from four UK trade marks, the earliest of which has a filing date of 22 June 1928.¹ It is registered for the following goods and services, all of which are relied on:

Class 6

Windows and window frames, doors and door frames, structural members, all made wholly or principally of common metals and parts and fittings for all the above goods; building materials, fittings for buildings, plates, strips, extrusions,

¹ The marks are UKTM No. 492639 (with a filing date of 22 June 1928), UKTM No. 1080724 (with a filing date of 7 July 1977), UKTM No. 1251101 (with a filing date of 27 September 1985) and UKTM No. 1251102 (with a filing date of 27 September 1985).

shaped sections, window and door furniture, clips, bolts, fasteners, hinges and pivots, all made wholly or principally of common metals or of alloys thereof.

Class 19

Windows and window frames, doors and door frames, cladding, structural members all made wholly or principally of non-metallic materials and parts and fittings for all the above goods; building materials, fittings for buildings, plates, strips, extrusions, shaped sections, window and door furniture, clips, bolts, fasteners, hinges and pivots, all made wholly or principally of non-metallic materials.

Class 37

Installation and repair of windows, window frames, doors and door frames; building construction; building repairs.

6. Under section 5(2)(b), the applicant claims that the marks are highly similar, with the dominant and distinctive part of the later mark (CRITTALL) being identical to the earlier mark and the other elements (STYLE DOORS) being non-distinctive. It argues that the registered proprietor's services include online advertising for all the goods covered by the earlier mark, and that the average consumer, seeing the online advertising services offered under the contested mark, would assume there to be an economic connection with the applicant's goods and services. Consequently, it claims that there exists a likelihood of confusion on the part of the public.

7. Under section 5(3), the applicant claims that the earlier mark has a reputation for all the goods and services for which it is registered, and that use of the contested mark, which would be without due cause, would take unfair advantage of, or be detrimental, to the distinctive character and/or reputation of the earlier mark. It argues that damage would occur in one or more of the following ways:

- i) The registered proprietor would unfairly gain a marketing boost from the reputation of the earlier mark;
- ii) There is a risk that members of the public would perceive the parties to be economically connected. Any actions taken by the registered proprietor, such as

the provision of poor services, would risk damaging the reputation of the earlier mark; and/or

iii) The distinctiveness of the earlier mark would be reduced and there is a risk that it may be turned into a generic term. The applicant continues: *“This is particularly the case because the later mark uses the wording CRITTALL STYLE together with the word DOORS which suggests, unfairly and without due cause, that there is such a thing as a ‘crittall style’ door, whereas in fact the trade mark CRITTALL should only be used to designate the genuine goods and services of the applicant for invalidation”*.

8. Under section 5(4)(a), the applicant claims to have used the sign **CRITTALL** throughout the UK since 3 October 1924 for the following goods and services: *Doors and windows and fitting of the same*. It claims that since that date it has been the largest of the three main suppliers of steel-framed windows in the UK and has acquired goodwill under the sign. Use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in the applicant’s business. Consequently, such use would be contrary to the law of passing off.

9. Under section 3(6), the applicant claims that the first registered proprietor had no *bona fide* intention to use the contested mark for the services for which it is registered. It submits that the business of the first registered proprietor, as shown on its website, was the production and sale of doors and frames for doors. The registered services would, in the applicant’s view, be offered by an advertising company, rather than a company that produces doors.

10. The applicant also claims that the registration of the contested mark gives the registered proprietor a defence to claims of trade mark infringement under section 11(1) of the Act, when used on the services for which it is registered. The applicant asserts that the registered proprietor is attempting to use the contested mark to extend the defence to cover the sale of doors themselves, and that this would be an unfair practice and constitute bad faith.

11. The registered proprietor filed a defence and counterstatement denying the claims made. In particular, it denies that the goods and services are similar and claims that the marks are not so similar that they could not co-exist. It also claims that it has not

been made aware of any confusion amongst the relevant public following the registration of the contested mark in 2020 and that there is no reason to believe that the applicant has suffered any damage to its reputation or that the relevant public has made an economic connection between the two marks. Further, it argues that the phrase “Crittall-style doors” is in common usage among retailers to refer to goods that may be similar to those of the applicant. I note here that the registered proprietor has not put the applicant to proof of use of the earlier mark and has not denied that the earlier mark enjoys a reputation for the claimed goods and services, or that the applicant has goodwill arising from use of the sign **Crittall** for the goods and services claimed under section 5(4)(a).

12. The registered proprietor’s defence of the section 3(6) is as follows:

“The Owner does not and has never used the CSD mark in relation to the sale of doors or windows. There is no occurrence of the mark on their website that is in any way connected to sales or goods of any kind. Furthermore, the Owner has no intention of expanding the usage of the mark to encompass the goods offered by the Opponent or any other goods. The Owner wholeheartedly rejects the notion that the CSD mark was registered in bad faith and asserts that they have always acted with integrity.”

13. The matter came to be heard by me by videolink on 3 September 2025. The applicant was represented by Michael Hicks of Counsel, instructed by Williams Powell. The registered proprietor was represented by Stephen Dobson of The Trademark Helpline.

EVIDENCE AND SUBMISSIONS

14. The applicant’s evidence comes from Russell Ager, the Managing Director of Crittall Windows Limited, a position he has held since January 2019. His witness statement is dated 1 December 2023 and is accompanied by 10 exhibits. It goes to the history of the mark, its use and reputation, the claims to goodwill, and actions undertaken by the applicant to protect the earlier trade mark.

15. The registered proprietor's evidence comes from Eduard Tincu, who was the Director of Doors 4 UK Ltd. He held this position since 3 June 2013. His witness statement is dated 9 April 2024 and is accompanied by 4 exhibits. It goes to the history of Doors 4 UK Ltd, the use of the contested mark and perceptions of the word "Crittall".

16. The applicant and registered proprietor also filed written submissions on 27 September 2023 and 9 April 2024 respectively.

RELEVANCE OF EU LAW

17. 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.

PRELIMINARY ISSUES

The contested mark was unopposed

18. At several points during these proceedings, the registered proprietor has noted that the contested mark was registered in 2020 without any opposition. This is not relevant to my consideration of the matter before me. The law provides the option of applying for a declaration of invalidity for the very scenario where, for whatever reason, a party has not been able to oppose the registration of a mark. Therefore, nothing can be read into the mere fact that the contested mark was not opposed.

The Tomlin Order

19. Mr Ager has given evidence on the past dealings between the two parties. He says that the applicant first became aware of the first registered proprietor's use of the phrase "Crittall Style Doors" in September 2019. Several letters were sent to the first registered proprietor, notifying it of the applicant's trade mark rights in "Crittall". These culminated in a Letter before Action dated 26 November 2019.² In January 2020, the

² Exhibits RA8 and RA9.

applicant issued a claim against the first registered proprietor in the Intellectual Property Enterprise Court (“IPEC”). This claim was settled by means of a Tomlin Order dated 1 May 2020 as the parties had agreed to terms of settlement set out in a confidential agreement.³

20. In his skeleton argument filed at 13.59 on 1 September 2025, Mr Dobson requested that I strike out the whole action as an abuse of process and contrary to contractual estoppel or, alternatively, list a short case management conference under Rule 62 of the Trade Marks Rules 2008 to determine appropriate directions. The reason for this was that he said that the confidential settlement to which I have referred in the previous paragraph contains a non-opposition covenant, and that the application for invalidity had been brought in breach of that covenant.

21. I dealt with this point at the start of the hearing. In particular, I asked Mr Dobson to explain why it had only been raised less than 48 hours before the main hearing, rather than earlier in the proceedings. He said that his client had been hoping not to have to fall back on it. He continued:

“However, the Applicant has referenced it and put it in its exhibits and that is why we have asked for this direction now because if the IPO believes that that decision actually supplants anything that is going to be discussed today, then it can save a lot of time and resource on everyone’s side”.⁴

22. I note here that only the Tomlin Order was filed in evidence. I have not had sight of the confidential agreement. Therefore I am unable to say whether it does in fact have the effect that Mr Dobson claims.

23. Mr Hicks submitted that this point should have been raised as soon as the invalidation proceedings had been launched and that it was not satisfactory to bring it up so close to the main hearing. In his view, the hearing should go ahead. If the application for invalidation were thought to breach the terms of the confidential agreement, the appropriate course of action would have been to seek to enforce those terms through the court, as stated in the Tomlin Order itself. He considered that, given the volume of cases that the Tribunal was dealing with, there would be plenty of time

³ Exhibit RA10.

⁴ Transcript, page 3.

to make an application at the court and then my decision could be delayed pending any resolution of that matter. Furthermore, the agreement was between the applicant and the first registered proprietor, not the current registered proprietor. He submitted that both parties had prepared to discuss the substance of the case at this hearing and that a postponement could lead to further delays and the incurring of unrecoverable costs.

24. I agreed with Mr Hicks, given the lateness of the procedural point and the fact that both parties had come prepared to give me oral submissions on the substantive issues of the case. I indicated that it was unlikely that a decision would be issued before 2026 and so an application could be made to the court under the Tomlin Order in the interim. I directed that, if an application were made, the Tribunal should be informed. The Tribunal has not been informed of any such application and so I proceed to give my decision.

DECISION

25. The relevant parts of section 47 of the Act are as follows:

“(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).

...

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless–

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if–

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered–

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes–

(a) 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

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(2D) and (2DA) Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

...

(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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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.”

Section 5(2)(b)

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

“A trade mark shall not be registered if because—

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

27. The registration relied upon by the applicant qualifies as an earlier mark under section 6(1)(a) of the Act. Although it was registered more than five years before the date of application for the contested mark, the registered proprietor has not requested that the applicant prove that the earlier mark has been genuinely used. Consequently,

the applicant may rely on all the goods and services for which the mark stands registered.

28. The following 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 Pairs Europe Inc & Anor* [2025] UKSC 25:

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

g) a lesser degree of similarity between the goods or services may be offset by a 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.

Comparison of goods and services

29. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court (“GC”) said in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, goods and services are complementary when

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

30. The goods and services to be compared are shown in the table below:

Contested services	Earlier goods and services
	<u>Class 6</u> <i>Windows and window frames, doors and door frames, structural members,</i>

Contested services	Earlier goods and services
	<i>all made wholly or principally of common metals and parts and fittings for all the above goods; building materials, fittings for buildings, plates, strips, extrusions, shaped sections, window and door furniture, clips, bolts, fasteners, hinges and pivots, all made wholly or principally of common metals or of alloys thereof.</i>
	<u>Class 19</u> <i>Windows and window frames, doors and door frames, cladding, structural members all made wholly or principally of non-metallic materials and parts and fittings for all the above goods; building materials, fittings for buildings, plates, strips, extrusions, shaped sections, window and door furniture, clips, bolts, fasteners, hinges and pivots, all made wholly or principally of non-metallic materials.</i>
<u>Class 35</u> <i>Online advertising.</i>	
	<u>Class 37</u> <i>Installation and repair of windows, window frames, doors and door frames; building construction; building repairs.</i>

31. Section 60A of the Act states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

32. Therefore, the mere fact that the applicant’s goods and services all belong to different classes from that of the registered proprietor’s service is not sufficient to find that they are dissimilar.

33. In *Extreme Networks Limited v Extreme E Limited* [2024] EWCA Civ 1386, Arnold LJ said:

“17. In Case T-133/05 *Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-2737 the General Court stated at [29] (internal citations omitted):

‘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 the trade mark application ... or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark ...’

The General Court has repeated this in numerous subsequent judgments. It is common ground that the same approach is applicable to the question of similarity: goods or services can be similar to goods or services falling within a more general category in a specification.”

34. With this comment in mind, Mr Hicks submitted that I should treat the registered proprietor's *Online advertising* as online advertising of the particular goods or services covered by the earlier mark.

35. At this point, I consider it helpful to address the question of the meaning of *Online advertising*. The correct approach to construing terms in specifications was summarised by Arnold LJ in *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch):

“56. ...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

36. Advertising is a service provided to companies or other organisations that want to promote the goods and services they offer, with the aim of maintaining or increasing their levels of sales. It achieves this by capturing the attention of potential customers who are then motivated to buy the goods and services directly from the responsible undertaking, or from a third-party retailer. In my view, it encompasses such activities as the development of advertising campaigns, production of the advertisements, dissemination of those advertisements and the selling of advertising space. It should not be confused with retail services, which involve the bringing together of a selection of goods so that they may be conveniently viewed by the customer. I consider that the core meaning of *Online advertising* is the dissemination of advertisements online, for example, by banner advertising on websites, pop ups or providing a website on which advertisements may be viewed. In some instances, such as pop ups, the end

consumer is unlikely to be aware of the origin of that service; but in others, such as websites, they may see indications of origin.

37. Mr Hicks submitted that *Online advertising* was similar to the applicant's goods and services, as the broader term in the contested specification included services for advertising all of the earlier goods and services. He referred me to the decision of the European Union Intellectual Property Office (EUIPO) First Board of Appeal in *ALCAR HOLDING GMBH v Alcar Aktiebolag (alcar.se)*, Case R 378/2018-1. In this case, the competing goods and services included, on the one hand, a range of motor vehicle parts and accessories and, on the other, dealer, retail and advertising services relating to boats and motor vehicles. The Opposition Division had found them to be dissimilar. However, the Board of Appeal said:

“32. It is clear that a specialist in the sale and manufacturing of vehicles has different market knowledge and applies different techniques and needs different contacts compared to a specialist in other areas of business such as foodstuffs, clothing or jewellery. It is therefore accepted that specialised sales services for specific goods are similar to those specific goods, in terms of complementarity and distribution channels. In the present case, the specialised advertising services are rendered to the same types of shops or other outlets, and to the same or similar producers as those for ‘vehicle parts’. The necessary knowledge to render the services of the trade mark applied for overlap with the knowledge necessary to find sales opportunities for vehicle parts, like ‘exhaust systems’.

33. The public could, therefore, establish a connection between the provider of the above services in the application and a provider of the goods such as ‘vehicle parts and accessories’, like ‘anti-theft devices for wheels’. These services are therefore similar to at least a low degree.

34. This reasoning applies to the ‘provision of advertising services’ in Class 35 *mutatis mutandis*.”

38. The decision of the Board of Appeal was upheld by the General Court.⁵

39. The Board of Appeal found that the advertising services would be sold to manufacturers of the goods at issue, but also to the shops and other outlets selling those goods to the end consumer. Both the supplier of the advertising services and the seller of the goods will need to have knowledge about the market for those goods. These areas of knowledge will, therefore, overlap. Because of this, the public could believe that there is a connection between the two undertakings. While the Board of Appeal set out its reasoning in some detail in respect of the retail services, including in paragraphs 30 and 31 that I have not reproduced here, it simply says that it is the same for advertising services as it is for retail services.

40. Mr Hicks made more detailed submissions at the hearing. The example he used was a website advertising windows and doors “*which consists of a showcase on which suppliers can advertise products or a website which has got little adverts down the side*”.⁶ He submitted that the average consumer could think that the same undertaking was responsible for the website and for producing windows and doors and that therefore the goods and services were complementary. He also argued that the average consumer “*may well think that installing and repairing windows, doors and building work generally may also be conducted by someone who provides a website with an advertising showcase of different windows and doors that could be used in a building*”.⁷ Taking *Online advertising of doors and windows* as the example, I consider that the goods are indispensable for the supply of the advertising services, as without the goods there would be nothing to advertise. At the hearing, I asked Mr Hicks whether it was likely that the average consumer would assume that a manufacturer of doors and windows was providing a service that allowed its competitors to advertise their own goods. I still consider that this is unlikely. However, it is possible that a door and window manufacturer that does not sell directly to customers may provide a website, or other online advertising service, for its distributors to use to attract custom. Consequently, I find that there is a degree of complementarity.

⁵ *Alcar Aktiebolag v European Union Intellectual Property Office (EUIPO)*, Case T-77/19. See, in particular, paragraph 41.

⁶ Transcript, page 12.

⁷ *Ibid.*, pages 12-13.

41. The user of the registered proprietor's services may be an undertaking producing and/or selling doors and windows, but they may also be an individual or organisation that wants to purchase those goods. I consider that there is some overlap in user. The purpose of the parties' respective goods and services is different, as is their nature and method of use. The online advertising may be part of the distribution channel through which the applicant's goods or services reach the end consumer. This would be the case where the end consumer uses the advertising website, clicks on to an advert and orders the goods or services from the undertaking that has placed that advert. Finally, I cannot see that there is any competition between the goods and services.

42. In *Extreme Networks*, Arnold LJ said:

“18. There is a large body of pre-Brexit case law of the General Court on similarity of goods and services which, together with relevant domestic case law, is helpfully analysed in Chapter 6 of Fhima and Gangee, *The Confusion Test in European Trade Mark Law* (OUP, 2019). The authors make two points which are pertinent for the purposes of this appeal and which I would endorse. The first is that, although the factors discussed above are frequently interrelated, it is also common for the factors to point in different directions, with some suggesting that the goods or services are similar and some suggesting that they are not. Some of the factors tend to be more influential than others, but this depends on the particular sets of goods or services under consideration. The significance of this point is that it confirms that the tribunal's task is an evaluative one, giving such weight to the various factors as appears appropriate in the specific circumstances of each case.

19. The second point is that it is important to ensure that the ultimate question is kept in view: are these goods or services sufficiently similar to give rise to a likelihood of confusion? A finding that the goods or services are not similar at all implies that there is no possibility of confusion no matter how strongly the other factors in the assessment of likelihood of confusion support the existence of a likelihood of confusion. It is therefore important to guard against the mistake of treating goods or services with a low degree of similarity as dissimilar, just as it is important not to make the opposite

mistake of treating highly similar goods or services as identical (which may lead to a relative rights conflict being wrongly treated as a double identity case where a likelihood of confusion is presumed).”

43. The purpose, nature and method of use of the parties’ goods and services point towards dissimilarity, as does the absence of any competition between them. Weighed against those factors are the overlap in user and trade channels and some degree of complementarity. If the goods were ordinary consumer items, then I may have found that the balance tipped towards dissimilarity. However, I bear in mind that these are specialist goods and services, and this leads me to find that there is some similarity between them, albeit at a low level.

Average consumer and the purchasing process

44. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 26.

45. In *Iconix*, 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:

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They

represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... 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, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed 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. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, 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."

46. The average consumer of the applicant's doors and windows is an individual or organisation making improvements to their buildings or constructing new ones. They may also be a business involved in installation and construction. The average consumer of the registered proprietor's *Online advertising* is a business selling such goods, although I also consider that the end consumer could use a website containing adverts during the process of choosing a supplier of doors and/or windows.

47. I shall deal first with the purchasing process for the doors and windows. The average consumer is likely to make their choice of a supplier after browsing the internet or seeing printed promotional material. They may also receive word-of-mouth recommendations from architects, building contractors or sales staff. In my view, the purchasing process is largely visual, but the aural aspects of the mark must also be considered. Mr Hicks submits that the degree of attention paid is average. I bear in

mind that these goods are purchased infrequently and may be costly. The average consumer will be thinking about the appearance of the goods and how they complement the overall look of the building or room. They may also consider factors such as materials used, energy efficiency and security. On this basis, I find that the average consumer will pay a higher than medium degree of attention. It will be fairly high, but not at the highest level.

48. I turn now to the registered proprietor's online advertising services. In my view, it is likely that the selection process will be largely visual. The average consumer will use the internet, although they may also see other forms of promotional material, such as reviews in printed publications. As with the goods discussed in the previous paragraph, I consider they may also receive word-of-mouth recommendations. These services are likely to be purchased either relatively frequently on an *ad hoc* basis or on a longer contract. The average consumer looking to place advertisements will be interested in the reach of the services, their cost and any contractual requirements. In my view, they would be a higher than medium degree of attention. The average consumer looking to use the advertising services to select a supplier of doors and/or windows will, to my mind, pay a medium degree of attention. This is because they are likely to incur no cost in accessing a website.

Comparison of marks

49. It is clear from *SABEL BV v Puma AG*, Case C-251/95, (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 in *Bimbo SA v OHIM*, Case C-519/12 P, that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

50. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

51. The respective marks are shown below:

Contested mark	Earlier mark
Crittall Style Doors	CRITTALL

52. Both marks are word marks. In *LA Superquimica v EUIPO*, Case T-24/17, the GC held that such plain word marks protected the word or words contained in the mark which may be used in any form, colour or typeface: see paragraph 39. Therefore, the fact that the earlier mark is registered in upper case and the contested mark in title case is not relevant for my comparison.

53. The earlier mark consists of a single word, “CRITTALL”, and therefore the overall impression of the mark rests in that word. The contested mark, on the other hand, is made up of three words. If the mark is used for *Online advertising* for doors, the second and third words are descriptive. The dominant and distinctive element of the mark is the word “Crittall”.

Visual comparison

54. The dominant and distinctive element of the contested mark is identical to the earlier mark. In addition, it appears at the start of the contested mark and average consumers tend to pay more attention to the beginnings of marks than to their ends: see *El Corte Inglés, SA v OHIM*, Joined cases T-183/02 and T-184/02, paragraph 81. I find that the marks are visually similar to a high degree.

Aural comparison

55. The earlier mark has two syllables and is likely to be articulated as “CRIT-ULL” or “CRIT-AL”. It will be pronounced in the same way in the contested mark. I consider that it is likely that all the words in the contested mark will be articulated. It has four syllables, the first two of which are identical to the earlier mark. I find that the marks

are aurally similar to a high degree. If I am wrong in this, and the average consumer only articulates the first word of the contested mark, the marks are aurally identical.

Conceptual comparison

56. Neither party has submitted that “Crittall” has a dictionary definition. The applicant’s evidence is that it was the surname of the founder of the business,⁸ but I consider that the average consumer would believe it to be an invented word and so the earlier mark has no conceptual content. The contested mark, on the other hand, will bring to the mind of the average consumer doors in a particular style, even if they do not know anything about that style. I find that the marks are conceptually dissimilar.

Distinctive character of the earlier mark

57. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented

⁸ Exhibit RA2A, page 4.

words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

59. Mr Dobson, for the registered proprietor, submitted that *“we believe and our client believes that there is a genericism attached to that word [Crittall] now”*.⁹ A registered trade mark must be assumed to have at least some distinctive character: see *Formula One Licensing BV v OHIM*, Case C-196/11 P, paragraphs 41-44. He also characterised “Crittall Style Doors” an industry-wide term.¹⁰ Exhibit ET2 has been adduced to show use of this phrase. It consists of the results of an internet search, with eight items exhibited. These include articles and print outs from e-commerce sites. However, these are all either undated or have a date after the relevant date in these proceedings, which is 11 November 2019. Mr Tincu states that, before making the application, the first registered proprietor conducted market research to find the best name for the service *“and found that the average customer associates metal framed windows and doors with the name ‘Crittall’ even when those products were not manufactured by the opponent”*.¹¹ However, he does not provide any information on the methodology of this research and so I find that the probative value of this evidence is weak in the context of assessing the distinctive character of the earlier mark.

60. In the absence of any evidence showing the position at the relevant date, I consider that at the time of application the average consumer would have perceived the earlier mark to be an invented word with no allusive qualities. Consequently, it has a high degree of inherent distinctive character.

61. Turning now to the question of enhanced distinctive character, I note that the registered proprietor has admitted that the earlier mark has a reputation for steel windows and doors.¹² In *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, Professor Phillip Johnson, sitting as the Appointed Person, said:

“39. ... I agree with the Hearing Officer that reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced

⁹ Transcript, page 19.

¹⁰ *Ibid.*, page 18.

¹¹ Witness statement, paragraph 3.

¹² Registered proprietor’s skeleton argument, paragraph 14.

distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact in each individual case.”

62. I shall say more about the applicant’s evidence when I come to the section 5(3) ground. For the present, as the registered proprietor has admitted reputation, I shall proceed on the basis that the distinctive character of the earlier mark has been enhanced to a very high degree.

Conclusions on likelihood of confusion

63. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. Because this is a global assessment, there is some interdependence between the factors and so a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa.

64. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 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)."

65. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

66. Earlier in this decision, I found that:

- a) the registered proprietor’s services are similar to the applicant’s goods and services to a low degree;
- b) the average consumer may be a business who would pay a fairly high degree of attention in what is largely a visual purchasing process;
- c) if the average consumer is a member of the general public, they are likely to pay a fairly high degree of attention when purchasing doors and/or windows, but only a medium level of attention when using online advertising services;
- d) the marks are visually and aurally similar to a high degree and conceptually dissimilar. If I am wrong on the aural comparison, the marks are aurally identical; and
- e) the earlier mark has a high degree of inherent distinctive character, which has been enhanced to a very high degree through use.

67. Mr Dobson submitted in his skeleton argument that there had been no instances of confusion.¹³ Mr Tincu states that “*Doors 4 UK Ltd has not used the name on its website to date pending the result of these proceedings*”.¹⁴ Mr Hicks submitted that this was not an accurate statement. The Annexes to the Letter Before Action dated

¹³ Paragraph 13.

¹⁴ Witness statement, paragraph 17.

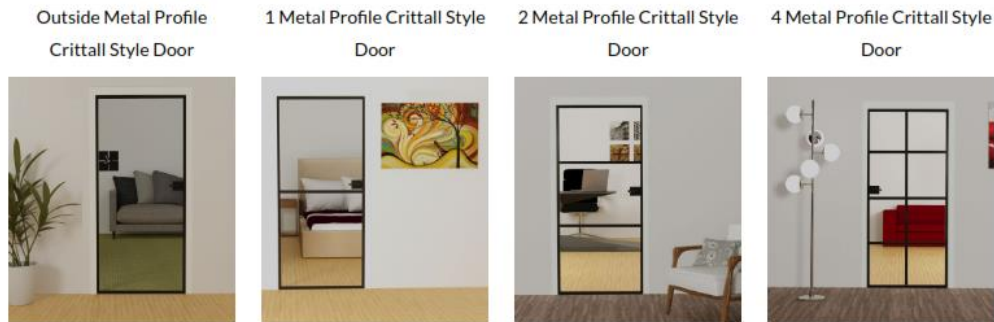
26 November 2019 contain extracts from the first registered proprietor's website. I have reproduced an example below:¹⁵

Crittall Style Doors

The metal-framed windows and doors appeared first on the market in the 1880s and become the best seller in the art deco era. Crittall windows and doors are having today a comeback as patio doors, wall-partitions, kitchen and dining room doors or old-fashioned windows. The aluminium crittall style doors never looked so good and that is why the interior designers love them so much. The minimalist decor which includes brick walls and oak flooring is the perfect environment for any type of crittall style doors, from single hinged ones to elaborated walls that can separate the bedroom from the rest of the house, making easier the transition of light.

Read more about our **premium metal framed doors** (<https://www.doors4uk.co.uk/premium-metal-framed-doors>)

Standard Designs for Crittall Style doors



68. These extracts are not dated, although the Letter Before Action was sent 15 days after the relevant date. At some point, then, the contested mark was being used, albeit not in an origin-specific way, by the first registered proprietor. I am unable to ascertain how long such use lasted. Consequently, I do not see that the alleged absence of actual confusion assists the registered proprietor. In *Maier & Anor v ASOS & Anor* [2015] Kitchin LJ (as he then was) said:

“80. ... the likelihood of confusion must be assessed globally, taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a

¹⁵ Exhibit RA9, page 7.

likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

69. Mr Tincu also states that:

“14. In the past five years of selling metal framed windows and doors, our customers regularly requested a ‘Crittall type of door’ or similar phrasing. ...

15. I estimate that more than half of our customers knew of other competitors, which are not representatives of the Opponent and are manufacturing similar types of doors, and they knew and understood the difference between the products, but still used the term ‘Crittall-Type’ or ‘Crittall-Style’ to identify the general characteristics of the doors.”

70. However, there is no direct evidence from any of these customers and I find it improbable that Mr Tincu knew what was in their minds. Consequently, I give little weight to this part of the witness statement.

71. My concern here is whether consumers will be able to rely on the contested mark, should it be used to identify the origin of the services supplied by the registered proprietor, without there being a likelihood of confusion with the goods or services offered by the applicant. As there is no evidence that the contested mark has been used in this way, I must do this on a notional basis.

72. I have already found that the earlier mark has a very high level of distinctive character. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting 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 of the mark that is identical or similar. There is only one element in the earlier

mark, and I found that this is distinctive element of the contested mark. I found that the average consumer, who is a member of the general public, would only pay a medium degree of attention when using advertising services. Given imperfect recollection, the high degree of visual similarity between the marks and the high degree of distinctive character of the earlier mark, it is my view that there is a likelihood of direct confusion for these consumers, notwithstanding the low degree of similarity between the goods and services. I consider that this is a significant proportion of the relevant public and so the section 5(2)(b) ground would succeed: see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraph 34.

73. In case I am wrong in this finding, I shall proceed to consider the business consumer. I found that they would pay a higher degree of attention, which would diminish the role played by imperfect recollection, without completely ruling it out. However, the additional elements in the contested mark are non-distinctive and the shared element has such a high degree of distinctive character and so I take the view that the average consumer will believe that this is another mark of the applicant. I find that there is a likelihood of indirect confusion.

74. The section 5(2)(b) ground is successful, but in case I am wrong in this finding I will undertake a full examination of the remaining grounds.

Section 5(3)

75. Section 5(3) of the Act is as follows:

“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 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.”

76. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

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

Reputation

77. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on

the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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."

78. I have already noted that Mr Dobson admitted that the earlier mark had a reputation for steel windows and doors at the relevant date of 11 November 2019. I need to address the extent of this reputation and its nature.

79. Mr Ager states that the applicant was incorporated in 1924, but its predecessors in business had been selling steel windows under the name "CRITTALL" since about 1884.¹⁶ He sums up the business as follows:

"4. The business of CWL [Crittall Windows Limited] is and always has included the manufacture and supply of steel framed windows (which are generally known as and which will be referred to in this witness statement as 'steel windows') and the supply of related goods and services. The

¹⁶ Witness statement, paragraph 5.

business includes commercial sales (that is, to architects, owners and developers of commercial projects) and residential sales (that is, to homeowners). It includes new, replacement and replica windows, external doors and interior screens and doors. Its associated services include consultancy, designing, planning, specifying and manufacturing to order its products.”

80. Use has clearly been very long-standing. The applicant’s products are shown to have a clean, elegant, modern style, with an emphasis on light. Mr Dobson also admitted that the applicant’s goods were noted for their high quality.¹⁷ The following images are taken from a 2011 brochure:¹⁸



¹⁷ Transcript, page 21.

¹⁸ Exhibit RA2.



81. The table below shows turnover since 2006:¹⁹

Year ending:	Total Turnover/GBP
31 Dec 2006	9,119,000
31 Dec 2007	9,287,000
31 Dec 2008	10,019,000
31 Dec 2009	11,194,000
31 Dec 2010	9,362,000
31 Dec 2011	7,734,000
31 Dec 2012	9,805,000
31 Dec 2013	10,007,000
31 Mar 2014	8,572,000
31 Mar 2015	10,041,000
31 Mar 2016	10,127,000
31 Mar 2017	12,826,000
31 Mar 2018	13,670,000
31 Mar 2019	14,207,000
31 Mar 2020	10,998,000

¹⁹ Exhibit RA2a.

82. A selection of invoices can be found in Exhibit RA4. They cover the period from 2014 to 2019 and show goods and services supplied to customers in the UK.

83. Mr Ager states that the applicant does not undertake “*extensive*” advertising and marketing.²⁰ The table below shows the marketing expenditure from the years just before the relevant date:²¹

Financial Year Ending	Marketing Expenditure (GBP)
March 2014	157,687
March 2015	195,015
March 2016	196,144
March 2017	190,005
March 2018	208,000
March 2019	317,864
March 2020	240,086

84. Marketing has mainly been done through placing advertorials and advertisements in the trade press. Included in the evidence are examples from 5 January 2015 to 1 January 2018 from publications such as *Housing Specification*, *DABS (Designer – Architect – Builder – Specifier)*, *Building News*, *Selfbuilder & Homemaker* and *Ideal Home*.²² In addition, the applicant’s goods have been featured in television programmes about architecture and design shown on Channel 4, such as *Ugly House to Lovely House*, Series 1 Episode 5, first broadcast on 24 March 2016, and *Renovation Man*, Series 5 Episode 3, first broadcast on 7 October 2019.²³ No viewing figures are given for these programmes. Mr Ager provided a link to them, but, in line with the practice of this Tribunal, I have not used it.

85. Mr Ager states that the applicant has a large share of the UK market for steel windows and doors. During the period 2009 to 2014, its share was estimated to be 41.9%.²⁴ He says that he expects the market share up to the relevant date to be close to this figure. I do not have any information on the size of the market for steel windows

²⁰ Witness statement, paragraph 12.

²¹ Exhibit RA5a.

²² Exhibit RA5.

²³ Witness statement, paragraph 11.

²⁴ Exhibit RA6.

and doors when compared to the market for all windows and doors. Nevertheless, I am satisfied that the evidence shows that among the building trade the earlier mark has a strong reputation for steel windows and doors.

Link

86. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU at paragraph 42 of its judgment in *Intel*. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

87. I have already found the marks to be visually similar to a high degree and aurally similar to a high degree or identical. I found them to be conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

88. I adopt the findings I made under section 5(2)(b). There is, in my view, a low degree of similarity between the contested services and the goods for which the earlier mark has a reputation.

The strength of the earlier mark's reputation

89. I found that the earlier mark has a strong reputation for elegant and modern steel windows and doors among the trade.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

90. Earlier in my decision, I found that the earlier mark had a high degree of inherent distinctive character, which had been enhanced through use to a very high degree.

Whether there is a likelihood of confusion

91. Under section 5(2)(b), I found that there is a likelihood of confusion.

Conclusions on link

92. Where there is a likelihood of confusion, there is automatically a link. Even if I had been wrong to find any similarity between the registered proprietor's *Online advertising* and the applicant's goods and services, I take the view that, where the contested mark is used for advertising the goods and services covered by the earlier mark online, there will be a link, given the reputation and high degree of distinctive character of that earlier mark.

Damage

93. The applicant claims that all three types of damage are likely to occur if the contested mark were used. If I am correct in my finding that there is a likelihood of confusion, the registered proprietor will gain an unfair advantage as consumers will use its services in the belief that they are the responsibility of the applicant, or that there is a connection between the two undertakings.

94. In the event that I am wrong in finding a likelihood of confusion, I still consider that there would be an unfair advantage as the elegant and modern image of the earlier mark would transfer to the registered proprietor's services. The public would assume that the registered proprietor's online advertising services promote goods that have these qualities.

95. I shall also consider whether there is detriment to distinctive character. In *L'Oréal*, the CJEU said:

"39. As regards detriment to the distinctive character of the mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29)."

96. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81, and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38. The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No. 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

97. In *Monster Energy Company v Red Bull GmbH* [2022] EWHC 2155 (Ch), Adam Johnson J said:

“45. ... the Court or tribunal can entirely permissibly draw inferences based on the inherent probabilities and by taking account of normal practice in the

relevant sector and the circumstances of the case. The Court or tribunal cannot proceed on the basis of ‘*mere suppositions*’, but an inference based on the inherent probabilities and the normal practice in the relevant sector will not be a mere supposition. It will be a rational and properly motivated conclusion.”

98. Mr Hicks submitted that there would be a risk of the earlier mark being turned into a generic mark. If the public is not confused by the contested mark, I take the view that they will be led to believe the goods being advertised on the website are similar to the applicant’s goods in appearance and represent a possibly cheaper alternative to doors sold under the earlier mark. I consider it likely that there will be a change in economic behaviour as potential purchasers substitute the applicant’s goods for ones that they have sourced through the registered proprietor’s online advertising service. The earlier mark is likely to become less able to distinguish the applicant’s goods from those of other undertakings. I find that the claim to damage is made out.

99. As I have found detriment to distinctive character and unfair advantage, I shall move quickly over the claim of detriment to reputation. This is a hypothetical argument and I dismiss it for the reasons explained by Ms Anna Carboni, sitting as the Appointed Person, in *Unite The Union v The Unite Group Plc*, BL O/219/13.²⁵

Due cause

100. The registered proprietor has not pleaded that it has due cause to use the contested mark. However, in his skeleton argument, Mr Dobson submitted that:

“16. ... The evidence in ET2 shows descriptive use of Crittall style by independent parties in editorial and retail contexts. Use in accordance with honest practices to identify style in advertising gives due cause.”

101. No request was made to amend the pleadings. I am aware that I could have asked the registered proprietor whether it wished to do so, but considered that it would increase the costs to both parties on a point that was not going to succeed. Furthermore, this point was first raised in the skeleton argument.

²⁵ See, in particular, paragraphs 46-47.

102. In *Leidesplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held that:

“60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.”

103. The evidence filed by the registered proprietor does not meet these conditions. The application for a declaration of invalidity succeeds under section 5(3).

Section 5(4)(a)

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

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

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

105. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

106. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off at [406]:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

107. *Halsbury’s Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged are likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

108. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

“165. ... Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

109. Although the registered proprietor claims the contested mark has not been used, I have found that it was used on the website. However, I do not have any information to tell me when such use started. The website extracts to which I have already referred were attached to the Letter Before Action, issued after the application date for the contested mark. The earliest reference is in the first letter to the first registered proprietor from the applicant dated 26 September 2019. This begins: “*We are writing regarding the use of the word **CRITTALL** (<https://www.doors4uk.co.uk/crittall-style-doors>)*”.²⁶ I shall therefore take this to be the relevant date for the purposes of this ground.

Goodwill

110. The applicant must show that it had goodwill in a business at the relevant date and that the sign relied upon, **CRITTALL**, is associated with, or distinctive of, that business. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

²⁶ Exhibit RA8, page 1.

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

111. The applicant has claimed that it has established goodwill from use of the earlier sign for *Doors and windows and fittings of the same*. On the basis of the evidence already summarised, I am content that the applicant has shown that it has protectable goodwill.

Misrepresentation

112. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].’

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

113. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises*, that the difference between the legal tests will produce different outcomes. I believe that to be the case here.

Damage

114. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ described the requirements for damage in passing off cases at [715]:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

115. Mr Hicks submitted that damage could occur through lost sales, with customers purchasing doors and windows from other undertakings advertising through the registered proprietor’s services, or through the lack of any control over the nature of the online advertising services. In my view, it is likely that the applicant will lose sales.

116. The application for a declaration of invalidity succeeds under section 5(4)(a).

Section 3(6)

117. Section 3(6) of the Act is as follows:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

118. In *Skykick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*, [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He explained that the categories of bad faith and the circumstances which may constitute bad faith are not “closed”, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), paras 46 and 47 [...].”

119. Later in the same judgment, he considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Sky plc & Ors v Skykick*

UK Limited & Anor, Case C-371/18, *AS v Deutsches Patent- und Markenamt*, Case C-541/18, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v EUIPO*, Case T-663/19, *pelicantravel.com s.r.o. v OHIM*, Case T-136/11, and *Psytech International Ltd v OHIM*, Case T-507/08. Lord Kitchin summarised the law as follows:

“240. The general principles are these:

(i) ...

(ii) The date for assessing whether an application to register an EU trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky CJEU*, para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the establishment and functioning of the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton*, para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly

in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; *Deutsches Patent- und Markenamt*, para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/04 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that the infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith

on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

120. Further relevant points arising from the case law are the following:

(a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that “*cogent evidence is required due to the seriousness of the allegation*”. This means that it is not enough to establish facts which are as consistent with good faith as bad faith: see *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

(b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

(c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch), paragraph 167.²⁷

121. The applicant claims that the first registered proprietor can have had no intention to use the contested mark for the services in the specification. In its pleadings, the applicant asserts that the business of the first registered proprietor was the production and sale of doors and door frames and there was no suggestion that it offered online advertising services. It also claimed that online advertising services would be offered by an advertising company, not by a company that produces doors.

122. Mr Hicks also referred me to a passage from Mr Tincu’s witness statement where he says that:

“13. The intended use of the CSD Mark is to make it clear to potential customers via online advertising that the Doors 4 UK Ltd. products were not manufactured by Crittall. Doors 4 UK Ltd. does not want to mislead its customers, so the CSD Mark is used as a type of shorthand to explain the

²⁷ This part of the judgment was approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

style of the doors in a simple and quickly understood manner for the customers.”

Mr Hicks submitted that this indicates a misunderstanding on the part of the registered proprietor, as the intended use was not to provide online advertising services but to assist in the online advertising of the registered proprietor’s own goods. I consider that this is the most plausible interpretation of the paragraph cited above. There does not appear to have been an intention to use the mark to signal the origin of goods or services.

123. At the hearing, Mr Dobson submitted that

“... our client does not make any of these windows or doors, our client does not brand them as Crittall in any way. They are purely an advertising hub for these third-party manufacturers to advertise their goods through...”²⁸

I do not consider that this is shown in the evidence adduced by either party. Mr Tincu describes the first registered proprietor as a business assembling doors from parts imported from Italy and Germany and then selling them to customers in the UK.²⁹ He also described it “as a leading supplier of high-quality glass and wood door sets” in the UK.³⁰ While it may well be the case that the first registered proprietor was not ultimately responsible for at least some of the goods it supplied, the website print-outs show that they were a retail supplier and installer of doors. I can see no evidence at all that other undertakings were being offered an online advertising service.

124. I take from Mr Tincu’s witness statement that the application was not made with an intention to use the contested mark as a trade mark, i.e., to signal trade origin. However, as Lord Kitchin explained in his summary of the relevant law, a finding of bad faith depends on “*objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for*

²⁸ Transcript, page 21.

²⁹ Witness statement, paragraph 2.

³⁰ Ibid, paragraph 4.

purposes other than those falling within the functions of a trade mark” (references omitted).

125. The applicant has claimed that the intention behind the filing of the application for the contested mark was to provide a defence against what Mr Hicks submitted was a misconceived claim of infringement of the applicant’s earlier mark. Section 11(1) of the Act provides that:

“A registered trade mark is not infringed by the use of a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1).”

126. The applicant wrote to the first registered proprietor on 26 September 2019 regarding its use of the word “CRITTALL” on its website. A second letter followed on 11 October 2019. In this second letter, the applicant warned that, if the first registered proprietor did not stop using the Crittall trade mark within seven days, it would pass the matter on to its trade mark attorneys to consider further action. Mr Ager states that no response was received.³¹ On 11 November 2019, the first registered proprietor filed its application for the contested mark. On 26 November 2019, the applicant sent its Letter Before Action.

127. While Mr Dobson submitted that the applicant’s claims were speculation, I consider that the timing of the application and the statements by Mr Tincu as to his intended use of the mark establish a *prima facie* case of bad faith. I also note that the registered proprietor claims that “Crittall” is generic and that Mr Dobson submitted at the hearing that *“we believe the fundamental principle here is that everybody should be allowed to use the words CRITTALL STYLE within their marketing”*.³²

128. The burden of proof therefore shifts to the registered proprietor. Mr Tincu states that the first registered proprietor started using the phrase “Crittall style doors” following research to which I have already referred. I have also noted that the methodology of this research has not been explained and no date is given for the decision. He does say that use began before the application for the contested mark was filed.³³ No

³¹ Witness statement, paragraph 18.

³² Transcript, page 21.

³³ Witness statement, paragraph 8.

explanation is given for the commercial rationale for making that application, as opposed to simply using the phrase on the Doors4UK website. I consider that the registered proprietor has not discharged the burden of proof.

129. The application for a declaration of invalidity succeeds under section 3(6).

OUTCOME

130. The application is successful. Subject to a successful appeal, UK Trade Mark No, 3443220 is declared invalid.

COSTS

131. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. In the circumstances, I make an award of £2400, that has been calculated as follows:

£400 for preparing a statement and considering and commenting on the other side's statement;

£1000 for preparing evidence and considering the other side's evidence;

£800 for preparing for and attending a hearing; and

£200 for official fees

£2400 in total

132. I therefore order Mr Eduard Tincu to pay Crittall Windows Limited the sum of £2400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of May 2026

Clare Boucher

For the Registrar,

Comptroller-General