

O/0840/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3535797

BY DORTECH DIRECT LIMITED

TO REGISTER:

DORTECH

AS A TRADE MARK IN CLASSES 1, 2, 3, 6, 7, 9, 17, 19, 35, 37 & 40

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 423235 BY

DORTEK LIMITED

BACKGROUND AND PLEADINGS

1. On 22 September 2020, Dortech Architectural Systems Ltd applied to register **DORTECH** as a trade mark in the United Kingdom in respect of goods and services in Classes 1, 2, 3, 6, 7, 9, 17, 19, 35, 37 and 40. The specification was amended twice since the initial filing. On 13 July 2021, the application was assigned to Dortech Direct Limited and I shall refer to this company as the applicant.

2. On 15 February 2021, the application was partially opposed by DorteK Limited (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns the following goods and services:

Class 6

Curtain walling and curtain wall facades; metallic building components and materials for use in curtain walling and curtain wall facades; articles of aluminium; windows; balustrades of metal; balusters of metal; balustrading of metal; aluminium profiles; aluminium supports for panels; metal door frames; metal ladders; metal doors; aluminium doors; handrails of metal; metal door handles; door hinges of metal; metal door knockers; letterboxes; escutcheons of metal; metal gates; roof lights [windows] of metal parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric window cleaning equipment; electric power tools; glass cutters (electrically operated); electric motors for use with doors; electric motors for use with windows; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 9

Software; software for doors, gates and windows; electric doorbells; security cameras; smart doors; smart door locks; alarm systems; smart windows; software for use with doors and windows; but not including any commercial and

industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 17

Sealing tape for use with insulated glass; seals, sealants and fillers; insulation and barrier articles and materials; films for windows; privacy films for windows and doors; anti glare films; plastic films for insulation; films for use in glazing; decorative films; tinted films; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; windows; door panels, not of metal; doors, gates, windows and window coverings, not of metal; doors made of glass for buildings; glazing; double glazing; glass doors; balcony enclosures (non-metallic); handrails, not of metal; damp proof membranes of synthetic plastics materials; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 35

The bringing together, for the benefit of others, of a variety of building components and materials for use in curtain walling and curtain wall facades, articles of aluminium building components, windows, and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the Internet; wholesale and retail services in relation to sanitisers for household use; paint brushes; paint trays, clamps (non-metallic) for fixing windows, non-metallic ladders, glass cleaning implements, cleaning cloths, mops; household utensils for cleaning; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk;

wholesale and retail services in relation to paints, sealants, primers; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk, paints, sealants, primers, cleaning preparations, glass cleaners, glass cleaning preparations, window cleaners in spray form, cleaning preparations for use on multi-surfaces, cleaning preparations for use on plastics, cleaning preparations for use on woods, soaps in liquid form, sugar soap, wipes incorporating cleaning preparations; wholesale and retail services in relation to curtain walling and curtain wall facades, metallic building components and materials for use in curtain walling and curtain facades, articles of aluminium, windows, balustrades of metal, balusters of metal, balustrading of metal, aluminium profiles, aluminium supports for panels, metal door frames, metal ladders, doors, metal doors, handrails of metal, metal door handles, door hinges of metal, metal door knockers, letterboxes, escutcheons of metal, metal gates, parts and fittings for the aforesaid; wholesale and retail services in relation to electric window cleaning equipment, electric power tools, glass cutters (electrically operated), electric motors for use with doors, electric motors for use with windows, parts and fittings for all of the aforesaid; wholesale and retail services in relation to software, software for doors, gates and windows, electric doorbells, security cameras, smart doors, smart door locks, alarm systems, smart windows, software for use with doors and windows; wholesale and retail services in relation to sealing tape for use with insulated glass, seals, sealants and fillers, insulation and barrier articles and materials, films for windows, privacy films for windows and doors, anti-glare films, plastic films for insulation, films for use in glazing, decorative films, tinted films; wholesale and retail services in relation to curtain walling and curtain wall facades, non-metallic building components and materials for use in curtain walling and curtain wall facades, windows, door panels, not of metal, doors, gates, windows and window coverings, not of metal, doors made of glass for buildings, glazing, double glazing, glass doors, balcony enclosures (metallic), balcony enclosures (non-metallic), handrails, not of metal, damp proof membranes of synthetic plastics materials, parts and fittings for all the aforesaid; information and advisory services relating to the aforesaid; but not

including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with doors, automatic doors, door frames, gates, coating, curtain walling, curtain wall facades, building components and materials for use in curtain walling and curtain wall facades, windows and parts, fittings and accessories therefor; information and advisory services relating thereto; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Metalworking; custom fabrication and manufacture of steel construction elements; joinery; custom manufacture; custom manufacture of doors, gates and windows; metal fabrication and finishing services; metal finishing; metalworking; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

3. Under sections 5(2)(b) and 5(3) of the Act, the opponent is relying on the following earlier marks:

UKTM No. 2024888

DORTEK

Filing date: 23 June 1995

Registration date: 18 October 1996

Class 6

Doors of metal, doors made principally of metal, door panels, door frames, door closers and door openers, door bumpers, spring bumpers, hinges, door

handles, door locks, door rings, bolts, door knobs; parts and fittings for all the aforesaid goods.

Class 9

Electric door opening and door closing mechanisms; electric locks; parts and fittings for all the aforesaid goods.

Class 19

Non-metallic doors; glass fibre polyester doors; door panels, panes, door frames, hinges; parts and fittings for the aforesaid goods.

Class 20

Door furniture and door fittings; pneumatic door opening and door closing mechanisms; door rail systems; door blades; parts and fittings for the aforesaid goods.

Class 37

Installation, repair and maintenance for manual and automatic doors.

EUTM No. 5017876

DORTEK

Filing date: 12 April 2006

Registration date: 7 May 2010

Class 6

Doors of metal; doors made principally of metal; door panels; door frames; door closers and door openers; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 7

Pneumatic door opening and door closing mechanisms; none being for use with or related to external gates or doors for securing outdoor areas of land.

Class 9

Electric door opening and door closing mechanisms; electric locks; parts and fittings for all the aforesaid goods; none being for use with or related to external gates or doors for securing outdoor areas of land.

Class 19

Non-metallic doors; glass fibre polyester doors; door panels, panels, door frames; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 20

Door furniture, door blades all for use with door systems having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 37

Installation, repair and maintenance for manual and automatic doors; information and advisory services relating to the aforesaid; none of the aforesaid services being for use with or related to external gates or doors for securing outdoor areas of land.

4. Although the UK has left the EU and the transition period has now expired, EU Trade Marks (“EUTMs”) are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice (“TPN”) No. 2/2020. Both marks qualify as earlier marks under section 6(1) of the Act and the opponent has stated that it has used them for all the goods and services for which they stand registered.

5. Under section 5(2)(b), the opponent claims that the marks are highly similar and that the goods and services covered by the marks are either identical or highly similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent claims that the earlier marks enjoy a significant reputation in the UK and that as a result of this reputation the relevant public is likely to make a mental link between the applicant's goods and services and those of the opponent. Damage would occur as the applicant would take unfair advantage of the reputation and distinctive character of the earlier marks. The opponent also asserts that use of the contested mark, which would be without due cause, would be detrimental to the earlier marks, if the applicant's goods and services do not live up to the relevant public's expectations of the opponent's goods and services. Consumers would be less likely to purchase the opponent's goods in future and the opponent claims that this possible change in economic behaviour is sufficient for a finding of detriment to the distinctive character or repute of the earlier marks.

7. Under section 5(4)(a), the opponent claims to have used the sign **DORTEK** throughout the UK since May 1989 for the following goods and services:

Doors of metal, doors made principally of metal, door panels, door frames, door closers and door openers, door bumpers, spring bumpers, hinges, door handles, door locks, door rings, bolts, door knobs; electric door opening and door closing mechanisms; electric locks; non-metallic doors; glass fibre polyester doors; door panels, panes, door frames; hinges; door furniture and door fittings; pneumatic door opening and door closing mechanisms; door rail systems; door blades; parts and fittings of all of the aforesaid.

Design, installation, repair and maintenance for manual and automatic doors.

8. The opponent claims to have acquired goodwill under the sign. According to the opponent, use of the contested marks would constitute a misrepresentation to the public that would damage the goodwill in its business. Damage is likely to occur through loss of sales or loss of control over the quality of goods and services. Consequently, use of the contested marks would be contrary to the law of passing off.

9. Following an extended cooling off period, the applicant filed a defence and counterstatement denying most of the claims made and putting the opponent to proof of use of the earlier marks for all the goods and services relied upon. It admitted that some of the goods and services in Classes 6, 7, 19 and 37 are similar but did not specify which ones. It also submitted that a likelihood of confusion would not exist because of the parties' honest concurrent use of the marks over many years.

10. Neither party requested a hearing and this decision has been taken following a careful consideration of the papers. Both parties filed written submissions in lieu of the same on 20 August 2024.

11. In these proceedings, the opponent is represented by Walker Morris LLP and the applicant by Appleyard Lees IP LLP.

EVIDENCE

12. The opponent filed evidence in the form of a witness statement dated 9 May 2023 from Alan O'Keane, Managing Director of Dorteck Limited. It is accompanied by 17 exhibits. He confirms that he has been a director of the company since April 2003. His evidence goes to the use made of the earlier marks and the claims to reputation and goodwill.

13. The applicant filed evidence in the form of a witness statement dated 8 January 2024 from James John Leo Sutherland, Group Managing Director of the Dorteck Group of companies, that includes the applicant, since 2021. It is accompanied by 12 exhibits. His evidence goes to the use made of the contested mark and past cooperation between the parties.

RELEVANCE OF EU LAW

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

DECISION

Proof of Use

15. Section 6A of the Act is as follows:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section ‘the relevant period’ means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (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.

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

16. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall*

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

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

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

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

But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

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

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

enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

17. The opponent submits that the evidence shows that it has used the earlier marks for the goods and services in respect of which they are registered and specifically “*in relation to products including ‘specialist door systems’ within the relevant period*”.¹ The relevant period is the five years ending with the application date of the contested mark, i.e. 23 September 2015 to 22 September 2020.

The opponent’s evidence

18. Mr O’Keane states that his business, DorteK Limited, was incorporated on 5 May 1989 but has been trading since 1968. He adds that it “*is a market leader in specialist hygienic door solutions*”.² This latter statement is one of a number that has been criticised by the applicant. I shall say more about these criticisms in due course.

19. The brand was launched in the UK and Mr O’Keane states that the company “*now*” has sites in Ireland, the Netherlands, Sweden, the United Arab Emirates and Qatar.³ However, the bulk of the evidence and the accompanying exhibits focuses on trade in the UK. Exhibit AOK3 contains what Mr O’Keane describes as samples of use of the mark in the UK. These appear to be information and data sheets about doors and windows. The mark is shown in stylised and word form, as in the example below, but none of the sheets is dated.⁴

¹ Written submissions in lieu of a hearing, paragraph 9a.

² Witness statement, paragraphs 2 and 3.

³ Paragraph 8.

⁴ Exhibit AOK3, page 17.



Cleanroom Windows

Hygienic Windows

Specifically designed for healthcare, pharmaceutical and cleanroom environments, DorteK windows are double or multiple glazed with an ultra-clean flush surface.

20. Mr O’Keane states that turnover in relation to goods sold in the UK during the relevant period was as follows:⁵

Year	Turnover (£)
2015	11,288,119.75
2016	12,444,669.42
2017	11,615,389.27
2018	8,215,321.99
2019	9,678,971.26
2020	9,800,100.04
2021	8,398,419.26

21. It is possible that some of the income from the first and last of these years was earned outside of the relevant period.

22. Exhibit AOK4 contains extracts from the opponent’s accounts. These show the following turnover figures:

Year Ended	Turnover (£)
31 March 2016	12,468,675
31 March 2017	11,615,390
31 March 2018	8,215,328
31 March 2019	9,553,971
31 March 2020	9,800,100
31 March 2021	8,398,418

23. Exhibit AOK5 contains information on doors produced for the pharmaceutical industry. This includes an undated general information sheet, a list of pharmaceutical

⁵ Paragraph 10.

clients and brief information on a number of projects in this sector. The listed clients are AstraZeneca (*“ongoing since 1995”*), GlaxoSmithKline (*“ongoing since 2000”*), MSD (*“ongoing since 1990”*), Pirimal (*“ongoing since 1990”*) and Lonza (*“ongoing since 2014”*). The projects highlighted consist of work for AstraZeneca (Cheshire), Arrow Pharma (Malta), Colourcon (Kent), GSK (UK) and Pfizer (Ireland). No dates are given for any of these, and the projects Mr O’Keane mentions in his witness statement date from 2000 and 2014, that is, before the relevant period.

24. Exhibit AOK6 contains information on doors produced for the healthcare sector. The structure of the exhibit is the same as that of Exhibit AOK5. The listed clients are Guys & St Thomas’ Hospital NHS Trust, London (*“2003 onwards”*), The London Clinic, Harley Street (2012), Salford Royal, Manchester (*“2018 and 2022”*), Spire Healthcare (nationally) (*“from 2016 onwards”*) and BMI Healthcare/Circle Health (nationally) (*“from 2017 onwards”*). The projects highlighted consist of work for Salford Royal Hospital, Schoen Clinic (London), Heartlands Hospital (Birmingham) and The London Clinic, Harley Street. As above, none of these is dated. In particular, I note that there is nothing to tell me whether, in the case of the Salford Royal Hospital project, the doors were supplied in 2018 (which would be within the relevant period) or 2022 (which would not).

25. Exhibit AOK7 contains information on doors produced for use in research laboratories and cleanrooms. The listed clients are The Francis Crick Institute (*“2014”*), Charles Rivers Labs (2015), The Sainsbury Welcome Centre, London (2014 and 2018), London School of Hygiene and Tropical Medicine (2020) and The Anne McLaren Building, Cambridge (2018 and 2022). All these projects were carried out in the UK. There is a single highlighted project, describing work done for Cancer Research UK (London), although this is undated.

26. The focus of Exhibit AOK8 is work in the retail sector. The listed clients are Lidl (2003 onwards), Ikea (2005 onwards), Sainsburys (1998 onwards), Smyths toy stores (2015 onwards) and Harrods (2015 onwards). Information sheets highlight undated projects involving the installation of glass reinforced polyester (*“GRP”*) crash doors for Asda, Lidl and Aldi.

27. Mr O’Keane states that the opponent has manufactured and installed doors within leisure centres, swimming pools and sports facilities at New Addington Leisure Centre in Surrey (2018), Center Parcs at Longleat (2017) and Pittville Leisure Centre in Cheltenham (2019). Exhibit AOK9 lists other clients as Seven Islands Leisure Centre in London (2017) and Ennerdale Leisure Centre in Hull (2014). Highlighted projects are ones carried out for Center Parcs at Longford, Ireland (undated, but the facility opened in 2019), Rotherham Community Special School and Harrods. The last two are also undated.

28. Exhibit AOK10 contains information on work done for clients in the veterinary sector. Listed clients are Dick White Referrals, Newmarket (2016), Battersea Dogs and Cats, London (2020), Large Animal Research and Imaging Facility, Edinburgh (2017), Fitzpatrick Referrals, Sussex (2015) and RSPCA, Norfolk (2000). The highlighted project is one carried out for Battersea Dogs and Cats Home.

29. Exhibit AOK11 contains information on work done for industrial clients. These are listed as Renault F1, Enstone (2018), Mercedes F1, Brackley (2022), Microsoft, Romsey (2021), Dyson, Malmesbury (2018), UK Battery Innovation Centre, Coventry (2021), BAE Systems, Samlesbury (2020) and Royal Mail, Denbigh (2022). It will be seen that a number of these dates are after the relevant date. There is also information on projects carried out for Carlsberg (Northampton), Müller (Shropshire), Nestle (Biessenhofen, Germany), but these are all undated.

30. Exhibit AOK12 is a screenshot from the website showing the logos of some of the opponent’s customers. These include some of the organisations already mentioned, along with Audi and the Royal National Lifeboat Institution (“RNLI”). This is undated.

31. Exhibit AOK13 contains a selection of invoices, some of which fall before the relevant period. I have summarised the ones from 23 September 2015 to 22 September 2020 in the table below:

Date	Address	Details	Value (£)
12.10.2015	Basingstoke	Fire doors (5), delivery, installation.	33,282.00
26.05.2016	Solihull	Fire doors (2), delivery, installation.	19,020.00
30.06.2016	Orpington	Fire doors (13), delivery, installation.	121,255.20

Date	Address	Details	Value (£)
15.03.2017	Omagh	Fire doors (28), ⁶ Single action doors (7), delivery, installation.	124,099.26
31.03.2017	Bathgate	Sliding door (2), Hermetically sealing chill sliding door (1), delivery, installation.	30,606.00
31.08.2017	Elstree	Fire doors (14), Single action door (1), Electric operator – mounted pull side (12), Steel door (1), delivery, installation, sundries.	182,099.82
31.10.2017	Guildford	Fire doors (35), delivery, installation, misc.	163,647.69
17.11.2017	London	Fire doors (4), single steel hinged door (1), TS4000 closer, delivery, installation.	28,548.00
28.03.2018	Edinburgh	Fire doors (3), delivery, installation.	26,640.00
16.05.2018	Llantrisant	Fire doors (21), Single action doors (13), glazed screens (17), delivery.	148,281.60
29.06.2018	Enfield	Single sliding fire doors (2), ⁷ Bi-parting sliding doors (8), delivery, installation.	119,916.00
23.07.2018	London	Fire doors (8), delivery, installation.	85,920.00
31.07.2018	Warrington	Butzbach (supplied and installed) (6).	63,355.20
01.08.2018	Birmingham	Single action doors (33), glazed screen (13), delivery, installation.	102,904.00
31.05.2019	Edinburgh	Single action doors (44), ⁸ 925mm blade (7), Single sliding doors (7), ⁹ Fire doors (2), Single action doors with lead lining (2), Single action door (Window controls push side) (2), delivery, installation.	347,315.93
31.05.2019	Scunthorpe	Single sliding fire doors (10), delivery, installation.	119,952.00
04.10.2019	London	Fire doors (5), delivery, installation.	58,182.00
23.01.2020	Edgbaston	Fire doors (27), Bi-parting sliding door (1), delivery, installation	299,154.00
28.07.2020	Heathrow	"S" type double action doors (6), ¹⁰ Fire doors (32), delivery, installation.	229,806.00
28.08.2020	Harrow	Single action doors (1), Single action doors (marked <i>VP Control Pull side</i>) (15), Single action doors (marked <i>VP Control Push side</i>) (1),	241,170.00

⁶ One marked "4-sided frame".

⁷ Marked "Door locking (if required) via motor blocker".

⁸ Three are marked "Window controls 'Push' side"; one is marked "Digi-pad lock?".

⁹ Two marked as containing lead lining.

¹⁰ This entry is marked "ISD Door Type B. ID_00; 127, 128. 129 to have double offset fixings".

Date	Address	Details	Value (£)
		interlock system, including programmable controller (3), delivery, installation.	

32. All the invoices contain the following mark in the top right corner of the first page:



33. Mr O’Keane states that the opponent has at least 85% of the hygienic GRP door industry.¹¹ Exhibit AOK14 contains an article on the global high speed doors market in 2021. The opponent is listed as a key player in this market.¹² However, the article does not provide any information specific to the EU or UK market. Mr O’Keane states that the opponent’s GRP doors have been installed in all IKEA stores in the UK and Ireland.¹³ He does not say when this work was done.

34. Mr O’Keane says that the opponent invested the following sums in marketing the brand: £54,700 in 2015, £50,000 in 2016, £48,000 in 2017, £45,000 in 2020.¹⁴ The firm has promoted DORTEK products at the Healthcare Estates Exhibition (“*various years since 2001*”), NAHFO Conference (since 2014), IAT Conference (since 2008), LASA Annual Conference (2008), ISPE regulatory and Guidance Update Conference (“*various since 2006*”), SLAB & UKSPA Science and Innovation Conference (“*various since 2017*”) and The London Vet Show in 2018.¹⁵ No images are provided from these events.

35. The opponent’s website received 62,431 visitors in 2019 and 65,066 visitors in 2020.¹⁶ Mr O’Keane does not say how many of these visitors were based in the EU or UK.

¹¹ Paragraph 17.

¹² Page 274.

¹³ Paragraph 21.

¹⁴ Paragraph 23.

¹⁵ Paragraph 24.

¹⁶ Paragraph 25.

Sufficiency of use

36. I recall that, while one of the earlier marks is a UKTM, the other is an EUTM. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) held that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, “*all facts and circumstances*” should be considered, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use, as well as its frequency and regularity: see also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, paragraphs 288-230, and *TVR Automotive Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-398/13, paragraph 57.

37. In its written submissions in lieu of a hearing, the applicant provides a detailed critique of each item of evidence adduced by the opponent. However, I am required to consider the evidence as a whole, as the General Court (“GC”) held in *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09:

“53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, if true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”

38. That said, there is force to some of the applicant’s criticisms. For example, as can be seen from the tables in paragraphs 20 and 22 above there are some discrepancies between the turnover figures presented in the witness statement and those shown in

the financial statements in Exhibit AOK4. There is no explanation as to why these differ. The discrepancies are small, but I shall give greater weight to the figures in the audited financial statements.

39. The applicant also notes that the turnover figures have not been broken down to show which goods or services have been supplied during the relevant period. I do have a sample of invoices showing some goods and installation services being provided for projects. In my view, it is reasonable to infer that the shipping address indicates the location of the project. Consequently, I find that these projects were carried out in the UK. The applicant submits that there is no reference to the earlier marks in the descriptions of the items sold and that the average consumer would assume that they are manufactured by third parties and fitted by the opponent. I am not persuaded by this argument. If the doors were sold under another party's mark, I would expect to see that information on the invoice, so the purchaser could verify that the correct goods had been ordered. I am supported in making this inference by the invoice dated 31 July 2018 for 6 units of a product described as "Butzbach". The invoice says that these are "*Supplied and installed*".¹⁷ On one of the information sheets, the opponent is described as an authorised Butzbach partner, from which I infer that Butzbach is a separate manufacturer.¹⁸

40. Mr O'Keane says several times that the opponent designs and manufactures doors, as well as installing them. He adds that the opponent has at least an 85% share of the hygienic GRP door industry.¹⁹ The applicant submits that this statement is uncorroborated and that no probative value can be attributed to the claim. While I accept that the figure is given in a witness statement containing a statement of truth and that a challenge has only been made by the applicant in its written submissions in lieu of a hearing, the probative value of this part of Mr O'Keane's witness statement is weakened by its lack of specificity. He does not say to what period or geographical area the figure relates.

41. Mr O'Keane has filed evidence showing doors produced by the opponent in Exhibit AOK3. The applicant submits that the source of this information is unclear. I note that

¹⁷ Page 248.

¹⁸ Exhibit AOK3, page 46.

¹⁹ Paragraph 17.

it appears to include some data sheets, and the language used on other documents in the exhibit suggests that these are promotional materials. For example, the sheet on Hygienic Hinged Doors says:

“Dortek’s hygienic door systems are manufactured using cutting edge technology and a revolutionary closed mould process. This creates a strong, uniform product with no seams or joins on the door surface and no voids, holes or crevices within for bacteria to harbor [sic].

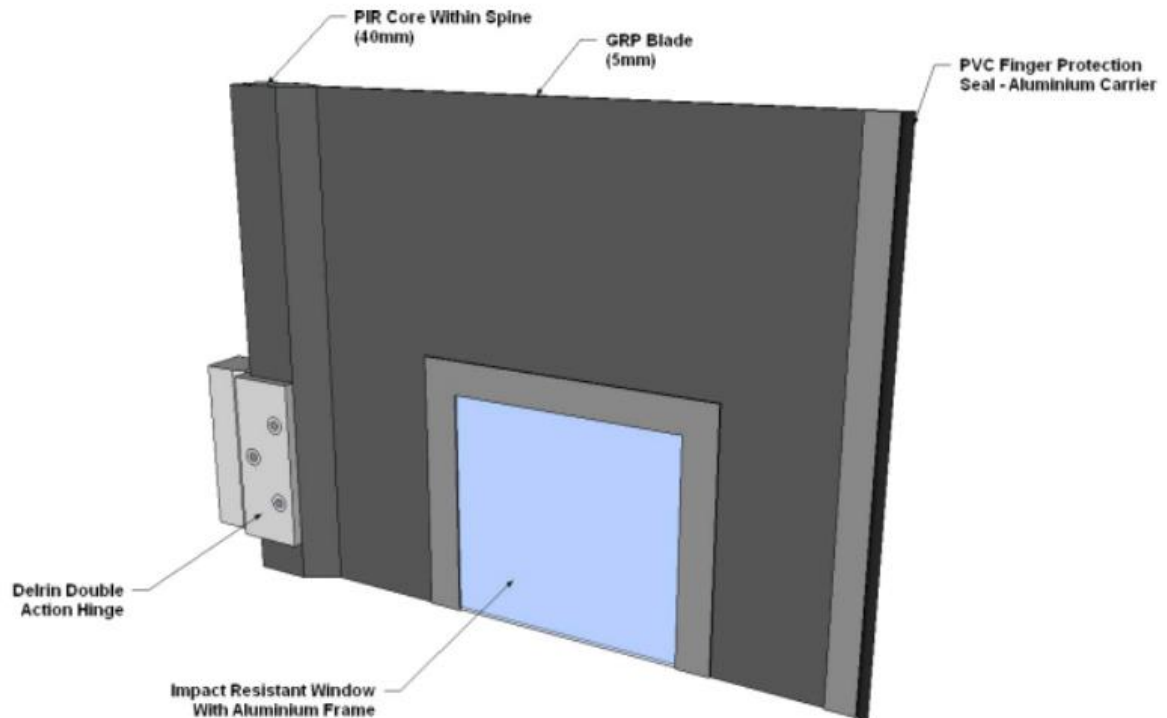
We are market specialists; with over 50 years’ experience in providing high performance door solutions to the world’s leading pharmaceutical, food and healthcare companies.

We understand the unique and stringent requirements of high hygiene environments. We understand air flows, work flows, contaminants and local regulations. We know what works and what doesn’t. Our product portfolio offers a comprehensive single source for all doors, frames, hardware and automations on a project.”²⁰

42. I accept that the material in this exhibit is undated. I have, however, used the information sheets to help me interpret the items listed on the opponent’s invoices, notably in the case of “door blades”. The opponent has not explained to me what this term means. A single invoice shows sales of 7 of these items. Five have a unit price of £3,364.00 while the other two are priced at £3,815.00 and £2,819.00. As a comparison, single action doors in this order are priced between £1,834.00 and £5,478.00, with sliding doors and lead-lined doors being more expensive. The image below, taken from one of the information sheets, suggests that the door blade is the main panel.²¹ I shall proceed on this basis.

²⁰ Page 28.

²¹ Exhibit AOK3, page 19.



43. In paragraph 17 above, I referred to the opponent’s submission that it had used the earlier marks for all the goods and services and specifically for “specialist door systems”. Mr O’Keane also uses this phrase in his witness statement but he does not elaborate on what goods one could expect to be included in a specialist door system. I remind myself that genuine use cannot be proved by means or probabilities or suppositions. The items shown in the invoices are fire doors, sliding doors and single action doors (which I understand from the information sheets to have been made from GRP), electric opening and closing mechanisms (“*Electric operator*”), steel doors, door blades, interlocking systems, and installation services. One invoice dated 15 March 2017 refers to a fire door with a “*4-sided frame*”.²² The (admittedly undated) information sheets state that the doors can be provided with or without frames. I consider that it is reasonable to infer that specialist door systems would include frames, especially where those doors have a fire retardant, hermetic or hygienic purpose.²³

²² Exhibit AOK13, page 220.

²³ See, for example, Exhibit AOK3, pages 30-31.

44. I have considered the evidential picture as a whole and taken account of the shortcomings set out above. On the basis of this assessment, I make the following findings of fact:

a) The opponent has used the marks in the relevant period for its business selling doors and door systems to commercial clients in sector such as healthcare, retail, food, leisure and research;

b) The information sheets stress the benefit for this sector of glass reinforced polyester, for example in terms of cleanliness, over other materials, such as timber. Mr O'Keane presents the opponent as a manufacturer of GRP doors;

c) The invoices also show some sales of steel doors;

d) The information sheets also state that the opponent provides frames, opening and closing mechanisms, automated systems, interlocking systems, and fittings for the doors. They also show the provision of door blades, which I interpret to mean the main door panels. While I accept that these sheets are undated, I note that some of the invoices do refer to closers and interlocking systems;

e) The opponent has also provided an installation service for the doors and door systems;

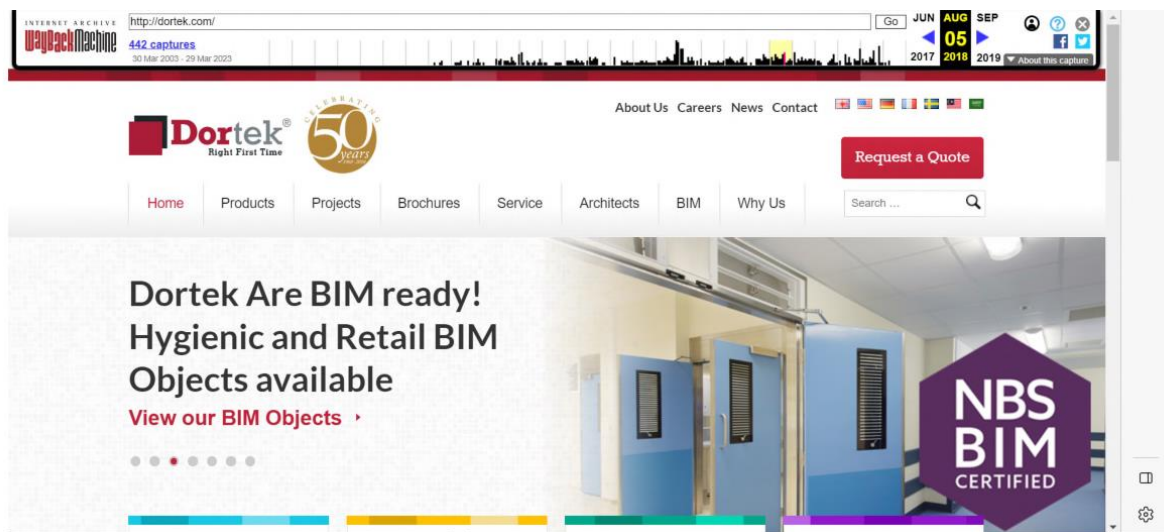
f) Turnover is shown in the table in paragraph 22. While these figures are not broken down by location of customer, all the invoices are directed to UK customers. I am satisfied that there has been use in the UK and that this is sufficient to count for use in the EU;

g) The opponent has made some investment in marketing the brand, as set out in paragraph 34 above, but there is little evidence to show how these sums were spent.

Form of the mark

45. Before considering what would constitute a fair specification for the mark, I briefly note that, although the evidence shows the word "DORTEK" in two colours and with

figurative devices, the mark is also used in plain word form and in the figurative form shown on the website screenshot below dated 5 August 2018.



46. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to be taken when assessing whether a variant form of a mark is acceptable. He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

47. I do not consider that the use in two colours, or the addition of a device, changes the distinctive character of the word mark. This is because it is my view that, in the context of the goods and services for which it is used, the average consumer would recognise that it is a neologism created from misspellings of the words “Door” and “Tech”. The use of the two colours merely serves to emphasise this meaning. The devices are simple and the word element is the distinctive element of both those forms of the mark.

A fair specification

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

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

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

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

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

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

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

legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

49. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-2491 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

50. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the

terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”²⁴

51. The specifications contain some broader terms, which I need to address. I will begin with *Doors of metal* and *Doors made principally of metal*. I have found that the earlier mark has been used for steel doors. In my view, these doors would be used for the same purpose and in the same environments as doors made from other common metals, such as aluminium. I also take the view that the average consumer would expect them to be manufactured by the same undertaking. However, I am conscious that metal doors as a category would include not only the types of doors supplied by the opponent but also garage doors and external doors for use in a domestic environment. Consequently, I consider that a fair specification for both marks could be devised by including the limitation from the EUTM, i.e. *Doors made of metal; Doors made principally of metal; door frames, all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.*

52. In Class 9, the specification includes *Electric locks*. I have found use for *Electric interlocking systems*. I understand that such systems are used with more than one door, so that one can be opened only if another is closed first. To my mind, such a system is likely to be more complex and would include components above and beyond those that would be required for single electric locks. It would be necessary for there to be a means of sending a message from one part of the system to another. For this reason, I consider that *Electric interlocking systems for use with door systems* represent an identifiable subcategory and would constitute a fair specification in Class 9.

53. I now turn to the doors in Class 19. I have already found that the opponent has used the mark for GRP doors. I understand that “glass reinforced polyester doors” and “glass fibre polyester doors” are two terms with the same meaning, namely, doors made from a composite of polyester and glass fibre. The opponent may therefore rely on *Glass fibre polyester doors*, and in my view it would also be fair that it can rely on glass fibre polyester frames. I see no reason why these materials could not also be

²⁴ Pages 10-11.

used to make garage doors and domestic external doors, which do not serve the same purpose as the opponent's doors. For this reason, I consider that it would be fair to limit the specification in the same way as for the doors in Class 6.

54. I do not consider that it would be fair to allow the opponent to rely on the broader term *Non-metallic doors*. This is because the broad term contains identifiable subcategories, such as wooden doors that might be used in a domestic environment, and there is no evidence that the opponent supplies these. I note that the undated Exhibit AOK3 appears to show that the opponent offers glass doors, but I have no dated evidence to indicate that the opponent made genuine use of the mark in connection with these goods during the relevant period.

55. I find that use has been shown for *Door blades*, but for the same reasons outlined above, the UKTM should be limited in the same way as the EUTM and confined to *Glass fibre polyester door blades*. I also consider that, given my understanding of the meaning of the term *Door blades*, the opponent should be allowed to rely on *Glass fibre polyester door panels*.

56. I do not consider that it would be fair for the opponent to be able to rely on terms such as *Parts and fittings* or *Door fittings*. The broad terms include identifiable subcategories, such as door handles, locks, escutcheons, and so on, and, again, there is no dated evidence that such goods were supplied. Had they been marketed, it should not have been difficult for the opponent to have provided evidence.

57. I consider that a fair specification for the UKTM would be:

Class 6

Doors of metal, doors made principally of metal, door frames, all the aforementioned having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 9

Electric door opening and door closing mechanisms; electric interlocking systems for use with door systems.

Class 19

Glass fibre polyester doors; Glass fibre polyester door panels; Glass fibre polyester door frames; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use within or related to garages, external gates or doors for securing outdoor areas of land.

Class 20

Glass fibre polyester door blades for use with door systems having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use within or related to garages, external gates or doors for securing outdoor areas of land.

Class 37

Installation for manual and automatic doors.

58. I consider that a fair specification for the EUTM would be:

Class 6

Doors of metal; doors made principally of metal; door frames; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 9

Electric door opening and door closing mechanisms; electric interlocking systems for use with door systems; none being for use with or related to external gates or doors for securing outdoor areas of land.

Class 19

Glass fibre polyester doors; Glass fibre polyester door panels; Glass fibre polyester door frames; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use within or related to garages, external gates or doors for securing outdoor areas of land.

Class 20

Glass fibre polyester door blades for use with door systems having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land.

Class 37

Installation for manual and automatic doors; none of the aforesaid services being for use with or related to external gates or doors for securing outdoor areas of land.

Section 5(2)(b)

59. 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.”

60. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

61. 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*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] PC 281 at [296]. As the GC said in *Boston Scientific Ltd v 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.”

62. In its written submissions in lieu, the opponent has provided a table which sets out those goods and services it considers to be identical and those it considers to be similar to its own goods and services. This table reflects the limitation filed by the applicant but relies on the entirety of the opponent’s specifications which, it will be recalled, I have reduced for the purposes of these proceedings into what I deem to be a fair specification, reflecting the use shown in the evidence.

63. The applicant accepts that there is some overlap between the parties’ terms but submits that any perceived overlap would be removed by the limitation that has been added to each of the classes within its own specification. The limitation is as follows: *but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP*. It does not, in my view, exclude use on commercial and industrial doors *per se*, but rather particular types of doors used in commercial and industrial settings. Some of these types of doors are included in the positive limitation within the opponent’s fair specification. However, the applicant’s limitation does not refer to fire retardant and acoustic applications that are covered by the opponent’s terms. In short, I consider

that both specifications cover fire retardant doors and doors with an acoustic application, and will proceed on this basis.

64. In making my comparison, I shall group the applicant's goods and services together where they are "*sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons*": see *SEPARODE Trade Mark*, BL O-399-10, paragraph 5.

Class 6

65. The first goods I shall compare are the applicant's *Metal doors; aluminium doors, but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP* and the opponent's *Doors of metal, having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land*. As explained above, I find that both parties' specifications would include metal and aluminium fire retardant doors and so I consider that the respective goods are identical.

66. I consider that the same rationale applies in respect of the applicant's *Articles of aluminium*, which could include *Aluminium doors*. I find that they are identical.

67. I now turn to the contested *Metal door frames; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high-speed and/or sectional doors or transfer hatches or doors made of wood and GRP*, which I shall compare to the opponent's *Door frames, having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use with or related to garages, external gates or doors for securing outdoor areas of land*. In my view, the same rationale applies as I have set out in paragraph 65 and the goods are identical.

68. Where the goods are identical, I find that *Parts and fittings for the aforesaid* will be similar to a medium degree, on the basis that they are complementary.

69. The next goods I shall consider are *Metal door handles; door hinges of metal; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer*

hatches or doors made of wood and GRP. The users of these goods will be the same as the users of some of the doors covered by the opponent's specification and the goods are likely to share some trade channels. I also find them to be complementary, as doors are essential for the use of the handles and the door hinges and the average consumer is likely to believe that both goods come from the same undertaking. I find that they are similar to a medium degree.

70. The next goods in the applicant's specification that I shall address are Metal door knockers; letterboxes; escutcheons of metal; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP. These are goods that could be used on metal doors for commercial and/or industrial use of a different type from those featured in the applicant's specification. In my view, the same analysis applies as for *Metal door handles*, and so I find that the goods are similar to a medium degree.

71. Having addressed all the goods that are doors or are related to doors, I turn to the rest of the class. The next group of contested goods consists of Curtain walling and curtain wall facades; metallic building components and materials for use in curtain walling and curtain wall facades; windows; aluminium profiles; aluminium supports; roof lights [windows] of metal; parts and fittings for the aforesaid. These goods are used in the construction of buildings, and I understand that a curtain wall is a form of exterior covering of a building, frequently made from lightweight materials as the curtain wall is not load-bearing. There may be an overlap in user, as both parties' goods would be used in the construction of buildings, but the core purpose of the goods is different, as is their method of use. They share a physical nature only in so far as they are all made of metal. Given that the opponent's goods include metal doors with an industrial or commercial application, there is likely to be some overlap in trade channels. I do not find any competition or complementarity. Taking these factors into account, I find that there is a low degree of similarity between the goods.

72. The next contested goods I shall consider are Metal gates; parts and fittings for the aforesaid. There is likely to be an overlap in user with the opponent's *Doors of metal*. I also consider that there may be an overlap in trade channels. The goods are similar in nature as both are made from metal. Doors will be used where it is important

to retain heat, prevent contamination of other areas, or provide a greater degree of security. A gate will also be a barrier, but it does not serve the additional purposes of a door. They are not complementary, but there may be some instances in which there is a degree of competition. I find that the goods are similar to a low to medium degree.

73. The next contested goods in this class are Balustrades of metal; balusters of metal; balustrading of metal; handrails of metal; parts and fittings for the aforesaid. These goods would be used on staircases and balconies, to prevent people from falling over the edge. The users of these goods overlap with the users of the opponent's metal doors and may share some trade channels. However, they differ in purpose and method of use. They are neither complementary nor in competition. There is some degree of similarity in nature as all the goods are made of metal. I find that the parties' goods are similar to a low degree.

74. The final contested goods in this class are Metal ladders; parts and fittings for the aforesaid. These are likely to be purchased by trade customers and members of the general public and businesses. There is likely to be some overlap with the opponent's goods. I do not consider that the trade channels will be shared to any noticeable extent. The purpose of the goods and method of use differ. They are not in competition or complementary. They are both made of metal but I do not consider that this is sufficient, even when combined with an overlap in user, to find any similarity between the goods, as a wide variety of goods can be made of metal. In my view, the goods are dissimilar.

Class 7

75. I shall compare the contested Electric motors for use with doors; parts and fittings for the aforesaid to the opponent's *Doors of metal and Glass fibre polyester doors.* For the reasons I have set out, I do not consider that the limitation has an impact on the comparison. They will be targeted towards the same users and share the same trade channels. They differ in purpose, method of use and nature and are not in competition. I consider that there is a degree of complementarity. The opponent's doors are essential for the use of the applicant's goods, and in my view the average consumer would assume that a provider of door systems was responsible for both the door and the motor. I consider that the same applies for the parts and fittings. The average

consumer would expect these also to be the responsibility of the same undertaking that is responsible for the doors. I find that the goods are similar to a medium degree.

76. The remaining contested goods are Electric window cleaning equipment; electric power tools; glass cutters (electrically operated); electric motors for use with windows; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP. The opponent has submitted that these goods are similar to goods that did not survive the proof of use assessment (namely *Pneumatic door opening and door closing mechanisms*). I cannot see that they are similar to any of the goods or services that remain in the fair specification. They may share an overlap in user, but this is not enough by itself for me to find any similarity. Consequently, I find that these goods are dissimilar to the opponent's goods.

Class 9

77. The first group of contested goods I shall consider comprises Software; software for doors ...; software for use with doors I shall compare them to *Electric interlocking systems for use with door systems*. I consider that it is likely that such interlocking systems would involve software in their operation and the applicant's goods are described in broad terms that would include such software. I find that the parties' goods are complementary, as the interlocking systems would require software and the average consumer would assume that the same party is responsible for all parts of the interlocking system. The users are the same and there are shared trade channels. I find that the parties' goods are similar to a medium degree.

78. I shall also compare Software for ... gates and windows and for use with ... windows to *Electric interlocking systems for use with door systems*. There is likely to be an overlap in user and there may also be shared trade channels, as the same undertaking may provide electric locking systems for use with doors, gates and windows, and the software that is used in their operation. I do not find the parties' respective goods to be complementary. I find that there is a low degree of similarity between the parties' goods.

79. I understand that a Smart door is a system that involves Smart door locks that can be operated using smartphones, fobs, facial recognition and so on, sensors,

connectivity software and a user interface that allows access permissions and other settings to be managed. The purpose of the goods is very similar to that of the opponent's *Electric interlocking systems for use with door systems* and the goods will be targeted towards the same users, and I consider that there is some similarity in nature, as both parties' goods contain locking systems and software. I consider that it is likely that there will be some shared trade channels. There may be a degree of competition between the goods. I find that they are similar to a medium degree.

80. The remaining contested goods are *Electric doorbells; security cameras; alarm systems; smart windows*. I note at this point that I understand *Smart windows* to be windows that adapt their visual characteristics to external factors such as sunlight or heat. I consider that all these goods differ from the opponent's goods and services, in purpose, method of use and nature. They are not in competition or complementary. They may overlap in user but this is not sufficient on its own for me to find similarity. Consequently, I find that these goods are dissimilar to the opponent's goods and services.

Class 17

81. The opponent submits that all the contested goods in this class are similar to its goods in Class 19 but does not provide any specific reasons. The extent of the explanation is as follows and covers almost all the goods and services in the applicant's specification:

"11. The goods and services highlighted above share the same users and the same or similar purpose; to provide specialist door solutions/ door solutions to customers. In addition, it is feasible that the products would be available via the same trade channels.

The Average Consumer

12. In addition, the average consumer may alternatively perceive the goods and services of the Applicant to be complementary to those of the Opponent and may believe that they originate from the same undertaking."

82. There is a difference in nature and method of use between the applicant's Class 17 goods and the goods I found the opponent could rely on in Class 19, namely, *Glass fibre polyester doors; Glass fibre polyester door panels; Glass fibre polyester door frames; all having a hygienic, fire retardant, acoustic, industrial or commercial application and none being for use within or related to garages, external gates or doors for securing outdoor areas of land*. I consider that the purpose of the applicant's goods is to fill holes, make gaps watertight or airtight or to reduce the amount of light coming through windows or glass panels in doors. The purpose of a door is to facilitate entry into, or exit from, a room or other space. I do not consider that the sealants, fillers and insulating material would be distributed through the same trade channels. These are goods that are likely to be sold through DIY stores or trade suppliers of building products, while the opponent's goods are more likely to come from specialist suppliers of doors. I am not persuaded that a supplier of doors would also supply privacy films, instead of doors containing panels of treated glass. In the absence of evidence or detailed submissions to the contrary, I find that all the goods in Class 17 are dissimilar to the opponent's goods.

Class 19

83. The contested *Door panels, not of metal; Doors ..., not of metal* are broad terms that include the opponent's *Glass fibre polyester door panels* and *Glass fibre polyester doors* respectively. For the reasons I have already explained, the limitations in both specifications do not have an impact on this finding. Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. I therefore find the goods to be identical.

84. Where the goods are identical, I find that *Parts and fittings for all the aforesaid* will be similar to a medium degree, on the basis that they are complementary.

85. The next group of contested goods comprises *Doors made of glass for buildings; glass doors*. I shall compare them to *Glass fibre polyester doors*. The goods will be targeted towards the same users, namely businesses constructing or refitting buildings. The method of use and purpose is the same, although the physical nature differs. There may be an overlap in trade channels. There is also likely to be a degree

of competition as in some circumstances a customer will choose which materials it wishes the doors to be made from. The goods are not complementary. I consider that the goods are highly similar. I find that Parts and fittings for all the aforesaid are similar to the opponent's goods to a medium degree, as I consider that some of these parts and fittings, such as handles or hinges, are likely to be able to be used on both types of door.

86. I come now to Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; windows; windows and window coverings, not of metal; parts and fittings for all the aforesaid. I consider that the analysis carried out for the metal equivalents of these building materials applies here and that the applicant's goods are similar to the opponent's *Glass fibre polyester doors* to a low degree.

87. I also consider that the same applies in respect of the applicant's Gates ... not of metal; parts and fittings for all the aforesaid which I find to be similar to the opponent's *Glass fibre polyester doors* to a low to medium degree, and Balcony enclosures (non-metallic); handrails, not of metal; parts and fittings for all the aforesaid, which I consider to be similar to the opponent's *Glass fibre polyester doors* to a low degree.

88. I shall now compare the applicant's Glazing; double glazing; parts and fittings for all the aforesaid to the opponent's *Glass fibre polyester doors*. The purpose of these goods is to allow light to enter a room, whereas the purpose of a door is to allow people to enter and exit rooms. Both parties' goods will be used in the construction or refitting of buildings and be targeted towards the same users. The nature and method of use of the goods are different. I consider that there is unlikely to be an overlap in trade channels. I find no competition or complementarity. Taking these factors into account, I find that the goods are similar to a low degree.

89. The final contested goods to consider in this class are Damp proof membranes of synthetic plastics materials; parts and fittings for the aforesaid. The purpose of these goods is as the name suggests: to protect buildings from moisture. There is likely to be an overlap in user with the opponent's doors, as the applicant's goods will be sold to companies carrying out construction projects but may also be purchased by members of the public. They differ from the opponent's doors in physical nature as

they come in the form of plastic sheets or rolls of sheeting and are sometimes supplied with parts to fix them to the building. The method of use is different. There may be some overlap in trade channels, as both parties' goods may be sold by large DIY chains and trade suppliers, but they are unlikely to be displayed in the same part of a shop or on the same webpage. The goods are not in competition or complementary. Despite the overlaps in trade channels and users, I find them to be dissimilar.

Class 35

90. This class contains a long list of wholesale and retail services related to goods that appear in the specification, along with *Information and advisory services relating to the aforesaid*. I shall deal with the wholesale and retail services first, beginning with those that relate to the goods that I found to be identical to goods in the opponent's fair specification. Those services are *Wholesale and retail services in relation to ... articles of aluminium, ... metal door frames, ... doors, metal doors; Wholesale and retail services in relation to ... door panels, not of metal, doors ..., not of metal*. They will be compared to *Door frames* (in Class 6), *Doors of metal*, *Glass fibre polyester door panels* and *Glass fibre polyester doors* respectively.

91. In *Oakley, Inc. v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

92. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning the comparison of retail services and goods. As well as *Oakley*, this included *Sanco SA v OHIM*, Case C-411/13 P and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, which was upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07 P.

93. It is clear from this case law that where the applicant's retail services are to be compared to the opponent's goods, the retail services will be different in nature, purpose and method of use from those goods. Despite these differences, where there is some complementarity and shared trade channels, retail services *may* be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of

similarity, where from the consumer's point of view, the retail services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

94. In the case of the wholesale and retail services I am currently comparing, I consider that there are shared trade channels and that the goods and services are complementary. In my view, the average consumer would not be surprised to find the retail services being offered by the same undertaking as the goods. Consequently, I find that there is a medium degree of similarity.

95. I now turn to *Wholesale and retail services in relation to doors made of glass for buildings, glass doors*. The services are likely to share the same trade channels as the opponent's *Glass fibre polyester doors* and the average consumer would, in my view, assume that the same undertaking is responsible for the services and the opponent's goods, as a retailer or wholesaler is likely to offer doors made from different materials. To my mind, there is a degree of complementarity. I find that the services are similar to the goods to a medium degree.

96. The next services I shall consider are the retail and wholesale services relating to *Software for doors, Smart doors, Smart door locks and Software for use with doors*. I found that the goods that are the subject of those retail and wholesale services are similar to a medium degree to the opponent's *Electric interlocking systems for use with door systems*. I consider that there are likely to be some shared trade channels and the average consumer is likely to believe that the goods are the responsibility of the undertaking providing the retail or wholesale services. I find that the applicant's services are similar to the opponent's goods to a low degree.

97. I do not consider there is any complementarity between the opponent's goods and the rest of the applicant's wholesale and retail services. There may be some shared trade channels with retail and wholesale services in relation to door handles and other parts for doors, as traders providing those retail and wholesale services may also sell the doors themselves. I do not consider it unlikely that there will be some traders that specialise in doors and parts and fittings for them, and so I think that there is a low degree of similarity here. In my view, this applies for the following services: *Wholesale*

and retail services in relation to ... metal door handles, door hinges of metal, metal door knockers, letterboxes, escutcheons of metal, parts and fittings for the aforesaid. I consider that it is less likely that the remaining contested goods that I found to be similar would be the responsibility of the undertaking providing retail or wholesale services, bearing in mind that trading in goods is not the same as providing those services.

98. In my view, the applicant's Information and advisory services relating to the aforesaid are services that the average consumer would expect to find supplied as part of the retail or wholesale services. A customer wondering which type of door to purchase is likely to seek advice from sales staff. Where I find similarity for *Retail and wholesale services*, I also find similarity for Information and advisory services.

Class 37

99. Both parties' specifications include Installation services in relation to doors and automatic doors and so I find these services to be identical.

100. I shall compare the applicant's Installation ... services in connection with ... door frames, ... parts, fittings and accessories therefor (and in connection with parts, fittings and accessories for doors and automatic doors) to the opponent's *Installation ... for manual and automatic doors*. I consider that these services are likely to be delivered through the same trade channels to the same users. There is some similarity in purpose, as the aim is to have doors (and all the goods needed for those doors to be functional) installed so that people can enter and leave rooms. The method of use and nature of the services are similar. I find that they are not in competition but there is likely to be a degree of complementarity. I find that the services are highly similar.

101. I now turn to the applicant's Maintenance and repair services in connection with doors, automatic doors, door frames, ... parts, fittings and accessories therefor. There is likely to be an overlap in user, but the purposes differ. The nature of the service may have a degree of similarity, as it seems to me that both parties' services are likely to involve the fitting of new parts where required. I also consider that it is plausible that the same undertaking may offer installation, maintenance and repair services and so there is some similarity in trade channels. I do not find the services to be in competition,

but it is possible that there is some complementarity. Overall, I find a medium degree of similarity between the services.

102. I also find a low degree of similarity with the remaining services in the applicant's specification. This is because the same undertaking may supply broader installation, repair and maintenance services covering other elements of a building, such as gates, coating, curtain walling and windows. These services would overlap in user and nature with the services of the opponent.

Class 40

103. The opponent submits that all the applicant's services in this Class are similar to its goods in Class 6 and 19 but makes no detailed submissions on its reasoning.

104. The first of the contested services I shall consider is Custom manufacture of doors. This is a service that involves the design and production of goods to meet the customer's specific needs. I shall compare these to the opponent's doors of metal and of glass fibre polyester. The nature of the goods and services is clearly different. There is likely to be an overlap in user and some competition between the services, as a user can choose whether to buy already manufactured doors or employ an undertaking to make the doors to its specific requirements. I consider that there is also likely to be some overlap in trade channels, as the same undertaking could provide a range of standard doors, while also offering custom manufacturing services. There is some similarity in purpose. I do not find the goods and services to be complementary. Taking these factors into account, I find that the goods and services are similar to a medium degree. However, I find that Custom manufacture of ... gates and windows is dissimilar to the opponent's goods.

105. As the applicant's Custom manufacture would also include the custom manufacture of doors, I also find that these services are similar to a medium degree to the opponent's goods.

106. The next contested services I shall compare are Metalworking; metal fabrication and finishing services; metal finishing. I am mindful of the need not to interpret terms, particularly those describing services, too broadly: see *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), paragraph 56, and *SkyKick UK Ltd & Anor v Sky Ltd*

& Ors (Rev1) [2024] UKSC 36, paragraph 365. The core meaning of the services is the fashioning of raw metal materials into finished goods, such as the opponent's doors. It does not, to my mind, include the design element that is part of *Custom manufacture*. The nature of the services is different from that of the opponent's doors and I do not consider that there is any competition between them, or an overlap in trade channels. The purpose is also different. I consider that these services are dissimilar to the opponent's goods.

107. I shall also construe the applicant's *Custom fabrication and manufacture of steel construction elements* keeping the core meaning of the term in mind. I understand that *Steel construction elements* are components that are used in creating a structure, such as beams and columns, but they may also include steel doors. Consequently, I find that the services are similar to the opponent's doors to a medium degree.

108. I understand that *Joinery* is an area of carpentry. The purpose is to construct furniture, buildings or fittings from wood. It is therefore different from that of the opponent's goods in Class 19. The nature is also different, and I do not consider that there will be shared trade channels. There is no competition or complementarity. Although the users may be the same, this is not sufficient on its own for me to find any similarity. I find that *Joinery* is dissimilar to the opponent's Class 19 goods.

109. Where I have found services to be similar, I consider that *Information and advisory services* relating to those services would also be similar, as they would, to my mind, be provided as part of the custom manufacturing service.

Final remarks on the comparison of goods and services

110. Under section 5(2)(b), it is necessary for the goods and services to be identical or similar. The opposition therefore fails under this ground in respect of the following goods and services, which I found to be dissimilar:

Class 6

Metal ladders; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric window cleaning equipment; electric power tools; glass cutters (electrically operated); electric motors for use with windows; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 9

Electric doorbells; security cameras; alarm systems; smart windows; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 17

Sealing tape for use with insulated glass; seals, sealants and fillers; insulation and barrier articles and materials; films for windows; privacy films for windows and doors; anti glare films; plastic films for insulation; films for use in glazing; decorative films; tinted films; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Damp proof membranes of synthetic plastics materials; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 35

The bringing together, for the benefit of others, of a variety of building components and materials for use in curtain walling and curtain wall facades, articles of aluminium, building components, windows, and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the Internet; wholesale and retail services in relation to sanitisers for household use; paint brushes; paint trays; clamps (non-metallic) for fixing windows, non-metallic ladders, glass cleaning implements, cleaning

cloths, mops; household utensils for cleaning; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk; wholesale and retail services in relation to paints, sealants, primers; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk, paints, sealants, primers, cleaning preparations, glass cleaners, glass cleaning preparations, window cleaners in spray form, cleaning preparations for use on multi-surfaces, cleaning preparations for use on plastics, cleaning preparations for use on woods, soaps in liquid form, sugar soap, wipes incorporating cleaning preparations; wholesale and retail services in relation to curtain walling and curtain wall facades, metallic building components and materials for use in curtain walling and curtain wall facades, ... windows, balustrades of metal, balusters of metal, balustrading of metal, aluminium profiles, aluminium supports for panels, ... metal ladders, ... handrails of metal, ... metal gates, parts and fittings for the aforesaid; wholesale and retail services in relation to ..., software for ... gates and windows, electric doorbells, security cameras, ... alarm systems, smart windows, software for use with ... windows; wholesale and retail services in relation to sealing tape for use with insulated glass, seals, sealants and fillers, insulation and barrier articles and materials, films for windows, privacy films for windows and doors, anti-glare films, plastic films for insulation, films for use in glazing, decorative films, tinted films; wholesale and retail services in relation to curtain walling and curtain wall facades, non-metallic building components and materials for use in curtain walling and curtain wall facades, windows, ... gates, windows and window coverings, not of metal, ..., glazing, double glazing, ..., balcony enclosures (metallic), balcony enclosures (non-metallic), handrails, not of metal, damp proof membranes of synthetic plastics materials, parts and fittings for all the aforesaid; information and advisory services relating to the aforesaid; but not including any

commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Metalworking; joinery; custom manufacture of ... gates and windows; metal fabrication and finishing services; metal finishing; metalworking; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Average consumer and the purchasing process

111. 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*, paragraph 26.

112. The opponent submits that “*The relevant public includes wholesalers, property developers, tradespeople, contractors, builders, architects, and the general public*”.²⁵ I agree that the average consumer is likely to be a builder, contractor or property developer, and that for some of the goods and services it may also be a tradesperson or a member of the public. However, I consider that the following contested goods are only likely to be purchased by a builder, contractor or property developer: *Curtain walling and curtain wall facades; metallic building components and materials for use in curtain walling and curtain wall facades; parts and fittings for the aforesaid* (all three terms in Class 6); *Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; parts and fittings for all the aforesaid* (all three terms in Class 19).

113. The opponent also submits that the level of attention paid would be high. In terms of the purchasing process, the opponent argues that the goods are unlikely to be on general display and that instead the customer will need to ask for them. Consequently,

²⁵ Written submissions, paragraph 7(ii).

in its view, the aural aspect of the mark will be important. The applicant makes no specific submissions on any of these points.

114. I accept the opponent's submissions on the level of attention paid. In my view, both visual and aural aspects of the mark will be significant, as the average consumer is also likely to view promotional material or websites before making the purchase.

Comparison of marks

115. It is clear from *SABEL* (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* 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.”

116. 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.

117. The respective marks are shown below:

Contested mark	Earlier mark
DORTECH	DORTEK

118. The earlier UKTM and EUTM are identical so I shall refer to them as “the earlier mark” from now on.

119. Both marks consist of single words beginning with the same five letters. In my view, given the goods and services at issue, the first three letters, “DOR”, will be perceived as a misspelling of the word “DOOR”. The second part of the contested mark will be recognised as an abbreviation of the word “TECHNOLOGY”. I consider that the second part of the earlier mark is likely to be perceived as a misspelling of that same abbreviation. The overall impression of both marks lies in the combination of the two elements into a single word.

120. The applicant submits that the marks are not similar at all. I cannot agree with this. As I have already noted, the first five letters of the marks are identical. The contested mark then has a further two letters and the earlier mark a further letter. In my view, the marks are visually highly similar. I also agree with the opponent that they are aurally identical. Given my findings on how the average consumer would perceive both marks, as meaning “Door Technology”, I find that the marks are also conceptually identical.

Distinctive character of the earlier mark

121. 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).”

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

123. The opponent submits that the earlier mark is highly distinctive as it has no meaning in relation to the goods and services. All the goods and services that survived the proof of use assessment relate to doors and I disagree that the mark has no meaning in the context of these goods and services. However, I do consider that the misspelling and the juxtaposition of the words elevates the distinctive character of the mark to a medium degree.

124. When I was considering proof of use, I made detailed comments on the shortcomings of the evidence. The evidence given on market share is, in my view, too vague for me to give it any weight. I accept that the mark appears to have been in use for some time, but there is very little specific evidence to indicate how the mark has been promoted. In my view, the evidence falls short of what would be required to show that the distinctive character of the mark had been enhanced through the use made of it.

Conclusions on likelihood of confusion

125. 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. However, I am required to take account of the interdependency principle, i.e. that 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.

126. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different but assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

127. Notwithstanding the high degree of attention paid by the average consumer, it is my view that, all other things being equal, the similarity between the marks is so high that they will be mistaken for each other. Marks are rarely seen side by side and imperfect recollection cannot be ruled out. In my view, there is a *prima facie* likelihood of direct confusion between them, even where the goods and services are similar to only a low degree.

Honest concurrent use

128. In the previous paragraph, I used the phrase “all other things being equal”. This is because the applicant argues that it has a defence of honest concurrent use, as it claims that the parties have co-existed for many years. I therefore need to decide whether the evidence shows such use and, if so, any effect it might have on my assessment of the likelihood of confusion.

The applicant’s evidence of use of the contested mark

129. Mr Sutherland states that the Dortech Group of companies, of which the applicant is a part,

“7. ... has over 30 years of experience in the industry, and are market leaders in curtain walling, aluminium windows, entrance doors and roof lights, trading throughout under the Dortech mark. Dortech Architectural Systems Ltd is a specialist glazing contractor who designs, manufactures and installs curtain walling, aluminium windows, glazed rooflights, canopies, entrance screens, aluminium entrance and exit doors. Dortech Maintenance Ltd provides maintenance services for a variety of aluminium windows, curtain wall and aluminium door systems including those from the product ranges of Schueco, Sapa, Wicona, Technal and Senior Architectural

Systems. Dorteck Direct Ltd is an online retail company that stocks and distributes building and glazing materials to the construction industry.”

130. He adds that the applicant is the owner of the trade marks used by the group, which include UKTM No. 2500448, registered for goods and services in Classes 6, 19, 35 and 37 related to curtain walling and windows:²⁶



131. Mr Sutherland states that the applicant’s goods and services have been offered for sale through its websites. Exhibit JSEX3 contains screenshots obtained via the Wayback Machine. These date from 15 January 2008 to 25 December 2019.

132. The word “Dorteck” is used, as are the following signs:



133. The website screenshots refer to glazing and curtain walling projects, including an office and hotel development scheme in Sheffield (2007), Darwen Academy (2008), Keighley College (2009), South Leicestershire College (2010), Kelvin Hall Academy, Hull (2012), Dyke House College, Hartlepool (2012), Wakefield Metropolitan District Council offices (2012), NHS Douglas Mill, Bradford (2012), Future Business Centre, Cambridge (2013), Munroe Court, Leeds (2014), University of Hull’s Brynmor Jones Library (2015), Kirklees Leisure Centre (2015). Later screenshots show work carried out at the University of Central Lancashire, Exchange Court in Manchester, Clippers

²⁶ The specification can be seen in the Annex to this decision.

Quay at Salford and the Great Sankey Neighbourhood Hub at Warrington. Where information is given on the projects, it indicates that Dortech tends to be employed by main building contractors to carry out the works.

134. Exhibit JSEX4 contains examples of product catalogues. Three are dated 2019-2020 but the others are undated. The goods shown include sealants, glazing compounds, primers, tapes, damp proof membranes and adhesives sold under the ARBO mark; curtain walls; rooflights; doors and door fittings; balconies; balustrading, shop front glazing; and glass fitting tools. No information is given on how widely these have been distributed. Furthermore, I have doubts as to whether one of them was distributed in the form in which it appears in the exhibit as it contains the typesetting sample text “*Lorem ipsum dolor sit amet...*”, etc.²⁷ At this point, I wish to make it clear that the product catalogues that relate to doors and door fittings are among those that are undated.

135. Approximate figures for total order value received and turnover are shown in the table below. Mr Sutherland states that they relate to goods bearing the mark, but does not specify which goods these were:²⁸

Year	Total Order Value Received	Turnover
1993	£1,305,916	
1994	£1,765,459	
1995	£1,833,913	
1996	£1,833,858	
1997	£2,490,261	
1998	£2,281,610	
1999	£3,915,133	
2000	£3,888,493	
2001	£3,953,016	
2002	£3,552,426	
2003		£4,399,044
2004		£3,158,679

²⁷ Exhibit JSEX4(2), page 107.

²⁸ Paragraph 12.

Year	Total Order Value Received	Turnover
2005		£4,051,846
2006		£5,359,201
2007		£9,636,530
2008		£9,956,703
2009		£11,464,048
2010		£11,487,473
2011		£10,914,401
2012		£9,493,438
2013		£5,723,987
2014		£6,915,473
2015		£9,261,987
2016		£8,121,884
2017		£8,007,628
2018		£8,343,904
2019		£8,831,886
2020		£8,760,637

136. Exhibit JSEX5 contains a selection of invoices dating from 3 December 1999 to 4 August 2020. Some of these invoices cover the types of projects described in Exhibit JSEX3, while others are lower value. I cannot always identify the product, but they do include sealants, adhesives and membranes.

137. Exhibit JSEX6 contains annual financial statements for Dorteck Architectural Systems Limited for the years ending 30 September 2018 and 30 September 2019.

138. Exhibit JSEX7 contains testimonials from clients. The include letters dated 22 April 2005, 25 October 2006, 28 March 2007 and 2 June 2009. There are also five pages of undated comments.

139. Mr Sutherland states that the applicant has spent the following sums on promoting the mark:²⁹

²⁹ Paragraph 16.

Year	Total Advertising Spend
2013	£19,100
2014	£28,300
2015	£45,200
2016	£76,200
2017	£139,684
2018	£162,838
2019	£155,034
2020	£191,122

140. It is not clear how these sums were spent.

141. Exhibit JSEX8 contains press articles mentioning “Dortech” from the *Huddersfield Daily Examiner* (18 December 2007, 8 July 2009, 16 April 2012, 13 June 2012, 7 August 2012), the *Yorkshire Post* (13 November 2008), *Kirklees Business News* (9 August 2011, undated), *Glass & Glazing Products* (February 2008), aluminiumarchitecture.co.uk (February 2011), TheBusinessDesk.com (6 August 2012), the *Brighouse Echo* (2 February 2012). There are also articles that appear to be from the applicant’s own newsletters.

142. Exhibit JSEX9 contains details of awards won by the applicant. These were given by HBG Construction, BAM Construction and Willmott Dixon, all of whom appear to be building and construction companies.

143. Exhibit JSEX10 contains an extract from a report showing that the Dortech Direct website had 50,000 visitors. Mr Sutherland states that this covers the year 2021.

144. Mr Sutherland states that the mark has been promoted through the applicant’s YouTube channel and his own LinkedIn account. Exhibit JSEX11 shows a series of pages headed “Current LinkedIn stats” and dated 05/05/2017, 10/08/2017, December 2017, February 2018, showing engagement with individual posts. It also shows that Mr Sutherland’s account had 9,105 followers, although the date of that information is not given. Number of viewers on the YouTube channel are provided in a table in paragraph 20 of Mr Sutherland’s witness statement. Two figures are given for 2016:

9,664 views and 15,019 views. The remaining figures are 19,084 views (2017), 58,128 views (2018) and 103,722 views (2019).

Cooperation between the parties

145. In 2012, the parties corresponded about an application from a third party to register DOORTECH as a trade mark in the UK. The opponent offered support to the applicant in these proceedings, who had opposed the DOORTECH application. An email chain from the time can be found in Exhibit JSEX12.

146. On 23 August 2012, the opponent's legal representative stated that the two firms *"had agreed to co-exist because you accept that there is no overlap between your respective offers. As you say the addition of a further entity with the identical sounding name and using your names as keywords will dilute both DORTEK and Dorteck"*. There followed some emails discussing the DOORTECH opposition.

147. On 21 November 2012, Mr Sutherland wrote to Mr O'Keane asking him *"for any further thoughts you have had in respect to drawing up a 'co-existence' type agreement between our two companies"*. Mr O'Keane replied the same day:

"I'll be honest I hadn't realised or remembered that you proposed a 'co-existence agreement'/MOU between Dorteck and Dorteck but yes I would have no problem with that."

148. Mr Sutherland then emailed Mr O'Keane an initial list of the products and services offered by the applicant. Mr O'Keane said that he would have a look at this the following week but noted that he saw a small amount of overlap as *"we would very occasionally do internal aluminium doors in industrial plants. Otherwise we are in a different 'space'."* Both these emails were sent on 21 November 2012.

149. Mr Sutherland refers to the opponent's *"express consent to this co-existence"*,³⁰ but there is no evidence to show what happened after the emails of 21 November 2012. In particular, there is no evidence that a co-existence agreement was drawn up and signed. Mr Sutherland states that the opponent was, however, fully aware of the

³⁰ Paragraph 26.

type of products offered by the applicant and that any additional goods and services are consistent with the business model of the applicant.

Assessment of the claim of honest concurrent use

150. I shall deal first with the applicant's submission that the opponent had acquiesced in the applicant's use of the contested mark.³¹ Statutory acquiescence (under section 48 of the Act) only applies to registered trade marks, not to signs that are the subject of trade mark applications. However, there is also what is known as "common law acquiescence" or "estoppel by acquiescence", where a party stands by in such a manner as to induce the party committing an act to believe that it consents to it. However, this is a claim that, if it were to be relied on, should have been pleaded. The applicant does not follow up on this early submission, so I take it that it is only honest concurrent use that is of relevance here.

151. The applicant has referred me to the decision of Carr J in *Victoria Plum Ltd (t/a Victoria Plumb) v Victorian Plumbling Ltd & Ors* [2016] EWHC 2911 (Ch) as authority for the key principles of honest concurrent use. In his judgment, Carr J considered the decision of the CJEU in *Budějovický Budvar NP v Anheuser-Busch*, Case C-482/09 ("the *Budweiser* case"), and the Court of Appeal's judgments in both that case and *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1439. He stated that a defence of honest concurrent use could, in principle, defeat an otherwise justified claim of trade mark infringement:

"74. The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's

³¹ Written submissions in lieu of a hearing, paragraph 3.

trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone.

iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill."

152. In assessing whether the defendant had acted honestly, the judge directed attention to the following factors at paragraph 79:

"i) The defendant has a duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

ii) All circumstances must be considered when ascertaining whether or not the use by the defendant is honest, including whether the defendant can be regarded as unfairly competing with the trade mark proprietor.

iii) However, the question is not simply whether use of the sign complained of gives rise to consumer deception, as such deception may have to be tolerated. Similarly, the defendant may well be aware of the existence of such confusion, having lived with it for a considerable period.

iv) The question is whether the defendant has taken steps which exacerbate the level of confusion beyond that which is inevitable and so has encroached upon the claimant's goodwill.

v) Whether the defendant ought to be aware that such steps will exacerbate confusion is a relevant factor."

153. The applicant also referred me to a passage from *Bentley 1962 Limited v Bentley Motors Limited* [2019] EWHC 2925 (Ch), in which the law was reviewed in paragraphs 85-88. However, a more recent review was carried out by Arnold LJ in *Match Group LLC & Ors v Muzmatch Limited & Anor* [2023] EWCA Civ 454. He considered all the aforementioned case law, including *Bentley*, and stated the following in paragraphs 115 to 119:

- a) Honest concurrent use is not a defence against infringement, but a factor in the analysis of the likelihood of confusion;
- b) A claim of honest concurrent use may defeat an allegation of infringement under section 10(1) and 10(2) of the Act, because it shows that the conditions for infringement are not satisfied;
- c) It may do so even if there is some actual confusion on the part of consumers, if most of the relevant class of consumers have come to understand that the trade mark and the sign denote different trade origins;
- d) In addition, it may do so even if the trade mark proprietor is the senior user;
- e) Once the trade mark proprietor has established a *prima facie* case of infringement, the burden shifts to the alleged infringer to establish that, by virtue of its honest concurrent use, there is nevertheless no adverse effect on any of the functions of the trade mark;
- f) The relevant date is the date when use of the sign complained of commenced;
- g) The assessment is not a “once-and-for-all assessment”. In theory, use which was initially infringing could eventually cease to be infringing if:
 - i) The trade mark proprietor took no action;
 - ii) There was substantial parallel trade for a long period; and
 - iii) As a result the trade mark and the sign came to be understood by the relevant class of consumers as denoting different trade origins.

154. The *Budweiser* case shows that honest concurrent use may also be relevant in trade mark opposition and cancellation proceedings. The CJEU also stressed in this case that the circumstances were exceptional.

155. The applicant submits that the opponent was aware of its use of the contested mark and agreed that there was no overlap between the parties’ goods and services. However, what the parties know about each other’s use is not relevant; what matters is the perception of the average consumer. This must be an objective test based upon

evidence and, because such cases will be exceptional, it follows that the evidential hurdle is relatively high.

156. I am satisfied that the applicant has been using the mark DORTECH for at least some of the goods and services of the application since 1999. I can therefore accept that use has been longstanding. On the basis of the evidence, I find that the use has centred on curtain walling and other glazing. There is an overlap in the type of projects that both parties have engaged in, for example, leisure centres and NHS facilities. Furthermore, it is my view that both parties' goods and services have been purchased by construction companies. Several of the invoices filed by the opponent are made out to construction companies, including Interserve, which is also a customer of the applicant. It is, in my view, reasonable to infer that this type of average consumer would be likely to have come across both parties. However, many of the goods would be purchased by members of the general public or tradespeople operating as small businesses. In my view, this would apply with respect to doors, windows and related goods and services.

157. Consequently, it is my view that, where those goods and services are likely to be purchased by construction companies and not by smaller tradespeople or members of the general public, the concurrent use leads me to find that there would not be a likelihood of confusion for the following goods and services:

Class 6

Curtain walling and curtain wall facades; building components and materials for use in curtain walling and curtain wall facades; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; parts and fittings for all the aforesaid, but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with curtain walling, curtain wall facades, building components and materials for use in curtain walling and curtain wall facades, ... and parts, fittings and accessories therefor; information and advisory services relating thereto; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Outcome of section 5(2)(b) ground

158. The opposition is successful under section 5(2)(b) in respect of the following goods and services:

Class 6

Articles of aluminium; windows; balustrades of metal; balusters of metal; balustrading of metal; aluminium profiles; aluminium supports for panels; metal door frames; metal doors; aluminium doors; handrails of metal; metal door handles; door hinges of metal; metal door knockers; letterboxes; escutcheons of metal; metal gates; roof lights [windows] of metal parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric motors for use with doors; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 9

Software; software for doors, gates and windows; smart doors; smart door locks; smart windows; software for use with doors and windows; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Windows; door panels, not of metal; doors, gates, windows and window coverings, not of metal; doors made of glass for buildings; glazing; double glazing; glass doors; balcony enclosures (non-metallic); handrails, not of metal; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 35

The bringing together, for the benefit of others, of a variety of articles of aluminium building components and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the internet; Wholesale and retail services in relation to software, software for doors, smart doors, smart door locks, software for use with windows; Wholesale and retail services in relation to articles of aluminium, metal door frames, doors, metal doors, metal door handles, door hinges of metal, metal door knockers, letterboxes, escutcheons of metal; Wholesale and retail services in relation to door panels, not of metal, doors, not of metal, doors made of glass for buildings, glass doors; Information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with doors, automatic doors, door frames, gates, coating, windows and parts, fittings and accessories therefor; information and advisory services relating thereto; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Custom fabrication and manufacture of steel construction elements; custom manufacture; custom manufacture of doors; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on

hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Section 5(3)

159. 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.”

160. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

161. 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."

162. The factors that are relevant for an assessment of reputation are the same as those that are relevant in the assessment of enhanced distinctiveness. The evidence of the opponent is not specific enough for me to be able to say that the earlier marks would be known by a significant part of the relevant public, who, in my view is the same as the average consumer of section 5(2)(b). The market share of 85% is an impressively high figure, but I am not told the period that this figure relates to, or the geographical region. I have also referred to the article on the global high speed doors market in 2021, but this provides very little information specific to the earlier mark. All it says is that it is one of 19 "key players" discussed in Chapter 9 of a longer report. Furthermore, these key players include *"not only the leading enterprises that have a voice on a global scale, but also the regional small and medium-sized companies that play key roles and have plenty of potential growth"*.³² It is difficult, then, to draw any

³² Exhibit AOK14, page 274.

robust conclusions on the reputation of the opponent at the relevant date. The section 5(3) ground therefore fails.

Section 5(4)(a)

163. 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

...”

164. 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.”

165. 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."

166. *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

167. 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.”

168. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act where one or both of the parties have used the mark at issue prior to the date of the application to register the contested mark. He explained that:

“41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user’s mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: ‘date of commencement of the conduct complained of’. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.”

169. In *Smart Planet Technologies, Inc. v Sharma*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when the first offer was made to market relevant goods or services under the mark. However, it could also be the date that the first public-facing indication was made that sales were proposed to be made under the mark in the future. If the user of the applied-for mark were not passing off at the time such use commenced, they will not normally be passing off by continuing to use the mark.

170. The application date of the contested mark is 20 September 2020. Earlier in my decision, I found that the applicant had used the contested mark before the date on which it applied to register it. Mr Sutherland has provided turnover figures from 1993, but, as I have already noted, does not specify which goods and services generated the revenue. Apart from this, the earliest evidence comes from invoices. An invoice dated 3 December 1999 refers to additional items, which include the supply and installation of “16 gauge pressings, fixed to back of our curtain walling to cover the front of the columns” and the removal and replacement of windows. There is another invoice for curtain wall and glazing works at a Peugeot dealership in Harrogate (11 August 2000); one covering the installation of electronic shoot bolts to the main entrance doors and the installation of door closers (30 August 2002); and another referring to windows and fixed lights (19 October 2005). “Dortech Architectural Systems Ltd” appears at the top of these invoices.³³ Press articles and website information on curtain wall and glazing projects start from 2007. This is also when the first mention of doors can be seen. I have already given details of these in paragraphs 133 and 141 above. To give a few examples, these describe the supply of aluminium curtain walling, windows and doors in projects such as the Tiger Developments City Gate project in Sheffield (2007-2008), Darwen Academy (2008), Keighley College (2009).

171. Consequently, I will consider the position from 3 December 1999 (curtain walling and windows) and 2007 (doors).

Goodwill

172. 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]:

“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

³³ Exhibit JSEX5, page 126-129.

attraction sufficient to bring customers home to the source from which it emanates.”

173. The opponent claims to have been using the earlier sign from May 1989. The applicant submits that the opponent’s evidence does not support such a claim.

174. Mr O’Keane has provided turnover figures going back as far as 1997. These are shown in the table below:³⁴

Year	Turnover (£)
1997	3,133,302
1998	4,011,815
1999	3,833,103
2000	3,998,174
2001	3,619,712
2002	4,003,777
2003	4,267,716
2004	4,290,415
2005	5,471,156
2006	5,021,948
2007	5,926,798
2008	6,169,602
2011	7,821,970.70
2012	7,166,760.90
2013	7,368,188.38
2014	7,979,321.64
2015	11,288,119.75
2016	12,444,669.42
2017	11,615,389.27
2018	8,215,321.99
2019	9,678,971.26
2020	9,800,100.04
2021	8,398,419.26

175. Exhibit AOK15(c) contains an article from the *Hull & Beverley Independent*, 17 November 1989:

“A new Hull business has won a £60,000-plus order to supply specialist doors for the new Birds Eye plant in Grimsby.

³⁴ Paragraph 10.

The deal is a significant coup for DorteK, which began trading in June. The company provides and installs doors which perform vital sealing and hygienic functions for industries such as the food and pharmaceutical trades.”

176. The article goes on to say that the business was set up to work with an Irish-based door manufacturer, Wen-plast:

“Wen-plast, based in Wicklow, had used a previous firm as agent but switched to DorteK when the business was formed. The two companies now have associated status, with the Hull firm supplying Wen-plast doors throughout the UK and even further afield.

The doors are made of fibre glass and are moulded so that there are no joins or cracks where bacteria can grow.

DorteK, based at Hull Business Centre, in Guildhall Road, also supplies high-tech sliding doors made by a Dutch firm, for use in freezers, chilling plants, meat factories and so on. The first such door to be installed in the country was recently put in at Hull cooked meat suppliers Oswald T Hall of Lee Smith Street.”

177. I can accept that the opponent was providing installation services for doors, which were being supplied under other signs, in 1989. However, I need to look further to ascertain whether there is any evidence of the opponent supplying doors and door-related goods in 2007 or earlier.

178. The information sheets in Exhibits AOK3 and AOK5 to AOK11 refer to DorteK doors. For example, in Exhibit AOK6 a sheet entitled “Healthcare Doors” states that:

“DorteK understands hygienic environments. As hygiene standards rise in hospitals around the world, DorteK continues to develop new products with patient safety and infection control in mind.”

179. This suggests that products are sold under the DorteK name. The difficulty for the opponent is that this sheet, and most of the remaining material in these exhibits, is undated. The exceptions are as follows:

a) In Exhibit AOK5, there is a list of pharmaceutical clients. The source of this is not clear and it is presented as follows:³⁵

Pharmaceutical Clients

Name	Date(s)
Astra Zeneca, Macclesfield	Ongoing since 1995
Glaxo SmithKline, Irvine	Ongoing since 2000
MSD, Cramlington	Ongoing since 1990
Pirimal (formerly Sanofi), Morpeth	Ongoing since 1990
Lonza, Slough	Ongoing since 2014

AOK05

b) In Exhibit AOK6, there is a list of healthcare clients, presented in the same way:³⁶

Healthcare Clients

Name	Date(s)
Guys & St Thomas' Hospital NHS Trust, London	2003 onwards
The London Clinic, Harley Street	2012
Salford Royal, Manchester	2018 and 2022
Spire Healthcare (nationally)	from 2016 onwards
BMI Healthcare/Circle Health (nationally)	from 2017 onwards

AOK06

c) In Exhibit AOK08, there is a list of retail clients, presented in the same way:³⁷

Retail Clients

Name	Date(s)
Lidl, nationally	2003 onwards
Ikea, nationally	2005 onwards
Sainsburys, nationally	1998 onwards
Smyths toy Stores, nationally	2015 onwards
Harrods, London	2015 onwards

AOK08

d) In Exhibit AOK10, there are veterinary clients:³⁸

³⁵ Exhibit AOK05, page 157.

³⁶ Page 167.

³⁷ Page 182.

Veterinary Clients

Name	Date(s)
Dick White Referrals, Newmarket	2016
Battersea Dogs and Cats, London	2020
Large Animal Research and Imaging Facility, Edinburgh	2017
Fitzpatrick Referrals, Sussex	2015
RSPCA, Norfolk	2000

AOK10

180. The precise nature of the work done for these clients and when it was done are not clear. For example, while the next page contains some information on the provision of fire doors and hermetically sealing doors for AstraZeneca in Cheshire, this page contains no dates. The earliest invoice in Exhibit AOK13 dates from 12 January 2015.

181. Turning now to the narrative evidence of Mr O’Keane, I note that he states that:

“12. We design and install specialist door systems to the following industries:

- Pharmaceutical - We have worked with UK based world leaders in the pharmaceutical industry including GSK in Irvine in 2000 ... to install suitable doors/hygienic solutions. ...

...

- Retail – DORTEK doors have been used extensively throughout major retail chains across the world including Ikea, Aldi and Lidl. ...

...

- Veterinary surgeries – within a veterinary surgery, infection control ranks high on the list of priorities. I exhibit herewith at AOK10 further details surrounding our DORTEK installations within surgeries including ... the RSPCA Rehoming Centre at East Winch, Norfolk in 2000. ...”

182. In my view, it is not clear whether the opponent was supplying goods under the sign by 2007. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith*,

Kenwyn House and Gary Stringer (a partnership) [2002] RPC 19 (HC), Pumfrey J stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co Ltd’s Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

183. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J (as he then was) stated that:

“8. [The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must

also do so as of the relevant date, which is, at least in the first instance, the date of application.”

184. In my view, the evidence is not sufficient to show that the opponent had established a protectable goodwill in connection with any goods, as opposed to installing another undertaking's doors, in 2007. Mr O'Keane says that the opponent has manufactured over 250,000 doors since 1968.³⁹ I also acknowledge that the opponent had some significant clients, such as Lidl, AstraZeneca and Ikea by 2007. However, as the 1989 article presents the business as one providing and installing doors made by third parties, there is no evidence to tell me that the doors themselves were supplied under the sign by 2007.

Misrepresentation

185. 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.”

186. It is not necessary for the parties to be operating in a common field of activity: see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) at [714]-[715]. Even

³⁹ Witness statement, paragraph 19.

so, I do not consider that this ground puts the opponent in any better position over the section 5(2)(b) ground. It is my view that for those goods and services in relation to which I found no likelihood of confusion, the differences in the fields of activity would be sufficient to avoid a substantial number of the relevant public from being misled into believing that the applicant's goods and services are the goods and services of the opponent or an entity linked to it, notwithstanding the high degree of similarity between the contested mark and the applicant's sign.

187. I consider that there is a *prima facie* case that the relevant public are likely to believe that doors, door frames, and goods related to doors, and services of repair, maintenance and custom manufacture of doors are the responsibility of an undertaking with goodwill in the installation of the doors, but I do not consider that this extends any further. It is also my view that it would not extend to installation of curtain walling or curtain wall facades, given the specialist nature of such services.

188. The applicant submits that no misrepresentation can be deemed to exist because of its honest concurrent use of the contested mark. In *W. S. Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18 (PCC), Mr Iain Purvis QC, sitting as a Deputy Judge, set out the following test for whether honest concurrent use provides a defence in a passing off action:

“61. The authorities therefore seem to me to establish that a defence of honest concurrent use in a passing off action requires at least the following conditions to be satisfied:

(i) the first use of the sign complained of in the United Kingdom by the Defendant or his predecessor in title must have been entirely legitimate (not itself an act of passing off);

(ii) by the time of the acts alleged to amount to passing off, the Defendant or his predecessor in title must have made sufficient use of the sign complained of to establish a protectable goodwill of his own;

(iii) the acts alleged to amount to passing off must not be materially different from the way in which the Defendant had previously carried on business when the sign was originally and legitimately used, the

test for materiality being that the difference will significantly increase the likelihood of deception.”

189. The first use of the sign complained of is 3 December 1999 for curtain walling and windows and 2007 for doors. I consider that the use in relation to curtain walling and windows was not an act of passing off, given the distance between the applicant’s goods and services and the services for which the opponent had protectable goodwill (installation of doors in industrial and commercial settings). On the basis of the evidence I have already summarised in paragraphs 129-144 of this decision, I consider that the applicant had made sufficient use of the sign to establish a protectable goodwill of its own for curtain walling, windows and other glazing by the time of the application for the contested trade mark. However, I come now to Mr Purvis’s third condition. The specification applied for covers a significantly wider range of goods and services than were being offered by the applicant when it first used the sign. Mr Sutherland states that:

“23. Our products and service range has naturally evolved over time, expanding beyond the goods and services covered by the Dorteck Registration. The products and services captured by the Application are all however consistent with the Dorteck business model, principally relating to tools, apparatus and services for doors, curtain walling and glazing.”⁴⁰

190. As I have already noted, the Dorteck Registration covers goods and services related to curtain walling and windows. It is my view that seeking registration for goods and services beyond those for which the contested mark was originally used, falls foul of Mr Purvis’s third condition. The applicant may not therefore rely on a defence of honest concurrent use under this ground.

191. I find that misrepresentation is made out for the following goods and services:

Class 6

Metal door frames; metal doors; aluminium doors; metal door handles; door hinges of metal; metal door knockers; letterboxes; escutcheons of metal; parts and fittings for the aforesaid; but not including any commercial and industrial use

⁴⁰ The “Dorteck Registration” is UKTM No. 2500448 and the specification can be seen in the Annex to this decision.

on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric motors for use with doors; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Door panels, not of metal; doors, not of metal; doors made of glass for buildings; glass doors; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with doors, automatic doors, door frames and parts, fittings and accessories therefor; information and advisory services relating thereto; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Custom manufacture of doors; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Damage

192. 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."

193. The opponent submits that damage would occur both from loss of sales and loss of control of the quality of goods and services. I consider that the customer of the services for which I found that the opponent has goodwill is likely to be exercising a fairly high degree of care. However, in the case of the Class 37 services listed above, I consider that there is a risk of a loss of sales, given the identity and high degree of similarity between the services and the high degree of similarity between the contested mark and the sign. In respect of the remaining goods and services for which I found misrepresentation, I consider that there is likely to be damage through loss of control.

194. The section 5(4)(a) ground is successful for the goods and services listed in paragraph 191 above.

OUTCOME

195. The opposition has been partially successful. Registration is refused for the following goods and services:

Class 6

Articles of aluminium; windows; balustrades of metal; balusters of metal; balustrading of metal; aluminium profiles; aluminium supports for panels; metal door frames; metal doors; aluminium doors; handrails of metal; metal door handles; door hinges of metal; metal door knockers; letterboxes; escutcheons of metal; metal gates; roof lights [windows] of metal; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric motors for use with doors; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 9

Software; software for doors, gates and windows; smart doors; smart door locks; software for use with doors and windows; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Windows; door panels, not of metal; doors, gates, windows and window coverings, not of metal; doors made of glass for buildings; glazing; double glazing; glass doors; balcony enclosures (non-metallic); handrails, not of metal; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 35

The bringing together, for the benefit of others, of a variety of articles of aluminium building components and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the Internet; wholesale and retail services in relation to articles of aluminium, metal door frames, doors, metal doors, metal door handles, door hinges of metal, metal door knockers, letterboxes, escutcheons of metal; wholesale and retail services in relation to software, software for doors, smart doors, smart door locks, software for use with doors; wholesale and retail services in relation to door panels, not of metal, doors, not of metal, doors made of glass for buildings, glass doors; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with doors, automatic doors, door frames, gates, coating, windows and parts, fittings and accessories therefor; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Metalworking; custom fabrication and manufacture of steel construction elements; joinery; custom manufacture; custom manufacture of doors, gates and windows; metal fabrication and finishing services; metal finishing; metalworking; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

196. Subject to a successful appeal, the application may proceed to registration in respect of the following goods and services (including those goods that were not opposed):

Class 1

Water repellents (chemicals); stain repellents; industrial adhesives; spray adhesives; screen adhesives; adhesives for glazing; adhesives for glass; adhesives for construction; adhesives for building use; substances for removing adhesives; adhesives for applying small coverings; commercial glues; caulk.

Class 2

Paints; sealants; primers.

Class 3

Cleaning preparations; glass cleaners; glass cleaning preparations; window cleaners in spray form; cleaning preparations for use on multi-surfaces; cleaning preparations for use on plastics; cleaning preparations for use on woods; soaps in liquid form; sugar soap; wipes incorporating cleaning preparations.

Class 6

Curtain walling and curtain wall facades; metallic building components and materials for use in curtain walling and curtain wall facades; metal ladders; parts and fittings for the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 7

Electric window cleaning equipment; electric power tools; glass cutters (electrically operated); electric motors for use with windows; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 9

Electric doorbells; security cameras; alarm systems; smart windows; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 17

Sealing tape for use with insulated glass; seals, sealants and fillers; insulation and barrier articles and materials; films for windows; privacy films for windows and doors; anti glare films; plastic films for insulation; films for use in glazing; decorative films; tinted films; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 19

Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; damp proof membranes of synthetic plastics materials; parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 35

The bringing together, for the benefit of others, of a variety of building components and materials for use in curtain walling and curtain wall facades, windows, and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the Internet; wholesale and retail services in relation to sanitisers for household use; paint brushes; paint trays, clamps (non-metallic) for fixing windows, non-metallic ladders, glass cleaning implements, cleaning cloths, mops; household utensils for cleaning; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk; wholesale and retail services in relation to paints, sealants, primers; wholesale and retail services in relation to water repellents (chemicals), stain repellents, industrial adhesives, spray adhesives, screen adhesives, adhesives for glazing, adhesives for glass, adhesives for construction, adhesives for building use, substances for removing adhesives, adhesives for applying wall coverings, commercial glues, caulk, paints, sealants, primers, cleaning preparations, glass cleaners, glass cleaning preparations, window cleaners in spray form, cleaning preparations for use on multi-surfaces, cleaning preparations for use on plastics, cleaning preparations for use on woods, soaps in liquid form, sugar soap, wipes incorporating cleaning preparations; wholesale and retail services in relation to curtain walling and curtain wall facades, metallic building components and materials for use in curtain walling and curtain facades, windows, balustrades of metal, balusters of metal, balustrading of metal, aluminium profiles, aluminium supports for panels, metal ladders, handrails of metal, metal gates, parts and fittings for the aforesaid; wholesale and retail services in relation to electric window cleaning equipment, electric power tools, glass cutters (electrically operated), electric motors for use with doors, electric motors for use with windows, parts and fittings for all of the aforesaid; wholesale and retail services in relation to software for gates and windows, electric doorbells, security cameras, alarm systems, smart windows, software for use with windows; wholesale and retail services in relation to sealing tape for use with insulated

glass, seals, sealants and fillers, insulation and barrier articles and materials, films for windows, privacy films for windows and doors, anti-glare films, plastic films for insulation, films for use in glazing, decorative films, tinted films; wholesale and retail services in relation to curtain walling and curtain wall facades, non-metallic building components and materials for use in curtain walling and curtain wall facades, windows, gates, windows and window coverings, not of metal, glazing, double glazing, balcony enclosures (metallic), balcony enclosers (non-metallic), handrails, not of metal, damp proof membranes of synthetic plastics materials, parts and fittings for all the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 37

Installation, maintenance and repair services in connection with curtain walling, curtain wall facades, building components and materials for use in curtain walling and curtain wall facades; information and advisory services relating thereto; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

Class 40

Metalworking; joinery; custom manufacture of gates and windows; metal fabrication and finishing services; metal finishing; metalworking; information and advisory services relating to the aforesaid; but not including any commercial and industrial use on hygienic, hermetic, x-ray, lead-line, high speed and/or sectional doors or transfer hatches or doors made of wood and GRP.

COSTS

197. Both parties have enjoyed some success in these proceedings, with the greater share going to the applicant, who is entitled to a contribution to its costs. It has requested that an off-scale cost award be made.

198. First, the applicant submits that the opponent has put it to significant unnecessary costs, given the opponent's prior knowledge of the business, their co-operation and, the words of the applicant, "*the obviously different fields of use*".⁴¹

199. Secondly, the applicant submits that the opponent has not fully engaged in settlement discussions with the applicant, despite a limitation to the opposed classes being filed on 21 November 2023 and a series of suspensions. I have already noted that the parties took the opportunity to have an extended cooling-off period. This lasted 18 months and expired on 3 October 2022. A further stay request was made on 22 February 2023 and the Registry agreed to stay the proceedings until 6 April 2023. The opponent then filed its evidence. A further joint request was made to stay the proceedings on 15 September 2023. The parties claimed that they were close to concluding a settlement and provided brief details of the action that had been taken. The request was granted. The applicant provides the following chronology which, it submits, shows a lack of engagement by the opponent in these later stages:

9 October 2023: Email from the applicant's legal representative to the opponent's legal representative.

16 October 2023: Email from the applicant's legal representative to the opponent's legal representative.

31 October 2023: Email from the applicant's legal representative to the opponent's legal representative.

8 November 2023: Email from the applicant's legal representative to the opponent's legal representative.

15 November 2023: Email from the applicant's legal representative to the opponent's legal representative.

5 December 2023: Email from the applicant's legal representative to the opponent's legal representative.

11 December 2023: Telephone call between the opponent's legal representative and the applicant's legal representative.

14 December 2023: Email from the applicant's legal representative to the opponent's legal representative.

⁴¹ Written submissions, paragraph 51.

15 December 2023: Email from the opponent's legal representative to the applicant's legal representative.

18 December 2023: Email from the applicant's legal representative to the opponent's legal representative.

18 December 2023: Joint application to stay proceedings.

12 January 2024: Email from the applicant's legal representative to the opponent's legal representative.

18 January 2024: Email from the opponent's legal representative to the applicant's legal representative.

200. The applicant submits that it was actively chasing the opponent, who did not promptly engage with it. It also states that "*The Applicant reached out directly to the Opponent to resolve the Opposition*" and that no response was received. No further details are given. In addition, it submits that the opponent failed to engage fully with it during the cooling off periods, but, again, provides no details.

201. The Tribunal may award costs "off the scale" to deal proportionately with unreasonable behaviour. Section 5.6 of the Tribunal Section of the Trade Marks Manual states that:

"It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some examples of what might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution."

202. I do not consider that it was unreasonable for the opponent to bring the opposition, notwithstanding its awareness of the applicant. Mr Sutherland himself admitted that the goods and services for which registration of the contested mark was sought represent an expansion of the activities of the applicant. The correspondence between the parties relating to a possible co-existence agreement, an agreement which was not provided in evidence and Mr Sutherland does not state was signed, dates from 2012, eight years before the contested application was made. A good deal can happen in eight years and there is no evidence of later correspondence between the parties to indicate the level of the opponent's awareness of the applicant's business.

203. Turning now to the chronology, I accept that it shows that there was a period during which the applicant made numerous attempts to contact the opponent. This appears to have lasted two months (from 9 October 2023 to 11 December 2023, when a telephone call took place). These are the only concrete details that I have been given. It was undoubtedly frustrating for the applicant to have to chase the opponent so many times for a response to its emails, but in the context of the proceedings as a whole I do not consider that this lack of a response over a two-month period is sufficient to warrant off-scale costs. As I have already noted, the applicant has not given me any further details to substantiate its other criticisms of the level of engagement shown by the opponent.

204. I have therefore decided that an award based on the scale set out in Tribunal Practice Notice 2/2016 is appropriate, and I have borne in mind the share of success enjoyed by the applicant. The award is calculated as follows:

£100 for preparing a statement and considering the other side's statement;

£600 for preparing evidence and considering and commenting on the other side's evidence;

£100 for preparing written submissions in lieu of a hearing.

£800 in total

205. I therefore order Dorteck Limited to pay Dorteck Direct Limited the sum of £800. This sum should be paid within twenty-one days of the expiry of the appeal period or,

if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of September 2025

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

ANNEX

Specification for UKTM No. 2500448

Class 6

Curtain walling and curtain wall facades; metallic building components and materials for use in curtain walling and curtain wall facades; articles of aluminium; windows; parts and fittings for the aforesaid goods.

Class 19

Curtain walling and curtain wall facades; non-metallic building components and materials for use in curtain walling and curtain wall facades; parts and fittings for all the aforesaid goods.

Class 35

The bringing together, for the benefit of others, of a variety of building components and materials for use in curtain walling and curtain wall facades, articles of aluminium building components, windows, and parts and fittings for all the aforesaid goods from a general merchandise retail outlet, from a catalogue by mail order or by means of the internet; information relating to the aforesaid services.

Class 37

Installation, maintenance and repair services in connection with curtain walling, curtain wall facades, building components and materials for use in curtain walling and curtain wall facades, building components and materials for use in curtain walling and curtain wall facades, windows and parts, fittings and accessories therefor; information and advisory services relating thereto.