

O/0847/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003986717

IN THE NAME OF ZOE HOLDING LIMITED

FOR THE TRADE MARK:



IN CLASS 9

AND

IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 508285

BY ZHEJIANG DAHUA TECHNOLOGY CO., LTD

BACKGROUND AND PLEADINGS

1. Zoe Holding Limited (“the proprietor”) is the owner of the trade mark shown on the cover page of this decision (“the contested mark”), which was filed on 1 December 2023 and registered on 26 April 2024. It stands registered for the goods shown in Annex 1 to this decision.

2. On 8 January 2025, Zhejiang Dahua Technology Co., Ltd (“the applicant”) applied to invalidate the contested mark pursuant to sections 47 and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The applicant claims to have used a sign identical to the contested mark throughout the UK since March 2022 in relation to “wireless security systems, wireless intruder alarm systems, panic buttons, smoke detectors, internal sirens, alarm hubs, door detectors, PIR-cameras, water leak detectors, PIR detectors, external sirens, alarm repeaters”. The applicant states:

“The cancellation applicant has generated goodwill through significant sales in the UK, in particular through their subsidiary company Dahua Technology UK Limited. It is clear the marks in suit are identical and furthermore the goods are identical, or at least highly similar. As such, there exists a misrepresentation that the proprietor’s goods are those of the applicant. The misrepresentation will cause damage to the applicant through lost sales and their inability to control the quality of the goods bearing the mark will damage the goodwill in the same.

In light of the above it is clear that use of the registration would be contrary to the law of Passing Off.”

3. The proprietor filed a counterstatement denying the claims made and claiming to have created the contested mark itself in 2020, prior to the applicant’s claimed first use.

4. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

5. The applicant is represented by Bailey Walsh & Co LLP.

6. The proprietor is unrepresented.

EVIDENCE AND SUBMISSIONS

7. The applicant filed evidence in chief in the form of the witness statement of Philip Stephenson dated 25 June 2025, which is accompanied by 2 exhibits (PS1 and PS2). Mr Stephenson is a trade mark attorney acting on behalf of the applicant in these proceedings.

8. The applicant's evidence was accompanied by undated written submissions.

9. The proprietor did not file evidence or written submissions.

RELEVANCE OF EU LAW

10. 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

11. Section 5(4)(a) of the Act has application in invalidation proceedings by virtue of section 47, the relevant parts of which state:

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

(a) [...]

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

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

[...]

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

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

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

12. Section 5(4)(a) states:

“(4) 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 of 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 (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

13. Subsection (4A) of section 5 states:

“(4A) 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.”

14. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

15. The prima facie relevant date is the filing date of the contested mark i.e. 1 December 2023. I note that, in its counterstatement, the proprietor has indicated that it first created the contested mark in 2020. However, no evidence has been filed in support of this and it is not clear when the mark was first publicly used such that it

could amount to the start of the behaviour complained about.¹ In any event, for reasons that will become clear below, nothing will turn on this. As such, I will only consider the position at the prima facie relevant date.

Goodwill

16. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage 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.”

17. 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 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 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.

¹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

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.”

18. The evidence filed by the applicant in this case is exceptionally thin. It consists of:

- a. A catalogue which includes the sign relied upon (without the rectangular background) in reference to a product called the “Dahua AirShield Wireless Security System”. The catalogue is dated 1 January 2023. It lists a series of businesses on the back page, which all share the word “Dahua” in the name (including Dahua UK and Dahua Technology).² Mr Stephenson states that this catalogue has been sent to “customers and retailers throughout the world, including the UK”.
- b. Two undated screenshots taken from YouTube, which Mr Stephenson states comes from the channel of the applicant’s retailer, Dahua Technology UK & Ireland.³ Both screenshots display the sign relied upon (again, without the rectangular background). The first video was posted on 20 November 2023 and has been viewed 8,832 times. The second video was posted on 14 November 2023 and has been viewed 1,093 times.

19. There are a number of issues with the evidence. Firstly, Mr Stephenson is the applicant’s representative and so it is not clear how he can give narrative evidence regarding the distribution of the catalogue enclosed at Exhibit PS1, nor does he provide any explanation regarding this. This appears to be hearsay evidence and, given that there does not appear to be any reason why a witness with firsthand knowledge of this could not have provided the evidence, I am not convinced about the

² Exhibit PS1

³ Exhibit PS2

weight that can be attributed to this. Secondly, there is nothing in the evidence which makes any connection between the sign and the applicant. It appears that the use shown is use by different entities (such as Dahua Technology UK & Ireland). Whilst I bear in mind Mr Stephenson's evidence that this is the applicant's UK retailer and the pleading which states that this is a subsidiary of the applicant, there is nothing in the evidence to suggest that any goodwill generated by sales made in the UK would accrue to the applicant. As such, I am not convinced that the applicant is the owner of any goodwill that has been generated.

20. Finally, and most importantly, even if the first two issues could be resolved, the evidence is simply insufficient to establish a protectable goodwill. I have been provided with no information regarding the scale of distribution of the catalogue displayed at exhibit PS1 i.e. to how many individuals/retailers in the UK it was distributed prior to the relevant date. With regard to the YouTube videos, whilst viewer numbers are visible, given that the screenshots are undated it is not clear whether this represents the position at the relevant date. It seems more likely that this is reflective of the position as of the date of Mr Stephenson's statement. As such, it is not clear whether these views took place before or after the relevant date, nor is it clear how many of these viewers are UK-based customers (as opposed to elsewhere). For example, the screenshots show that the YouTube channel in question is owned by "Dahua Technology UK & Ireland". Consequently, even if viewers are limited to those based in the UK and Ireland, that would include individuals located in the Republic of Ireland (and, therefore, outside of the jurisdiction).

21. I have been provided with no information regarding the number of sales made to UK customers, no turnover figures (despite claims of significant sales in the Form TM7) and no advertising/marketing expenditure for the UK. This is information that should have been straightforward for the applicant to provide. This is important because I must be satisfied not simply that there has been use in the UK, but that there is use on a scale sufficient to establish a protectable goodwill. For example, in *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

22. Similarly, in *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

23. In that case, 10 invoices amounting to sales approaching 40,000 paper cups “fell well short” of establishing sufficient goodwill to maintain a claim of passing off. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the evidence showed sales of £2,000 per quarter in early 2008, rising to £10,000 per quarter by September 2010. By the relevant date, sales had been made to 37 outlets

and there was evidence of repeat purchases. The judge at first instance described that evidence as “very limited”, but whilst the sales were small, they were found to be sufficient to support a claim for passing off.

24. This case law demonstrates the importance of establishing the scale of trade; this is what enables a distinction to be drawn between a trivial (and not protectable) goodwill and a small (but protectable) goodwill. In this case, the evidence falls well short of establishing a protectable goodwill in the UK at the relevant date.

Final Remarks

25. In reaching this decision, I have borne in mind the applicant’s submissions, the totality of which read as follows:

“1. The evidence presented herewith demonstrates that the trade mark below was used in the course of trade in 2023 before the application date of the registration in suit.



2. It is simply not credible that the proprietor would independently create a virtually identical mark without knowledge of the applicant’s use of their trade mark in the course of trade.”

26. Whilst the question of whether there has been deliberate copying can be relevant to an analysis of misrepresentation, the lack of evidence to demonstrate a protectable goodwill means that the claim under this ground falls at the first hurdle and the issue of misrepresentation does not need to be considered. Consequently, these submissions take the applicant no further forward.

CONCLUSION

27. The application for invalidation is unsuccessful and, subject to appeal, the contested mark may remain registered.

COSTS

28. The proprietor has been successful and would, therefore, ordinarily be entitled to a contribution towards its costs. However, as the proprietor is unrepresented, the Tribunal wrote to it on 3 September 2025 inviting it to file a costs proforma if it wished to make a claim for costs. That letter stated:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

29. The proprietor did not file a costs proforma. Consequently, as it did not pay any official fees, I decline to make an award of costs.

Dated this 22nd day of September 2026

S WILSON

For the Registrar

ANNEX 1

Class 9

Measuring, signalling, checking (supervision), life-saving apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software; accumulators, electric; acoustic couplers; remote control apparatus; audio- and video-receivers; audiovisual teaching apparatus; batteries, electric; cordless telephones; computer memory devices; connected bracelets (measuring instruments); bullet-proof waistcoats; measuring devices, electric; measures; high-frequency apparatus; branch boxes (electricity); video screens; camcorders; video baby monitors; video telephones; viewfinders, photographic; sighting telescopes for firearms; telescopic sights for firearms; peepholes (magnifying lenses) for doors; loudspeakers; detectors; smoke detectors; bells (warning devices); dictating machines; disks, magnetic; telerupters; electric installations for the remote control of industrial operations; electric door bells; electro-dynamic apparatus for the remote control of signals; electrified fences; electronic publications, downloadable; electronic interactive whiteboards; electronic pens (visual display units); encoded identification bracelets, magnetic; locks, electric; electronic agendas; voltage surge protectors; sound alarms; sound recording carriers; acoustic conduits; junction boxes (electricity); couplers (data processing equipment); connections for electric lines; connections, electric; readers (data processing equipment); bar code readers; pressure indicators; interfaces for computers; memory cards for video game machines; smart cards (integrated circuit cards); encoded key cards; mouse pads; push buttons for bells; cinematographic cameras; compact discs (read-only memory); encoded magnetic cards; computer hardware; computer game software; joysticks for use with computers, other than for video games; computer keyboards; computer peripheral devices; printers for use with computers; magnetic tape units for computers; computer programs (downloadable software); computer programmes (programs), recorded; computer operating programs, recorded; cabinets for loudspeakers; battery boxes; laptop computers; magnets; decorative magnets; magnetic encoders; magnetic tapes; videotapes; crash test dummies; materials for

electricity mains (wires, cables); megaphones; portable media players; microprocessors; mouse (computer peripheral); microphones; mobile telephones; cell phones; modems; monitors (computer hardware); monitors (computer programs); navigational instruments; headphones; notebook computers; optical discs; optical data media; intercommunication apparatus; speaking tubes; transmitters of electronic signals; transmitters (telecommunication); tablet computers; plates for batteries; wafers for integrated circuits; fire alarms; electric loss indicators; quantity indicators; computer software applications, downloadable; time recording apparatus; Global Positioning System (GPS) apparatus; video recorders; data processing apparatus; record players; computer software, recorded; projection apparatus; projection screens; theft prevention installations, electric; anti-theft warning apparatus; processors (central processing units); control panels (electricity); baby monitors; transmitting sets; radios; radiotelephony sets; walkie-talkies; light dimmers (regulators), electric; demagnetizing apparatus for magnetic tapes; identity cards, magnetic; distribution consoles (electricity); distribution boards (electricity); whistle alarms; signals, luminous or mechanical; signal bells; alarm bells, electric; signal lanterns; alarms; signalling whistles; signalling panels, luminous or mechanical; sirens; scanners (data processing equipment); smartwatches; smartglasses; smartphones; flashing lights (luminous signals); monitoring apparatus, electric; observation instruments; bags adapted for laptops; chips (integrated circuits); integrated circuits; heat regulating apparatus; USB flash drives; digital signs; covers for smartphones; sleeves for laptops.