

**O/1055/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003846149**

**BY G.T. WINDOWS LIMITED**

**TO REGISTER THE TRADE MARK:**

**SECURI CLIP**

**IN CLASS 6**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 439199**

**BY GRETSCH-UNITAS GMBH BAUBESCHLÄGE**

## BACKGROUND AND PLEADINGS

1. On 4 November 2022, G.T. Windows Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 18 November 2022. The applicant seeks registration for the following goods:

Class 6      Metal windows; metal fittings for windows; metal fittings for doors.

2. The application was opposed by Gretsch-Unitas GmbH Baubeschläge (“the opponent”) on 16 February 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

# GU Secury

Comparable trade mark (IR) registration no. UK000810468263<sup>1</sup>

Filing date 26 April 2012; Registration date 24 May 2013.

Relying upon some of the goods for which the earlier mark is registered, namely:

Class 6      Ironwork or fittings for windows, doors, stairs, jalousies and furniture, all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials.

3. The opponent claims there is a likelihood of confusion because the marks are visually, phonetically and conceptually similar, and the goods are identical/similar.

4. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use.

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<sup>1</sup> Following the end of the transition period of the UK’s withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (IR)’ retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

5. The opponent is represented by Withers & Rodgers LLP and the applicant is represented by Sonder & Clay. Both parties filed evidence in chief. Neither party requested a hearing but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **RELEVANCE OF EU LAW**

6. 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.

## **EVIDENCE**

7. The opponent's evidence consists of the witness statement of Robert Rossall dated 11 August 2023. Mr Rossall is the Managing Director of the opponent's UK subsidiary Gretsch-Unitas Limited and his statement accompanied by 5 exhibits (RR1-RR5).

8. The applicant's evidence consists of the witness statement of Carl Taylor dated 16 October 2023. Mr Taylor is the Director of the applicant and his statement is accompanied by 5 exhibits (CT1-CT5).

9. I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

## **DECISION**

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

10. Section 5(2)(b) reads as follows:

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

(a)...

(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.”

11. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(ab) of the Act as its filing date is earlier than the filing date of the applicants’ mark.

12. As the opponent’s mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

**Proof of use**

13. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

14. Section 6A of the Act states:

“(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),  
(aa) 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)-(5A) [Repealed]

(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.”

15. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants’ mark, i.e. 5 November 2017 to 4 November 2022.

16. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“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 P *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 Bunderversvereinigung 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 Merken 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]; *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].”


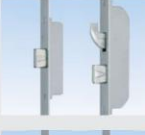
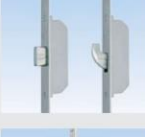



### Evidence of use

18. I note the following from the opponent’s evidence:

- a) Mr Rossall states that he is unable to access the opponent’s archived sales data for the years 2017 to 2020, but has provided the following sales figures made under its GU SECURY mark in the UK for the years 2021 and 2022:

Year	Volume (in excess of)	Sales in GBP (in excess of)
2021	518,261	2,075,653
2022	442,790	1,830,538

b) **Exhibit RR2** contains marketing material and “promotional emails” which Mr Rossall states shows use of its mark. I note that within this exhibit is an undated “GU-SECURY multi-point locks” brochure. The table of contents is as follows:

System solutions	Page	
GU-SECURY multi-point locking systems	4–5	
<b>Self-locking locking systems</b>		
Individual solutions with GU-SECURY Automatic	6–7	
The GU-SECURY Automatic range	8–9	
GU-SECURY Automatic		
GU-SECURY Automatic with safe-T-catch		
GU-SECURY Automatic 4 (automatic double latchbolt)		
GU-SECURY Automatic AB 2 (automatic bolt)		
GU-SECURY Automatic AC (Automatic-Comfort)		
GU-SECURY Automatic with panic function E		
<b>Manual-locking locking systems</b>		
Individual solutions with key or handle-operated locks	10–11	
<b>Key-operated locks</b>	12–13	
GU-SECURY MR 2, MR 4, MR/R (MR bolt)		
GU-SECURY SH 2, SH 4, SH/R (SH bolt)		
GU-SECURY DR (double bolt)		
GU-SECURY R 4 (roller cam)		
GU-SECURY P/R (mushroom cam and roller cam)		
<b>Handle-operated locks</b>	14–15	
GU-SECURY EUROPA MR 2, MR 4, MR/R (MR bolt)		
GU-SECURY EUROPA SH 2, SH/R (SH bolt)		
GU-SECURY EUROPA R 2, R 4 (roller cam)		
GU-SECURY EUROPA R/P (roller cam and mushroom cam)		
<b>Mortise locks</b>	16–17	
GU-ECONOMY		
<b>The house entrance door concept</b>		
Secure – convenient – flexible	18–19	
GU-SECURY Automatic with A-opener kit	20	
Automatic locking: GU-SECURY Automatic		
Motor-driven unlocking: GU-SECURY AutomaticTE daytime release function		
<b>Electronic accessories, locking systems</b>		
GU-SECURY A-opener	21	
Emergency power backup system for GU-SECURY A-opener	21	
Wireless power and data transmission SECUREconnect	22	
Cable ducts	23	
Additional locking elements with query	23	
Access control GU-BKS ACCESS	24	
Electric door strike series No. 6	25	
<b>Mechanical accessories, locking systems</b>		
Lever-operated gears	26	
Accessories on frame side	27	
GU-SECURY with safe-T-catch	28	
<b>Supplementary range</b>		
Door closer	29	
GU thresholds	30	
GU door hinges	31	

c) It is clear from the above brochure that “GU-SECURY” goods are different types of locks for doors (including automatic, massive bolt, hook bolt and double bolt).

d) **Exhibit RR2** also includes a second brochure titled “GU SECURITY Casement Locking System with ICAM Technology. It is dated “edition 1 2020”. It states that the GU Secury casement locking system with ‘ICAM’ is a “new generation of espag locking systems with adjustable and rotating cams for built-in flexible adjustment for the whole window”. I note that under “part codes and descriptions” the goods listed are:

- i. GU Secury Standard Casement Espag
- ii. GU Secury Twin Cam Casement Espag
- iii. GU Secury Casement Striker Keeps
- iv. GU Secury Casement Striker Keeps – Reversible

- e) The third undated brochure contained within the exhibit is titled “The new locking type GU-SECURY Automatic-DR combines security with ease of use”. The brochure again contains depictions and lists of their “GU SECURITY automatic” door lock goods (latch bolts, hook bolts and main lock).
- f) The above is supported by **exhibit RR1** which Mr Rossall states contains a “selection of invoices” from the opponent. The customers names are redacted; however, I note the following from them:
- a. 11 invoices that fall within the relevant period show the sale of “GU Secury Espag Twin Cam” or “GU Secury Repair Espag ICam”.
  - b. The invoices are dated between 11 August 2020 to 1 August 2022.
  - c. These invoices show that the quantity of each GU Secury item brought varies between 20 to 4,000 per invoice.
  - d. Therefore the price of these goods in the above quantities vary between £26.20 to £7,960 per invoice.
  - e. The invoices are addressed to customers in Middlesbrough, Stirlingshire, Dublin, Shropshire and Leeds.
  - f. 6 invoices that fall within the relevant period show the sale of “Door lock SECURITY Automatic 35/92”.
  - g. The invoices are dated between 30 June 2020 to 17 August 2022.
  - h. I note that one of the invoices (number 6082713) shows the code “GUSECURYAUTO35” in the description column for the Door lock SECURITY Automatic 35/92.
  - i. These invoices show that the quantity of each door lock brought varies between 2 to 80 per invoice.
  - j. Therefore the price of these goods in the above quantities vary between £99.18 to £4,616.80 per invoice.
  - k. The invoices are addressed to customers in Shropshire, London, Croydon and Stirlingshire.
- g) Whilst Mr Rossall states promotional materials are the opponent’s primary form of marketing, **exhibit RR3** contains 2 marketing invoices for the opponent’s GU

Secury product brochures and flyers. The invoices are redacted so I cannot determine where the invoices came from, but, nonetheless, I note the following:

- a. An invoice dated 16 November 2020 showing the creation and production design of GU Secury Flyer was purchased for £250, and it was printed for £150 (alongside a GU Brochure).
- b. An invoice dated 10 March 2020 showing the production of GU Secury Casement brochure was purchased for £1,500.
- h) **Exhibit RR4** contains extracts from the opponent's retailer UK websites. The goods are named as "GU Secury", and they are all types of door locks. I also note that some of the goods are priced at £138 or £147. However, all of the evidence has a print date of 8 October 2023, which falls after the relevant date.
- i) **Exhibit RR5** contains screenshots from the opponent's UK website. Again the website reiterates the above (all of the GU Secury goods are types of locks for doors). I also note that the evidence has a print date of 8 October 2023, which, again, falls after the relevant date.

#### Assessment of genuine use

19. Despite being registered as a figurative mark; the opponent's mark consists solely of the words "GU SECURITY" in a standard typeface. As the words "GU SECURITY" appear on the invoices and brochures, I am satisfied that the mark has either been used as registered or in an acceptable variant form.

20. I will now consider the global assessment of genuine use. This assessment is made by looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup> As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been

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<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

21. In regard to the opponent’s above evidence, there are clearly some issues with some of the exhibits, which are either undated or fall after the relevant period. However, I have been provided with UK unit and sales figures for 2021 and 2022, which shows that 961,051 GU SECURITY goods were sold, which amounted to a turnover of £3,906,191. This has been supported with brochure and invoice evidence dated between 2020 and 2022. The invoice evidence clearly shows goods described as “GU Secury Espag Twin Cam” and “GU Secury Repair Espag ICam” have been sold during the relevant period, and the brochure dated 2020 confirms that these goods are types of locks for windows. The invoice evidence also shows the sale of “Door lock SECURITY Automatic 35/92” goods during the relevant period. I note that on one of the invoices this item description is followed by the code “GUSECURYAUTO35”, and that the remaining two brochures in the opponent’s evidence are for its GU SECURITY Automatic door locks. Moreover the opponent’s GU SECURITY sales for its window and door locks were geographically spread across the UK (Middlesbrough, Stirlingshire, Dublin, Shropshire, London, Croydon and Leeds). I have been provided with invoice evidence for the opponent’s marketing which shows that its GU SECURITY brochures were created as a method of advertising. Whilst the evidence only shows two years of use, use does not have to be shown for the entirety of the relevant five-year period. Therefore, taking the above into account, I consider that the opponent has established genuine use of its mark in the UK in relation to door and window locks during the relevant period.

### Fair Specification

22. While I have concluded that there is genuine use, I do not consider that the use is sufficient to allow the opposition to continue in respect of all of the goods relied upon by the opponent.<sup>3</sup>

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<sup>3</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

23. Clearly the opponent sells door and window locks. I therefore consider that the opponent's class 6 "ironwork or fittings for windows, doors, stairs, jalousies and furniture, all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials" needs to be narrowed down to reflect the opponent's window and door locks only (which I consider to be appropriate sub-categories).

24. Consequently I consider a fair specification for the opponent's mark to be:

Class 6      Door locks; window locks; all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials.

#### **Section 5(2)(b) - case law**

25. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts 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 B.V.* 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 great 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;
- (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

26. The applicant's goods are listed in paragraph 1, and the opponent's goods are listed in paragraph 24.

27. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

28. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

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

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“... 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 the responsibility for those goods lies with the same undertaking.”

*Metal fittings for doors.*

31. The opponent’s “door locks; all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials” falls within the applicant’s above broader category. The goods are identical on the principle outlined in *Meric*.

*Metal fittings for windows.*

32. The opponent’s “window locks; all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials” falls within the

applicant's above broader category. The goods are identical on the principle outlined in *Meric*.

*Metal windows.*

33. The applicant's above goods are similar to the opponent's "window locks; all said products made of metal or metal combined with plastic, with the exception of plexiglass and transparent materials". Whilst the goods do not overlap in method of use and purpose, the goods will overlap in nature, being made from metal, or metal combined with plastic. I also consider that the goods would be sold by the same trade channels and would be purchased by the same users. Moreover, the goods are complementary in the way described by the case law cited above, as they are important and indispensable to one another (you need a window to be able to use a window lock) and the consumer would believe that they originate from the same undertaking. Therefore, taking all of the above into account, I consider that the goods are similar to at least a medium degree.

### **The average consumer and the nature of the purchasing act**

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

35. The average consumer for the goods will be members of the general public, and professionals such as builders and construction workers. The cost of the purchase is likely to vary, as will the frequency of purchase. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

36. The goods are likely to be obtained by self-selection from the shelves of a hardware retailer, its catalogue or online equivalent. Alternatively, the goods may be purchased following the perusal of advertisements. This means that visual considerations will be the most significant. However, I do not discount that there will also be an aural component to the purchase of the goods, as advice may be sought from a sales assistant and word-of-mouth recommendations may play a part.

### **Comparison of the trade marks**

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

38. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<b>GU Secury</b>	<b>SECURI CLIP</b>

40. The opponent's mark consists of the words GU SECURITY. For reasons I will come to discuss in the conceptual comparison, I consider that the "GU" element plays a greater role in the overall impression of the mark, with the "SECURITY" element playing a lesser role.

41. The applicant's mark consists of the words SECURI CLIP. For reasons I will come to discuss in the conceptual comparison, I consider that the overall impression lies in the combination of these elements.

42. Visually, the marks coincide in the letters S, E, C, U and R in the second word element of the opponent's mark and in the first word element of the applicant's mark. This acts as a visual point of similarity. However, the opponent's second word element ends in the letter Y and the applicant's first word element ends in the letter I. I also note that the opponent's mark begins with the "GU" element, a position to which the average consumer pays more attention to.<sup>4</sup> The applicant's mark also ends in the word "CLIP". These, therefore, act as visual points of difference. Consequently, taking all of the above into account, I consider that the marks are visually similar to between a low and medium degree.

43. Aurally, I consider that the opponent's mark will likely be pronounced as GEE-YOU SEK-CURE-EE. I consider that the applicant's mark will likely be pronounced as SEK-

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

CURE-EE CLIP. Therefore as the marks share the identical SEK-CURE-EE element, I consider that the marks are aurally similar to at least a medium degree.

44. Conceptually, the opponent states that “the words” are made up and the applicant states that the marks include invented terms apart from the word “clip”. I agree that the letters “GU” in the opponent’s mark will not be assigned any conceptual meaning, since the letters may stand for any number of word combinations. I also note that letters on their own don’t convey a particular concept over and above their existence as letters in the English alphabet. I also agree with the applicant that the word “CLIP” is an ordinary dictionary word which will be recognised by the average consumer.

45. However, I bear in mind that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

46. Both the words SECURITY and SECURI in the parties marks are aurally identical. I also consider that due to their pronunciation, and spelling, the average consumer will consider that these invented terms derive from the ordinary dictionary words “secure” and “security”. On the basis it evokes a tangible meaning, I consider it plays a lesser role in the overall impression of the opponent’s mark (with “GU” element which does not evoke a meaning playing a greater role). I also consider that the “SECURI” element in the applicant’s mark, followed by the word “CLIP”, forms a new unitary meaning, which the average consumer will understand as “a secure clip”. Therefore I consider that the words “SECURI” and “CLIP” play an equal role in the overall impression of the applicant’s mark.

47. Regardless, as the marks share and evoke the concept of “secure” and “security”, I find that they are conceptually similar to a medium degree.

### **Distinctive character of the earlier trade mark**

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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 promotion of 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).”

49. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

50. I will begin by assessing the inherent distinctive character of the opponent's GU SECURITY mark. As noted above, the letters "GU" may stand for any number of word combinations, and therefore does not evoke any concept. I consider that the average consumer will see the SECURITY word element at the end of the mark, due to its spelling and pronunciation, as deriving from the ordinary words "secure" and "security". I note that this is highly allusive of the goods for which the mark is registered, on the basis that door and window locks should be secure and provide security for the user. Consequently, I consider that the "GU" element is the dominant and distinctive part of the opponent's mark, and that taking the opponent's mark as a whole into account, it is inherently distinctive to no more than a medium degree.

51. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

52. I have been provided with UK invoice evidence, which is geographically spread across the UK (Middlesbrough, Stirlingshire, Dublin, Shropshire, London, Croydon and Leeds). I have also been provided with UK sales figures for 2020 and 2021 which amounts to £3,906,191 from the sale of 961,051 GU SECURITY goods. Whilst I appreciate that these sales are high, and could amount to a significant share of the market (albeit every house in the UK presumably has a lock and therefore the market is likely to be significant), I have not been provided with any evidence of the opponent's market share, nor have I been provided with any advertising figures. Albeit I have been provided with 3 brochures (only one dated 2020), and 2 invoices showing that brochures were made advertising its door and window lock goods, I have not been provided with any figures as to how many were printed and distributed, and how many UK consumers would have been exposed to their brochure advertising. I also do not have any other advertising evidence before me. Therefore, I do not consider the evidence sufficient to establish enhanced distinctiveness.

53. However, if I am wrong in this finding, and the marks distinctiveness is enhanced through use, it will only be to between a medium and high degree at best.

## Honest Concurrent Use

54. I note that Mr Taylor's statement has been filed noting that it has used its mark continuously since at least 1999, and has exhibited evidence including sales made from May 2009. I appreciate that in proceedings before the Tribunal, such evidence is capable of being used to support a defence that there has been honest concurrent use of the marks at issue and, as a result, any likelihood of confusion may be diminished. However, the applicant did not actively plead such a defence. Instead, in its submissions in lieu, the applicant states that the marks have co-existed in the marketplace and that they are not aware of any evidence of actual confusion. This, in my view, would be a sufficient reason to dismiss the claim. That being said, I will consider the point briefly here.

55. I note the following from the applicant's evidence:

- a) **Exhibit CT1** includes a fax copy of a data sheet dated 4 January 1999 showing use of the word "SECURI-CLIP". It also includes 2 undated pages of marketing materials.
- b) **Exhibit CT2** includes a datasheet for "SECURI-CLIP" which Mr Taylor states is for a product "dating from 2009".
- c) **Exhibit CT3** includes an undated datasheet for "GT Securi-Clip".
- d) **Exhibit CT4** includes a sales sheet for May 2009 to April 2010 showing the sale of 1,092,082 products. Whilst I note Mr Taylor states that these products were SECURI-CLIPs I note that this product is not referred to using that mark on the exhibit.
- e) **Exhibit CT4** includes a sales sheet for November 2022 to October 2023 showing the sale of 715,222 products. Whilst I note Mr Taylor states that these products were SECURI-CLIPs I note that this product is not referred to using that mark on the exhibit.
- f) In his witness statement, Mr Taylor notes that the applicant has sold over 20,000,000 products under the SECURI CLIP mark.

56. Taking all of the applicant's evidence above into account, I do not consider that the exceptional circumstances outlined in *Budejovicky Budvar NP v Anheuser-Busch*

*Inc*,<sup>5</sup> and those factors in *Victoria Plum Ltd v Victorian Plumbing Ltd*<sup>6</sup> are present in the case before me. I also note that in *Budejovicky Budvar*, paragraph 82 makes reference to the “long period of honest concurrent use between the marks”, and in *Match Group, LLC & Ors v Muzmatch Ltd & Anor*<sup>7</sup> Arnold LJ held use which was initially infringing could eventually cease to be infringing if the trade mark proprietor took no action, there was substantial parallel trade for a long period, and as a result the trade marks came to be understood by the relevant class of consumers as denoting the goods/services of more than one trader.

57. In this case, whilst the applicant has provided a fax document using its mark dated 1999, its actual evidence of sales is only from May 2009 to April 2010 and November 2022 to October 2023. I therefore do not consider that this evidence is demonstrative of longstanding use.

58. Additionally, there is no evidence that demonstrates that the marks at issue ever came into conflict during this time. For example, I have not been provided with evidence that that the goods of the parties were made available to consumers via the same trade channels to give rise to circumstances where they would be viewed alongside each other. The evidence is, therefore, of no assistance in giving rise to a defence of the existence of honest concurrent use. As a result, the applicant’s reliance upon this defence is dismissed.

### **Likelihood of confusion**

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser

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<sup>5</sup> Case C-482/09, EU:C:2011:605

<sup>6</sup> [2016] EWHC 2911

<sup>7</sup> [2023] EWCA Civ 454 at [115] to [117]

degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

60. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to at least a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the earlier mark to be inherently distinctive to no more than a medium degree, and at best, enhanced to between a medium and high degree.
- I have identified the average consumer as the general public, and professionals such as builders and construction workers, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- The parties' goods are identical or similar to at least a medium degree.

61. Taking all of the factors listed in paragraph 60 into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that a consumer paying a medium degree of attention during the purchasing process will overlook the "GU" element at the beginning of the opponent's mark, a position which tends to make more of an impact than the ends. I also do not consider that the average consumer would overlook the word "CLIP" at the end of the applicant's mark (which creates a unitary meaning with the word SECURI). I do not find there to be a likelihood of direct confusion even when the marks are considered on identical goods.

62. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

63. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

64. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories, above, of indirect confusion and that indirect confusion ‘tends’ to fall in one of them. I note that the opponent hasn’t provided any submissions as to what category this case would fall within. However, for the sake of completeness, I will go through each category.

65. Firstly, where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. In this case, the common element that the parties’ marks share are the letters S, E, C, U

and R in the words SECURY and SECURI. As noted in paragraph 50 above, I consider that the average consumer will see the SECURY word element at the end of the opponent's mark, due to its spelling and pronunciation, as deriving from the ordinary words "secure" and "security". This is highly allusive of the goods for which the mark is registered, and results in the "GU" element being the dominant and distinctive part of the opponent's mark. Therefore, even on the basis that the average consumer imperfectly recalled the applicant's SECURI element, as SECURY, this element is low in distinctiveness. On this basis, I do not consider that the common element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to the parties' metal windows, and metal fittings for doors and windows (including locks) which should be secure and provide security for the user. I therefore do not consider this category is satisfied.

66. Secondly, where the later mark simply adds a non-distinctive element to the earlier mark. In this case, the entirety of the opponent's mark is not replicated (and the dominant and distinctive "GU" element is removed). Consequently, the second category cannot be satisfied. However, I also bear in mind wrong-way round confusion.<sup>8</sup> Of course, the entirety of the applicant's mark is not replicated in the opponent's mark. I also note that the "GU" element which appears at the beginning of the opponent's mark is the dominant and distinctive element as it does not convey any particular meaning, and thus is neither allusive nor descriptive of the goods. Consequently it plays a greater role in the overall impression of the mark and thus is not a non-distinctive addition. It is also not a word which is frequently used to indicate sub-brands such as 'LITE' or 'EXPRESS'. The second category is not satisfied.

67. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, I still bear in mind that SECURY and SECURI could be imperfectly recalled as

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<sup>8</sup> See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, regarding "wrong way round confusion", referring to *Comic Enterprises* (cited above) at paragraphs 75-84. In that case Kitchin LJ explained that "right way round" or "wrong way round" confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. He explain further that in both instances the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

each other. However, the change from the opponent's mark beginning with the distinctive and dominant "GU" element, to removing this, and adding the word "CLIP" at the end of the applicant's mark, are not logical or consistent with a brand extension. Especially, as noted above, the words "SECURI" and "CLIP" together create a unitary meaning, to evoke a "secure clip" whereas the "GU" and "SECURY" elements within the opponent's mark does not form a unit. I therefore do not consider that the third category is satisfied.

68. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's and the opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. I find there is no likelihood of indirect confusion, even when the marks are considered on identical goods.

## **CONCLUSION**

69. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

70. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. As noted above, the applicant's evidence was of no assistance. On this basis, I shall not be awarding any costs in relation to it. Consequently, I award the applicant the sum of **£1,200** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£250
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Considering the opponent's evidence	£600
Preparing and filing written submissions in lieu of a hearing	£350
<b>Total</b>	<b>£1,200</b>

71. I therefore order Gretsch-Unitas GmbH Baubeschläge to pay G.T. Windows Limited the sum of £1,200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 7<sup>th</sup> day of November 2024**

**L FAYTER**

**For the Registrar**