

O/1092/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF UK REGISTRATION NUMBER UK00002024888

IN THE NAME OF DORTEK LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

DORTEK

IN CLASSES 6, 9, 19, 20, 37

AND IN THE MATTER OF UK REGISTRATION NUMBER UK00905017876

IN THE NAME OF DORTEK LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

DORTEK

IN CLASSES 6, 7, 9, 19, 20, 37

AND

AN APPLICATIONS FOR REVOCATION THEREOF

UNDER NUMBERS CA000507340 AND CA000507341

BY DORTECH DIRECT LIMITED

Background and pleadings

1. Trade mark number UK00002024888 and UK00905017876 stand registered in the UK for the marks shown on the front page of this decision (“***the Contested Marks***”), in the name of Dortek Limited (“***the Proprietor***”). The Proprietor’s registration UK00002024888 was filed on 23 June 1995 and it was registered on 18 October 1996 for the following goods and services:

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.

2. The Proprietor’s registration UK00905017876 is a comparable mark (EU).¹ It was filed on 12 April 2006 and completed its registration process on 7 May 2010. The mark is registered for the following goods and services:

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

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) 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 (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

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, panes, 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.

3. On 13 May 2024, Dorteck Direct Limited, ("**the Applicant**") filed respective revocation actions number CA000507340 and CA000507341 against the trade marks UK00002024888 and UK00905017876. Both revocation actions are filed against the Contested Marks in their entirety, for non-use under section 46(1)(a) and section 46(1)(b) of the Trade Marks Act 1994 ("**the Act**"). The Applicant alleges that the Proprietor has not used the Contested Marks in the United Kingdom within the five-year periods set out below:

CA507340

Contested Mark (i): UK00002024888

DORTEK

Section 46(1)(a): following the date of completion of the registration process, i.e. 19 October 1996 – 18 October 2001 ("***the first relevant period***"). The earliest possible revocation date is 19 October 2001.

Section 46(1)(b):

Start dates	End dates	The earliest possible revocation dates	
21 September 2000	20 September 2005	21 September 2005	<i>"the second relevant period"</i>
21 September 2005	20 September 2010	21 September 2010	<i>"the third relevant period"</i>
21 September 2010	20 September 2015	21 September 2015	<i>"the fourth relevant period"</i>
21 September 2015	20 September 2020	21 September 2020	<i>"the fifth relevant period"</i>

CA507341

Contested Mark (ii): UK00905017876

DORTEK

Section 46(1)(a): following the date of completion of the registration process, i.e. 8 May 2010 – 7 May 2015. The earliest possible revocation date is 8 May 2015.

Section 46(1)(b): 21 September 2015 – 20 September 2020 (“*the fifth relevant period*”). The earliest possible revocation date is 21 September 2020.

4. As the Contested Mark number UK00905017876 is a comparable mark, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, use within the EU is relevant for any part of the relevant period which falls prior to IP Completion Day (i.e., 31 December 2020).
5. In its statement of grounds, the Applicant submitted that the Contested Marks should be revoked for all the goods and services in accordance with sections 46(1)(a) and 46(1)(b) of the Act.
6. The Proprietor filed a defence and counterstatement² denying the claims made in relation all its goods and services.
7. Both proceedings were consolidated under the lead case, cancellation action number 507340, on 8 October 2024.
8. The Applicant is represented by Appleyard Lees IP LLP and the Proprietor is represented by Walker Morris LLP.

Evidence and submissions

9. During the evidence rounds, only the Proprietor filed evidence in the form of a witness statement of Alan O’Keane, dated 9 December 2024, and accompanied by eighteen exhibits (Exhibits AOK1 – AOK18). Mr O’Keane is the Managing Director of the Proprietor, DorteK Limited, and he has been a Director of the Proprietor since April 2003. Therefore, Mr O’Keane is duly authorised to make submissions on behalf of the Proprietor. Neither party requested a hearing, but they both filed written submissions in lieu on 23 April 2024. The submissions will not be summarised here but will be referred to as and where appropriate during this decision. A summary of the Proprietor’s evidence is provided below. This decision is taken following a careful consideration of all the papers.

² Dated 13 May 2024.

10. Since both the Contested Mark (i) and Contested Mark (ii) consist of the same mark “DORTEK”, in my decision I will refer to both the contested marks indistinctively as the “DORTEK” mark or the “*Contested Marks*”, unless otherwise specified.

Summary of the evidence of use

11. Mr O’Keane provides some of the Proprietor’s history reporting that the company was initially incorporated on 5 May 1989 (although it had started trading since 1968),³ it secured a contract to supply specialist doors for the value of £60,000 in 1989,⁴ and the Proprietor registered its website “dortek.com” in March 2000.⁵ Mr O’Keane states that Dortek is a market leader in specialist hygienic door solutions and that, since the launch of the brand in the UK, this has grown quickly and “now” the Proprietor has sites also in Ireland, the Netherlands, Sweden, the UAE and Qatar.⁶

12. Exhibit AOK3 includes what Mr O’Keane refers to as examples of use of the Contested Marks in the UK. The evidence seems to consist of information and data sheets relating to doors and windows (Figure 1). The mark “DORTEK” appears in both stylised (Figure 2) and word form. None of the evidence is dated.

³ AOK1 features extracts from Company House showing when Dortek limited was incorporated and Mr O’Keane’s position in the company.

⁴ AOK16c, page 215.

⁵ AOK2b.

⁶ Mr O’Keane’s witness statement at [8].



Glass Doors

Hygienic Glass Doors

Dortek manufactures a wide range of Hygienic Glass Doors & Side Screens to suit all applications where hygiene and visibility are of utmost importance.

Dortek manufactures a wide range of Hygienic Glass Doors & Side Screens to suit all applications where hygiene and visibility are of utmost importance.

Dortek Glass doors have similar hygienic properties to GRP doors. Our hygienic glass has no crevices or cavities for bacterial growth and both systems can be used together, making it a popular choice for many specifications.

Figure 1



Figure 2

13. Mr O'Keane states that turnover in relation to goods sold in the UK during the relevant periods was as follows:⁷

Year	Turnover £
2024 (projected)	£12,000,000
2023	£12,225,992
2022	£13,705,248
2021	£8,398,418
2020	£9,800,100
2019	£9,553,971
2018	£8,215,328
2017	£11,615,390
2016	£12,468,675
2015	£11,288,698
2014	£7,979,321.64
2013	£7,368,188.38
2012	£7,166,760.90
2011	£7,821,970.70
2008	£6,169,602
2007	£5,926,798
2006	£5,021,948
2005	£5,471,156
2004	£4,290,415
2003	£4,267,716
2002	£4,003,777

⁷ Mr O'Keane's witness statement at [10].

2001	£3,619,712
2000	£3,998,174
1999	£3,833,103
1998	£4,011,815
1997	£3,133,302

14. I note the evidence does not contain the revenue numbers relating to the years 2009 and 2010. Mr O’Keane states that the revenues refer to the goods sold in the UK.

15. Mr O’Keane provides copies of the annual accounts for the years 2014 – 2024 confirming the numbers provided in the table.⁸ Mr O’Keane also clarifies that the projected 2024 turnover for Dortek is £12,000,000 and €31,000,000 for the Group (of which Dortek is a 100% owned subsidiary). I note Mr O’Keane’s statement although the turnover figures concerning 2024 do not concern the proceedings at hand as they are placed outside of the relevant periods. I also note that the Groups’ turnover figures are in euro. Although Mr O’Keane did not clarify on this point, I believe this is because whilst the table above reports the turnover for the UK, the Group’s turnover concerns the Proprietor’s wider commercial activity, including turnover from other EU countries along with the fact that the Group is headquartered in Ireland.

16. Mr O’Keane states that the Proprietor has, over the years, provided and installed specialist door systems to various clients in different industries. In combination with Mr O’Keane’s witness statement, the evidence features extracts that seem to be informational material describing various projects the Proprietor has carried out for its clients in different commercial sectors. The evidence shows a date of when it was presumably extracted (April 2024) which is outside of the relevant periods.⁹ However, for almost each project featured in the evidence, a list of clients and related dates is present, the dates reported are contained in the relevant periods

⁸ AOK4.

⁹ AOK5 pages 78 – 87.

and presumably refer to the dates of when the commercial collaborations with the different clients took place.

17. For the pharmaceutical industry, the evidence indicates the Proprietor provided pharmaceutical doors (i.e., GRP hinged non-fire rated and fire rated sliding doors, hermetically sealing doors, hermetically sealing sliding doors, GRP hinged fire doors, GRP bi-parting sliding doors, hygienic fire rated swing doors, single action doors) to clients in different parts of the UK (e.g., AstraZeneca in Cheshire, Colourcon in Kent, Covance in Harrogate). The evidence also indicates that the Proprietor collaborated with clients such as MSD and Pirimal (since 1990), Astra Zeneca (since 1995), Glaxo SmithKline (since 2000), and Lonza (since 2014).
18. In the healthcare sector, Mr O’Keane reports the Proprietor provided healthcare doors¹⁰ to clients in this sector in the UK such as The London Clinic (2012),¹¹ Salford Royal (Manchester in 2018 and 2022),¹² Great Ormond Street Hospital (London, between 2016 and 2023),¹³ St Mary’s Hospital (London, 2019), Circle Health (2015-2024), Schoen Clinic (London, undated),¹⁴ and Heartlands Hospital (Birmingham, undated).¹⁵
19. For the research sector, the Proprietor provided research laboratory doors¹⁶ to Charles River Labs (Motherwell, 2015), Sainsbury Welcome Centre (London 2014 and 2018), Cambridge Biomedical Campus (London, 2022),¹⁷ Cancer Research UK (London, undated).¹⁸
20. In the retail sector, the Proprietor provided “retail doors”¹⁹ to Sainsbury (2005 – 2024), Ikea (2010 – 2024), Lidl (2004 – 2024),²⁰ Harrods (London, since 2015),²¹ Asda, and Aldi. The evidence shows the doors installed were “GRP (hygienic) crash doors”.

¹⁰ Hygienic FRP doors; hygienic hermetically sealing sliding doors.

¹¹ AOK6, page 97.

¹² AOK6, page 93.

¹³ AOK6, page 95.

¹⁴ AOK6, page 94.

¹⁵ AOK6, page 96.

¹⁶ Hygienic GRP doors (hinged and sliding).

¹⁷ AOK7, page 103.

¹⁸ AOK7, page 102.

¹⁹ GRP (double action) crash doors and polyethylene doors.

²⁰ AOK8, page 110.

²¹ AOK8, page 112.

21. In the leisure sector Mr O’Keane reports that the Proprietor provided GRP waterproof leisure doors to New Addington Leisure Centre (Surrey, 2018), Center Parcs (Longleat, 2017), Pitville Leisure Centre (Cheltenham, 2019) and Community Special School (Rotherham, 2019).²²
22. In the veterinary sector, Mr O’Keane reports that the Proprietor provided hygienic GRP doors²³ to Battersea Dogs and Cats Home (London, 2020), Newbrook Animal Welfare Centre (Birmingham, undated),²⁴ The Large Animal Research and Imaging Facility (Edinburgh, 2017).²⁵
23. In the industrial sector, Mr O’Keane also reports that the Proprietor has provided doors to clients in market sectors where “cleanroom”-type areas are necessitated such as Formula One, Mercedes (Brackley, 2021), Renault (Oxfordshire, 2018), Microsoft (Romsey, 2021), Royal National Lifeboat Institution (Pwllheli, undated).²⁶
24. Mr O’Keane indicates that the Proprietor provided doors (such as, for example, non-fire/fire rated single/double action doors, GRP K type hinged sliding doors and chiller doors, hygienic hinged doors) to brands within the food sector such as Carlsberg (Northampton, undated), Muller (Shropshire, undated) and Nestlé.²⁷ The evidence for this market sector does not contain the list of clients and years. Looking at what the evidence shows, the part concerning Nestlé shows the goods were provided in Germany. All the evidence of exhibit AOK11 is undated.
25. Mr O’Keane also provides a list of the Proprietor’s “longstanding” clients including, for example, Audi, Tesco, Aldi, RNLI and Pfizer. To this end, the evidence contains an extract from the Proprietor’s website featuring some brand logos of the Proprietor’s clients (e.g., AstraZeneca, Cancer Research UK, MSD, NHS).²⁸ Mr O’Keane did not clarify further on this piece of evidence. The evidence is undated.
26. The evidence contains copies of invoices showing sales of some of the Proprietor’s products and services as reported in the table below.²⁹

²² AOK9 page 118.

²³ hygienic hinged doors with stainless steel frames; fire doors.

²⁴ AOK10, page 124.

²⁵ AOK10, page 125.

²⁶ AOK12, page 135.

²⁷ AOK11 pages 126 - 131

²⁸ AOK13, page 137.

²⁹ AOK14, pages 139 - 202.

Invoice No	Date	Client/Location	Products (Qty)	Services Provided	Total (GBP)
17387	12 Jan 2015	RBH, Reading	Fire doors (9); Single action doors (11); Door interlock system (2)	Delivery; Installation; Interlock system	£111,279.60
17895	29 Apr 2015	Princess Margaret Hospital, Slough	Fire doors (17)	Delivery; Installation; Installation (weekend)	£119,760.00
18004	21 May 2015	Waitrose / John Lewis, Horsham	Fire doors (3)	Delivery; Installation	£24,654.00
18227	25 Jun 2015	Dairy Crest, Davidstow (Cornwall)	Fire doors (10); Single action doors (56)	Delivery; Installation	£157,262.00
18764	12 Oct 2015	Waitrose / John Lewis at Home, Basing View	Fire doors (5)	Delivery; Installation	£33,282.00
19953	26 May 2016	Waitrose, Solihull	Fire doors (2)	Delivery; Installation	£19,020.00
20193	30 Jun 2016	N/A	Fire doors (13)	Delivery; Installation	£121,255.20
21551	15 Mar 2017	TMC Dairies, Artigarvan	Fire doors (28); Single action doors (7)	Delivery; Installation	£124,099.26
21599	31 Mar 2017	ALDI Bathgate RDC	Sliding door (2); Hermetically sealing chill	Delivery; Installation	£30,606.00

			sliding door (1)		
22374	31 Aug 2017	BPL, Elstree	Fire doors (14); Single action doors (1); Electric operator – mounted pull side (12); Steel doors (1)	Delivery; Installation; Electric operator	£182,099.82
22712	31 Oct 2017	Univ. of Surrey	Fire doors (36)	Delivery; Installation	£163,647.69
22814	17 Nov 2017	Waitrose, Fulham (London)	Fire doors (4); single steel hinged door (1); TS4000 closer	Delivery; Installation; Installation (out of hours)	£28,548.00
23404	28 Mar 2018	Waitrose, Morningside	Fire doors (3)	Delivery; Installation; Installation (out of hours)	£26,640.00
23606	16 May 2018	Purolite, South Wales	Fire doors (21); Single action doors (13); glazed screens (17)	Delivery	£148,281.60
23817	29 Jun 2018	CFH, Enfield	Single sliding fire doors (2); Bi-parting	Delivery; Installation	£119,916.00

			sliding doors (8)		
23947	23 Jul 2018	Harrods – Trevor Square Fire Strategy (London)	Fire doors (8)	Delivery; Installation	£85,920.00
24036	31 Jul 2018	AAH Pharma, Warrington	Butzbach (6)	Delivery; Installation	£63,355.20
24064	01 Aug 2018	New Birmingham Wholesale Market	Single action doors (33); glazed screen (13)	Delivery; Installation	£102,904.00
25658	31 May 2019	St Johns Market, Scunthorpe	Single sliding fire doors (10)	Delivery; Installation	£119,952.00
25724	31 May 2019	Research & Imaging Facility, Edinburgh	Single action doors (44); 925mm blade (7); Single sliding doors (7); Fire doors (2); Single action doors with lead lining (2); Single action door (Window controls push side) (2)	Delivery; Installation	£347,315.93
26313	04 Oct 2019	Harrods – Men's AIDR (London)	Fire doors (5)	Delivery; Installation supervision	£58,182.00

26873	23 Jan 2020	BMI, The Priory	Fire doors (27); Bi-parting sliding door (1)	Delivery; Installation	£299,154.00
27741	28 Jul 2020	Do & Co, Heathrow	“S” type double action doors (6); Fire doors (32)	Delivery; Installation	£229,806.00
27834	28 Aug 2020	BMI Clementine	Single action doors (1); Single action doors (marked VP Control Pull side) (15); Single action doors (marked VP Control Push side) (1); interlock system, including programmable controller (3)	Delivery; Installation; Interlock system	£241,170.00
28161	16 Oct 2020	Harrods – Rooms of Luxury 2	Fire doors (2)	Delivery; Installation	£28,782.00
28657	19 Jan 2021	Tesco Extra, Dudley	Double action doors (9)	Delivery; Installation; Installation (out of hours)	£32,540.40

29874	26 Jul 2021	Waitrose, Ecclesall Rd (Sheffield)	Fire doors (6)	Delivery; Installation; Installation (out of hours)	£51,050.00
30458	05 Nov 2021	Waitrose, Rushden	Fire doors (10); Single action doors (2)	Delivery; Installation; Installation (out of hours)	£127,896.00

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



28. As correctly indicated by the Applicant, the invoices dated 2021 are outside of the relevant periods.³⁰

29. Mr O’Keane reports, in his witness statement, that, when the statement was submitted, the Proprietor had over 150 employees and the Proprietor’s market share for the “hygienic GRP door industry” was at least 85%.³¹ No additional evidence was filed on these points.

30. Mr O’Keane provides an article from “www.theexpresswre.com” dated 9 January 2023 where the Proprietor is listed among the key players in the global High Speed Doors market.³² The article is dated outside of the relevant period and features prices in US dollars.

31. The evidence also includes an article dated 30 April 2021, which appears to be from the news section of the Proprietor’s website, reporting that the Proprietor

³⁰ Applicant’s submissions in lieu dated 24 April 2025 page 10.

³¹ Mr O’Keane’s witness statement dated 9 December 2024, at [15] and [16].

³² AOK15, pages 203 – 209.

supplied doors for the new IKEA set to open in the Philippines. Notably, the article states: “we have installed GRP doors in all of the IKEA stores in the UK [...]”.³³

32. Mr O’Keane provides a table outlining the Proprietor’s marketing spending for advertising and exhibitions as reported below:

Year	Advertising spend £
2022	£52,000
2020	£45,000
2017	£48,000
2016	£50,000
2015	£54,700

33. I note the evidence does not contain the spend figures relating to the years 2018 and 2019. Mr O’Keane did provide any clarification on this point.

34. Mr O’Keane clarifies that the Group’s spend on marketing activities is around €120,000 per annum of which €25,000 is in the UK. Mr O’Keane does not clarify further on this point. It is unclear to which year (if any) the expenditure of €25,000 relates and how this figure reconciles with the figures provided in the table above.

35. Mr O’Keane reports that the Proprietor has, over the years, consistently attended and promoted the Contested Marks at various trade shows such as the Healthcare Estates Exhibition (various years since 2001), NAHFO Conference (since 2014), IAT Conference (since 2008), LASA Annual Conference (since 2008), ISPE Regulatory and Guidance Update Conference (various since 2006), SLAB & UKSPA Science and Innovation Conference (various since 2017) and The London Vet Show (2018). Mr O’Keane did not provide additional evidence in this regard such as, for example, evidence showing how the Contested Marks were advertised or displayed at these events.

36. Mr O’Keane provides the number of visitors to the Proprietor’s website (“www.dortek.com”) for the years between 2019 and 2023 averaging around 50,000 visitors per year. I note that for the proceedings at hand, only the numbers

³³ AOK17, page 217.

concerning the years 2019 and 2020 fall within the relevant periods. The evidence features a few screenshots from the “dortek.com” website, dated 15 January 2020, showing some sections of the website (e.g., contacts, news & events, projects) and one screenshot of the website’s homepage dated 5 August 2018. All the extracts feature the Contested Marks.³⁴

37. That completes my summary of the Proprietor’s evidence.

Decision

Statutory provisions

38. The relevant provisions of section 46 of the Act are as follows:

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

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

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

(c) [...]

(d) [...]

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

³⁴ AOK18, pages 219 – 224.

mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(4) [...]

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

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

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

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

39. Section 100 of the Act is also relevant, which reads:

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

40. Given that the Contested Mark (ii) is a comparable mark, paragraph 8 of part 1, schedule 2A of the Act is also relevant, which states:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

Relevant case law

41. 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.

42. 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].”

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 the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

[...]

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

actually provided is inconclusive. By the time the tribunal [...] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

43. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

44. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark in respect of the goods and services for which it is registered.

45. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.

[...]

48. To determine whether the condition of genuine use in the Community is satisfied, I consider that the national court must examine all forms of use of the mark within the internal market. In that context, the geographical definition of the relevant market is the entire territory of the 27 Member States. The borders between Member States and the respective sizes of their territories are not pertinent to this inquiry. What matters is the commercial presence of that mark, and consequently that of the goods or services covered by the mark, in the internal market.

[...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

46. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52, Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those

areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that ‘genuine use in the Community will in general require use in more than one Member State’ but ‘an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State’. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

Assessment of the sufficiency of use

47. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the UK (or the EU for the Contested Mark (ii)) during the relevant periods. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods/services for which use has been shown;
- the nature of those goods/services and the market(s) for them; and

- the geographical extent of the use shown.

48. The Applicant submitted a detailed criticism of each exhibit submitted by the Proprietor. According to the case law cited above (*Dosenbach*) I must consider what the evidence, as a whole, shows rather than focusing on each individual piece of evidence. Furthermore, 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, it is 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 through 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).”

49. In any case, I appreciate that the comments made by the Applicant on the evidence are relevant and I have taken them into consideration in my assessment.

50. I remind myself that the relevant period for the Contested Mark (i) spans, overall, from 19 October 1996 to 20 September 2020, whereas the relevant periods for the Contested Mark (ii) are from 8 May 2010 to 7 May 2015 and from 21 September 2015 to 20 September 2020.

51. Mr O’Keane, in his witness statement, provides a list of clients in various commercial sectors to which the Proprietor provided its goods and services throughout the relevant periods.³⁵ To this regard, most of the extracts in exhibits from AOK5 to AOK12 feature what seems to be informational material from the Proprietor’s website (i.e., the section “Projects”) where the Proprietor’s clients are indicated along with a description of the goods/services provided to them. The

³⁵ Clients in the pharmaceutical, healthcare, research, retail, leisure, veterinary, and industrial sectors for the years 2000, 2004, 2005, 2010, 2012, 2014, 2015, 2016, 2017, 2018, 2019, 2020.

Applicant contends, for each of these exhibits, that the evidence appears to have been created by the Proprietor and that such evidence is either undated or dated outside the relevant periods.³⁶ Whilst I appreciate that the extracts contained in the evidence are undated (or dated outside the relevant periods), I note that the evidence also contains, for each category of clients (apart from the “Food clients” in exhibit AOK11), a list of the clients’ names and dates reflecting the information reported in Mr O’Keane’s witness statement. Therefore, I cannot disregard this evidence. Nonetheless, I appreciate that the extracts contained in the evidence are undated (or dated outside the relevant periods) and I will bear this in mind in reaching my final decision.

52. The Proprietor provided a table showing consistent revenues between 1997 and 2020. I appreciate that the revenues table is not broken down by product and, as the Applicant argues in its submissions in lieu, the turnover figures for the period 1997-2015 have not been corroborated by the Proprietor’s annual accounts. To this regard, I also appreciate that the sample invoices provided are dated between 2015 and 2021. Nonetheless, looking at the evidence showing the Proprietor’s projects, and the years listed in the evidence summarised above (exhibits from AOK5 to AOK12), I have reason to believe that the Proprietor has been commercially active also in the years previous to 2014/2015.

53. The Applicant also argues that the turnover figures have not been broken down by product. Although I appreciate the Applicant’s argument, the Proprietor provided samples of invoices that detail the goods/services provided. Additionally, the evidence features a series of projects where the Proprietor specifies the type of doors provided to the different clients. Thus, from the totality of the Proprietor’s evidence, I can safely derive that the Proprietor’s commercial activity has, over the years, revolved around the retail of specialist door systems (and the provision of related services). Therefore, I find safe to assume that the revenue figures provided, in light of the invoices and the additional evidence, refer to the retail of specialist door systems and their related services (as further clarified below in this decision) for the whole period showed in the table of turnover figures.

³⁶ Applicant’s submissions in lieu dated 23 April 2025 at [13] e) – l).

54. Furthermore, the Applicant contends that in the invoices' description there is no reference to DorteK and that the consumers will assume that the goods are manufactured by a third-party and installed by the Proprietor. I disagree with the Applicant's submission because, if that was the case, I believe that it would emerge from the invoices. Firstly, the invoices separate between the retail of the goods and the provision of the delivery/installation services. Therefore, the relevant consumers are likely to refer directly to the Proprietor to obtain "DorteK" doors and have them delivered/installed from the same provider. Secondly, the invoice dated 31 July 2018 shows one instance where the Proprietor provided delivery/installation services for 6 items described as "Butzbach". One of the information sheets shows that the Proprietor is described as an authorised Butzbach partner, from which I infer that Butzbach is a separate manufacturer. This commercial relationship is, thus, reflected in the invoice.

55. Mr O'Keane also reports that, at the time of the witness statement, the Proprietor had at least the 85% of market share for the hygienic GRP door industry and that it employed over 150 employees within the business. The Applicant contends that these claims have not been substantiated with supporting evidence and, thus, they have no probative value.³⁷ Mr O'Keane's claims have been provided in a witness statement containing a statement of truth, therefore, I must accept them as being true. However, I appreciate that the information Mr O'Keane provided lacks specificity regarding the relevant periods and geographical extension. This especially considering that the Proprietor, as reported by Mr O'Keane, operates in the EU and internationally.

56. Mr O'Keane, in his witness statement, provides a table showing the Proprietor's marketing expenditure. The Applicant submits that the evidence does not clarify to which goods and/or services these figures refer and that there is nothing in the evidence to corroborate the figures provided in the table.³⁸ Mr O'Keane, along with the table of advertising spend, lists a series of trade shows where he says the "DORTEK" products and services were promoted. Therefore, according to Mr O'Keane's statement and considering the evidence as a whole, I find it likely that the figures for the marketing spend refer to the provision of the Proprietor's

³⁷ Applicant's submissions in lieu dated 23 April 2025 at [13] o) and p).

³⁸ Idem at [13] w).

specialist door systems and related services. Nonetheless, I find this evidence presents a few issues. First, Mr O’Keane states that total marketing spend for the Group is around €120,000 per annum (around £105,000 pa) of which around €25,000 (£22,000) is in the UK. However, the table shows an average spend of £50,000 per annum. Absent further clarification from Mr O’Keane, it is unclear whether the average spend for marketing activities in the UK averages around £20,000 or £50,000. In any case, the volume of marketing expenditure for the years 2015 – 2020 remains relevant. Second, Mr O’Keane reports that the Proprietor has promoted “DORTEK” at various trade shows over a number of years respectively “since” 2001, “since” 2006, “since” 2008 and “since” 2014, however, the expenditure figures for these trade shows are neither reproduced in the table nor present in the evidence. Thus, overall, I find this part of the evidence, although relevant, to have a reduced probative weight.

57. Mr O’Keane, in his witness statement, reports that the Proprietor’s website has been active since 2000. The table reporting the figures of the website’s user traffic refers to the years 2019 – 2023. With regard to the relevant periods, the table reports 62,431 visitors for 2019 and 65,066 visitors for 2020. Exhibit AOK18 features some samples of extracts from the Proprietor’s website dated August 2018 and January 2020. The evidence shows, for example, one extract from the “Projects” section of the Proprietor’s website featuring the Contested Marks at the top of the page and reporting one project in London for the “Battersea Dogs and Cats Home” to which 40 doors were provided. Although the evidence does not cover the whole relevant periods, it nonetheless shows use of the Contested Marks in relation to the relevant goods at hand for at least part of the fifth relevant period (i.e., 2018 – 2020).

58. I appreciate that some parts of the evidence are undated, imprecise, and have a few gaps. However, I find the evidence showed that the Proprietor has created and maintained, in all the relevant periods, a good market presence for some of its goods and services. The evidence shows that the Proprietor has provided part of the goods and services to various clients in different market sectors throughout the relevant periods, consistent revenues between 1997 and 2020, a list of invoices for the period between 2015 and 2021 detailing the goods and services retailed or provided in different parts of the UK, relevant marketing expenditure (although not

fully clear) a list of some marketing activities, and use of the Contested Marks on the Proprietor's website. Therefore, in light of the above considerations, I find the evidence provided shows genuine use of the "DORTEK" mark in relation to some of the registered goods and services throughout the relevant period. Later in this decision I will detail which goods and services I consider there to have been genuine use for and what constitutes a fair specification.

Form of the mark

59. In the evidence the word-only registered marks "DORTEK" are mostly represented in two colour variations. One variation features the mark's initial three letters "DOR-" in red and the last three letters "TEK" in black. The letters in the mark present a small degree of stylisation. The mark is preceded by a stylised figurative device (see Figure 3).



Figure 3

60. The second variation shows the mark's initial three letters "DOR-" in red and the last three letters "TEK" in grey. The mark is represented in lower case and preceded by a geometric figurative device (see Figure 4).



Figure 4

61. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark *dreams* qualified as use of the registered word-only mark 'DREAMS'. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

62. As the Contested Mark is registered as a word mark, it may be used in any form, in any colour or font type.³⁹ I find that use of the Contested Marks in its different colours amounts to use of the marks as registered because the verbal component of the mark “DORTEK” remains clearly visible in the mark and the level of stylisation in the variant forms does not alter the distinctive character of the mark. Consequently, it is fair and notional use of the registered mark and/or use upon which the Opponent can rely in accordance with the guidance in *Dreamersclub*.
63. Additionally, I note that, in most (if not all) instances, the Contested Marks (in their acceptable colour variations) have been used alongside a logo featuring either a geometric logo design consisting of two red overlapping, angular shapes that resemble interlocking hexagons or parallelograms (Figure 3 above) or two overlapping red and black squares (Figure 4 above). With regard to the use of both logos, I consider that the use of “DORTEK” (whether in its accepted colour variants or as word only) along with either of the logos, does not prevent the element “DORTEK” from being viewed independently to indicate the origin of the goods and/or services.⁴⁰ Therefore, I find that “DORTEK”, even when showed in combination with the stylised logos, remains an acceptable use of the Contested Marks.
64. I also notice that in most instances the acceptable variations of the Contested Marks are used in combination with a strapline or slogan such as “Opening Innovation”, “Bespoke Opening Innovation” or “Right First Time”. The same reasoning above applies here. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. Therefore, in those instances where the Contested Marks are used in conjunction with one of the straplines reported above, the words are likely to be viewed as an indication of the overarching slogan of the Proprietor. Therefore, I consider that the word “DORTEK” maintains its role as an independent indication of origin. Thus, also these uses amount to use of the marks as registered.

Fair specification

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

⁴⁰ As per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

65. Having found use of the Contested Marks, I must determine a fair specification upon which the Proprietor is entitled to rely, bearing in mind the use that has been demonstrated.

66. 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.”

67. 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 3653. 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.”

68. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“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.”

69. In defining a fair specification, I first turn to the specification for the contested mark number UK00002024888. Regarding the terms “*Doors of metal*” and “*doors made principally of metal*” in class 6, the evidence shows that the Proprietor markets glass reinforced polyester (GRP) doors with stainless steel frames and rail systems (for sliding doors). Along with GRP, the technical data sheets show that some of the Proprietor’s doors are also made with a MDF (Medium-Density Fiberboard) core and an HPL (High-Pressure Laminate) outer (see Figure 8). In various parts of the technical data sheets, it is even made clear, for example for the hermetically sealing sliding doors, that “*these doors outperform wood and steel alternatives*”.⁴¹ Therefore, I find the terms “*Doors of metal*” and “*doors made principally of metal*” to be excessively wide. As explained below in this decision, the Proprietor may keep the registration for “*glass fibre polyester doors*” in class 19.

70. The technical data sheets indicate that the doors are supplied “*pre-hung and fully fitted-out*”⁴² and that door panels and ironmongery (thus, including door handles, door locks, door rings, bolts, door knobs and other parts and fittings) are optional. Given the optional nature of these goods, evidence is needed to show that they are provided along with the purchased doors. No evidence in this sense has been provided. The same reasoning applies to “*door bumpers*”. I appreciate the technical data sheets indicate that door bumpers are an available option for some of the Proprietor’s doors,⁴³ however, I have no evidence before me showing the Proprietor’s retail of these goods. The opposite reason applies to “*hinges*”. As the doors are provided pre-hung and fitted-out, the Proprietor is likely to offer hinges along with the doors it installs.

⁴¹ See, for example, AOK3, page 26.

⁴² AOK3, page 31.

⁴³ See, for example, AOK3, page 20.

71. With regard to “door closers and door openers”, although the evidence shows instances where the doors have closers/openers installed (Figure 5 and Figure 6),⁴⁴ I have no evidence before me showing the Proprietor manufactures and retails this type of goods.



Waterproof Doors

Waterproof Doors

Waterproof doors need to be strong, durable and lightweight to be able to withstand heavy usage. At the same time, they need to be hygienic and aesthetically pleasing. Our unique range of GRP doors meet and exceed these requirements and meet the European EN1634-1 standards of fire certification, meaning they are fire tested and approved for up to 5 hours.

Figure 5

⁴⁴ See, for example, AOK pages 49 and 30.

Hygienic Fire Hinged Doors

Single Action - GRP
Fire Rated Automatic or Manual



Figure 6

72. Turning to class 9, the technical data sheets indicate that automations and interlocking systems are an option that the Proprietor offers. The invoices show instances where the Proprietor provided (and installed) door interlocking systems. Such systems are likely to include door opening and door closing mechanisms as well as interlocking systems especially designed for doors. Therefore, rather than “electric locks” I find fair to find that the Proprietor provides “*electric door opening and door closing mechanisms*” and “*electric interlocking systems for use with door systems*”.

73. Class 19 features the term “*Non metallic doors*”. The evidence shows that the Proprietor’s doors are mostly made of GRP and some are made of MDF core with HPL outer. Whilst I appreciate that the technical data sheets indicate that glass doors are part of the Proprietor’s offer, no evidence was provided for the retail of this type of doors. Hence, considering that the Proprietor offers doors in different

non-metallic materials, rather than exclusively in GRP, I find fair to allow “*Non metallic doors*” in the specification. With regard to “*door panels*”, from the architectural details provided in the technical data sheets, I understand that whilst the Proprietor provides door blades (i.e., the main piece forming a door, see Figure 7), the panels are not an integral part of the doors for which evidence has been provided (e.g., hermetically sealing sliding doors, hygienic hinged doors, hygienic sliding doors), but they remain an option to purchase as additional feature. Panels are an integral part of glass doors, but as stated above, no evidence has been provided regarding this type of doors. No evidence has been provided regarding the provision of door panels as additional options to the provision of doors. The same reasoning applies to “*panes*”.

74. From the technical data sheets (Figure 7) and the architectural details (Figure 8, Figure 9 and Figure 10),⁴⁵ door frames and hinges are provided along with the doors. As already found above, as the doors are provided pre-hung and fitted-out they are likely to be provided along (and installed to) hinges and frames. The technical data sheets specifies that the frames are available in aluminium or stainless steel.⁴⁶ Hinges are described once in the evidence as being made of stainless steel.⁴⁷

75. As “*frames*” and “*hinges*” are exclusively of metal they cannot be in class 19. I already found these goods to be contained in class 6 (to which metal goods are proper).

⁴⁵ AOK3, respectively at pages 27, 29 and 33.

⁴⁶ See for example, AOK3, page 27.

⁴⁷ AOK3, page 39.

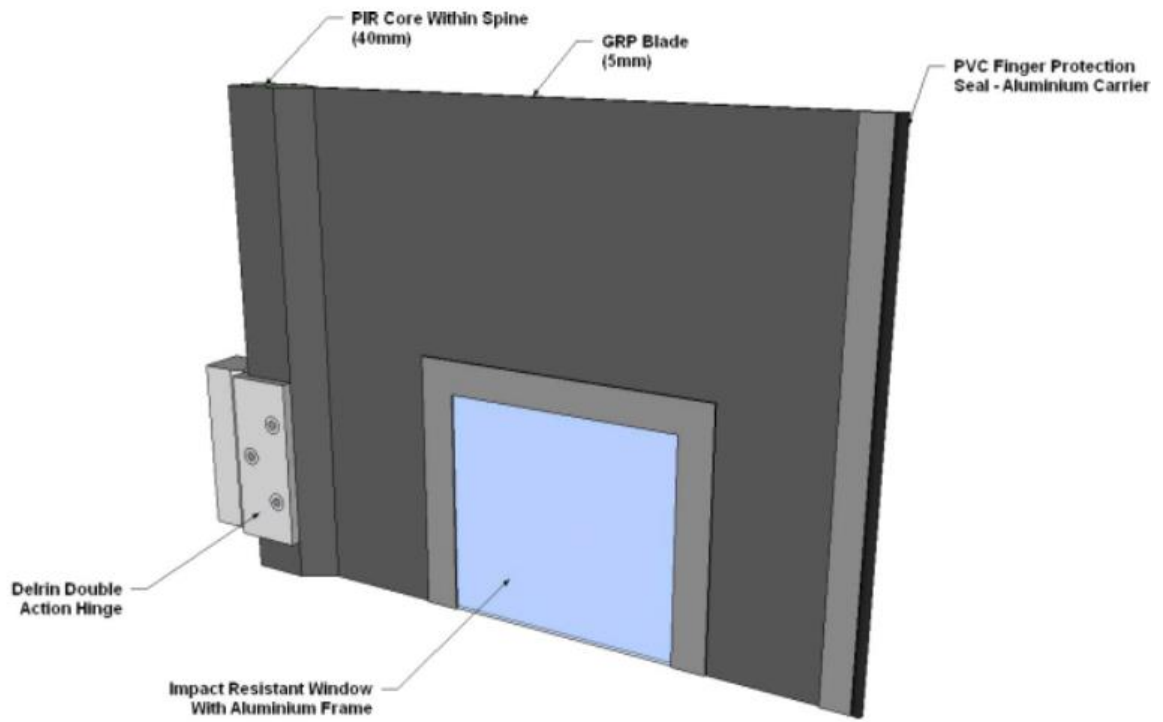
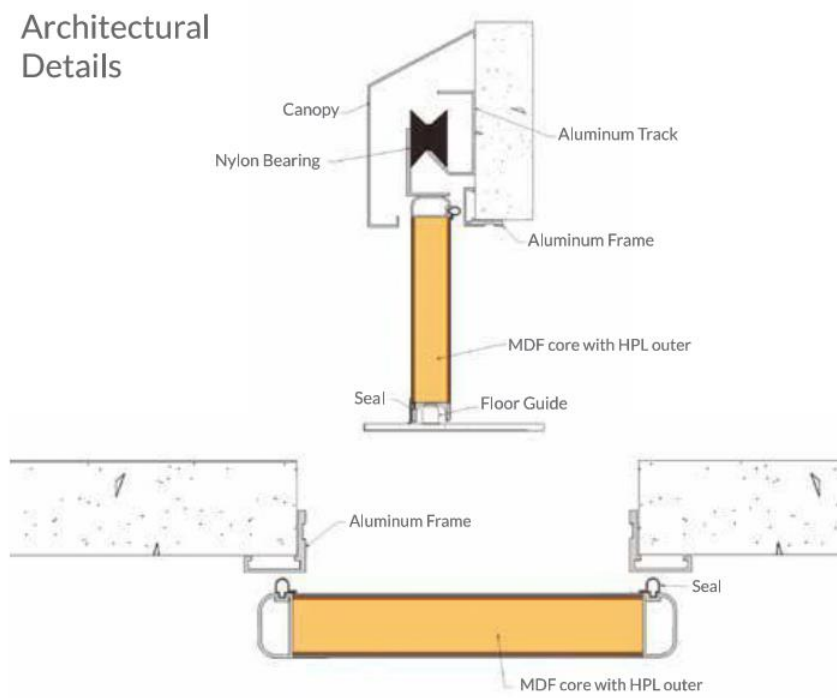


Figure 7

Hermetically Sealing Sliding Doors

Architectural Details

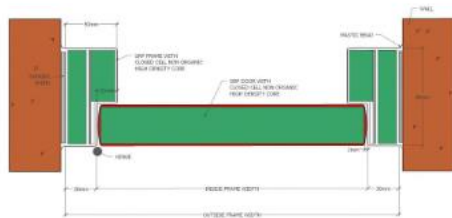


Hermetic sliding door, fixed to aluminum frame

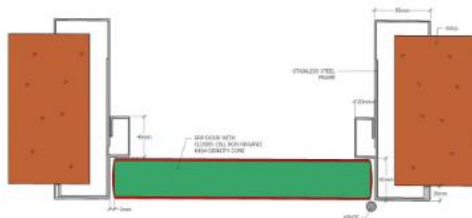
Figure 8

Hygienic Hinged Doors

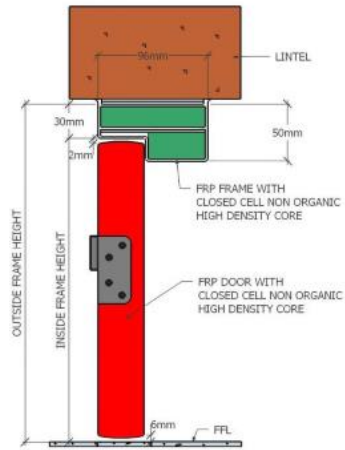
Architectural Details



Left hand hung blade, fixed to GRP frame



Right hand hung blade, fixed to Stainless Steel frame



Side section, fixed to GRP frame detail

Figure 9

Hygienic Sliding Doors

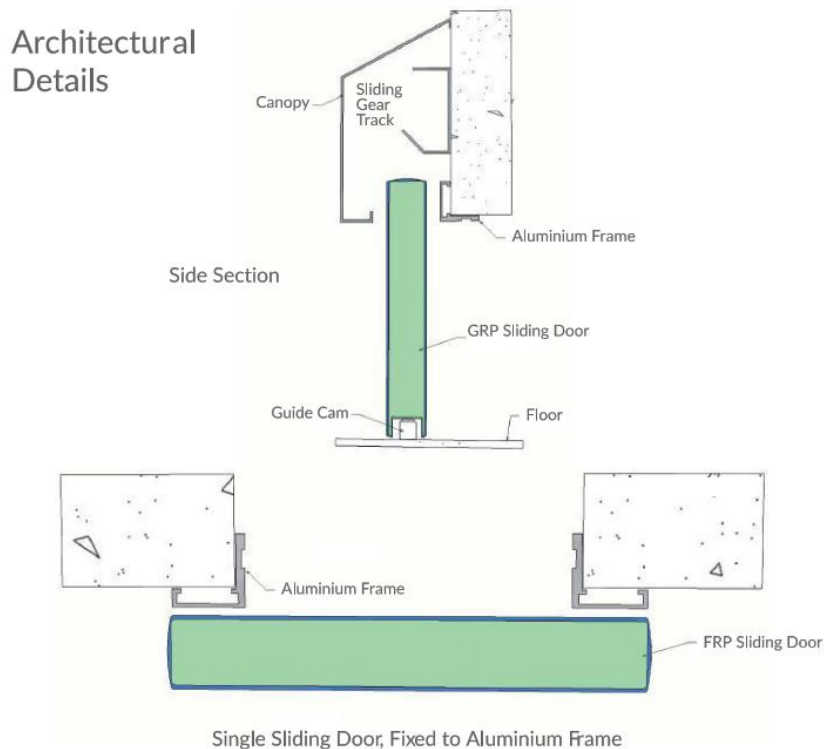


Figure 10

76. The remaining term in class 19 “*glass fibre polyester doors*” could also be used in relation to garage doors and domestic external doors, which do not serve the same purpose as the Proprietor’s doors. For this reason, I consider that it would be fair to limit the specification in the same way of the Contested Mark (ii) by the addition of “*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*”.

77. Turning to class 20, the specification features the term “*pneumatic door opening and door closing mechanisms*”. The same reasoning outlined at paragraph [71] applies. With regard to “*door blades*”, this term refers to the main integral part of the door. The Proprietor has clearly shown use for both these types of goods.

78. Regarding “*parts and fittings*” in class 20, the broad term includes, for example, door handles, locks, or escutcheons. There is no dated evidence that such goods were supplied.

79. Turning to class 37, from the technical data sheets it is clear that most (if not all) the doors provided can be automatic or manual. The invoices provided in the evidence show the Proprietor provided delivery and installation services for the doors provided. No evidence was provided with regard to repair and maintenance services.

80. With regard to the specification for mark UK00905017876 the same reasoning outlined above applies. With regard to class 7, exclusively featured in the specification of the Contested Mark (ii), the same reasoning carried out at paragraph [71] for the term “*door closers and door openers*” in class 6 applies.

81. From the above considerations I believe that a fair specification for the mark number UK00002024888 would be:

Class 6 Door frames, hinges.

Class 9 Electric door opening and door closing mechanisms; electric interlocking systems for use with door systems.

Class 19 Non-metallic doors; glass fibre polyester doors; 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 Glass fibre polyester doors; door rail systems; glass fibre polyester door blades; 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 37 Installation for manual and automatic doors.

82. I consider that a fair specification for the mark number UK00905017876 would be:

Class 6 Door frames.

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 Non-metallic doors; glass fibre polyester doors; glass fibre polyester 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 Glass fibre polyester doors; glass fibre polyester 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 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.

Outcome

83. The application for revocation on the grounds of non-use under section 46(1)(a) and section 46(1)(b) partially succeeds for the classes 6, 9, 19, 20 and 37 for both the Contested Marks and it fully succeeds for class 7 of the Contested Mark (ii).

84. As a result, the Contested Marks are, subject to any successful appeal, hereby revoked as outlined above.

85. The effective date of revocation for the Contested Mark (i) is 19 October 2001.

86. The effective date of revocation for the Contested Mark (ii) is 8 May 2015.

Costs

87. I find the parties obtained a similar degree of success. Therefore, each party should bear its own costs.

Dated this 24th day of November 2025

For the Registrar

Andrea Rossi