

**O-1077-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO 3534028**

**IN THE NAME OF ANTONIUS CORNELIS DE MAAIJER**

**FOR THE MARK**

**ZIPTRAK**

**IN CLASSES 19, 20 & 22**

**AND**

**OPPOSITION THERETO (UNDER NO. 422940)**

**BY**

**IDEAS BY DESIGN LTD**

## BACKGROUND

1) On 16 September 2020, Antonius Cornelis de Maaijer ('the applicant') applied to register the trade mark ZIPTRAK in respect of the following goods:

**Class 19:** Blackout blinds (outdoor) (other than of metal or textile); Non-metal exterior blinds; Outdoor blinds, not of metal and not of textile; Polyvinyl chloride blinds (outdoor); Roller blinds for external use (not of metal or textile); Window blinds (outdoor) not of metal or textile.

**Class 20:** Blackout blinds (indoor); Blind bolt fasteners of non-metallic materials; Blind pulls of non-metallic materials; Blinds (indoor); Holders for use in securing blinds; Indoor blinds (of all materials); Indoor blinds (roller); Indoor window blinds (insulating blinds) (furniture); Indoor window blinds (roller blinds) (furniture; Indoor window blinds [shade] [furniture]; Indoor window shades [furniture]; Interior textile window blinds; Plastic hardware for blinds; Polyvinyl chloride blinds (indoor); Pulleys of plastics for blinds; Roller blinds (indoor); Roller blinds for use indoors; Screens in the nature of blinds (indoor); Thermal blinds (indoor); Vertical blinds (indoor); Window blinds (indoor).

**Class 22:** Awnings of textile; Awnings of synthetic materials; Blackout blinds (outdoor) of textile; Blinds (outdoor), of textile; Outdoor blinds of textile; Roller blinds of textile for external use; Window blinds (outdoor) of textile.

2) The application was published in the Trade Marks Journal on 30 October 2020 and notice of opposition was later filed by Ideas by Design Ltd ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). Under the former ground, it relies upon the following UK trade mark registrations:

- **UKTM 2525552A**

ZIP

**Filing date:** 07 September 2009

**Date of entry in register:** 05 August 2011

**Class 20:** Interior window blinds; interior blinds for protection against light; interior slatted blinds; interior roller blinds; interior operating devices for blinds; interior window furniture; interior blinds; interior shades; interior window shades; parts and fittings for all of the aforesaid goods.

- **UKTM 2525552B**

ZIP SCREEN

ZIPSCREEN

(Series of 2 marks)

**Filing date:** 07 September 2009

**Date of entry in register:** 29 July 2011

**Class 20:** Window blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; window furniture; blinds; shades; window shades; parts and fittings for all of the aforesaid goods.

**Class 24:** Textiles and textile goods, not included in other classes; banners; advertising banners; cloth; cloths, fabrics and textiles for making into blinds and shades; window blinds for external use; external blinds for protection against light; slatted blinds for external use; roller blinds for external use; operating devices for external blinds; external window furniture; external

blinds and shades; external window shades; parts and fittings for all of the aforesaid goods.

3) It is claimed that the respective goods are either identical or closely similar and the respective marks are similar such that there exists a likelihood of confusion under Section 5(2)(b).

4) The trade marks relied upon by the opponent under section 5(2)(b) of the Act are earlier marks, in accordance with section 6 of the Act. As both completed their registration procedure more than five years prior to the date on which the contested trade mark application was filed, they are both subject to the proof of use conditions, as per Section 6A of the Act. The opponent made a statement of use in respect of all the goods relied upon.

5) Under section 5(4)(a) of the Act, the applicant relies upon use of the following signs:

- i) ZIP, throughout the UK since 1998.
- ii) ZIP SCREEN and ZIPSCREEN, throughout the UK since 1998.



6) All of the above signs are said to have been used in relation to 'Blinds, window blinds, screens, window screens, window coverings, shades and window shades; operating devices for blinds, window blinds, screens, window screens, window coverings, shades and window shades; parts and fittings for the aforesaid goods'. It is claimed that use of the applicant's mark, in respect of the goods applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with each of its earlier signs.

7) The applicant filed a counterstatement in which it puts the opponent to proof of use of its earlier marks. It also states that the respective marks are dissimilar and there is therefore no likelihood of confusion under section 5(2)(b) 'despite any possible overlap in the respective goods'. Further, it denies the claims made under Section 5(4)(a) and puts the opponent to proof that it had the requisite goodwill at the relevant date.

8) The applicant is represented by Marks & Clerk LLP; the opponent is represented by Maguire Boss. The opponent's evidence in chief comes from two individuals: Mr Martin Dibben provides a witness statement dated 29 June 2021 with twenty-three exhibits and Mr David Tate provides a witness statement dated 02 July 2021 and one exhibit. This evidence was accompanied by written submissions dated 02 July 2021. The applicant's evidence consists of a witness statement from Marc De Maijjer dated 01 November 2021 and four exhibits. The applicant also filed written submissions dated 04 November 2021. The opponent's evidence in reply consists of a second witness statement from Mr David Tate dated 14 December 2021 and four exhibits. This evidence was also accompanied by written submissions of even date. Neither party requested a hearing; both filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

#### Mr Tate's evidence in chief

9) Mr Tate is a trade mark attorney at Maguire Boss. His evidence goes to the issue of the distinctiveness of the TRAK element of the applicant's mark. He provides a print from the applicant's website<sup>1</sup> and draws attention to the following statement which is made on that page:

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<sup>1</sup> Exhibit DT1

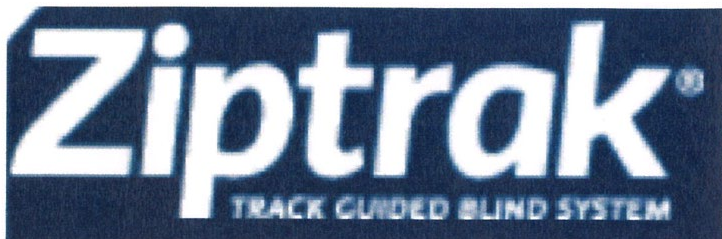
***“WHAT ARE OUTDOOR TRACK GUIDED BLINDS?”***

*Ziptrak® is a patented outdoor **track** [my emphasis] guided blind system, invented in Australia. Most blinds allow a user to lower and raise the blind, utilising the material of the blind to provide light control and privacy. **Track** [my emphasis] guided blinds take this a step further, securing the blind material at the left and right within vertical **tracks** [my emphasis].*

*The blind material is always held within these **tracks** [my emphasis], and the **tracks** [my emphasis] are mounted to the wall. This results in a protective layer that controls the flow of air and restricts dust, dirt and insects from entering. The blind won't flap in the wind and there is no unsightly cords, ropes or latches. The sealed system allows the user to trap warmth within their outdoor area during winter, and block the heat from entering during summer.*

*....”*

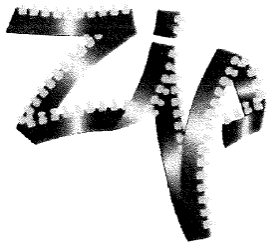
10) Mr Tate also highlights the use on the applicant's website of the strapline 'TRACK GUIDED BLIND SYSTEM', as shown below:



Mr Dibben's evidence in chief

11) Mr Dibben is the Chairman of the opponent. His evidence focuses primarily upon showing proof of use of the earlier marks and supporting the claims to goodwill. It is those aspects of his evidence that I will summarise here. I will summarise other aspects of his evidence later if, and when, it becomes relevant to do so.

12) Mr Dibben provides a witness statement dated 06 May 2010<sup>2</sup> which was submitted by him in earlier unrelated opposition proceedings<sup>3</sup> before this tribunal which, he states, sets out the background behind the opponent's adoption of the marks ZIP and ZIP SCREEN. He states that that witness statement shows use of the marks ZIP and ZIP SCREEN in the period 1998 – 2010 (which is said to lend further support to the claim to goodwill in the instant proceedings). However, I note that one of the marks relied upon by the opponent in that earlier case was stylised, as follows:



Furthermore, although mention is made of the marks ZIP and ZIP SCREEN in the witness statement, none of the exhibits from the earlier proceedings have been submitted. Therefore, I cannot tell what the marks relied upon in that case actually looked like in use (whether they were stylised or not and, if they were stylised, what that stylisation looked like). I therefore do not find the witness statement dated 06 May 2010, of itself, to be particularly helpful in the instant case where the marks relied upon are the word-only marks ZIP and ZIP SCREEN/ZIPSCREEN and the



13) Mr Dibben states (in his witness statement dated 29<sup>th</sup> June 2021) that the opponent trades as SHY and has used the marks ZIP and ZIP SCREEN throughout the relevant period in relation to blinds, screens, shades and parts and fittings and cloth therefor.

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<sup>2</sup> Exhibit MD1

<sup>3</sup> Opposition 99528 & Invalidity 83427. I note that no decision was made by the tribunal in those cases because the respective trade mark application and registrations against which they were filed were withdrawn and surrendered before a decision was made.

14) A series of screenshots from an archived version of the opponent's website are provided<sup>4</sup>. The screenshots show that it is possible to order various goods such as blackout blinds, manually operated and electric blinds, rooflights, screens, shades and parts and fittings for blinds (including cloth) which are all referred to as either 'SHY ZIP' or some as just 'ZIP' or 'SHY'. The screenshots date from 18 April 2018 and show use of the following:



## ZIP® Blinds

Our ZIP® blinds achieve a standard virtually unsurpassed by any other roller blind screen system on the UK market today.

15) A number of invoices are provided in Exhibit **MD5** dating from 2016 – 2020 (and beyond). They all show prominent use of the mark 'SHY' (stylised) in the top right-hand-corner. The invoices appear to relate to the sale of various gravity drop blinds which are referred to as 'External ZIP' in the column entitled 'System Description'

16) Exhibit **MD7** is a screenshot from an archived page of the opponent's website, dated 24 April 2018, showing a list of over 70 distributors of the opponent. The top of the page shows only the stylised mark 'SHY'. Other marks, including a stylised version of 'ZIP' are present underneath the list of distributors.

17) Exhibit **MD8** is a screenshot from an archived page of the opponent's website, dated 14 October 2016, showing 'ZIP' Blackout screens and roller blinds. The mark ZIP is used in conjunction with the mark 'SHY' i.e. SHY® ZIP® system.

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<sup>4</sup> Exhibit MD2



18) Approximate Annual turnover figures for products sold under the marks ZIP and ZIP SCREEN in the UK are said to be as follows:

<b>Year</b>	<b>Turnover</b>
2010	£1,267,000
2011	£1,388,000
2012	£1,421,000
2013	£1,291,000
2014	£1,342,000
2015	£1,245,000
2016	£1,303,000
2017	£1,592,000
2018	£1,657,000
2019	£1,380,000
2020	£1,225,000

19) The estimated number of blinds, screens and shades sold under the marks ZIP and ZIP SCREEN are given as follows:

<b>Date Range</b>	<b>Total number of goods</b>
May 2010 to Sept 2015	19,100
Sept 2015 to Sept 2020	19,000

20) Advertising expenditure under the marks ZIP and ZIP SCREEN is said to have been:

Year	Expenditure
2010	£37,000
2011	£17,000
2012	£28,000
2013	£11,000
2014	£20,000
2015	£21,000
2016	£10,000
2017	£17,000
2018	£26,000
2019	£17,000
2020	£11,000

21) Mr Dibben states that ZIP and ZIP SCREEN products have been advertised in the magazines “Openings” and “Blinds and Shutters”. These are said to be quarterly trade magazines. Various extracts from these magazines are provided spanning the years from 2009 – 2021<sup>5</sup>. All of these adverts are for various kinds of blinds and roller systems and show prominent use of the mark ‘SHY’ alongside the mark ‘ZIP’ and/or ZIP SCREEN. The mark ZIP is sometimes stylised (to look like a zip) up until about 2017, and sometimes used as the plain word ‘ZIP’. An example of the form of use, up to 2017, is shown below:



22) I note that from 2018 onwards, some of the use shown, for example in ‘Blinds and Shutters’ magazine, is as follows, showing far more prominent use of the stylised mark ‘SHY’ than the mark ‘ZIP’<sup>6</sup>:

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<sup>5</sup> Exhibits MD10 – MD13

<sup>6</sup> Exhibit MD13



23) The use in 'Openings' magazine from 2016 onwards all refers to SHY and its various blinds such as ZIP® dim-out blinds etc.

24) Exhibit **MD14** and **MD15** are a selection of screenshots from the opponent's LinkedIn page showing various posts between 2016 and 2020. Again, there is prominent use of the mark 'SHY' (stylised) but the body of the posts also all refer to ZIP® blinds and/or ZIP® screens.

25) Exhibit **MD17** consists of photographs taken on 8 October 2012 at the opponent's stand at an exhibition in Coventry which looked like this:



26) Exhibit **MD18** contains a number of invoices dated between 2015 and 2020. All of the invoices bear the following mark, prominently positioned in the top right-hand-corner of the page (mark i) was used up to 2017 when it was replaced with mark ii):

i)



ii)



The term 'ZIP' is used in the column entitled 'System description' in relation to various 'rooflight blinds' and 'gravity drop blinds'. The latter are a type of roller blind (as per the explanation of this term in Exhibit MD4).

27) Exhibit MD21 is a product size chart from 2018 for the opponent's various products, including ZIP products. It looks like this:

	Box Size (mm <sup>2</sup> ):	65 Box			85 Box			110 Box			150 Box			200 Series Box			150 Box Twin			200 Series Box Twin			
		Side Channel Size:			33 x 28mm			33 x 28mm			33 x 28mm			33 x 28mm			33 x 28mm			33 x 28mm			
		Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	Max Width	Max Drop	Max Area	
<b>Zip</b>	Gravity Drop	Manual	2.4	1.8	3.0	3.0	2.4	7.0	3.5	3.6	12.0												
		Electric - Mains				3.0	2.4	7.0	4.0	3.6	14.0	5.0	6.4	30.0	6.5	10.0	50.0	3.0	2.4	7.0	4.0	3.6	14.0
		Electric - DC	2.4	1.8	3.0	3.0	2.4	5.0															
		Battery				3.0	2.4	7.0	2.0	3.6	7.0												
	Rooflight Shaped or Lifting	Manual	2.4	1.8	3.0				2.7	3.5	9.0												
		Electric - Mains				3.0	2.4	7.0	4.0	3.6	14.0	5.0	3.8	14.0				2.0	2.4	4.0	2.0	3.7	6.0
		Electric - DC																					
		FTS										5.0	6.4	30.0	6.5	20.0	50.0						
	Cassette Roller Blinds with ZIP <sup>®</sup> side channels		Battery				3.0	2.4	7.0														
	<b>Sunfacta</b>	Gravity Drop	Manual	2.4	2.5	5.2	3.0	3.5	10.0	3.5	4.5	14.0											
Electric - Mains			2.4	1.6	3.7	3.0	3.5	10.0	4.0	5.0	18.0	5.0	7.0	34.0	6.5	10.0	60.0	3.0	3.5	10.0	4.0	5.0	18.0
Electric - DC			2.4	2.5	5.2	3.0	3.5	8.0															
Battery			2.4	1.6	3.7	3.0	3.5	10.0	2.0	5.0	10.0												
Rooflight Shaped or Lifting		Manual	2.4	1.8	3.0	3.0	3.5	10.0	3.0	3.5	10.0												
		Electric - Mains				3.0	3.5	10.0	4.0	4.0	15.0	5.0	4.0	15.0									
		Electric - DC																					
		FTS				2.7	4.5	12.0	4.0	5.0	18.0	5.0	7.0	34.0	6.5	20.0	60.0						
Cassette Roller Blinds without side channels		Battery	2.4	1.6	3.7																		
<b>Obscura</b>		Gravity Drop	Manual	2.0	2.8	4.8	2.4	3.0	5.0	2.6	3.6	8.0	3.0	4.0	10.0	3.5	4.5	14.0					
	Electric - Mains								2.6	3.6	8.0	3.0	4.0	10.0	4.0	5.0	18.0	5.0	7.0	34.0	6.5	10.0	60.0
	Electric - DC		2.0	2.8	4.8				2.6	3.6	8.0	3.0	3.5	8.0									
	Battery								2.6	3.6	8.0	3.0	4.0	10.0	2.0	5.0	10.0						
	Rooflight Shaped or Lifting	Manual							2.6	3.5	8.0	3.0	3.5	10.0	4.0	4.0	15.0	5.0	4.0	15.0			
		Electric - Mains							2.6	3.5	8.0	3.0	3.5	10.0	4.0	4.0	15.0	5.0	4.0	15.0			
		Electric - DC																					
		FTS										2.7	4.5	12.0	4.0	5.0	18.0	5.0	7.0	34.0	6.5	10.0	60.0
	Roller Blind (no headbox)		Battery						2.6	3.5	8.0												



28) Exhibit **MD22** is a copy of a decision of the EUIPO Opposition Division, dated 4 October 2013, in the opponent's favour against the applicant's IR(EU) No. 1097399 for the mark ZIPTRAK. Mr Dibben highlights that that application was refused protection in its entirety.

#### Mr De Maijjer's evidence

29) Mr De Maijjer is the applicant's CEO. He explains that the applicant's business is primarily concerned with the sale, design and manufacture of track-guided blinds under the mark ZIPTRAK, where the TRAK element is a deliberate misspelling of the word TRACK.

30) Mr De Maijjer states that the applicant has a number of trade mark registrations in countries other than the UK, including in Australia.<sup>7</sup> He also provides undated prints from the applicant's website showing use of the name ZIPTRAK above the strapline 'Track Guided Blind System'. He states that that mark has been used by the applicant since 2010. The website appears to be an Australian one. That completes my summary of Mr Maijjer's evidence to the extent I consider necessary.

#### Mr Tate's evidence in reply

31) In Exhibit DT(2)1, Mr Tate provides examples of the word 'track' being misspelled as the word 'trak' which he says are currently being used in the UK marketplace. All of these examples appear to show the word 'trak' being used as part of a trade mark by third parties for goods such as caravan tracking systems, logistics tracking systems, power tools, fleet management, clothing (track pants) and GPS tracking software.

32) In Exhibits DT(2)2 and DT(2)3, Mr Tate highlights a number of instances in his evidence in chief (Exhibits MD2 and MD3) which he states show use of the mark ZIP without the house mark, SHY.

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<sup>7</sup> Exhibit MC1, MC2 & MC4

33) Exhibit DT(2)4 is a print from the applicant's website showing a list of its distributors, none of whom are in the UK.

### **Proof of use**

34) Section 6A of the Act states:

#### **“Raising of relative grounds in opposition proceedings in case of non-use**

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if -

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

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

(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.”

35) Section 100 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.”

36) Consequently, the onus is upon the opponent to prove that genuine use of its registered trade marks was made in the relevant period. In accordance with section 6A(1A) of the Act, that period is the five-year period ending on the date of application of the contested mark i.e. **17 September 2015 to 16 September 2020**.

37) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].



(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *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].”

38) Mr Dibben’s evidence shows that the opponent has been running a business providing various kinds of blinds and parts and fittings therefor for a considerable period of time, including during the relevant period. The sales figures are substantial and there has been advertising throughout the relevant period in various trade magazines. Although the most prominent mark used appears to have been the mark SHY (stylised), and although there is clearly some descriptive use of the term ‘zip’ in the evidence before me in relation to the opponent’s goods, I find that there is also sufficient trade mark use of ZIP and ZIP SCREEN (word-only) alongside the SHY (stylised) mark to constitute use of ZIP and ZIP SCREEN/ZIPSCREEN as registered. I do not consider it necessary to consider whether the stylised versions of ZIP (where the letters appear to be formed from a zip fastener or the word ZIP is used with the small triangular device above that word) constitutes an acceptable variant because

there is, in my view, enough use of ZIP and ZIP SCREEN (word only) within the relevant period to satisfy the genuine use requirement.

39) I now need to consider what constitutes a fair specification for each earlier registration, having regard for the goods upon which genuine use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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.”

40) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

41) I find that a fair specification for the mark ZIP, bearing in mind the specification as registered, and how the average consumer is likely to fairly describe the use is 'Interior window blinds; parts and fittings for the aforesaid goods'.

42) Turning to ZIP SCREEN/ZIPSCREEN, I find that a fair specification for that mark, bearing in mind the specification as registered, and how the average consumer is likely to fairly describe the use is 'Window blinds; parts and fittings for the aforesaid goods'.

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

43) This section of the Act states:

“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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

44) The leading authorities which guide me are from the CJEU: *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.

### **The principles**

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

45) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

46) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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.

47) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

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

In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”



48) The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>ZIP</u></p> <p><b>Class 20:</b> Interior window blinds; parts and fittings for the aforesaid goods.</p> <p><u>ZIP SCREEN/ZIPSCREEN</u></p> <p><b>Class 20:</b> Window blinds; parts and fittings for the aforesaid goods.</p>	<p><b>Class 19:</b> Blackout blinds (outdoor) (other than of metal or textile); Non-metal exterior blinds; Outdoor blinds, not of metal and not of textile; Polyvinyl chloride blinds (outdoor); Roller blinds for external use (not of metal or textile); Window blinds (outdoor) not of metal or textile.</p> <p><b>Class 20:</b> Blackout blinds (indoor); Blind bolt fasteners of non-metallic materials; Blind pulls of non-metallic materials; Blinds (indoor); Holders for use in securing blinds; Indoor blinds (of all materials); Indoor blinds (roller); Indoor window blinds (insulating blinds) (furniture); Indoor window blinds (roller blinds) (furniture; Indoor window blinds [shade] [furniture]; Indoor window shades [furniture]; Interior textile window blinds; Plastic hardware for blinds; Polyvinyl chloride blinds (indoor); Pulleys of plastics for blinds; Roller blinds (indoor); Roller blinds for use</p>

	<p>indoors; Screens in the nature of blinds (indoor); Thermal blinds (indoor); Vertical blinds (indoor); Window blinds (indoor).</p> <p><b>Class 22:</b> Awnings of textile; Awnings of synthetic materials; Blackout blinds (outdoor) of textile; Blinds (outdoor), of textile; Outdoor blinds of textile; Roller blinds of textile for external use; Window blinds (outdoor) of textile.</p>
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49) Whilst the applicant's goods in class 19 may not be made of the same or similar materials as the opponent's goods, they have the same/similar purpose of providing shade from the sun, albeit that the applicant's goods are for outdoor use and the opponent's goods are for indoor use. The respective goods may be in competition and they are also likely to share trade channels and have the same users. I find the respective goods to be **highly similar**.

50) The applicant's goods in class 20 fall within the broader categories of goods covered by both earlier marks. They are **identical** as per *Meric*.

51) The applicant's goods in class 22 and the opponent's goods covered by both earlier marks will have the same/similar purpose of providing shade from the sun, albeit that the applicant's goods are for outdoor use and the opponent's goods are for indoor use. The respective goods are likely to be made of the same or similar materials and some may be in competition. They are also likely to share trade channels and have the same users. I find the respective goods to be **highly similar**.

### **Average consumer and the purchasing process**

52) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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. 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.”

53) The average consumer for all the goods at issue is a member of the general public and businesses that require blinds for their premises. The cost of the goods is likely to vary. A large awning, for example, is likely to be far more expensive than a small indoor roller blind. However, even in the case of the more inexpensive goods the consumer is likely to take account of various factors such as size, aesthetics, ease of use, functionality, ease of installing etc. Furthermore, these are unlikely to be frequent purchases. Generally speaking, I find that at least a **medium** degree of attention is likely to be paid during the purchase for all of the goods at issue but where the size and cost of the goods increases and/or where the goods must be tailored to fit, the level of attention is also likely to increase to be **higher than average**. The purchasing act for all the goods is likely to be primarily visual; they are likely to be selected after perusal in retail outlets or from photographs on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example.

### **Distinctive character of the earlier marks**

54) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

55) I will first assess the inherent distinctiveness of the opponent’s ZIP and ZIP SCREEN/ZIPSCREEN. I note that the opponent concedes that the term SCREEN in the latter marks is descriptive<sup>8</sup>. As for the term ZIP, this is a very common English word with a well-known meaning i.e. a type of fastening device. At paragraph 9 and 10 of the witness statement from Mr Dibben, dated 06 May 2010, (which was submitted in earlier proceedings before this tribunal)<sup>9</sup>, he explains that:

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<sup>8</sup> See the final paragraph on page 9 of the Opponent’s submissions, dated 14 December 2021

<sup>9</sup> Exhibit MD1

9. By way of background, in February 1997 I visited the Stuttgart R+T trade fair and on a small stand tucked away found a Japanese company called SHY, offering a blind system they called the WINKEY System as the cloth was keyed into the side channel (by a zip) and could resist the wind.
10. Through my experience in the window blind industry I could immediately see its potential and so negotiated with the Japanese to start manufacturing in the UK.

Further, at paragraphs 16 – 18, Mr Dibben states:

16. We pursued various marketing activities and initiatives where we introduced and pushed the concept of how a zip was used to manufacture a window blind.
17. In the early days, it was always an uphill struggle to explain why we were marketing on a component you could not see in the installed product, that you did not use with the zip with teeth interlocking and why we used a zip in this way, namely the knobby part of the zip was used to slide down the side channel like a key way and so became trapped and would not pull out, yet was flexible enough to roll up around the roller at the top without unnecessary bulky build-up.
18. We have conducted over the years many thousands of demonstrations and conversations to educate our customers, potential customers, the window blind trade and generally window blind specifiers and users what a zip in this context does and the benefits of a zip within a window blind and therefore why we have chosen to call this product a ZIP SCREEN.

56) In addition to the above, there are numerous instances throughout Mr Dibben's evidence which show that the opponent's goods have a zip component, incorporated within the mechanism of the blind system which enables the blind to be held securely in place in the side channels. Some examples of such use are:

i) "The heart of the system is SHY®'s specially designed zipper ribbon which is welded to the edges of the blind fabric to create a sup-strong, flat join. The zipper ribbon is securely held in a shaped plastic side channel which allows the blind to run freely and quietly but prevents the fabric from being pulled out of the channel."<sup>10</sup> (my emphasis)

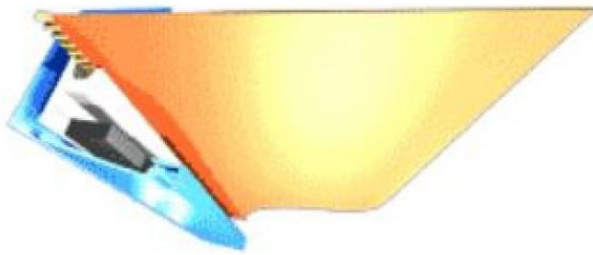
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<sup>10</sup> Exhibit MD2, pages 22-23. See also, Exhibit MD8 (pages 106 – 107)

ii) The following snapshot from the evidence shows the presence of a zip component “welded along the edge of the blind”<sup>11</sup>:

## How SHY’s Zip screen works

SHY Zip’s secret lies inside its slim side-guides.



A “zip” - welded along the length of the cloth side - runs inside an inner channel - held back firmly in the outer channel by cushioning pads. The zip stops the cloth from being pulled out of the edge channelling.

iii) “The zipper is welded to the edge of the cloth which then runs in the side channels of the system, guiding the fabric and ensuring it runs square...”<sup>12</sup> (my emphasis)

iv) “Hardware

For our products, a zip is welded to the edges of the cloth. This is securely held in the side channels to prevent the cloth coming out during use and provides an excellent degree of light exclusion through the channel itself. The use of a black zip also helps with light reduction, through this important component of the blind”<sup>13</sup> (my emphasis)

v) “SHY pioneered this technology nearly 20 years ago using a clever zip welded to the edge of the fabric which is then securely held in a special channel at the side of the blind”<sup>14</sup> (my emphasis)

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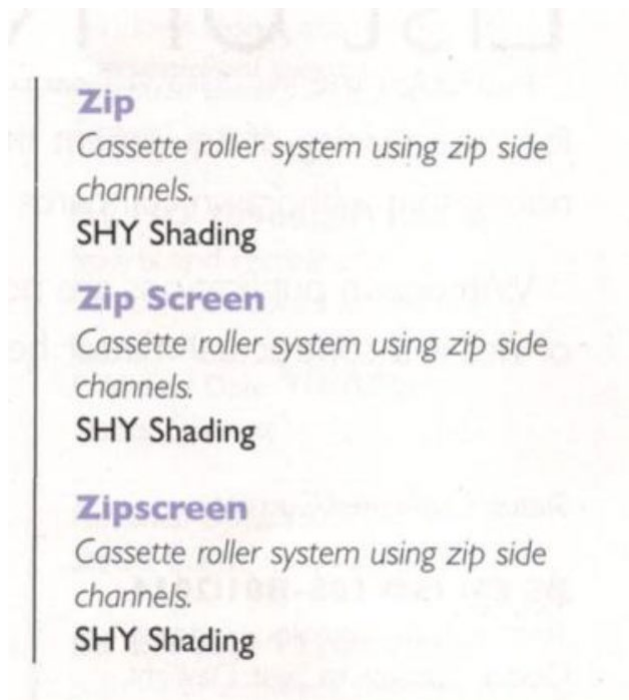
<sup>11</sup> Exhibit MD3, page 29

<sup>12</sup> Exhibit MD11 which is an article from “Openings” magazine Winter 2015/2016 (paragraph 4 of the article on page 141). See also Exhibit MD13 which is an article from “Blinds & Shutters” 2016, paragraph 5, page 172

<sup>13</sup> Exhibit MD11 which is an article from “Openings” magazine, Autumn 2016 (paragraph entitled ‘Hardware’, page 147)

<sup>14</sup> Exhibit MD13, page 177 (paragraph 2 of the article from “Blinds & Shutters” 2017)

vi) The following snapshot is taken from “Blinds & Shutters” magazine (2019 edition), referring to ‘zip side channels’<sup>15</sup>:



vii) The following snapshot is taken from one of the opponent’s brochures. A zip component can be seen on the edge of the blind cloth<sup>16</sup>:

- The specially designed zip is welded to the cloth ensuring a strong, flat join. The zip runs in a plastic inner channel securely contained in the aluminium side channel of the system. This ensures the fabric will not pull out of the channels, yet still allows the free running of the blind.



57) As the opponent points out<sup>17</sup>, in accordance with Section 72 of the Act, it is not open to me to conclude that the opponent’s earlier marks are non-distinctive as, to

<sup>15</sup> Exhibit MD13, page 183

<sup>16</sup> Exhibit MD16, page 217

<sup>17</sup> Opponent’s submissions dated 14 December 2021, page 5

do so, would call into question the validity of those registrations and no such grounds have been raised before me. However, given the nature of the evidence I have shown above, together with the fact that the opponent's marks are registered simply as the plain words ZIP and ZIPSCREEN/ZIP SCREEN and therefore bear no stylisation at all to elevate their distinctiveness, I have no hesitation in concluding that both of the earlier marks must be attributed with an **extremely low degree of inherent distinctiveness**.

58) I now turn to consider whether the use shown before me is sufficient to show that the inherent distinctiveness of the marks has been elevated through the use made of them. Although I have found that there is sufficient evidence to satisfy the requirements for proof of use, I do not consider that, bearing in mind the already extremely low degree of inherent distinctiveness of the marks, the extent of use is sufficient to have enhanced the inherent distinctiveness of either of the earlier marks. In my view, use on a far more substantial scale would be required to enhance the distinctiveness of those marks given their extremely low degree of inherent distinctiveness. This is all the more so where, as the evidence set out above shows, not all of the use that has been made by the opponent has been trade mark use of the term 'zip'.

59) I should make clear here, given that my findings above differ to those made by the EUIPO which involved the opponent's ZIP mark, that I do not consider there to be any tension between those findings. Firstly, I am not bound by the decision of the EUIPO. Secondly, it would appear that no evidence was filed in the EUIPO case by the opponent to show the nature of its use. Further, it appears that the applicant did not file sufficient evidence to support its contention, in those proceedings, that zip was descriptive because blinds can incorporate a kind of zip. The situation before me is quite different. There is a large amount of evidence before me which was not before the EUIPO, clearly showing that the opponent's goods incorporate a zipper ribbon. It is in the face of that evidence that I have reached the conclusion that the earlier marks are extremely low in distinctiveness.

### **Comparison of marks**



60) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

It would wrong, therefore, artificially to dissect the marks, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

61) The marks to be compared are:

Opponent's marks	Applicant's mark
<p>ZIP</p> <p>ZIPSCREEN</p> <p>ZIP SCREEN</p>	<p>ZIPTRAK</p>

62) The overall impression of ZIP rests in the word itself. The word SCREEN in ZIP SCREEN and ZIPSCREEN is entirely descriptive and non-distinctive, as conceded

by the opponent. Despite its extremely low distinctiveness, the distinctiveness of those registered marks must therefore reside in the word ZIP which therefore has slightly more weight than SCREEN in the overall impression.

63) Turning to the overall impression of the applicant's mark, I have borne in mind Mr Tate's evidence showing use of the term 'trak' in trade which is intended to show that that element of the applicant's mark will have little impact. However, none of that use is in relation to the goods at issue and the use that has been submitted appears to be use as/within a trade mark, as opposed to mere descriptive use. I do though bear in mind that the evidence before me shows that the applicant intends to use its mark in relation to 'track guided blinds'. Notwithstanding this, in my view, the distinctiveness of ZIPTRAK lies in the whole with no one element having greater weight in the overall impression. This is because, firstly, although TRAK will likely be perceived as alluding to the word 'track' (which is obviously of relevance to track-guided blinds), the misspelling nevertheless gives that element a degree of distinctiveness (albeit a low one given its resemblance to the word 'track'). Secondly, although ZIP is present at the beginning of the mark, it is, in my view, and in the light of evidence before me (indicating that blinds may incorporate a zip component), no more distinctive than TRAK in the context of the relevant goods. The combination of these factors, together with the conjoining of the words ZIP and TRAK to form a single word, is such that neither word can truly be said to have more weight than the other in the overall impression of the mark.

64) Visually, the ZIP mark is wholly incorporated at the beginning of the applicant's mark. However, the latter also includes the element 'TRAK' which is absent from the former. I find a **medium** degree of visual similarity overall between those marks. As for ZIP SCREEN/ZIPSCREEN, again all the respective marks include ZIP at the beginning. However, they differ as regards the SCREEN and TRAK elements. I find a **medium** degree of visual similarity between ZIP SCREEN/ZIPSCREEN and the applicant's mark.

65) Aurally, the words ZIP and SCREEN are well-known English words, the pronunciation of which requires no explanation. TRAK will likely be pronounced in the same way as 'track'. I find a **medium** degree of aural similarity between ZIP and

ZIPTRAK bearing in mind the identical first syllable but the respective absence and presence of TRAK. I also find a **medium** degree of aural similarity between ZIP and ZIP SCREEN/ZIPSCREEN owing to the common first syllable but different second syllable.

66) Conceptually, the word ZIP in the opponent's marks will be perceived as meaning a fastening device. The meaning evoked by SCREEN is obvious and entirely descriptive. The applicant's mark evokes the concept of some kind of fastening device track. I find a **fairly high** degree of conceptual similarity between each of the opponent's marks and the applicant's mark. However, the shared concept is far from being a particularly distinctive one.

### **Likelihood of confusion**

67) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier marks are, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

68) The respective goods are highly similar or identical. This is an important factor weighing in the opponent's favour. The respective marks are visually and aurally similar to a medium degree. However, despite sharing a fairly high degree of conceptual similarity, that shared concept is far from being a particularly distinctive one. Further, the earlier marks are extremely low in distinctiveness. While I bear in mind the principle of imperfect recollection, I find that even where the average consumer pays a medium level of attention (rather than higher than average), therefore increasing the potential for imperfect recollection, they are unlikely to mistake either of the earlier marks for the contested mark or vice versa. There is no likelihood of direct confusion.

69) I now turn to consider whether its, nevertheless, a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

70) 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.

71) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

72) An important factor in the current case is the extremely low degree of distinctiveness of the common element. In this connection, I bear in mind that in *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

However, I must also be mindful that in *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33., Mr Justice Arnold (as he then was) stated at [44] that:

“...what can be said with certainty is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

Further, in *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393, in [27] Mr Justice Birss (as he then was), having agreed with Arnold J’s statement of principle cited above, stated that:

“...If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.”

In [31] he further stated that:

“The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.”

73) The degree of similarity between the marks at issue stems from the common word ZIP. The distinctiveness of that element is not just low, it is extremely low in the context of the relevant goods. Bearing in mind the principle in *Whyte and Mackay*, this therefore points away from the consumer putting the similarities that exist between each of the earlier marks and the contested mark down to the goods coming from the same/linked undertaking(s). Further, although TRAK in the contested mark closely resembles the word ‘track’, I have found that the misspelling gives that part of the mark a degree of distinctiveness which is at least as distinctive,

if not more so, than the ZIP part of that mark. This is therefore not a case where the other element within the contested mark is less distinctive than the common element between the marks as described in *L'oreal*. Bearing all of this in mind, I come to the view that the average consumer is likely to put the common use of the word ZIP, in each of the earlier marks and the contested mark, down to mere coincidence and nothing more, even where identical goods are concerned. There is no likelihood of indirect confusion.

**74) The grounds under section 5(2)(b) of the Act fail.**

**Section 5(4)(a)**

75) This section of the Act states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

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

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

a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

77) There is nothing in the evidence before me to indicate that the applicant has used its mark prior to the filing date in the UK. The relevant date is therefore the filing date of the contested mark, namely 16 September 2020.

#### The claims based upon ZIP and ZIP SCREEN/ZIPSCREEN

78) The first hurdle that the opponent must overcome is to show that it had goodwill in a business at the relevant date and that those signs were distinctive of, or associated with, that goodwill.

79) I am satisfied that the opponent enjoyed substantial goodwill in a business providing window blinds and parts and fittings therefor at the relevant date. However, as to the sign(s) which are distinctive of, or associated with, that substantial goodwill, although I accept that the opponent has made some genuine use of ZIP and ZIP SCREEN/ZIPSCREEN, those signs are always used with the far more distinctive sign, SHY (in various forms of stylisation). The latter is used far more prominently on all the invoices before me and on the advertising material which has been provided. I have no doubt that the sign SHY was distinctive of the opponent's substantial goodwill at the relevant date but I do not consider the same is true of the marks relied upon before me. However, in case I am wrong about that, I will go on to consider whether, in the event they are distinctive of, or associated with, the opponent's substantial goodwill, there would be misrepresentation in relation to any of them.



80) I have already considered the signs ZIP and ZIP SCREEN/ZIPSCREEN under section 5(2)(b) of the Act for the same goods. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “*a substantial number of members of the public are deceived*” rather than considering whether the “*average consumer is confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I am mindful that in the well-known case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*<sup>18</sup> (*‘Office Cleaning’*) Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

I find that even if ZIP and ZIP SCREEN/ZIP SCREEN were distinctive of, or associated with, the opponent’s goodwill at the relevant date in relation to a business selling window blinds and part and fittings therefor, it is unlikely that a substantial number of the opponent’s customers will be misled into purchasing any of the applicant’s goods in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion.

**81) The grounds under section 5(4)(a) based upon ZIP and ZIP SCREEN/ZIPSCREEN fail.**

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<sup>18</sup> [1946] 63 RPC 39



82) There is little use of the 'zip+device' sign in the evidence before me in the period leading up to the relevant date and there is no use at all on any of the invoices or any of the advertising material in the magazine articles. Like the other signs relied upon, this sign is also, in my view, extremely low in distinctiveness, given that it is the word ZIP which dominates the overall impression of it and, where use of it is shown in the evidence before me, it is always used in close proximity to the far more distinctive sign, SHY (stylised). Bearing these factors in mind, I do not consider that the opponent has shown that the 'zip+device' sign was distinctive of its goodwill at the relevant date. However, if I am wrong about that, I do not consider there would be misrepresentation, in any event. The 'zip+device' sign is even less visually similar, and no more aurally or conceptually similar, to the contested mark than the earlier sign ZIP, in respect of which, I have already found there would be no misrepresentation. The opponent is in no stronger position in relation to the 'zip+device' sign than its earlier ZIP (word-only) sign, having regard for the guidance in *Office Cleaning* and that the only element in common between the contested mark and the earlier sign is the plain word ZIP.

**83) The grounds under section 5(4)(a) of the Act fail.**

## **OVERALL OUTCOME**

**84) The opposition has failed.**

## **COSTS**

85) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering

the opponent's statement	£300
Preparing and filing evidence	£500
Written submissions in lieu	£300
<b>Total</b>	<b>£1100</b>

86) I order Ideas by Design Ltd to pay Antonius Cornelis de Maaijer the sum of **£1100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7<sup>th</sup> day of December 2022**

**Beverley Hedley**  
**For the Registrar,**  
**the Comptroller-General**