

O/959/22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003567801

IN THE NAME OF ADFIL LTD

FOR THE FOLLOWING TRADE MARK:

ZENITH

IN CLASSES 6, 17 & 19

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504206 BY

FIBRE CONCRETE SOLUTIONS

BACKGROUND AND PLEADINGS

1. ADFIL Ltd (“the proprietor”) is the registered proprietor for the trade mark shown on the cover of this decision (“the contested mark”). The contested mark was filed on 14 December 2020, was registered on 7 May 2021 and enjoys a priority date of 7 August 2020. The contested mark stands registered for the following goods:

Class 6: Steel fibres; cut pieces of metal wires for the reinforcement of mixtures, materials and products of concrete; reinforcing rods and bars of metal for use in concrete; steel reinforcement for use in the construction of concrete floors, concrete walls, concrete pipes, sprayed concrete, pre-cast concrete.

Class 17: Raw fibres of carbon, other than for textile use; synthetic fibres, other than for textile use; artificial fibres, fabrics, felts, and threads, none being textile or for textile use; polymer resin fibres [other than for use in textiles]; fibres for use in concrete and cementitious blends; fibres for use in concrete and cementitious blends to give flexural and tensile properties.

Class 19: Fibres for use in building materials; fibres for use in building materials to give flexural and tensile properties; aggregate materials for use in concrete; concrete; reinforced concrete; mortar, lime, ready-mixed concrete and ready-mixed mortar; concrete balancing mortar; concrete building materials; ready to use concrete; ready to use cement; cement, asbestos cements, fibre cements, fire retardant cements, refractory cements, blended cements, cement base mixture for use in building, cement based coatings and/or materials, cement mortar for use in construction, cementitious materials and preparations; plaster; decorative building products; decorative building products made of cementitious materials; pre-cast concrete products; concrete blocks and pipes, pre-cast concrete pipes; building materials of mineral fibres.

2. On 1 October 2021, Fibre Concrete Solutions (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). In pursuit of the invalidation, the applicant relies on section 5(4)(a) of the Act. The application is targeted at all goods for which the contested mark stands registered and relies on the unregistered sign ‘Zenith’ which the applicant claims to have used throughout the UK since 14 April 2020 for “steel fibre reinforced concrete products”.
3. The applicant’s pleaded case is that as a result of the activities undertaken and the accreditations obtained, it has generated a substantial goodwill and reputation in respect of the Zenith products. The applicant argues that the proprietor’s use of the contested mark would cause confusion in the market and mislead prospective purchasers.
4. The proprietor filed a counterstatement denying the claims made.
5. Both parties filed evidence in chief with the applicant also filing evidence in reply. The applicant’s evidence in chief was accompanied by written submissions. A hearing took place before me on 3 October 2022, by video conference. The applicant was represented by Mr Rupert Beloff of Kings Chambers, acting on instruction from BRM Law Limited, who have represented the applicant throughout these proceedings. The proprietor was represented by Ms Jacqueline Reid of 11 South Square, acting on instruction from Haseltine Lake Kempner LLP, who have represented the proprietor throughout these proceedings. Both parties filed skeleton arguments in advance of the hearing.
6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

7. As above, both parties have filed evidence. The applicant's evidence came in the form of the witness statements of Simon Evans dated 27 January 2022 and 27 April 2022, the latter being the evidence filed in reply. Mr Evans is the director of the applicant, a position he has held since September 2020. His first statement is accompanied by six exhibits, being those labelled exhibits SE1 to SE6, with his second not being accompanied by any exhibits.
8. The proprietor's evidence came in the form of the witness statement of Ruth Bond dated 28 March 2022. Ms Bond is a Chartered Trade Mark Attorney and Associate at the proprietor's legal representative firm. Ms Bond's statement is accompanied by 11 exhibits, being those labelled exhibits RB1 to RB11.
9. While I do not intend to reproduce the evidence and submissions here, I have read and considered them in full and will, if necessary, refer to the relevant parts at appropriate points throughout my decision.

PRELIMINARY ISSUES

10. I note that the applicant's evidence refers to the existence of its own registration, being the trade mark registered under number UK00003621587. While this is noted, the existence of the applicant's mark on the trade mark register has no bearing on the present proceedings. The assessment I must make throughout this decision is in relation to the claimed goodwill in the applicant's unregistered sign.
11. The applicant's evidence sets out that:

“There is no doubt in my mind that Adfil's attempt to obtain their own Trademark in advance of our application is little more than a commercial “spoiling tactic” and is founded on precisely the fact that our product(s) and company represents a challenge to them as competitors within the same industry.”¹

¹ Paragraph 14 of the first witness statement of Simon Evans

12. I do not consider that such a claim points towards a pleading of an intention to deceive under the 5(4)(a) ground. Instead it appears that, while not expressly mentioned, the above comment is directed at a claim that the contested mark was applied for in bad faith. Such a claim would need to be brought under section 3(6) of the Act. This is not a ground that has been raised in the present proceedings and, therefore, the above comments have no bearing on the present proceedings.

13. The applicant's evidence also discusses the fact that it is not aware of the proprietor attempting to promote or market the contested mark and neither has it obtained the appropriate independent certification to take its goods to market. For the avoidance of doubt, these are not relevant factors to the present decision. The fact that the applicant is not aware of such steps taken by the proprietor does not mean that it hasn't taken them. Even if it had not, this is not a requirement during the trade mark application process. Further, the grounds relied upon by the applicant in the present case do not require the proprietor to prove use of its mark so any issues regarding this point are not relevant to the decision I must make. Having said that, I do acknowledge that under the pleaded ground, it is possible for earlier use by the proprietor to have an impact on the relevant date (a point which I shall discuss later).

DECISION

Section 5(4)(a): legislation and case law

14. Section 5(4)(a) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47.

(1) [...]

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

(a) [...]

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

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

[...]

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

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

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

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

16. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

17. 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).”

18. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant Date

19. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander K.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

20. The contested mark enjoys a priority date of 7 August 2020. No evidence has been filed that the proprietor has used the contested mark prior to the date of the application at issue and, therefore, there is no need to consider the existence of an earlier date that was capable of being the start of the behaviour complained about. Therefore, the relevant date of the assessment I must now make is the contested mark's priority date, being 7 August 2020.

Goodwill

21. The first hurdle for the applicant is that it needs to show that it had generated a protectable level of goodwill in its business at the relevant date and that the sign relied upon, being 'Zenith', is associated with, or distinctive of, that business. In making this assessment, I am guided by the case law reproduced below. If a protectable level of goodwill is demonstrated in the evidence, I will proceed to

consider whether there is likely to be misrepresentation and damage as a result of the proprietor using the contested mark. However, in the event that I fail to find that the applicant has a protectable level of goodwill, the invalidation application will fail in its entirety.

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

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

23. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not

occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

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

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

25. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

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

26. Goodwill arises as a result of trading activities. For me to find goodwill, the evidence filed by the applicant must demonstrate those trading activities. Further, those trading activities must be in relation to the goods relied upon in these proceedings, being “steel fibre reinforced concrete products”. I will now assess the evidence to determine whether it warrants a finding that the applicant had generated a protectable level of goodwill as at the relevant date.

27. At the hearing, the applicant’s representative argued that while each piece of evidence on its own may not point to a protectable level of goodwill, the evidential picture as a whole is clear in that it does satisfy the requirements of there being goodwill in the applicant’s sign. To confirm, I agree that it is necessary to look at the evidential picture as a whole rather than focus on individual pieces of evidence. However, in order to make such an assessment of the whole, I must consider each item of evidence individually. During the hearing, both parties presented arguments as to their position in respect of the evidence provided. I do not intend to reproduce those submissions in full but will, if necessary, refer to specific points below. For the avoidance of doubt, I confirm that I have given the evidence and submissions full consideration in making my decision.

28. While the applicant’s pleaded case is that it began using its sign on 14 April 2020, the evidence filed contradicts this by setting out that it had been using its ‘Zenith’ branding since October 2019. In support of such a claim, the applicant relies on a number of screenshots taken from its website.² In total, there are 23 pages worth of screenshots, the majority of which show blog posts published by the applicant. While all of the screenshots appear to have been captured after the relevant date, there are blog posts dated between 26 May to 29 July 2020. However, of the total amount of screenshots provided, only eight pages are dated prior to the relevant date and there is no mention of a date in October 2019. On this point, I note the presence of a certificate that is dated 7 October 2019 and appears to have been issued in Slovenia.³ Even if it could be said that this was the beginning of the applicant’s use of its sign, it is a Slovenian issued document and there is nothing further suggesting its relevance in relation to the beginning of the use in the UK.

² Exhibit SE1

³ Pages 2 and 3 of Exhibit SE4

29. Of those screenshots that are from posts prior to the relevant date, there are a number of references to “Zenith steel fibres”, “Zenith structural’ fibre solutions” and “a Zenith range of steel figures”. While the screenshots from after the relevant date may not be of any particular assistance, I note that they are along the same lines in that they make reference to a range of products under the “Zenith” banner. There is nothing further in the evidence to assist me in determining the relevance of these screenshots and what their reach was across members of the relevant public, such as unique visitors or how many sales were generated as a result of their presence on the website.

30. A number of print-outs from the applicant’s social media accounts have been provided, namely its Twitter account⁴ and LinkedIn page.⁵ Both accounts are under the name ‘Fibre Concrete Solutions’ and while ‘Zenith’ is mentioned in some (but not all) of the posts, so too are the brands ‘Nexus’ and ‘Vertex’. I note that the Twitter print-outs are all dated 14 September 2021, being over a year after the relevant date. While some of the posts shown have posting dates from prior to the relevant date, they only span from 8 May 2020 to 29 July 2020 and not all of them refer to ‘Zenith’. As at the date of the screenshots, the account had 593 followers. There is no indication how many followers were present at the relevant date and, secondly, whether they were followers from the UK. The latter point is of particular importance as I note that there is other supporting evidence that indicates an EU and global presence (which I will discuss below). As a result, I am simply unable to accept the Twitter evidence as demonstrating how many followers the applicant had in the UK as at the relevant date.

31. As for the LinkedIn screenshots, I note that these are also dated 14 September 2021. Unlike the Twitter posts discussed above, there are no dates associated with the posts made as they simply date how long ago they were posted, i.e. ‘1yr’ or ‘7mo’ (being one year and seven months, respectively). I note that one year is the oldest timestamp specified for the posts. I have no explanation as to how the timestamps on LinkedIn operate. For example, it is possible that the timestamp of

⁴ Exhibit SE2

⁵ Exhibit SE3

'1yr' covers anything from one year exactly to one year and 11 months. However, without any evidence to support this, I am unable to accept that this is the case and will, therefore, treat those posts as being made just one year prior to the print-out date meaning that the posts shown are from on or around 14 September 2020, being after the relevant date. In any event, the same issues highlighted when discussing the Twitter account above also apply here.

32. The applicant's evidence discussed a number of industry accreditations such as the approval for CE accreditation (being something that is described by the applicant as a mandatory requirement) in the EU.⁶ The CE certificate appears to have been issued in Slovenia, being a Member State of the EU. There was discussion at the hearing regarding the relevance of EU issued certificates in light of Brexit. The proprietor's representative argued that the certificate does not apply to the UK and that there is no evidence of such. I do not intend to get into the issue regarding Brexit and the relevance of EU issued certificates prior to expiration of the transition period for the UK's withdrawal (being 31 December 2020), however, in assessing this evidence, I do not consider it to be something that necessarily of assistance to the applicant. While the existence of the certificate is noted, it is not capable of pointing to a level of sales in the UK and there is no explanation or supporting evidence to demonstrate precisely what such an accreditation means, how it is obtained and how such a certificate would affect the applicant's goodwill.

33. Other accreditations have been provided in the form of a number of certificates from the British Board of Agrément, which relates to the UK housing market.⁷ I note that the first certificate refers to 'Nexus 85' and 'Zenith 60'. I also note that the certificates refer to CE accreditation and, at the hearing, the applicant's representative explained that this can be cross referenced with the certificate discussed at paragraph 32 above by using the reference numbers provided. While noted, I am not sure of the relevance this has to the issue at hand. For the same reasons set out when discussing the relevant of the CE certificate discussed above, these certificates are not something that are capable of pointing towards a level of sales or other trading activities across the UK.

⁶ Pages 2 and 3 of Exhibit SE4

⁷ Pages 4 to 25 of Exhibit SE4

34. The only evidence before me that is capable of even remotely pointing to a level of sales by the applicant is paragraph 6 of Mr Evans' first witness statement, which states:

“Our sales of FCS products have been consistently risen with approximately 200,000m² (2,000,000 sqft) of industrial concrete flooring and pavement constructed to date.”

35. In response to this claim, the proprietor filed evidence to demonstrate the relativity of these figures when compared with the size of the ready-mixed concrete market in the UK. I do not intend to go over this evidence in great detail but note that it includes the following:

- a. a report from a market research consultancy that sets out that the ready-mixed concrete market is estimated to have reached 21 million m³ in 2020,⁸
- b. a report showing that the largest producers of ready-mixed concrete in the UK make up 57% of the market (none of which include the applicant);⁹
- c. a Statista print-out that shows that between 2015 and 2019, the production volume of ready-mixed concrete in the UK was between 24,701,000 and 26,575,000 metric tonnes;¹⁰ and
- d. a case study that sets out that 12,504 tonnes of steel fibres were used in the construction and reinforcement of a Crossrail project between 2012 and 2015.¹¹

36. Such evidence was filed to prove that the 200,000m² figure is low when compared to the size of the market. When taken at face value, I accept that the evidence pointing to 200,000m² of industrial concrete flooring and pavement constructed is very low when compared to the size of the market for ready mixed concrete in the UK. However, it is necessary to point out that the goodwill relied upon does not need to be supported by significant sales figures as it is possible that goodwill that

⁸ Exhibits RB3 and RB4

⁹ Exhibit RB5

¹⁰ Exhibit RB5

¹¹ Exhibit RB7

is more than trivial in extent is sufficient to carry a passing off claim.¹² While that may be the case, my issue with this evidence is not the fact the figures are low but the fact that the applicant has not provided anything further to assist me in determining how these figures point to a sufficient level of trading activities of 'Zenith' products in the UK prior to the relevant date. I note that the statement refers to "FCS products" at large and no information is provided as to how much of these products relate to 'Zenith' branded products. This is a particular issue on the basis that the applicant's evidence makes several references to what appear to be other types of brandings under the applicant's product ranges, namely as "Vertex" and "Nexus".¹³ Secondly, the figures are "to date", meaning that those figures are accurate as of 28 January 2022, some 18 months after the relevant date at issue. It is, therefore, plausible to suggest that all of the figures stem from jobs/projects after the relevant date. Also, the evidence does not confirm that these figures are specific to the UK and, on this point, I note that the evidence confirms that the applicant "provides a range of fibre solution [...] across the globe through a network of both direct and distribution channels."¹⁴ Therefore, it is entirely plausible to infer that some of these figures relate to use outside of the UK. In addition to the above concerns, I have nothing to assist me in determining whether the 200,000m² figure relates to one job/project or a number of jobs/projects. On this point, I am reminded that evidence of repeated customers is helpful in determining the existence of goodwill.¹⁵ This is something that I am unable to determine in the present case. Put simply, it is not possible for me to determine what level of UK sales accrued under the sign 'Zenith' before the relevant date. I note that the proprietor's representative also raised similar issues at the hearing.

37. In addition, the proprietor's representative also raised an issue with the fact that the evidence is not capable of pointing towards customers and that, as per the *Plenty of Fish* cases,¹⁶ this is an essential factor in determining goodwill under section 5(4)(a) of the Act. While I agree that evidence of customers are an important factor in determining goodwill, it is necessary to point out that specific or

¹² *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

¹³ See pages 2, 6, 8, 11 and 16 of Exhibit SE1 and pages 3 and 4 of Exhibit SE2, for example

¹⁴ Page 15 of Exhibit SE1

¹⁵ *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

¹⁶ *PlentyofFish Media Inc v Plenty More LLP* [2011] RPC 14 and *PlentyofFish Media Inc v Plenty More LLP* [2012] RPC 5

exact figures of customers or a customer base are not entirely necessary. Instead, such evidence of the existence of customers or a customer base can be provided by way of turnover figures and invoices as evidence of sales. No such evidence has been provided here and there is nothing to assist me in determining the existence of customers or customer base for the applicant in the UK as at the relevant date.

38. The applicant's evidence includes what it refers to as an 'advertorial' that it placed in the trade press in the Autumn of 2020.¹⁷ The purpose of this was to aid in the industry recognition of the Zenith product line. Having reviewed the advertorial, I note that it includes what appears to be three separate articles that were published on 'www.concrete.org.uk' in September 2020. Firstly, there is no evidence as to the reach of the website these articles were published on and, second, there is no supporting evidence to demonstrate how many readers in the UK accessed them. In any event, the article was published after the relevant date and is, therefore, not capable of pointing to the position as at the relevant date.

39. I have set out above that it is necessary to look at the evidential picture as a whole. In doing so, I am not satisfied that the applicant has provided anything sufficiently solid that demonstrates any level of trading activities in the UK for the goods it claims to have used its sign for. I have set out above my issues with each specific piece of evidence and even taking them all together, I am unable to conclude that, collectively, they are sufficient to satisfy the requirements in determining the existence of a protectable level of goodwill. I accept that the evidence points to the existence of a brand called 'Zenith' under the applicant's umbrella of operations. However, it is my view that there is simply nothing further provided to demonstrate that the applicant has undertaken any trading activities under its 'Zenith' sign whatsoever, let alone to a point that would attract a protectable level goodwill in the business, regardless of whether the applicant's sign would be distinctive of or associated with that goodwill or not. Lastly, I refer to the case law cited above which sets out that evidence of goodwill comes primarily from the trade and the public, will be supported by evidence of the extent of use and, to be useful, must be directed to the relevant date. In the present case, these requirements have simply

¹⁷ Exhibit SE6

not been met. None of the evidence is focused on the trade undertaken by the applicant, neither does it address the public targeted or the extent of the use and, finally, it is not directed at the relevant date, with much of the evidence coming after or lacking specificity in that it makes vague references of figures 'to date'. As a result, the applicant has failed to demonstrate that its sign enjoyed a protectable level of goodwill across the UK as at the relevant date. Therefore, the applicant's reliance upon section 5(4)(a) of the Act fails in its entirety.

40. For the sake of completeness, I wish to address the issue raised by the proprietor's representative at the hearing regarding the specific goods relied upon and the goods that the evidence points to. In short, the proprietor's position is that the goods shown in the evidence are not the goods relied upon in these proceedings. While these submissions are noted, I am of the view that regardless of what specific goods have been demonstrated in the evidence, the evidence is not sufficient to demonstrate a protectable level of goodwill and, therefore, it is not necessary for me to consider the nature of the goods relied on against the goods discussed by the applicant in its evidence.

CONCLUSION

41. The application for invalidity has failed in its entirety and the contested mark may, therefore, remain registered.

COSTS

42. As the proprietor has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the proprietor filed its own evidence in chief, however, I am of the view that it was not particularly relevant to the present proceedings. While I would ordinarily reduce a costs award for the evidential category as a result, I will not do so in the present case on the basis that the proprietor was still required to consider the applicant's evidence in chief and evidence in reply.

43. In the circumstances, I award the proprietor the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Reviewing the invalidation application and the filing of a defence and counterstatement:	£200
Considering the applicant's evidence and preparing and filing evidence:	£500
Preparation for and attendance at the hearing:	£500
Total	£1,200

44.I therefore order Fibre Concrete Solutions to pay ADFIL Ltd the sum of £1,200.

This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of November 2022

A COOPER

For the Registrar