

O/0700/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003893573
BY SHENZHEN BEITABEI DIAN ZI KE JI YOU XIAN GONG SI
TO REGISTER:**

DCA

dca

(SERIES OF TWO)

AS TRADE MARKS IN CLASSES 20 AND 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 442001
BY TIANJINTIANYING HARDWARE SALES CO. LTD**

BACKGROUND AND PLEADINGS

1. Shenzhen beitabei dian zi ke ji you xian gong si (“the applicant”) applied to register the trade marks no. UK00003893573 ‘DCA’ and ‘dca’ (series of two) in the UK on 27 March 2023. It was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following goods:

Class 20: *Drawers; Drawer organizers; Stacking dresser drawer units; Drawer storage for cards; Drawer pulls of plastic; Drawer handles (Non-metallic -); Drawers for furniture; Storage drawers [furniture]; Drawer sliders (Non-metallic); Plastic drawer lining material; Bedside cabinets; Cupboards; Drawers [furniture parts]; Drawers as furniture parts; Storage cupboards [furniture]; Kitchen cabinets; Kitchen cupboards; Storage cabinets [furniture]; Bathroom cupboards; Bathroom cabinets; Plastic inserts [trays] for tool boxes; Stacking trays of plastic; Boot trays [furniture]; Computer keyboard trays; Trays, not of metal; Portable boxes [containers] of plastic; Stacking boxes of plastic.*

Class 21: *Cutlery trays; Trays [household]; Trays for domestic use; Plastic plates [dishes]; Trays for household purposes; Make-up brushes; Make-up sponges; Eye make-up applicators; Makeup sponge holders; Cosmetics brushes; Eyeliner brushes; Cosmetic brushes; Hair brushes.*

2. On 18 July 2023, TIANJINTIANYING Hardware Sales Co. Ltd (“the opponent”) opposed the trade mark on the basis of Section 5(4) (a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its alleged earlier rights in the sign ‘DCA’. The opponent claims to have been selling *Drawer organizers; Stacking dresser drawer units; Drawer storage for cards; Storage drawers [furniture]; Stacking trays of plastic; Trays, not of metal; Portable boxes [containers] of plastic; Stacking boxes of plastic; Cutlery trays; Trays for domestic use; Trays for household purposes* in the UK under this sign since January 2020 and to have acquired goodwill under the sign. It also claims that the use made pertains “*to the merchandise*” goods identified above and that use of the trade mark applied for would be a misrepresentation to the public and result in damage to the aforementioned goodwill.

3. The applicant filed a counterstatement stating as follows:

“The applicant is complied with to relative law since its use in the UK in relation to the goods applied for is liable to be permitted.

The applicant is the owner of the goodwill in the mark DCA and has used this mark throughout the UK since as early as July 2019 in relation to the above-mentioned goods “Drawers; Drawer organizers; etc in Class 20; Cutlery trays; Trays [household]; etc. in class 21”.

To register DCA, the Applicant has made a truth representation to the public, the goods offered by the Applicant are those of or related to the owner of the earlier rights, that’s true”.

4. Notably, the applicant does not deny that the opponent is the owner of goodwill in the sign ‘DCA’ in respect of *Drawer organizers; Stacking dresser drawer units; Drawer storage for cards; Storage drawers [furniture]; Stacking trays of plastic; Trays, not of metal; Portable boxes [containers] of plastic; Stacking boxes of plastic; Cutlery trays; Trays for domestic use; Trays for household purposes* as a result of use in the UK since January 2020. Neither does it deny misrepresentation and damage.

5. The opponent is represented by Pawel Wowra. The applicant is represented by Xuezhong Li. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Neither side filed written submissions and no hearing was requested. I make this decision based on a reading of all the material before me.

THE EVIDENCE

6. The opponent filed evidence in the form of a witness statements of Zhi Yong Li (with exhibits 1-4) dated 4 November 2023. Mr Yong Li is the legal representative and beneficial owner of the opponent’s company, a limited company incorporated and registered in China.

7. The applicant filed evidence in the form of a witness statements of Xue Zhong Li (with exhibits A-D) dated 9 April 2024. Mr Zhong Li is the legal representative of the applicant, the latter also being a Chinese company.

RELEVANCE OF EU LAW

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

Legislation

9. 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.”

10. 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.”

11. 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).”

12. 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 reputation 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 source 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.”

PRELIMINARY POINT

13. Aside from the brief comments made in the counterstatement (which I have reproduced above in their entirety) and aside from the evidence, I have no other submissions from the applicant. I have already noted that the counterstatement does not deny any of the opponent’s claims as to use, goodwill, misrepresentation and damage. However, at paragraph 10 of his witness statement Zhong Li states:

“I have read the Counter Statement filed by the Opponent. I deny each and every statement made in the counter statement. The Opponent is put to strict and cogent documentary proof in support of the statement made by them in their Counter Statement’ that is priority and use of the trade mark “DCA””.

14. There are three points to which I need to draw attention.

15. First, the opponent’s pleadings were straightforward; its pleadings on goodwill, misrepresentation and damage were, admittedly brief, but nonetheless full and clear.

16. Second, the applicant’s pleadings were not initially found to be inadequate. Although the applicant did not deny any of the opponent’s claims as to goodwill, misrepresentation and damage, its pleaded case is that it was entitled to apply for the contested mark because it started using it in the UK since July 2019 which is before the opponent’s alleged use (which started in January 2020).

17. Although prior use is not a defence *per se*, it can have an impact on a claim for passing off as explained by Mr Daniel Alexander QC as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11:

“41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user’s mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act

of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.”

18. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC, as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no one else had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

19. Accordingly, the first consequence of the applicant theoretically having used the applied-for mark prior to the filing date of the contested application is that the issue of whether the opponent had sufficient goodwill to sustain an action for passing off must be determined at “*the start of the behaviour complained about*”. This was also explained in *Advanced Perimeter Systems Limited* in the following terms:

“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. Following from this, the applicant could effectively defeat the opponent’s passing off claim by establishing that it began to use the applied-for mark before the opponent started using the unregistered sign relied upon in the opposition. This is because, at the date on which the conduct complained of commenced, the opponent could not have acquired any actionable goodwill (having made no use of the unregistered sign at all at that point in time) and the applicant could not be found guilty of any misrepresentation.

21. In those circumstances, although the filing date of the contested mark might also be relevant, it would be difficult (or more difficult than would otherwise have been the case) for the opponent to establish misrepresentation at that date. The reason for this is that even if the sign relied upon had become distinctive of the opponent’s business at the filing date of the contested mark, the opponent’s goodwill came into existence after the applicant’s goodwill (if, indeed, the applicant had developed such goodwill). Provided that, having started to use the contested mark before the opponent started using its sign, the applicant had continued to trade under the contested mark and had generated its own goodwill under the same, the question of whether the applicant was passing off at the filing date of the contested application would likely be answered in the negative, because the applicant had built its own protectable goodwill and was the senior user.

22. Third, whilst the applicant’s witness states that the applicant denies “*each and every statement made in the counter statement*” it is important to note that:

- (a) These denials are not contained in the counterstatement and the applicant did not make a formal request to amend the counterstatement.

- (a) The applicant's statement that "*the Opponent is put to strict and cogent documentary proof in support of the statement made by them in their Counter Statement*" **that is priority and use of the trade mark "DCA"** would suggest that the only claim the applicant denies (and in relation to which proof is requested) is "*the priority*" of the opponent's use, not the existence of goodwill, misrepresentation and damage at the relevant date.
- (b) Even if the applicant intended to deny the opponent's claims to goodwill, misrepresentation and damage, these denials are contained within the applicant's evidence which was filed after the opponent's evidence. This means that, effectively, the applicant had put the opponent to "*strict and cogent documentary proof*" of the statements made in its statement of grounds after the opponent had filed its evidence. In my view, the applicant's late denials and challenges to the opponent's pleadings are neither admissible nor fair, as nothing would have put the opponent on notice that its claims to goodwill, misrepresentation and damage were in issue before it filed its evidence.

23. Admittedly, whilst it is not open to me to amend the pleading unilaterally,¹ Hearing Officers have the power to request clarifications from a party to proceedings under Rule 62(1)(a) of the Trade Marks Rules 2008. I have pondered whether in those circumstances it would be appropriate for me to write to the applicant and request clarifications as to what is denied. In doing so, I have borne in mind that the applicant has not sought to resile from its pleaded position and neither has it offered any further explanation regarding the same, by way of written submissions. In this connection, it would certainly have been helpful for the applicant to have requested a hearing (or filed written submissions in lieu) in order to clarify its position. However, none of this was done. Lastly, I note that no application has been made to amend the applicant's pleadings in the ordinary way (or via Civil Procedure Rule (CPR) 14.2(11) to amend

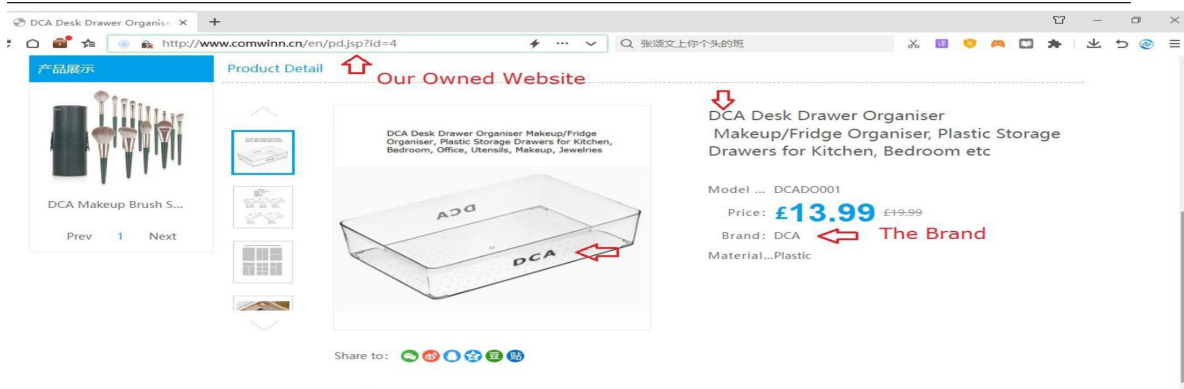
¹ See SKYCLUB (Trade Mark: Opposition) BL-O044/21 at [18], where the AP found that the HO's approach was not consistent with the guidance in *Magdeev v Tsvetkov* [2019] EWCA Civ 1902 at [22] to [28] that a court cannot proceed to consider something requiring an application without a formal application actually being made (to amend the pleadings). The AP found that it was not open to the HO to amend the pleading unilaterally but that it was open to him (under Rule 62(1)(e)) to invite the applicant to make an application to amend its counterstatement.

or withdraw an admission - if that applies to lack of denials). In this connection, I looked at the decision in *Skyclub*, BL-O-044/21, in which Mr Phillip Johnson, sitting as the Appointed Person, referred to CPRs 16.5(1) and 16.5(5) emphasising that they make clear a defendant must state what is denied, what it is unable to admit and what is admitted; whilst he noted that neither the Registry nor the AP is governed by the CPR he referred to TPN 4/2000 that at [19] and [20] provides a similar rule to the CPR.

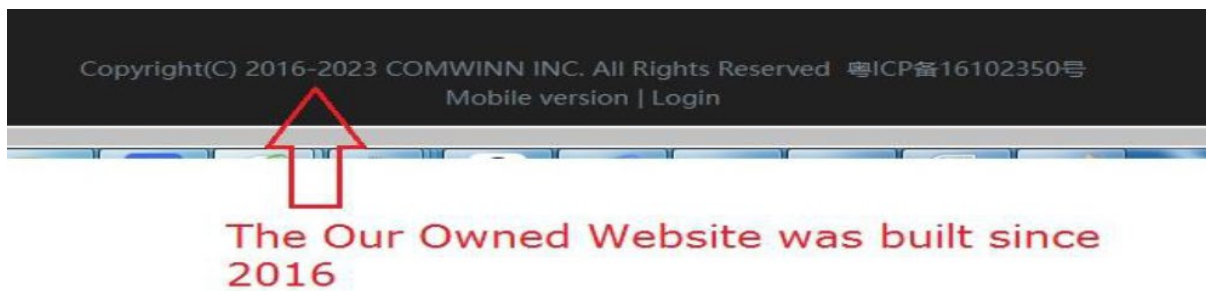
Hence, in the absence of a clear indication that, contrary to its pleadings, the applicant wished to deny the opponent's claims as to goodwill, misrepresentation and damage, I conclude that it would be a step too far for me (i) first, to unilaterally amend the applicant's pleadings and (ii) second, to request clarification in order to invite the applicant to apply to amend its pleadings to put in issue goodwill, misrepresentation and damage. This is all the more so since there has been no hearing where both parties were present, and the matter could be discussed fairly and fully. Accordingly, I will proceed on the basis that the opponent's claims as to goodwill, misrepresentation and damage have not been denied and, consequently, are admitted.

24. I now turn to Mr Xue Zhong Li's witness statement to see whether its evidence is sufficient to establish the claim that the applicant is the senior user of the sign 'DCA'.

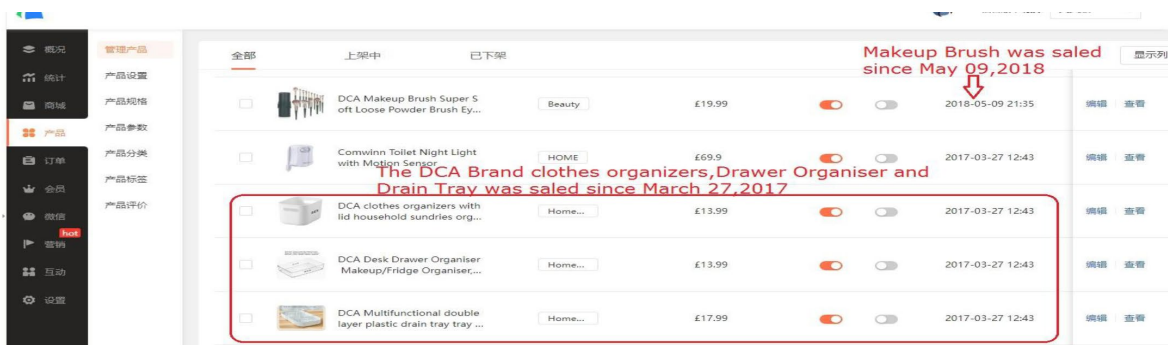
25. Mr Li claims that he has been using the trade mark 'DCA' in relation to clothes organizers, drawer organizers and drain trays since 27 March 2017 and in relation to make-up brushes since 9 May 2018 on the website www.comwinn.cn. He also states that the mark is clearly visible on the website and that "*these have been used throughout the UK*". Undated copies of the webpages are provided which appear as follows:



26. Although this evidence contains the text “our owned website was built since 2016” (shown below), the webpages supplied are undated and there is no evidence of how they looked prior to the relevant date, or indeed that ‘DCA’ branded products were offered for sale in the UK prior to the relevant date:



27. Mr Li also provides the screenshots below which shows ‘DCA’ branded goods allegedly sold in 2018:



28. Admittedly the description of the goods is in English, and the price of the goods is in pound sterling as it can be seen from the enlarged image which I have reproduced below:

The DCA Brand clothes organizers, Drawer Organiser and Drain Tray was saled since March 27, 2017

DCA clothes organizers with lid household sundries org...	Home...	£13.99	<input checked="" type="checkbox"/>	<input type="checkbox"/>	2017-03-27 12:43
DCA Desk Drawer Organiser Makeup/Fridge Organiser,...	Home...	£13.99	<input checked="" type="checkbox"/>	<input type="checkbox"/>	2017-03-27 12:43
DCA Multifunctional double layer plastic drain tray tray ...	Home...	£17.99	<input checked="" type="checkbox"/>	<input type="checkbox"/>	2017-03-27 12:43

29. However, the domain name appearing at the top of the page is <https://i.mall.fkw.com> which is not a UK domain name:



30. Also, on the left-hand side and on the bottom and top of the page there is a Chinese writing which is not translated:





31. To be relevant, the behaviour complained about must be directed at the UK public. In my view, whilst the applicant's evidence demonstrates that the applicant used the applied-for mark before the opponent's alleged use in January 2020, it falls short of showing that such use was in the UK or through websites targeting the UK public. Admittedly, the best evidence consists in showing that some 'DCA' branded goods were priced in pound sterling, however, there is no evidence of these goods being shipped to the UK or sold to UK consumers and the pages exhibited are from two websites (www.comwinn.cn. and <https://i.mall.fkw.com>) which are not UK based websites.

32. Taking all of the above into account, my conclusion is that the applicant has failed to establish that it has used the contested mark in the UK prior to the relevant date. It follows that the only relevant date is the filing date of the contested mark. The applicant having failed to deny the opponent's claims as to goodwill, misrepresentation and damage, I find that these claims are admitted and the opponent's passing off claim under Section 5(4)(a) is successful.

33. If I am wrong in treating the opponent's claims as admitted, I will go on making an alternative finding on the basis of the evidence filed by the opponent. However, this is on the basis of a much briefer analysis than I would otherwise have done.

34. Mr Yong Li's evidence shows that the opponent sells its 'DCA' branded products on Amazon UK, that the opponent has a UK VAT registration number having obtained a VAT certificate on 10 May 2021 (i.e. approximately two years prior to the relevant date)², and that the opponent's DCA products were first available on Amazon in January 2020. Exhibit 2 contains a screenshot from Amazon UK showing the

² Exhibit 1

opponent's 'DCA' products available for sale; it shows that the opponent's products received nearly 11,000 ratings scoring an average of 4.4 out of 5 stars though a proportion of those reviews must relate to after the relevant date as the screenshot is undated. Exhibit 3 is a copy of a business report generated from the DCA store on Amazon UK showing that between 10.06.2021 and 15.06.2023, there were the following sales of 4 types of DCA products, all consisting of drawer organisers: £112,755; £22,120; £10,203 and £56 for a total value of £145,134 and 10,739 units sold. Further, Mr Yong Li says that one of the opponent's 'DCA' products achieved a rank of 3 in the category of clothes drawing organiser across the entire Amazon UK platform. Lastly, the opponent invested just over £6,000 in advertising its products on Amazon UK which generated 5.5million impressions of the opponent's products in the UK.

35. Although the opponent's sales and promotional figures are not exceptional and the opponent sells its products through one platform only, the opponent's use began about 3 years before the relevant date and the opponent was rated as one the 3rd top seller for draw organisers on Amazon UK. Further, the goods are relatively cheap and nearly 11,000 units were sold by the relevant date.

36. It is true that goodwill must be more than trivial.³ However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at

³ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

first instance put it, “very limited”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS.

37. In the present case, whilst the opponent’s goodwill was small, it was sufficient to conclude that there would be substantial damage on the basis of the misrepresentation relied upon⁴ as the competing signs are identical and most of the goods are identical or similar (all being trays or items of furniture which would be sold to the same consumers through the same trade channels). Admittedly, the applied-for specification covers items such as makeup sponges and applicators as well as brushes which are dissimilar; however, the similarity of the goods is not in dispute.

OUTCOME

38. The opposition is successful, and the application will be refused registration.

COSTS

39. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £700, calculated as follows:

Preparing a statement and considering the other side’s statement: £300

Evidence: £400

Total: £700

40. I therefore order Shenzhen beita bei dian zi ke ji you xian gong si to pay TIANJINTIANYING Hardware Sales Co. Ltd the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

⁴ *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20),

Dated this 28th day of July 2025

TERESA PINTO
For the Registrar