O/0776/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004110700
BY MADDOURI LLC
TO REGISTER:

ZCOMFORT

AS A TRADE MARK IN CLASS 10

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 452230 BY
NOVELAND DIGITAL MARKING

BACKGROUND AND PLEADINGS

1. On 11 October 2024, MADDOURI LLC ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the applicant's mark"). The applicant's mark was published on 10 January 2025 and registration is sought for the following goods:

   Class 10: Therapeutic mouthpieces for the prevention of snoring.

2. On 28 January 2025, the applicant's mark was opposed by Noveland Digital Marking ("the opponent"). The opposition is based on sections 3(1)(b), 3(1)(d), 3(3)(b), 3(6), 5(4)(a) and 5(4)(b) of the Trade Marks Act 1994 ("the Act").

3. Under the section 3(1)(b) ground, the opponent argues that the applicant's mark would not be viewed as an indicator of commercial origin but, rather, a descriptive or general term for the product category. As such, it is claimed that the applicant's mark is devoid of any distinctive character and is, therefore, objectionable under the provisions set out in section 3(1)(b) of the Act.

4. Under the section 3(1)(d) ground, the opponent argues that the applicant's mark has become a sign that has been established in the trade for describing and marketing anti-snoring mouthpieces. The claimed extensive use of the mark has led to a loss of any distinctiveness it may have had. It is, therefore, claimed that it primarily serves to describe the product's characteristics or intended purpose. As a result, the opponent claims that the applicant's mark is objectionable under section 3(1)(d) of the Act.

5. Under the section 3(3)(b) ground, the opponent argues that the applicant's mark should be refused registration due to its deceptive nature, arising from the alleged false claim that the applicant's products have FDA approval. It is claimed that such a misrepresentation poses a sufficiently serious risk of deceiving the public about

the quality and regulatory status of the goods, which is likely to materially affect consumers' purchasing decisions.

6. Under the section 3(6) ground, the opponent argues that because the applicant is merely drop shipping a generic product from China, it lacks the requisite genuine intention to use the mark as an indicator of trade origin. The opponent claims that the applicant's lack of *bona fide* intention is such that its mark is inconsistent with the essential function of a trade mark. It is also claimed that the applicant is seeking to gain an unfair monopoly over a common descriptive term, which demonstrates an intention to restrict competitors from using a term that has become customary in the trade and is being used by multiple sellers for identical or similar products. Lastly, the opponent argues that the applicant neither designed nor manufactured the product and is therefore misrepresenting the origin of the goods to consumers and the UK IPO.

7. Under the section 5(4)(a) ground, the opponent relies on the earlier sign 'ZCOMFORT'. It claims to have been using this sign throughout the UK since 7 May 2024 in respect of "an anti-snoring mouthpiece (therapeutic mouthpieces for the prevention of snoring)". It is claimed that the opponent has developed goodwill associated with this sign thanks to its use of the same. Therefore, it claims that the applicant attempting to register an identical mark for the same product would cause a misrepresentation to the public. The opponent argues that such a misrepresentation is likely to cause damage by way of loss of sales.

8. Lastly, under the section 5(4)(b) ground, the opponent claims that it has been using the name 'ZComfort' for the same goods as the applicant since 7 May 2024 and, as such, has established an earlier right by virtue of the law of copyright or the law relating to industrial property rights. As such, the application for an identical mark and identical goods should be prevented.

9. The applicant filed a counterstatement wherein it denied the claims against it.

10. The opponent is unrepresented and the applicant is represented by Digip AB. Both parties filed evidence in chief with the applicant also electing to file written submissions during the evidence rounds. No hearing was requested and neither party filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

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

EVIDENCE

12. The opponent's evidence in chief was provided by way of the witness statement of Isaac Cheung dated 21 April 2025. Mr Cheung is the director of the opponent. His evidence is accompanied by five exhibits, being IC1 to IC5, and was adduced in order to prove the claims made under the various grounds relied upon.

13. The applicant's evidence came in the form of the witness statement of Baha Maddouri dated 28 April 2025. Baha Maddouri is the director of the applicant, a position they have held since 10 October 2023. Their evidence is accompanied by 16 exhibits, being MA1 to MA16, and was adduced to demonstrate information about the applicant company and its alleged earlier use of the 'ZCOMFORT' brand.

14. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

15. I will approach my decision by dealing with the various grounds of opposition in the order I have set them out above.

Section 3(1) case law and legislation

16. Section 3(1) of the Act provides as follows:

> "3(1) The following shall not be registered –
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) […]
>
> (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:
>
> Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

17. The relevant date for determining whether the applicant's mark is objectionable under sections 3(1)(b) and 3(1)(d) is its filing date, being 11 October 2024.

18. The position under the present grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and

circumspect: *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04. The applicant's goods are ordinary consumer goods that will be sought by members of the general public who will pay a medium degree of attention.

Section 3(1)(b)

19. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union ("CJEU") in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

> "29...... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been

applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel* v *OHIM*, paragraphs 36 and 38; and *Audi* v *OHIM*, paragraph 37)."

20. The opponent's position is that 'Z' in 'ZCOMFORT' is often associated with sleep or snoring and 'COMFORT' is a descriptive term relating to the purpose of the products. It is claimed that when these are combined, they do not create a distinctive character that is capable of distinguishing the goods. Firstly, I am not convinced that a single 'Z' would be associated with sleep or snoring. I appreciate that multiple Z's (such as 'ZZZ') would be seen as a reference to sleep or snoring but that is not the case here. As such, I fail to see how the use of the letter 'Z' would automatically connect to sleep in the way described by the opponent. In any event, even if such a connection was made, it would, in my view, be allusive as opposed to descriptive. For example, a 'Z' (if associated with snoring/sleep) would not describe an anti-snoring mouthpiece but would only allude to a connection between the product and snoring/sleep. As for the word 'COMFORT', I disagree that this

would describe the purpose of the goods. The purpose of a mouthpiece for the prevention of snoring is to *prevent snoring*, not to be comfortable. While the reference to 'COMFORT' may be laudatory in that consumers will consider it to be a statement that the goods will be comfortable to wear, this is not directly descriptive of the purpose of the goods in the way claimed by the opponent.

21. I accept that, even on the opponent's best case, the applicant's mark carries some allusive and laudatory qualities but this does not mean that the mark is devoid of any distinctive character. On the contrary, I am of the view that it is a mark that is capable of distinguishing the applicant's goods from the goods of others. Therefore, I find that the applicant's mark is not objectionable under the provisions set out under section 3(1)(b) of the Act.

22. It is noted that part of the opponent's section 3(1)(b) claim includes reference to the mark being used by multiple retailers and sellers and that such use means that the mark is not perceived by consumers as an indicator of commercial origin. This is noted but such an argument lends itself to the provisions of section 3(1)(d) of the Act which relates to claims that marks have been customary in the current language or in the *bona fide* and established practices of the trade. As above, the opponent has sought to rely on this ground, which I will now proceed to consider.

Section 3(1)(d)

23. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM,* Case T-322/03, the General Court summarised the case law of the CJEU under the equivalent of section 3(1)(d) of the Act, as follows:

> "49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods

or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS,* paragraph 40)."

24. In light of the case law above, the relevant question is whether, on the relevant date (11 October 2024), the mark 'ZCOMFORT' had become customary in the

current language or in the *bona fide* and established practices of the trade to designate the goods for which the mark is registered, being therapeutic mouthpieces for the prevention of snoring in class 10. That question must be based on the perception of the average consumer of the goods in the UK, who I have identified at paragraph 18 above.

25. The opponent's evidence in respect of the present ground comes in the form of a number of different screenshots showing 'mouthpieces for the prevention of snoring' listed for sale.[1] Each listing shown includes the wording 'ZCOMFORT'. That being said, the evidence is very limited in that it demonstrates just 11 different items for sale. Further, only one of the listings can be said to apply to the UK market. This is the last listing shown, being one taken from Amazon.co.uk.[2] The first 10 screenshots show goods listed for sale in US dollars and come mostly from '.com' websites, including the US retailer Walmart. In short, there is nothing before me to indicate the reach of such listings to consumers in the UK and it is noted that the websites appear to have been accessed from Hong Kong so their presence does not even demonstrate that such goods are suitable for shipping to the UK. As above, the present ground is to be assessed based on the perception of the average consumer in the UK meaning that 10 of the 11 screenshots provided are of no assistance here. Lastly, none of the screenshots provided include any dates in order to assist me with determining when they were obtained. Given that my assessment is to be directed at the relevant date, even if it could be said that the printouts were directed at the UK consumer, they cannot be said to reflect the position in the market at that time.

26. For the reasons set out above, the opponent's evidence offers no assistance to the present ground and fails to demonstrate that, as at the relevant date in the UK, the sign 'ZCOMFORT' had become customary in the current language or in the *bona*

[1] IC3
[2] See page 8 of IC3

fide and established practices of the trade. Therefore, the applicant’s mark is not objectionable under the provisions set out under section 3(1)(d) of the Act.

Section 3(3)(b)

27. Section 3(3)(b) of the Act states:

> “A trade mark shall not be registered if it is—
>
> > (a) […]
> >
> > (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

28. The case law in relation to section 3(3)(b) was helpfully summarised by Professor Phillip Johnson, as the Appointed Person, in *TWG Tea Company v Mariage Frères*, BL O/358/17 at paragraph 84:

> (a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: C-87/97 *Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; C-259/04 *Emanuel*, ECLI:EU:C:2006:215, paragraph 47; C-689/15 *W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;
>
> (b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer): *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei,* paragraph 55;
>
> (c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective

statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder's Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the deception must have some material effect on consumer behaviour: *CFA Institute's Application* [2007] ETMR 76, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05 *HUP Uslugi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficiently specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16 *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T-29/16 *Caffè Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS — École de ski internationale v OHIM*, EU:T:2991:200, paragraph 50; *Caffè Nero*, paragraph 47.

29. The argument put forward by the opponent in respect of the present ground is that the applicant's mark is objectionable because the applicant has falsely claimed that its goods have FDA approval. The evidence on this point is merely a photo of the applicant's packaging showing an 'FDA approved' badge or mark, a screenshot of the applicant's website stating that its product is FDA approved and a screenshot from the FDA's website showing no results found for a search of 'zcomfort'.[3] This evidence is noted but is of no assistance. I say this because the FDA is, as far as I understand it, a governmental department in the USA that deals with the administration of food and drugs sold in the USA. It is, therefore, not relevant to the UK market. Further, the evidence does not demonstrate an attempt by the applicant to sell goods with FDA approval in the UK. On this point, the evidence showing the reference to 'FDA approval' is taken from the applicant's '.com' website and cannot, therefore, point to an offer for sale of such goods in the UK. In any event (and more crucially), as set out at point (b) in the case law cited above, in order for use to be deceptive under section 3(3)(b) of the Act, it must arise from use of the mark itself. Whether the applicant's claim as to FDA approval is false or not is immaterial to the issue as to whether the mark itself is deceptive. As a result, and without anything further from the opponent, there is no valid basis for finding that the applicant's mark is deceptive in accordance with section 3(3)(b) of the Act.

Section 3(6)

30. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

[3] IC5

31. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).
>
> (v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but

either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

32. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probabilities). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

33. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull* (cited above). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

34. The relevant date for the present assessment is the same as that under the grounds assessed above, being 11 October 2024. Under the present ground, the opponent's case can be broken down as follows:

   a. The applicant is merely drop shipping a generic product from China. It, therefore, lacks the requisite genuine intention to use the mark as an indicator of trade origin. It is claimed that this lack of *bona fide* intention is such that its mark is inconsistent with the essential function of a trade mark.

   b. The applicant is seeking to gain an unfair monopoly over a common descriptive word, which demonstrates an intention to restrict competitors from using a term that has become customary in the trade and is being used by multiple sellers for identical or similar products.

c. The applicant neither designed nor manufactured the product and is therefore misrepresenting the origin of the goods to consumers and the UK IPO.

35. Taking these arguments in turn, I fail to see how drop shipping a product from China automatically means that the applicant lacks the genuine intention to use the mark as an indicator of trade origin. It is noted that the opponent's evidence in support of the present ground shows screenshots of the applicant's website dated 21 April and 13 September 2024.[4] However, these show use of the 'ZComfort' branding on the webpages themselves. While the packaging for the product shown may not appear to show the relevant branding, the appearance of the mark on the website clearly shows an intention to use the mark. In addition, it is noted that in defence of this point, the applicant's own evidence demonstrates sales of 'ZCOMFORT' products via a range of orders bearing the mark to UK-based consumers from October 2023 onwards.[5] This would clearly suggest that the applicant has been using the mark as an indicator of origin for its goods in the UK.

36. It is noted that in respect of the first argument raised under the present ground, the opponent's narrative evidence claims that the applicant only 'recently' created branded packaging, solely for the purpose of supporting the trade mark application, rather than reflecting genuine use as an indicator of origin. This claim is entirely unsupported in the evidence and, in any event, the existence of packaging bearing a trade mark is not a requirement for someone applying for trade mark protection in the UK. Therefore, I fail to see how it could be said that the change of packaging was merely done to support the application and not with a *bona fide* intention to use the mark on the relevant goods.

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[4] IC4
[5] See BM6 to BM15

37. Turning to the second claim listed above, I have found that the mark at issue is not descriptive and neither is it one that has been proven to be common in the trade. As a result, it cannot be said that the applicant is demonstrating any intention to restrict competitors from using a term that has become customary in the trade.

38. Lastly, I turn to the third argument raised. Put simply, the fact that an undertaking may not have designed or manufactured a product they are selling under a trade mark is in no way proof that they are seeking to misrepresent the origin of the goods to consumers or the UKIPO. As far as I am aware, it is a relatively common practice for undertakings across various trades to bulk buy products that they did not design or manufacture with a view to selling them under their respective brandings. Such a practice is in no way indicative of bad faith. In any event, the only evidence filed in support of this point is via an undated screenshot showing an identical product listed for sale in euros on AliExpress.[6] This, by itself, is not proof that the applicant has not designed or manufactured the goods it sells. Again, even if it did not, that does not automatically mean that the application for the mark at issue was in bad faith.

39. Taking all of the above into account, the opposition reliant upon the section 3(6) ground falls far short of proving that the applicant applied for its mark with dishonest intentions and that its actions fell below the acceptable standards of commercial behaviour. The present ground, therefore, fails.

Section 5(4)(a)

40. Section 5(4)(a) of the Act states as follows:

> "5(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 -

[6] See the second screenshot on page 3 of IC5

(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.

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".

41. Subsection (4A) of section 5 of the Act 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."

42. 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)."

43. 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[1] 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."

Relevant Date

44. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O/410/11, Mr Daniel Alexander QC (now KC) as the Appointed Person considered the relevant date for the purposes of section 5(4)(a) of the Act where the applicant/proprietor or both of the parties have used the mark(s) at issue prior to the date of the application to register the contested mark(s). He explained that:

"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."

45. In addition to the above, I remind myself of *Smart Planet Technologies, Inc. v Rajinda Sharma*, BL O/304/20, wherein Mr Thomas Mitcheson QC (now KC), 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 the 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. This means that if A starts to use a mark, and continues to use it in the same way, he or she will not be passing off as B, even if B acquires a protectable goodwill under the same or similar mark before A does.

46. In the present case, the applicant has provided evidence of its own earlier use of its 'ZCOMFORT' mark. This comes from a range of sales of the 'ZCOMFORT' anti-snoring product to customers in the UK between the dates of 22 January 2024 and 1 May 2024.[7] There are 30 transactions shown in total and I note that they include confirmation of the order, proof of payment and tracking information. Each transaction shows clear use of the 'ZCOMFORT' branding. In addition, evidence of a further nine UK customer orders from 18 October 2023 to 6 August 2024 are provided under the cover of separate exhibits.[8] Each of these exhibits show ZCOMFORT products shipped to UK addresses.

47. As above, the earliest date referred to in the evidence regarding when the applicant's own use began was 18 October 2023. I accept that the outward offering of the goods subject to this transaction is likely to have come before that date in order to facilitate the sale. However, given that this is the earliest date that I can determine from the evidence, I will proceed on the basis that this is the date on which the behaviour ultimately complained about in these proceedings began. As set out at the outset of this decision, the opponent's claim is that its own use of the sign relied upon began on 7 May 2024. This is after the date on which the applicant began using its mark and given this earlier use by the applicant and in light of the case law discussed above, the applicant cannot be said to be passing off as the opponent as at the date on which either the opponent's use began or when the applicant filed for its own mark. As such, the present ground fails on the basis that the opponent is not the senior user of the sign it has relied upon.

48. In the event that I am wrong to reject the present ground for the reasons above, I will, for the sake of completeness, proceed to consider the issue of whether the opponent's business enjoyed a protectable level of goodwill by the time the applicant filed its mark.

[7] BM6
[8] See BM7 to BM15

Goodwill

49. 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."

50. 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 off 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 that 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."

51. 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."

52. 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."

53. Goodwill stems from trading activities. The evidence of the opponent's trading activities comes from undated screenshots of Google search results for 'zcomfort'[9], a support email dated 17 June 2024 to one customer[10] and two 'snapshots' of sales records from May 2024.[11] Firstly, the undated screenshots of Google search results are incapable of showing any actual trading activities in the UK. Secondly, the support email to a customer is merely a response to a complaint that a customer has yet to receive their order. All it states is that the order will be with the customer within a week. No details of the location of the customer are provided. Lastly, as for the two snapshots, I note the following:

    a. The first snapshot is simply an image of the opponent's inbox showing 10 emails dated between 22 and 29 May 2024. Only the subject lines of the emails are shown and it is noted that four of the emails are 'ZComfort Customer Messages', one covers a payment[12] and five are '[ZComfort] New Customer Orders' (with the orders numbered 1392, 1393, 1395, 1396 and 1397). While the 10 emails are noted, I have no way to determine whether the four 'message' emails or the payment email cover actual sales or not. That being said, because it represents the opponent's best case, I will proceed as if each individual email covers one sale. In such circumstances, the emails cover 10 sales. There is no further information provided regarding the customers.

    b. The second snapshot is of the opponent's sales record for May 2024. This shows 16 transactions between 19 and 31 May 2024. The transactions are

[9] IC1
[10] See the screenshot at the top of page 2 of IC2
[11] See the screenshots on page 1 and the bottom of page 2 of IC2
[12] It is not clear whether this is a payment for an order or not.

shown in dollars and no information is provided regarding the customers. Additionally, it is noted that five of these orders (numbered 1392, 1393, 1395, 1396 and 1397) reflect the same order number in the 'confirmation emails' discussed at point (a) above.

54. I remind myself that when considering goodwill under the present ground, it is necessary for the opponent to show that it has customers in the UK.[13] As above, there is no information as to the customers covered by the transactions and given that 16 of them are shown as being made in US dollars, it is reasonable to conclude that they are sales to US-based customers. Even if they are not, there is nothing before me to suggest that they are UK sales and given that the burden for proving the existence of goodwill lies solely with the opponent, I consider it reasonable to expect that clarification on this point should have been provided. Therefore, I am not content to conclude that any of the sales covered in the opponent's evidence are to UK customers, meaning that this ground must fail.

55. In any event, even at the opponent's best case that the transactions shown were to UK customers, the totality of the evidence shows just 22 sales.[14] This reflects a very low level of use and while I appreciate that small businesses with low levels of use can sustain claims for passing off,[15] I consider this at too low a level and over too short a period of time to support a finding that there exists a protectable goodwill in the opponent's business.

56. In light of what I have said above, even ignoring the issue regarding the relevant date for the present assessment, the present ground fails due to the opponent's failure to demonstrate a protectable goodwill in the UK.

[13] *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31
[14] I reach this figure on the assumption that the transaction discussed in the 'support' email from June 2024 was not covered by the two snapshots. Further, I have deducted the five duplicate orders that appear across the two snapshots
[15] *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

Section 5(4)(b)

57. Section 5(4)(b) of the Act states:

"5(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) […]

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.

58. In proceedings before the Tribunal, it is common for the present ground to be relied upon in respect of copyright work, primarily artistic works as defined by section 4 of the Copyright, Designs and Patents Act 1988. However, the opponent's pleaded case in respect of the present ground is as follows:

"The trademark "ZComfort" should not be registered as its use in the United Kingdom is liable to be prevented by virtue of an earlier right, specifically the law relating to industrial property rights, as per Section 5(4)(b) of the Trade Marks Act 1994.

Our store, zcomfort.net, has been using the name "ZComfort" for the same anti-snoring mouthpiece since May 7, 2024, which predates the applicant's trademark application. This continuous use has established an earlier right in the form of unregistered trademark rights and associated goodwill.

Our store, zcomfort.net, ranks first for the keyword "ZComfort" on Google and other search engines, demonstrating significant market presence and consumer recognition.

In fact, many other online stores also use the name "ZComfort" for the same anti-snoring mouthpiece. This is a common phenomenon in the world of dropshipping businesses. The applicant is also dropshipping from China. They just designed a branded package box recently, solely in order to trademark the name "ZComfort". However, the widespread use of the name "ZComfort" supports that it should remain available for use by all traders rather than being monopolized through registration.

Registration of the trade mark would significantly damage our earlier right. It would prevent us from continuing to use the name "ZComfort" for our established business. Substantial monetary loss would result from the forced cessation of business under this name, given our trading history since May 7, 2024. It could also lead to the closure of many other existing businesses using this name, disrupting the market and potentially reducing consumer choice.

Therefore, the application should be refused to protect our earlier right and maintain fair competition in the marketplace."

59. Under the present ground, the opponent is not seeking to rely on an earlier copyright work but, instead, an industrial property right, being the trade mark 'ZCOMFORT'. The pleadings under the present ground essentially mirror the claims of the opponent's section 5(4)(a) ground in that it argues that its own earlier use of 'ZCOMFORT' gave rise to goodwill and that this is capable of preventing the applicant's mark from being registered. As such, I can deal with the present ground briefly. Insofar as the mark 'ZCOMFORT' is capable of being an industrial property right,[16] I repeat the findings I have made under the section 5(4)(a) ground, namely that the right relied upon does not qualify as an earlier right because of the applicant's own earlier use of the same. Further, the opponent's evidence of trading

[16] My primary view is that the trade mark 'ZCOMFORT' would not ordinarily fall within the definition of an 'industrial property right'. However, for reasons that will be obvious, I proceed here as though it is.

activities falls short of demonstrating the existence of a protectable level of goodwill in the opponent's business.

60. Lastly, it is noted that the claim under the present ground includes aspects of the same arguments put forward under the section 3(1)(d) and 3(6) grounds in that, respectively, there is widespread use of 'ZCOMFORT' in the UK (being the relevant territory) and that the applicant is merely drop shipping goods from China. I mirror the comments I have made in respect of those arguments above in that (1) there is no evidence before me of any widespread use of the 'ZCOMFORT' name by other traders and (2) the drop shipping issue is entirely irrelevant to the issue of the applicant's mark. As a result, I fail to see how these arguments are applicable here.

61. For the reasons set out above, the present ground fails.

CONCLUSION

62. The opposition fails and, subject to any successful appeal against my decision, the applicant's mark may proceed to registration for all of the goods applied for.

COSTS

63. The applicant has successfully defended its mark 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 applicant the sum of £1,300 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing the counterstatement:	£400

Reviewing evidence of the opponent and preparing its own evidence and submissions:	£900
Total:	**£1,300**

64. I hereby order Noveland Digital Marking to pay MADDOURI LLC the sum of £1,300. The above 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 26th day of August 2026

A COOPER
For the Registrar