

**O-447-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3108120  
BY CRAIG GEORGE WEST  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 37**



**AND**

**THE OPPOSITION THERETO  
UNDER NO 404834  
BY  
BRENDAN O'CONNELL**

## Background and pleadings

1. On 11 May 2015, Craig George West applied for the mark



in class 37 for *advice relating to preventing blockages in plumbing lines; advisory services relating to the installation of plumbing; Advisory services relating to the maintenance of plumbing; advisory services relating to the repair of plumbing; maintenance of plumbing; plumbing and glazing services; renovation of plumbing; plumbing and gas and water installation; plumbing; plumbing maintenance advisory services; plumbing repair advisory services.*

2. The application was published for opposition purposes on 29 May 2015. Brendan O'Connell opposes the application, claiming that it offends sections 3(1)(a), (b), (c), (d) and 3(6) of the Trade Marks Act 1994 ("the Act"). These sections state:

"3.— (1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time

of production of goods or of rendering of services, or other characteristics of goods or services,

- (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 practice 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.”

“3.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

3. I set out here, verbatim, the claims made by Mr O’Connell:

- 3(1)(a): “I am concerned that Mr Wests applied for trademark and copied company identity is so similar to my trademark small job plumber

And company small job plumber Ltd that it would be impossible to distinguish his company from mine and would lead to public confusion as we both live in the same town Brighton East Sussex

My trademark has been in constant use since 2013 and is well known in the in the area.

Through advertising campaigns including a sign written van, page 1 of Google search for plumbers in Brighton, checktrade page and thousands of business cards

Mr Wests applied for trademark has only been used in the last month or so and is really just another way Mr West has found in his continued campaign of harassment towards my company and me”.

- 3(1)(b): “I also oppose this trademark, as it has no distinctive character it has had minimal use and sounds the same as my trademark it has not been in use and is not distinctive in any way and it is just a camouflaged version of my trademark that has been in use nearly 2 years.”
- 3(1)(c): “I also oppose this on 3c the time of production of goods or of rendering of services, or other characteristics of goods or services,

Mr west applied for trade mark small job on time same day plumber today with a clock, this is an impossible claim that he is on time and same day services it is impossible in any service industry to claim this as it is impossible to know how long a job is going to take until you actually get to the job and assess how long it will take to complete, so how can it be possible to tell customer [a] that you will be there at 9 and then tell customer [b] you will be there at a certain time when you don't know how long job [a] is going to take?. So if job [a] and job [b] take longer than expected then job [c] might not get done until the following day?

This is a badly thought out logo is a recipe for a disaster for the public who require an honest plumbing service

And again its Mr wests way of harassing my company with his continued obsession wit my company name small job plumber ltd”.

- 3(1)(d): “Because ALL plumbing company’s aim to be on time and

All plumbing companies offer a same day service depending on if it is an emergency and or if they are fully booked that day.

There are also many plumbing company’s that use or refer to an allotted time to the work

Including

On time plumber

On time plumbing

24/7 plumbing

Am/pm plumbing

Around the clock plumbing

And every plumbing company will give an allotted time to do required work as this is how the plumbing industry works and ALL plumbing companies should be allowed the use of these bonafide every day words used in the plumbing industry. Without the threat of harassment from Mr west”.

- 3(6): “I met Mr Craig west in the alter summer of 2013 and since the day I met this man he has continued to harass me and copy everything I do with my company to the extent that he has opened a total of 9 company’s that are all a variation on my legitimate company. Small job plumber ltd. Opened in 2013

He has claimed to the director of my company and has a very unhealthy twisted idea that it is ok to steal people’s company identities and the piracy of trademarks is expectable and it is ok to behave like this.

I feel that Mr wests motives are plain and simple.

That his intention is to harass me so much that I will close my company.

My opposition to Mr wests application for small job on time same day plumber today, is because he has applied for this in bad faith to further his harassment of my company small job plumber ltd and myself.

Mr west thinks by adding on time and same day makes his application sufficiently different from mine. But it does not as I offer a same day services and am on time for my appointments as I aim to leave time slots to allow this

Mr west also applied for this trademark after opposing my application for my trademark small job plumber with house and tap as logo.

This shows pure bad faith in his application. As what he has opposed me doing he has applied for himself and I don’t think it is more possible to show such transparent bad faith and show his intention to continue to harass me

## **Final note**

Things to be noted about mr wests behaviour

He has not only copied my company identity he is doing it to other people

He has opened a company call my builder man that is a copy of an internet company called my builder who give work to mr west I have evidence of this

And also after going to a dance class hosted by west coast swing as he claims on his face book page. He decided to open a company called west coast jive and apply for the trademark to go with the company. I'm glad to say the trademark has been withdrawn

I'm sure it is clear to see what kind of man mr west is?"

4. Mr West filed a counterstatement in which he denies all the grounds of opposition. The content of the counterstatement appears in Mr West's evidence, summarised below.

5. Mr O'Connell and Mr West both filed evidence and written submissions. Neither chose to be heard or to file submissions in lieu of attendance at a hearing. I make this decision after a careful reading of all the papers filed.

## **Evidence**

6. Mr O'Connell's first witness statement is dated 7 February 2016. It is short. He states that Mr West first used the applied for trade mark in 2015 but then goes on to say that it has not been used. The remainder of the statement comprises a list of the attached exhibits, which are:

- CW1: a screenshot from the website 'companycheck.co.uk' showing that Mr O'Connell registered a company called SMALL JOB PLUMBER LTD on 13 November 2013.
- CW2: a screenshot from the website 'companycheck.co.uk' showing that Mr West was appointed director of the newly incorporated company called Small Job On Time Same Day Plumbers Limited, on 23 April 2014.
- CW3: a copy of Mr O'Connell's trade mark registration certificate for the following mark (registered in the name of his company, small job plumber ltd):

3079140



Class 37: Advice relating to preventing blockages in drains; Advisory services relating to the maintenance of plumbing; Pipeline construction and maintenance; Pipeline maintenance; Plumbing; Plumbing and gas and water installation; Plumbing and glazing services; Plumbing maintenance advisory services; Plumbing repair advisory services.

Filing date: 29 October 2014; completion of registration procedure: 11 December 2015.

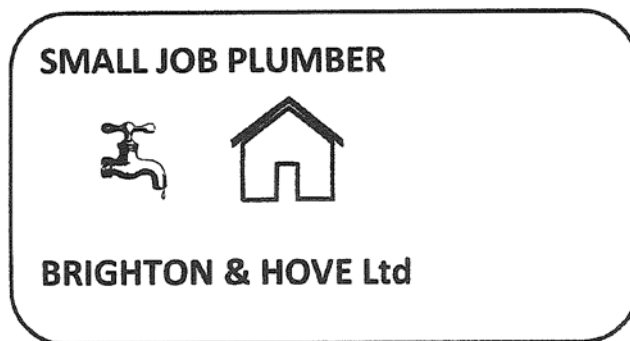
- CW4: This is a copy of part of Mr West's notice of opposition against Mr O'Connell's trade mark, shown above. Mr O'Connell has highlighted the following text in Mr West's statement of grounds:

“The trade mark is devoid of distinctive character because I own the company Small Job Plumber Brighton and Hove Ltd and the trade mark applied for would appear to the public to be that of my company”.

Mr O’Connell explains that he has included this exhibit because it shows Mr West stating that he “owns small job plumber Brighton and Hove with a house and a tap as his logo a copy of my trademark”. The second page of this exhibit, from Mr West’s notice of opposition shows the following logos:



Exhibit 2:



- CW5: This is a print from a website called Freeindex, which appears to be an online business directory. Mr O’Connell has highlighted the date of 10 June 2015. The entry is “Small Job On Time Same Day Plumbers”, with some text by Mr West describing the company as having been established in 2006 with nearly fourteen years of experience in the plumbing trade. Mr O’Connell states that Mr West’s company is less than two years old.
- CW6: This appears to be a screenshot from Mr West’s website. Mr O’Connell has underlined the sentence “Craig developed the original small job plumber”. Mr O’Connell states that this is Mr West claiming that he developed Mr O’Connell’s company, “small job plumber”.



- CW7: Mr O’Connell states that this exhibit shows Mr West deceiving consumers by claiming that his company has been a member of checktrade for seven years with 550 reviews, when the company is less than two years old. The exhibit comprises another screenshot from Mr West’s website. It appears to relate to Mr West having been a member of checktrade for seven years with over 550 reviews, as the rest of the page is written in the first person singular; e.g. “I book very little if any work in advance so have most of the day free for a SAME DAY SERVICE for small plumbing jobs!”
- CW8: Mr O’Connell states that this exhibit shows Mr West trying to make Mr O’Connell look like a criminal. This exhibit is a copy of Mr West’s counterstatement, with highlighted sections, such as:

“The Police have also issued him [Mr O’Connell] with a warning letter that he is not to contact me [Mr West] directly again, which would now constitute a criminal act.”

- CW9: Mr O’Connell describes this exhibit as “Mr wests own words showing he is not on time not same day not today he doesn’t turn up.” The exhibit is from Mr West’s counterstatement , with the following highlighted by Mr O’Connell:

“Currently I recommend around 40 jobs per month to other plumbers, a labour value of at least £4,000. I would be happy to recommend them to Brendan if he reverses his stance on this...”.

7. Mr O’Connell also filed written submissions at the same time as his witness statement. Some of the submissions contain factual statements. As these have not been filed via a witness statement, the factual statements cannot be taken into account. I will not summarise the submissions, but I have taken all of those which are not factual into account. I add here that some of the submissions relate to confusion between the marks, which is not a pleaded ground of opposition.

8. Mr West's witness statement is dated 27 February 2016. I give here a summary of the facts contained therein, but not the submissions, although I will, of course, bear them in mind.

9. Mr West states that his mark represents the final evolution of a business he started in 2004, trading as a SMALL JOB SPECIALIST, changing to ON TIME PLUMBER in 2007 and then to SMALL JOB ON TIME SAME DAY PLUMBERS in April 2014. He states:

"The name was chosen as it describes and reflects the nature of the services I provide and to distinguish myself distinctively from Brendan's company name."

10. ON TIME PLUMBER joined Checkatrade in 2008, and SMALL JOB ON TIME SAME DAY PLUMBERS in April 2014. Mr West states that the business was renamed in April 2014 to describe more accurately the nature of the services provided.

11. Regarding Mr O'Connell's claims of harassment, Mr West states that the complaints to the police were not upheld, whereas his were and a warning letter issued preventing direct contact. An email from Sussex Police is exhibited at TM02, in which the officer confirms that passing off (which was Mr O'Connell's complaint) is a civil rather than a criminal matter.

12. The remainder of the exhibits are copies of exchanges (emails, notes etc) between the parties of a personal nature; advice received from a trade mark attorney; a copy of submissions which were filed in the previous proceedings; a letter from Mr West's solicitors to Mr O'Connell; and an email to Mr West from the Information Centre at the Intellectual Property Office. It is unnecessary to give details of this evidence as it does not have a bearing on the matters before me. Exhibit TM10 is a copy of two pages from the Hearing Officer's decision in the previous proceedings. I will say more about this decision below.

13. Mr O'Connell filed a second witness statement in reply, dated 8 May 2016. Exhibit 1 comprises the first page of Mr West's witness statement which Mr O'Connell states contain lies, in that Mr West claims to have been trading as a small job specialist since 2004, and wants to use Mr O'Connell's trade mark identity by using the URL 'small job plumber Brighton and Hove'. Exhibit 2 is a screenshot from the companycheck website, showing the dates of incorporation of various companies of which Mr West is a director. One is called The Small Job Specialist Limited, with a date of appointment of 26 May 2015. Mr O'Connell states that this shows Mr West opened 'the small job specialist' in 2015, not 2004, which means he is lying in his witness statement. Exhibit 3 is another screenshot from the same website which shows a company called Small Job On Time Same Day Plumbers Limited was not opened until 2014.

14. Mr O'Connell states that Exhibit 4 shows Mr West lying to consumers via his website, claiming that Small Job On Time Same Day Plumbers Limited was established in 2004. Mr O'Connell states that Exhibit 5, from Mr West's website, shows that he is claiming to be the original small job plumber in Brighton and Hove since 2004, and that this is Mr O'Connell's company and trade mark identity. Exhibit 6 shows information from Companies House's website about Mr West, revealing that his registered companies date from 2010. Exhibit 7 is not really relevant: it consists of Mr O'Connell's opinion about Mr West and the fact that Mr West does not turn up on time on the same day.

15. It is useful to place these proceedings in the context of the previous proceedings, which concerned Mr West's opposition to Mr O'Connell's application to register the mark shown in paragraph 6, number 3079140:



16. The grounds of opposition in that case were the same as for the present proceedings, with the exception that there was no section 3(1)(a) pleading. The Hearing Officer's decision, BL O/490/15, was issued on 20 October 2015, after Mr O'Connell had filed his opposition against Mr West's mark. Although I am not bound by the earlier decision and its persuasive value is also limited, in which Mr West's opposition failed, I have noted that the pleadings were similar to those in this case. I therefore find it useful, and hope it will be useful to the parties, to touch upon what the Hearing Officer said in that case, when assessing the grounds before me.

## Decision

### ***Section 3(1)(a): trade marks which do not satisfy the requirements of section 1(1)***

17. Section 1(1) of the Act states:

“1.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

18. Strictly speaking, there is no need for me to decide whether this ground succeeds or fails. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*<sup>1</sup>, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b), (c) and (d) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under section 3(1)(b),(c) or (d) succeed, the outcome under section 3(1)(a) becomes moot. However, for the sake of completeness, I set out here, briefly, why the ground fails, regardless of the grounds under section 3(1)(b), (c) and (d) of the Act.

---

<sup>1</sup> [1997] RPC 168.

19. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*,

paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

20. Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. The mark is not incapable of distinguishing any goods and services. It follows from this authority that the ground of opposition under section 3(1)(a) must fail. Furthermore, Mr O'Connell has pleaded this ground as being one of confusion (which falls under section 5 of the Act). Section 3(1) of the Act is an 'absolute' ground of refusal, concerned with the very nature of a mark, regardless of the marks of third parties. It is not about whether one mark is in conflict with another.

**21. The ground under section 3(1)(a) fails.**

***Section 3(1)(b): trade marks which are devoid of any distinctive character***

22. Section 3(1)(b) states:

**"3.— (1)** The following shall not be registered –

(a) .....

(b) trade marks which are devoid of any distinctive character,

(c) ....

(d) .....

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.”

23. 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 s.3(1)(b) of the Act) were conveniently summarised by the 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).”

24. Mr O’Connell’s pleaded case is:

“I also oppose this trademark, as it has no distinctive character it has had minimal use and sounds the same as my trademark it has not been in use and is not distinctive in any way and it is just a camouflaged version of my trademark that has been in use nearly 2 years.”

25. Again, Mr O’Connell’s pleading relates more to confusion with his mark, rather than the intrinsic qualities of Mr West’s mark. If Mr West’s mark solely consisted of SMALL JOB PLUMBER (which are the co-incidental words in Mr O’Connell’s mark), then I would agree that the mark would not be distinctive because it would not distinguish the services from those of other undertakings. However, there is more to the mark than just these words. There are other words which, although non-distinctive in themselves, are arranged around a circle. With the digits and the position of the tick, the whole is arranged to resemble a clock face. The combination of all of the elements is sufficient to give the mark enough distinctive character so that the average consumer will perceive, without further thought, that the mark denotes the services of a single undertaking. It is, therefore, able to distinguish Mr West’s services.

**26. The ground under section 3(1)(b) fails.**

**27. Sections 3(1)(c) and (d) of the Act**

28. Sections 3(1)(c) and (d) state:



“3.— (1) The following shall not be registered –

(a) .....

(b) ....

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(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 practice 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.”

29. Just as in the earlier decision, referred to above, these grounds are bound to fail because Mr West’s trade mark does not consist exclusively of the characteristics referred to in the wording of the Act which I have set out in the previous paragraph. The mark as a whole is not comprised of descriptive elements, and the arrangement of the clock face is not descriptive of the services or a characteristic of the services. This means that the section 3(1)(c) ground fails. Likewise, the section 3(1)(d) objection must fail because of the presence of the clock (meaning that the mark does not consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade); furthermore, there is no evidence to show that the mark as a whole has become customary in the current language or in the *bona fide* and established practice of the trade.

### **30. The grounds under sections 3(1)(c) and (d) fail.**

#### **Section 3(6): bad faith**

31. Section 3(6) of the Act states that:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

32. In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch) (“Sun Mark”) Arnold J summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

130 A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131 First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133 Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of

probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207–2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134 Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004 ) at [8].

135 Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see Cipriani at [185].

136 Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137 Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT*

*WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138 Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

33. Whether the matter must be assessed at a particular point in time. As stated in the *Sun Mark* case, the relevant date is the date on which the application was made to register the trade mark, which in this case is 11 May 2015.

34. It is useful to record here the Hearing Officer's final remarks from the previous decision, which were *obita dicta*, and which were made after the parties indicated, at the hearing, that the observations would be helpful (footnote omitted):

"27. The principle of trade mark registration is that the mark is registered for its totality. Subject to what I will come on to say, a registrant has no exclusive right or monopoly in relation to individual components of a trade mark. The absolute right (to prevent use by others) is of the mark as a whole in relation to the same or similar goods and/or services.

28. Beyond that, a registrant may be entitled to prevent the use of similar trade marks for the same or similar goods and services. However, the capacity to do so is a multi-factorial assessment based on whether the average consumer is likely to confuse the respective marks. To illustrate the point, I think it highly unlikely that the use of the mark shown at paragraph 21 [Mr West's mark] above would give rise to a likelihood of confusion with the applicant's mark [Mr O'Connell's mark]. This is because the average consumer would not see the common use of the words SMALL JOB PLUMBER within the marks as something which was indicating trade origin. Of course, if another mark was more similar to the applicant's mark as a whole then that may be a different matter - each case must be considered on its own merits."

35. The hearing officer was talking about the same two marks in the earlier decision. His view was that they would not give rise to a likelihood of confusion with each other. I agree with him. I also agree that the words SMALL JOB PLUMBER are completely descriptive of the services. These are the only words in Mr West's application which coincide with Mr O'Connell's earlier mark. There is no monopoly in these words by themselves. Mr West's mark also looks completely different to Mr O'Connell's house and tap mark. If the only coincidental element is a descriptive

one in relation to the services for which the application has been made, and the mark as a whole is entirely dissimilar to the earlier mark, it follows that the application was not made in bad faith. Neither is there any protection per se for the concept of operating a business of plumbing services for small jobs. Even if the evidence showed that Mr O'Connell was the first to do so and even if this inspired Mr West, the application to register a mark which does not confuse the public and one where the only co-incidence is in descriptive language cannot be an act of bad faith.

**36. The ground under section 3(6) fails.**

**Outcome**

**37. The opposition fails.**

**Costs**

38. The opposition having failed, Mr West is entitled to a contribution to his costs of defending his trade mark application. Bearing in mind that Mr West has not been legally represented and so would not have incurred legal fees, I award the following costs:

Considering the opposition and preparing a counterstatement	£100
Filing and considering evidence -	£250
<b>Total</b>	<b>£350</b>

39. I therefore order Brendan O'Connell to pay Craig George West the sum of £350. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26<sup>th</sup> day of September 2016**

**Judi Pike  
For the Registrar,  
The Comptroller-General**