

**O-490-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3079140  
BY SMALL JOB PLUMBER LTD  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 37:**




**AND**

**OPPOSITION THERETO (NO. 403650) BY  
MR CRAIG WEST**

## **Background and pleadings**



1. This dispute concerns whether  should be registered as a trade mark. It was filed by Small Job Plumber Ltd (“the applicant”) on 29 October 2014 and was published for opposition purposes on 21 November 2014. Registration is sought for the following services in 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.

2. Mr Craig West (“the opponent”) opposes the registration under sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”), and, also, on a ground under section 3(6). I will detail the pleadings under the various section 3(1) grounds later. In relation to section 3(6), which constitutes an allegation of bad faith, the basis of the opponent’s claim is that the application was filed:

“...not seeking to create something unique and distinctive but to use a trade mark in furtherance of his battle with me .... to prevent me from using the descriptive term ”small job plumber”. It is a way of monopolising the descriptive term in the course of a bona fide and established service rather than a way of distinguishing one undertaking from other undertakings.”

3. The applicant filed a counterstatement denying the opposition. The main protagonist on the applicant’s part is its managing director, Mr Brendon O’Connell. He provides a lot of information regarding the respective parties’ businesses. I will touch on this later, to the degree necessary. Both sides have represented themselves. The opponent filed written submissions, the applicant then filed evidence and written submissions, the opponent then filed evidence in reply. The opponent requested a hearing. A hearing was subsequently arranged which took place before me on 9 October 2015. The opponent (Mr West) represented himself. Mr O’Connell attended on behalf of the applicant.

## **Section 3(1)(b) of the Act**

4. Section 3(1)(b) of the Act prevents registration of trade marks which are “...devoid of any distinctive character”. It is equivalent to article 7(1)(b) of the CTM Regulation, the principles of which 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). 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)."

5. The opponent's pleaded case reads:

"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. The use of the web address does not prevent the fact that the average consumer perceives a mark as a whole and does not analyse its various components. The consumer would believe that the mark is that of my company Small Job Plumber Brighton and Hove Ltd. The mark is merely a textual reference to a trader with common place designs in the industry, as well as a geographical area. It has no distinctive character, particularly if I were to use my company name of Small Job Plumber Brighton and Hove as the text."

6. On face value, it could be said that the pleading is misconceived because it refers to the mark being incapable of distinguishing the applicant's services from those of the opponent. The reason this could be a misconceived objection is because section 3(1)(b) is an "absolute ground" for refusal. In other words, there is a problem with the inherent or intrinsic nature of the mark, which, applied to section 3(1)(b), means that the mark is devoid of any distinctive character and, thus, cannot do the job of distinguishing the services of one trader from any other trader. The ground of refusal is not about conflict with other marks or business names. However, it was clear from the discussion at the hearing that the ground was pleaded because SMALL JOB PLUMBER is a descriptive phrase and, therefore, its presence in the mark meant that it would not be capable of functioning as a badge of trade origin.

7. The applicant does not agree that the words SMALL JOB PLUMBER are descriptive. It is also clear from the applicant's evidence that the mark it has filed is its business logo which it has been using for some time (and before the opponent adopted a similar name).

8. I will begin by making one thing clear. The words SMALL JOB PLUMBER constitute a wholly descriptive phrase. The words, by themselves, would not distinguish one trader's services from those of others. This is because those words send an extremely clear and unambiguous message that the services in question are provided by a plumber who specialises in dealing with small jobs. Evidence has been filed to support the point including: i) a letter from the IPO stating that the term is descriptive (although this alone is not persuasive), ii) indications that other businesses use the term or similar terms (e.g. a company name registration (06474661) for the words SMALL JOBS PLUMBER; a business name being used by "Mr Small Job Plumbing"; a trade mark registration (3053345) for "SMALL FIX "small jobs are important too""; a business name on the website of Checkatrade called Small Job Company; and the listing of a business called smallJobsMan.co.uk on a trading standards website. Indeed, Mr O'Connell accepted at the hearing that terms such as "small job friendly" were being used.

9. If the mark had been for the words SMALL JOB PLUMBER alone I would have had little hesitation in upholding the opposition. However, the mark is not for those words alone. The mark consists of the following composite logo:



10. The mark is comprised of a number of elements: i) the words SMALL JOB PLUMBER incorporated into a domain name, ii) the geographical words "BRIGHTON & HOVE AND SURROUNDING AREAS", iii) some telephone numbers and, iv) a figurative element of the outline of a house, the outline evoking images of a pipe leading to a tap with a drop of water coming from it. Even if all of the elements lacked distinctiveness individually, it does not follow that the mark as a whole lacks distinctiveness - the individual elements may create a whole which is greater than

the sum of its parts. However, the applicant's position is somewhat better than this because the figurative element does not seem to obviously lack distinctiveness. The opponent referred in its pleading to "common place designs", but there is no evidence that the figurative element is common place. Whilst the figurative element is clearly suggestive/allusive, the way in which it blends together creates, in my view, a distinctive totality. I asked Mr West at the hearing what his view was on the mark as a whole. He accepted that, as a whole, the mark may be distinctive but stressed the "false monopoly" point mentioned earlier.

11. Based on the above response, together with my own views on the mark, I come to the view that, as a whole, the mark is not devoid of any distinctive character. It is a mark that will be perceived by the relevant public as a badge of trade origin belonging to a particular undertaking. It will serve to distinguish the applicant's services from those of others. **The ground under section 3(1)(b) is dismissed.**

### **Other section 3(1) grounds of opposition**

12. Sections 3(1)(c) and (d) prohibit registration of trade marks which consist "exclusively [my emphasis] of signs or indications" which, respectively:

"..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"

or

"which have become customary in the current language or in the *bona fide* and established practices of the trade."

13. The presence of the figurative element, an element which comprises a significant part of the mark, prevents the opponent from succeeding on these grounds. Whilst figurative elements can be descriptive, the figurative element is not something likely to be used as a simple descriptor and would not be caught by the need to keep free. Thus, even without going into whether the other elements are descriptive, the mark as a whole cannot be said to consist exclusively of descriptive elements. The position is even starker for the "customary" objection under section 3(1)(d). There is no evidence to show that the figurative element is "customary in the current language or in the *bona fide* and established practices of the trade". This is re-enforced by Mr West's acceptance that, as a whole, the mark may be distinctive. **Although shortly stated, the grounds under sections 3(1)(c) and (d) are dismissed.**

### **Section 3(6) of the Act**

#### **Legislation and leading case-law**

14. 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."

15. 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).”

16. Whether the trade mark was applied for in bad faith must be assessed at a particular point in time. As stated in the *Sun Mark* case, the relevant date is the application date of the application to register the trade mark. The relevant date is 29 October 2014.

## The claims/counterclaims

17. The following comes from the opponent's statement of case. The opponent claims that the applicant:

"...is not seeking to create something unique and distinctive but to use a trade mark in furtherance of his battle with me .... to prevent me from using the descriptive term "small job plumber". It is a way of monopolising the descriptive term in the course of a bona fide and established service rather than a way of distinguishing one undertaking from other undertakings."

18. The opponent goes on to claim that:

- i) If granted the trade mark, the applicant would believe that he has monopolised the descriptive term SMALL JOB PLUMBER rather than the mark as a whole.
- ii) The applicant would continue to complain to official bodies that the opponent is breaching the applicant's trade mark.
- iii) The opponent owns a number of companies that contain the term small job plumber and that there are many small job plumbers not just in Brighton & Hove, but nationwide.
- iv) The opponent has been trading longer and continuously as a small job plumber and could claim an unregistered mark if it was possible to register the term.
- v) The applicant worked for the opponent in the summer of 2013. Relations broke down and the applicant set up Small Job Plumber Ltd.
- vi) Tensions have arisen because the applicant feels that by having its company name (Small Job Plumber Ltd) it created and owns the service [of small job plumbing].
- vii) The opponent does not call himself "Small Job Plumber Ltd" but simply says "I am **A** small job plumber" [the opponent's emphasis].
- viii) Registration of the mark will give the applicant "false ammunition" to harass the opponent and others.

19. Attached to the opponent's statement of case are a number of logos headed "MY LOGOS". They all contain the words SMALL JOB PLUMBER BRIGHTON & HOVE LTD together with pictures of taps and/or outlines of a house.

20. The applicant's counterstatement contains a lot of information. The most relevant pieces of information are that:

- i) The applicant started the company Small Job Plumber Ltd on 13 November 2013 and the logo was used two weeks later (on You Tube).
- ii) The opponent's company (I assume using the logos described above) was not started until 11 months later and, therefore, the opponent copied the applicant.
- iii) The opponent's previous company was called On Time Plumber Ltd. The opponent was happy with that identity until the applicant opened its business.



- iv) An attached web print shows use of the name ONTIMEPLUMBER.CO.UK with the following words alongside: “SMALL JOB ON TIME SAME DAY PLUMBERS LTD”, which, if I understand the applicant correctly, is a later incarnation of the opponent’s company.

### **The evidence/submission**

21. Largely speaking, both sides’ evidence/submissions merely repeat/re-enforce what was said in the original claims (as set out above). In terms of the opponent, there is nothing I need to additionally highlight. In terms of the applicant, Mr O’Connell confirms that he has been trading since the end of 2013. It is clear that the logo is used on all of his business material. He states that the mark was filed as it was “his idea” and that the mark was filed to protect his business identity from being copied by Mr West. He also highlights that the opponent applied to register the following trade mark on 11 May 2015:



22. The above mark has been opposed by Mr O’Connell, albeit there is no opposition to the above mark on the basis that it will be confused with the applicant’s mark.

### **Was the application filed in bad faith?**

23. As I have already stated, bad faith is a serious allegation. What is clear from the evidence provided is that the applicant has been using the logo the subject of the application for some time. An application for a distinctive trade mark by a company that it has already been using would, I would say, rarely give rise to a finding of bad faith.

24. In terms of the “tension” between the two parties, it is clear that the applicant was upset by the opponent changing his business identity to something which the applicant considered to conflict with its business identity. The opponent, of course, sees nothing wrong in this as the primary point of similarity resides in a descriptive term. This is what led to the application for the trade mark. The application was filed with a desire to protect the applicant’s existing business identity.

25. I accept that the applicant may have certain misconceptions as to the extent of the rights that the trade mark provides. However, had the primary purpose of the application been to unfairly monopolise the term then one would have expected the application to be for the words SMALL JOB PLUMBER alone. One is left with the

fact that what has been filed is the logo version of the mark, a mark which is inherently distinctive as a whole, a mark which has been used by the applicant prior to the date of filing. Although there are examples in the evidence of Mr O'Connell replying to Mr West in correspondence using intemperate language, this does not mean that the application itself was filed other than to protect the interests of the applicant. The filing of the mark as a whole does not, in my view, amount to an act of bad faith. Indeed, the circumstances are likely to be regarded as a prudent form of conduct with the aim of protecting the business' interests. **The opposition under section 3(6) of the Act is dismissed.**

### **Disclaimers**

26. At various times the opponent has asked for a disclaimer to be entered in the register requiring the applicant to disclaim the exclusive right to the use of the words SMALL JOB PLUMBER. It is not within the power of the tribunal to make such a direction. Since the Act was introduced in 1994, disclaimers constitute voluntary additions that an applicant may enter in relation to an application.

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 above would give rise to a likelihood of confusion with the applicant'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<sup>1</sup>. 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.

29. The other reason a disclaimer is not needed is because there are further safeguards to protect honest traders who are simply using descriptive terminology. As the applicant pointed out in submissions, section 11(2)(b) indicates that a trade mark is not infringed<sup>2</sup> by:

“the use of indications concerning 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”.

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<sup>1</sup> This is a purely *obiter* observation that will not bind either party. I have made the observation in order to assist the parties, both of whom are unrepresented, and both of who indicated at the hearing that such an observation would be helpful.

<sup>2</sup> This provision relates only to descriptive use in the course of trade, not to applications to register trade marks.

30. In summary, therefore, I cannot direct that a disclaimer be entered. If the applicant considers it prudent to clear up the matter then a disclaimer can be duly entered at its request.

### **Costs**

31. The opposition has failed on all of the grounds pleaded. The applicant has, therefore, been the successful party and is entitled to a contribution towards its costs. In making my assessment I have borne in mind that the applicant was not legally represented so would not have incurred any legal fees. The opponent may feel aggrieved in having to pay costs because the opposition was lodged, from his perspective, to ensure that the applicant does not have “false ammunition” to use against him. This may be so, but the applicant has had to engage in the opposition proceedings to defend its application and it remains the case that it has been successful on all grounds. I award the applicant the sum of £450 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

*Preparing a statement and considering the other side’s statement - £100*

*Filing and considering evidence - £250*

*Attending the hearing - £100*

***Total - £450***

32. I therefore order Mr Craig West to pay Small Job Plumber Ltd the sum of £450. 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 21st day of October 2015**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**