

**O-013-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3058295  
BY PAUL GEORGE HARROD TO REGISTER THE TRADE MARK**

**PGH**

**IN CLASS 37**

**AND IN THE MATTER OF OPPOSITION  
THERETO UNDER NO 402994  
BY PETER GRAEME HIGGS**

**AND**

**IN THE MATTER OF APPLICATION NOS 3059803 AND 3059792 RESPECTIVELY  
BY PETER GRAEME HIGGS TO REGISTER THE TRADE MARK**

**PGH**  
Pest Control & Prevention

**AND**

**PGH**

**IN CLASSES 37 AND 40**




**AND IN THE MATTER OF OPPOSITIONS  
THERETO UNDER NOS 403470 AND 403490  
BY PAUL GEORGE HARROD**

## Background and pleadings

1) Terry Spreadbury applied to register the trade mark 3058295 in the UK on 4 June 2014. The application was subsequently assigned to Paul George Harrod with an effective date of 4 June 2014. It was accepted and published in the Trade Marks Journal on 4 July 2014 in respect of the following services:

*Control of pests; Control of vermin; Extermination of pests; Exterminating (Vermin- ) services; Fumigation of buildings against pests; Fumigation services; Fumigation of buildings against vermin activity; Fumigation of commodities against pests; Fumigation of commodities against vermin activity; Pest control; Pest control for the prevention of insect infestation; Pest control relating to birds; Pest control relating to buildings; Pest control services; Pest eradication and extermination services; Proofing of buildings against pest and vermin access; Proofing of land against pest and vermin access; Proofing of premises against pest and vermin access; Proofing of structures against pest and vermin access; Removal and relocation of insect hives; Treatment of surfaces with pest control formulations; Vermin control services; Vermin eradication and extermination services; information, advisory and consultancy services relating to all the aforesaid services.*

2) Peter Graeme Higgs opposes the application in respect of all the services listed on the basis of Section 5(4)(a) and Section 3(6) of the Trade Marks Act 1994 (the Act). Mr Higgs claims that the application offends under Section 5(4)(a) of the Act because he has goodwill identified by the following signs:

<b>Sign relied upon</b>	<b>Date of first use</b>	<b>Where</b>
PGH Environmental	2014	South East and London
	2010	London and South East England
PGH Pest Control & Prevention	2009	South East and London, Surrey and Sussex
P.G.H. Pest Control & Prevention	2009	South East and London, Surrey and Sussex
PGH Pest Control Services	2008	Surrey and Sussex
PGH Pest and Vermin Control	2008	Surrey and Sussex
P.G.H. Pest Control & Vermin Services	2008	Surrey and Sussex
P.G.H.	2008	Surrey and Sussex
	2008	Surrey and Sussex
	2008	Surrey and Sussex
PGH	2008	Surrey and Sussex
PGH Pest Control and Country	2008	Surrey and Sussex

Services		
----------	--	--

3) He claims that the above signs have been used in respect of the following list of services:

**Class 37**  
**Control of pests; control of vermin; Extermination of pests; exterminating vermin services; fumigation of buildings against pests; fumigation services; fumigation of buildings against vermin activity; fumigation of commodities against pests; fumigation of commodities against vermin activity. Pest control; pest control for the prevention of insect infestation; Pest control relating to birds; pest control relating to buildings; pest control services; pest eradication and extermination services. Proofing of buildings against pest and vermin access. Proofing of land against pest and vermin access; proofing of premises against pest and vermin access; proofing of structures against pest and vermin access; removal and relocation of insect hives; treatment of surfaces with pest control formulations; vermin control services; vermin eradication and extermination services, information, advisory and consultancy services relating to all the aforesaid services.**

4) Mr Higgs claims that since first using the initials PGH in 2008/9, he has spent a lot of time and money building up a considerable client base throughout Surrey and Sussex and now has a considerable online presence. He claims to have used PGH as a prefix for several business names and now uses the sign “PGH Pest Control and Prevention”.

5) Mr Higgs claims the application offends under Section 3(6) of the Act because he believes that Mr Spreadbury was aware of his use and reputation of the name PGH. Mr Higgs claims that he has conducted a search of the trade mark register and found a number of marks in the name of Mr Spreadbury that he knows have been used for many years by other pest control businesses. He surmises that Mr Spreadbury has done this because he uses “generic phrases such as ‘The Rat Man’ [...] and he is not happy that some other businesses in the sector have been using that phrase on their vans and advertising”. It is therefore claimed that Mr Spreadbury’s actions are a “tit for tat”. It is claimed that Mr Spreadbury’s behaviour falls below the acceptable standards of commercial behaviour. Further, Mr Higgs states that, during the opposition period, Mr Spreadbury transferred the application to a Mr Paul George Harrod, a person who does not exist and is an attempt, by Mr Spreadbury, to make the application appear genuine and to conceal the fact that it was applied for in bad faith.

6) Mr Harrod filed a counterstatement denying the claims made and stating that he has made use of a PGH mark for more than 25 years and such use includes use in respect of pest control services. It is explained that Mr Spreadbury “arranged for the filling of the mark and subsequent and simultaneous transfer of rights to [Mr Harrod]” and it can be shown that Mr Harrod is the earlier rights holder.

7) Mr Harrod subsequently commenced opposition proceedings against Mr Higgs’ applications 3059803 and 3059792 that were both applied for on 13 June 2014. These oppositions are both based upon the same grounds namely:

- In the case of application 3059803, it offends under Section 5(2)(b) of the Act because it consists of a mark where the PGH is the dominant element or, in the case of application 3059792, it offends under Section 5(1) and Section 5(2)(a) of the Act because it is in respect of an identical mark to Mr Harrod's mark. Further, it is claimed that the respective goods/services are identical or closely related. Mr Harrod relies on his application 3058295 as the earlier mark;
- The application offends under Section 5(4)(a) because he and other family members have goodwill in respect of pest control services identified by the mark PGH in the South East of England, Sussex and Surrey since 1 January 1987.

8) Mr Higgs filed counterstatements in both oppositions, denying the claims and also claiming that he has used his "word-only" version on the mark since 2008 and the word and device mark ("the pin mark") since 2010.

9) All three sets of proceedings were subsequently consolidated and both sides filed evidence and Mr Harrod also provided written submissions. I will not summarise the submissions, but I will keep them in mind.

10) Mr Harrod is represented in these proceedings by ip21 Limited and Mr Higgs is represented by Barlow Robbins Solicitors.

11) No hearing was requested and so this decision is taken following careful consideration of the papers.

### **Mr Harrod's evidence**

12) This consists of a witness statement by Mr Harrod. He states that he provides a variety of building related services including leadwork and related pest control services under the marks "PGH", "P.G.H." and "Paul George Harrod" for more than thirty years.

13) At Exhibit PH1, Mr Harrod provides a witness statement by Melanie Jane Harvey of ip21 Limited, Mr Harrod's representative in these proceedings. At Ms Harvey's Exhibit MH1 is a "to whom it may concern" letter from Mr Harrod explaining that the application was originally made by a Mr Spreadbury who also trades under the name of PGH Pest Control, but "passed the application on to" Mr Harrod "as he thought the initials PGH better represented [his] name". Mr Harrod states that, for the last 26 years, Mr Spreadbury has only ever known him as Paul George Harrod, as do many others. He explains that his father, George Harrod, was in the business of plumbing and leadwork for over 40 years and Mr Harrod worked with his father for more than 27 years. He states that even his brother calls him Paul George.

14) In the letter, Mr Harrod also explains that Mr Spreadbury used Mr Harrod's brother's address when applying for the mark and that his brother also trades under the name *PGH Pest Control - Pestus Gogga Hortus* that is already registered. Mr Harrod and his brother "have tried to keep the initials PGH in the family".

15) Mr Harrod explains further in the letter that Mr Spreadbury is PGH Pest Control in Sussex, Kent, Hampshire and Surrey and works closely with Mr Harrod's brother. Mr Harrod is also aware of another trader using PGH, but this trader has no issues with the other parties using the mark and Mr Harrod has no issues with this other trader. Mr Harrod states he had no knowledge of Mr Higgs or his business before these proceedings commenced. In his witness statement, Mr Harrod confirms much of the content of his letter.

16) Mr Harrod states that he provides a number of pest control services continuously under the contested marks. He refers to further exhibits to Ms Harvey's witness statement. Exhibit MH3 is an invoice dated 4 August 2002 from "P.G.H. Paul & George Harrod Plumbing – Pest Control, Leadwork contractor" in respect of the repair of lead flashing. Exhibit MH4 consists of a hand-written quote in respect of a replacement bath and new pipe work and dated 16 April 2003. This has the same printed indication of the issuer as in the invoice in the previous exhibit. Exhibit MH5 consists of an undated printed advert under the heading "Roofing". The complete content of the advert is:

P.G.H.

Lead Roofing  
Lead Flashing  
Est. 20 yrs

[mobile phone number]

17) Ms Harvey, in her witness statement, states that it was not the intention that Mr Terry Spreadbury would be the recorded proprietor, a fact he believed he had confirmed when issuing the filing instructions. When the error was identified an assignment was completed with an effective date of 4 June 2014, being the application date. Ms Harvey states that Mr Spreadbury is not a party to the proceedings.

### **Mr Higgs' evidence**

18) This takes the form of a witness statement by Mr Higgs (his "first witness statement"). He states that he is a sole trader using the name PGH and provides pest control services and has done so since about 2009. At Exhibit PGH1, Mr Higgs provides a further witness statement (his "second witness statement").

19) At Exhibit PGH2 of Mr Higgs' first witness statement he provides a copy of an invoice dated 13 December 2013 for the provision of the "1<sup>st</sup> treatment" relating to "flying & crawling insect control". The header of the invoice includes the mark "P.G.H. Pest Control & Prevention".

20) In his second witness statement, Mr Higgs states that since 2008, he has operated his pest control business widely throughout the South East of England and specifically Surrey, West and East Sussex, Hampshire, Berkshire, Kent and London.

21) Mr Higgs states that his reputation was enhanced in 2012 and 2013 when he was the recipient of The Prince's Trust National RBS and Samsung Enterprise Awards for London and the South East and then nationally. As a result of this, his business received very high media attention. Exhibit PGH1 to this second witness statement consists of a copy of a page from the publication *Pest Control News* from May 2013, noting this achievement. The Article reports Mr Higgs as saying that he decided he wanted to start his own pest control company in 2009 and that he has been supported by the Prince's Trust since 2010. It also states that having received a business loan from the Prince's Trust he set up his business, PGH Pest Control.

22) A number of business cards are shown at Exhibit PGH2 to the second witness statement showing both of Mr Higgs applied for marks. Although these are not dated, Mr Higgs states that he has used these cards since 2009 and that his "pin" mark has been used since 2010.

23) The remaining exhibits are from Mr Higgs' first witness statement. Two invoices to "PGH Pest Control" are provided at Exhibit PGH3, dated 22 July 2008 and 8 June 2010 respectively and relate to the purchase of rat and mouse boxes and a refund in respect of soft shell jackets. Two invoices issued by "P.G.H. Pest Control & Prevention" dated from 2010 are provided at Exhibit PGH4. The hand written details are not legible in the first, but it is in respect of work amounting to £553. The second relates to "2 inspections and treatment for the control of moles". Exhibit PGH5 consists of an invoice to Mr Higgs, dated 5 March 2010, relating to the production of his business cards. An illustration of the card is shown at the bottom of the invoice and includes the stylised version of the PGH mark shown as the second mark in the table in paragraph 2, above.

24) Exhibit PGH6 consists of a copy of an advertisement that appeared in the *Shere, Peaslake and Gomshall Parish Magazine* in March 2010. The advertisement has the mark "P.G.H. PEST CONTROL & PREVENTION" at the top and promotes its "friendly & local professional pest controller from EWHURST". Mr Higgs' name is given as the contact. Exhibit PGH7 consists of a copy of a page from the "Homes in Brief" section of the publication *Premier Magazine*. It contains a further advertisement for Mr Higgs' pest control services. It contains Mr Higg's pin mark and encourages readers to visit the website [www.pghpestcontrol.co.uk](http://www.pghpestcontrol.co.uk). It also states "covering southeast". No date is provided but Mr Higgs states it is an example of "recent use" and that the magazine is distributed to prestige addresses in Surrey and the SW3 area of London.

25) Mr Higgs has 1566 clients on his records and he provides turnover figures for his business as follows:

<b>Year ending March</b>	<b>Turnover</b>
2009	£4,012
2010	£9,124
2011	£32,923
2012	£74,460
2013	£98,555
2014	£124,381
2015 (up to 13 March)	£205,949

26) Currently Mr Higgs employs two technicians and utilises PGH branded vehicles.

27) Mr Higgs states that he was runner-up at a Young Entrepreneur award in 2011. Documentation relating to this is provided at Exhibit PGH9. Exhibit PGH10 is a photocopy of the front page of the *Surrey Advertiser*, dated 5 April 2013. The lead article reports that Mr Higgs had “scoped” a Prince’s Trust Award, namely the RBS Enterprise Award. It also commented that his business was identified as “PGH Pest Control and Prevention”.

28) Exhibit PGH11 consists of a copy of an article written by Mr Higgs that appeared in the January-March 2013 edition of *Premier Magazine*. The article is about pests in the home and promotes PGH Pest Control & Prevention.

## DECISION

29) I will begin by considering the respective parties’ grounds based upon Section 5(4)(a) and their respective claims of passing off.

30) The relevant part of the Act reads:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

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

31) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

32) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(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 confusion or 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.”

33) The following was stated in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

#### The relevant dates

34) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better

interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

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.

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

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

35) Therefore, the relevant date for the purposes of Mr Higgs' opposition is the filing date of Mr Harrod's application, namely 4 June 2014. However, Mr Harrod claims that he has been providing services under his mark since 1 January 1987.

36) Mr Higgs' two applications were both filed on 14 June 2014. This is the date that is the relevant date in both these proceedings. There is also a counterclaim from Mr Higgs that he has used his word only mark since 2008 and his pin mark since 2010.

The respective parties' claim to goodwill

37) Having identified the relevant dates in the different proceedings, next I will consider Mr Higgs' claim of goodwill.

38) Mr Higgs has provided evidence that illustrates that he has provided pest control services and he has provided annual turnover figures that, in 2013 (the last full year before the relevant dates of all the proceedings in June 2014), had risen to nearly £100,000. He also discloses that his business has had a total of over 1,500 clients.

39) Further, Mr Higgs provides an example of advertisements that he placed in local press in March 2010 and this features the mark P.G.H. PEST CONTROL & PREVENTION, one of the marks he relies upon for the purposes of these grounds. The same mark appears in association with a local magazine article written by Mr Higgs and appeared in the January – March 2013 edition of the magazine.

40) There is also third party recognition of Mr Higgs' business, notably, an enterprise award from the Prince's Trust. This received coverage on the front page of the local newspaper, the *Surrey Advertiser* in April 2013 and in the trade publication, *Press Control News*, the following month.

41) Taking all of this together, I conclude that, at the relevant date, Mr Higgs' business had built up goodwill in Surrey and Sussex in respect of various pest control services, with the earliest use shown being July 2008 (a trade invoice to "PGH Pest Control" provided at Exhibit PGH3). This goodwill is shown as being identified by, at least, the following marks:

1) P.G.H. Pest Control & Prevention

2)

**PGH**  
Pest Control & Prevention

42) Mr Harrod claims goodwill beginning in 1987, but he provides little evidence of this. In fact, the only corroborative evidence provided to support Mr Harrod's statement is an invoice dated 4 August 2004 and a hand-written quote dated 16 April 2003, where the issuer of both documents is recorded as "P.G.H. Paul & George Harrod Plumbing – Pest Control, Leadwork contractor". Despite "pest control" being mentioned in the issuer's name, neither of these documents are actually in respect of pest control services. The invoice relates to the repair of lead flashing, the quote to a replacement bath. These two documents are not sufficient to demonstrate that Mr Harrod has goodwill in respect of pest control services. The documents are dated some 10 years before the relevant dates and there is no evidence of more recent activities in the field of pest control.

43) Further, reference to use, by his brother, of the mark *PGH Pest Control – Pestus Gogga Hortus* is not relevant because his brother is not a party to the proceedings. There is nothing more other than unsubstantiated statements by Mr Harrod that he has undertaken pest control services. Whilst there is no reason to doubt such statements, there is no information regarding the scale of such use, how the

provision of such activity interacts with the provision of his brothers services, by what sign was such use identified, whether such use was/is promoted, just what proportion of pest control work is undertaken relative to, what is plainly Mr Harrod's main business in the field of lead roofing. Put simply the evidence is so sparse that I am unable to conclude that Mr Harrod has any goodwill in respect of pest control services. It is well established that goodwill must be of more than trivial nature (see *Hart v Relentless Records* [2002] EWHC 1984 (Ch) where 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.”

44) In light of this finding, Mr Harrod cannot rely upon a counterclaim to an earlier goodwill in respect of Mr Higgs' opposition to his mark insofar as it is based upon Section 5(4)(a) and further, his grounds based upon Section 5(4)(a) relied upon in his two oppositions to Mr Higgs' applications fail for lack of substantiation of the claimed goodwill.

*Mr Higgs' opposition: Misrepresentation and damage*

45) In paragraph 41, I have concluded that Mr Higgs has the requisite goodwill and I now consider whether use, by Mr Harrod, would result in misrepresentation of, and damage to Mr Higgs' business.

46) In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been

adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

47) From the evidence provided, it is apparent that Mr Higgs' goodwill is restricted to the area of Surrey and Sussex, however, this is the same area in which Mr Harrod operates his leadwork-related business. Therefore, it is reasonable that I infer that any future pest control business undertaken under the mark PGH by Mr Harrod will be in the same area, or that they will at least include this area. After all, Mr Harrod's trade mark application covers the whole of the UK. Therefore, normal and fair use of the mark would include use in Surrey and Sussex. Whilst the size of Mr Higgs' reputation and goodwill is not large, it is reasonable in size and has been consistently growing so that by the relevant date he was enjoying a turnover of over £125,000 a year and had had a total of over 1,500 customers. The law of passing off protects small businesses as well as large. The dividing line is between small but real businesses, and those with no, or only a trivial level, of relevant goodwill.

48) The services listed in Mr Harrod's application are all pest control services and, consequently, are either identical or highly similar to the services provided by Mr Higgs. Further, the mark applied for, being the plain letters “PGH” is the same as the distinctive element of Mr Higgs' marks (see paragraph 41, above). Therefore, there is a good deal of similarity overall between the respective marks. Further, the descriptive matter in Mr Higgs' marks describes both his own services and those listed in Mr Harrod's application.

49) Taking account of all of the above, I find that it is inevitable that Mr Higgs' customers and potential customers will be confused when confronted by Mr Harrod's mark being used in respect of the pest control services listed in his specification. This will have the effect of diverting customers away from Mr Higgs' business. Consequently, there will be misrepresentation and damage.

50) Therefore, Mr Higgs' opposition, insofar as it is based upon Section 5(4)(a), is successful in its entirety and Mr Harrod's application to register the mark “PGH” is refused. As Mr Higgs' grounds based upon Section 5(4)(a) has been determinative, it is not necessary for me to make a finding regarding his additional claim of bad faith brought under Section 3(6) of the Act.

51) As a consequence of this, Mr Harrod has no application that may subsequently (if registered) become an earlier mark for the purposes of his grounds based upon Section 5(1), Section 5(2)(a) and Section 5(2)(b) in his oppositions against both of Mr Higgs' applications. As I have already found that his grounds based upon Section 5(4)(a) also fails for want of the requisite goodwill (see paragraph 44, above), then both his oppositions fail in their entirety.

### **Summary**

52) Mr Higgs's opposition 402994 to Mr Harrod's application 3058295 to register the mark "PGH" is successful and Mr Harrod's application is refused.

53) Mr Harrod's oppositions 403470 and 403490 to Mr Higgs' two applications 3059803 and 3059792 both fail in their entirety and Mr Higgs' applications can proceed to registration.

### **COSTS**

54) Mr Higgs has been successful in respect of all three consolidated proceedings and is entitled to a contribution towards his costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that an interlocutory hearing was held on 9 December 2014 where Mr Higgs was required to amend his pleadings in respect of opposition 402994. It is appropriate that Mr Harrod has costs in his favour in respect of this. I also take account that both sides filed evidence and that no hearing took place. I award costs as follows:

Preparing statement and counterstatements & considering other side's statements	£900
Application fee (Opposition 402994)	£200
Reduction in respect of interlocutory hearing	(£200)
Evidence	£500
<b>Total:</b>	<b>£1300</b>

55) I order Paul George Harrod to pay Peter Graeme Higgs the sum of £1300 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 14<sup>TH</sup> day of January 2016**

**Mark Bryant**  
**For the Registrar,**