

**O-432-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 3230427**

**FOR THE TRADE MARK:**

**BCS APPROVED INSPECTORS**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 501866**

## **Background and pleadings**

1. On 11 May 2017, BCS Approved Inspectors Ltd and Building Control Surveyors Ltd (“the first proprietor” and “the second proprietor”, respectively; collectively “the proprietors”) applied to register the trade mark **BCS Approved Inspectors** under number 3230427 (“the contested mark”). It was registered on 25 August 2017 for the following services in classes 35 and 42:

Class 35: Administrative processing of purchase orders placed by telephone or computer; Administrative services relating to referrals for general building contractors; Advertisement for others on the Internet; Consultancy (Professional business -).

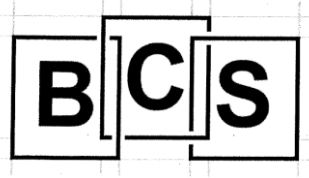
Class 42: Advisory services relating to architecture; Advisory services relating to building design; Advisory services relating to design engineering; Advisory services relating to energy efficiency; Advisory services relating to industrial design; Advisory services relating to planning applications.

2. On 7 November 2017, an application to invalidate the registration under s. 47 of the Trade Marks Act 1994 (“the Act”) was filed. The joint applicants are Building Control Services (Approved Inspectors) Limited and Building Control Services Ltd (“the first applicant” and “the second applicant”, respectively; collectively “the applicants”). The grounds, as amended, are based on ss. 3(6) and 5(4)(a) of the Act and the invalidity is directed against all of the services in the contested trade mark’s specification.

3. The applicants claim under s. 5(4)(a) of the Act that the sign shown below (“the BCS (AI) sign”) has been used throughout the UK since 26 March 2013:



4. They further claim under s. 5(4)(a) that the sign shown below (“the BCS sign”) has been used since 9 February 2005, though it is not entirely clear whether the claim is to use throughout the UK or in London and the Home counties:<sup>1</sup>



5. The applicants claim that:

- The first applicant has used the sign BCS APPROVED INSPECTORS since March 2013. This sign is based upon the sign BCS used by the second applicant since February 2005;
- further, or in the alternative, the first applicant has used the signs BCS APPROVED INSPECTORS and BCS since March 2013. These signs are based upon the sign BCS used by the second applicant since February 2005;
- further, or in the alternative, the second applicant has used the sign BCS since February 2005

6. Both signs are said to have been used for the following services:

Class 35: Administrative processing of purchase orders placed by telephone or computer administrative services relating to referrals for general building contractors; consultancy (professional business-).

Class 37: Advisory services relating to building construction; advisory services relating to the alteration of buildings; advisory services relating to the construction of buildings; advisory services relating to the maintenance of buildings; building construction advisory services; building consultancy; building consultancy services; information services relating to the construction of buildings; providing information relating to building construction.

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<sup>1</sup> TM26(l), section C, question 1 and paragraph 33B of the amended statement of grounds.

Class 42: Advisory services relating to architecture; advisory services relating to building design; advisory services relating to design engineering; advisory services relating to energy efficiency; advisory services relating to industrial design; advisory services relating to planning applications; building inspection services [surveying]; inspection of buildings [surveying]; professional consultancy relating to energy efficiency in buildings.

7. The applicants claim that they have acquired goodwill under the signs and that the use of the contested mark would result in deception or confusion for the relevant public. The applicants claim that there may, as a consequence, be an erosion of the distinctiveness of the earlier signs or a loss of control of the goodwill.

8. Under s. 3(6), the applicants claim that the proprietors were or ought to have been aware of the applicants' use of the signs. They claim that the applicants' use of the signs makes it unlikely that the proprietors were not aware of the applicants' use and that the failure to check whether the mark was in use was an act of bad faith. The applicants also claim that the proprietors attempted to deceive or confuse the relevant public by displaying the mark on their website and through the choice of website design and colour scheme, implying that the parties are connected. Further, the applicants claim that the proprietors filed the application in order "to gain from the Applicant's goodwill or prevent the Applicants from continuing to use and or register their mark".<sup>2</sup> The applicants also claim that the mark was filed without a bona fide intention to use it.

9. The proprietors filed a counterstatement, subsequently amended, in which they deny both of the grounds of invalidity and put the applicants to proof of their claims. They deny that the applicants have goodwill in the signs, and assert that the second applicant had, by the application date, relinquished any goodwill because it would not have used the mark for over three years. The proprietors further claim that the applicants' use of the sign does not predate the proprietors' own use. In applying for the trade mark, the proprietors were, it is claimed, acting in good faith, simply seeking legal protection for a

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<sup>2</sup> Statement of grounds, §28.

mark they have been using for many years. The allegation that the proprietors did not intend to use the mark is expressly denied.

10. Both parties filed evidence. Both also filed submissions during or subsequent to the evidence rounds, which I will take into account. Neither party requested a hearing; only the applicants filed written submissions in lieu. I will bear these in mind. The proprietors have been represented throughout by Baron Warren Redfern; the applicants are not professionally represented.

11. This decision is taken following a careful reading of all of the papers.

### **Procedural issues**

12. The proceedings were originally launched in the name of the first applicant only, with a request to add the second applicant being filed after service of the TM8 and counterstatement. The tribunal indicated to the parties that it considered it appropriate to allow the second applicant to be added, after which the proprietors filed an amended counterstatement. In that counterstatement, there are a number of comments regarding the status of the two companies, which are repeated and amplified in the submissions filed later. The proprietors' professional representatives did not, however, make a request to be heard on the matter of joining the second applicant. I therefore proceed on the basis that no challenge was made at the appropriate time to the registrar's provisional decision. I will, however, bear in mind the proprietors' submissions regarding the approach to be taken in the assessment of the applicants' respective rights.

### **Evidence**

13. I have read all of the evidence. I will summarise only the relevant material.

## Applicants' evidence

14. The bulk of the applicants' evidence is provided by Paul Cattell, in two witness statements. Mr Cattell describes himself as the Managing Director of the first applicant since 2013 and of the second applicant since 2005. I note that he describes the applicants as "my companies" and that it appears he was responsible for the creation of both. There are also witness statements from Janice Cope, tax advisor and accountant to the applicants, and Jason Cattell, a Director of the first applicant.

### *Use of the BCS sign*

15. Twenty-eight invoices dated between 5 May 2005 and 30 March 2013 are exhibited, though the amounts billed have been redacted.<sup>3</sup> Each of these shows the BCS sign at the top of the page. Services provided include building control services/advice, site inspections, DDA audits and reports, and condition survey reports. Despite redaction of some customer details, eight different customers are visible, all in London or Essex. Some of the invoices include work undertaken at a number of different addresses. These sites are also in London and Essex, as well as other locations such as Cambridge, Middlesex and Suffolk.

16. Financial information for the second applicant is provided.<sup>4</sup> Turnover is given as £100,340 for the year ending June 2006 and £80,461 in 2007. From 2008, only abbreviated accounts are provided. Debtors are as follows:

|      |         |      |         |      |         |
|------|---------|------|---------|------|---------|
| 2008 | £20,080 | 2010 | 10,591  | 2012 | £22,316 |
| 2009 | £6,427  | 2011 | £21,214 | 2013 | £29,936 |

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<sup>3</sup> PC1.

<sup>4</sup> PC9.

17. The BCS sign is shown on website prints, taken from the WayBackMachine archive, dated 28 February 2009.<sup>5</sup> The pages simply give the contact details for the second applicant. I note, however, that the copyright date is 2005.

18. I also note that the BCS sign appears on correspondence to the applicants' accountant and tax advisor from 2005 and 2013.<sup>6</sup>

19. There are, in addition, photographs of a vehicle advertisement which shows the BCS sign.<sup>7</sup> The second photograph indicates that the file date is 16 May 2017, though the narrative evidence is that the sign was placed on the vehicle in 2016.<sup>8</sup>

#### *Use of the BCS(AI) sign*

20. The applicants' evidence is that the first applicant was incorporated in 2013, on advice from the Construction Industry Council, following Paul Cattell's application to become a government-approved inspector.<sup>9</sup>

21. A number of letters to clients, most of which have corresponding invoices dated between November 2013 and May 2017, are exhibited, though the clients' details have been redacted.<sup>10</sup> The BCS (AI) sign is visible at the top of all of the documents and the first applicant is identified as the sender. The invoices are for "building control services" at locations in London, Hertfordshire, Cambridgeshire, Essex and Kent. The quotations indicate that the fee is for production and serving of the Initial Notice ("on the Local Authority to confirm our role as the Building Control Body"), plans assessment, site inspections, consultation with the Fire Authority and overseeing the project to issue of the Final Certificate. A range of construction and refurbishment projects are described in the documents.

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<sup>5</sup> PC6, pp. 4-5.

<sup>6</sup> Janice Cope and exhibits JC1 and JC2 thereto.

<sup>7</sup> PC4, pp. 14-15

<sup>8</sup> Paul Cattell 1, §2(d)(iii).

<sup>9</sup> Paul Cattell 1, §11.

<sup>10</sup> Exhibit PC8

22. Thirty-one “Initial Notices” are provided, dated between 26 March 2013 and April 2017.<sup>11</sup> The BCS (AI) sign is shown at the top of the page, and the first applicant’s name appears in the body of the documents along with the abbreviated form “BCS (Approved Inspectors) Ltd”. All are addressed to Local Authorities in London, Essex and Hertfordshire, for works at different addresses in those areas. It is said that copies of these Notices are usually also sent to clients.<sup>12</sup> Various works are listed, including construction of residential buildings as well as extensions, structural and internal alterations, conversions (barn, garage, loft) and refurbishment. Undertakings to consult the relevant fire authorities and sewerage undertakers are given in several of the Notices.

23. Archive screenshots are provided which show the BCS (AI) sign.<sup>13</sup> The first of these is dated 18 May 2013, though I note that the website is under construction at this time. There are further prints from 2015 and 2016 which show the BCS (AI) sign. The site describes the “effective building control service” it offers; specific services such as Disabled Access Audits, assistance in site inspections, plan vetting and fire risk assessments are indicated, along with “SAPCALCS” (the term is not explained) for new builds.<sup>14</sup> Previous commercial and residential projects are detailed, including the Victoria Beckham and Burberry London flagship stores, as well as other sites in Surrey, Buckinghamshire, Essex and London. No precise date is given for these projects, nor is there any particular detail about the nature of the work. Not all of the prints clearly show the BCS (AI) sign but what is visible is consistent with its use elsewhere on the site.

24. There is a copy of an advertisement which appeared in *Optima* magazine in October 2015.<sup>15</sup> The banner on the front page indicates that the magazine is delivered to 42,000 homes in South Hertfordshire and North Middlesex. The advertisement is headed “LOOKING FOR A BUILDING CONTROL SPECIALIST?”. Reference is made to the Building Control Performance Standards and to the provision of “an effective building

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<sup>11</sup> PC3. The final Notice is dated after the application date.

<sup>12</sup> Paul Cattell 1, §2(c), Paul Cattell 2, §3.

<sup>13</sup> PC6.

<sup>14</sup> For example, pp. 7, 8, 9.

<sup>15</sup> PC4.



control service". The BCS (AI) sign is visible. The advertisements discuss obtaining Building Regulations approval, as well as advice and consultancy services on property matters (including to architects, developers and contractors) in London and the Home Counties. It is said that the evidence also shows an advertisement that appeared in October 2015 in the *East London & West Essex Guardian* but the only documentary support is an undated photograph of an individual holding an open newspaper (the advertisement itself is visible). Photographs date-stamped September 2014 and August 2016 are provided, which show the BCS (AI) sign affixed to construction hoardings.

25. Sales figures are provided for the first applicant.<sup>16</sup> The first sales figures are £10,900 for May 2013. Although the monthly figures fluctuate, annual sales are given as £151,745 in 2013/2014, £255,091 in 2014/2015, £341,931 in 2015/2016 and £456,895 in 2016/2017. The figures for March and April 2017 are in excess of £40,000 each. The same exhibit contains Approved Inspector Monitoring Returns, which include a summary of work, including the number of Initial Notices served and Final and Partial Final Certificates issued. Abbreviated accounts for the first applicant, for the years ending February 2014 to February 2017, are exhibited but there is no need to record the figures here.<sup>17</sup>

26. Advertising expenditure is also provided for the first applicant.<sup>18</sup> £373 was spent in 2014/2015, £1,144 in 2015/2016 and £2,574 in 2016/2017.

### *Proprietors' business*

27. The above represents what the applicants have said about their own business but they have also provided evidence regarding the proprietors' business activities. Prints of the proprietors' websites are exhibited.<sup>19</sup> It refers to "landmark projects throughout London and beyond" but no more detail is provided. The proprietors' website address

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<sup>16</sup> PC5. See also Paul Cattell 1, §8.

<sup>17</sup> PC11.

<sup>18</sup> PC5; Paul Cattell 1, §9.

<sup>19</sup> PC7.

was, in 2016, [www.buildingcontrolsurveyors.com](http://www.buildingcontrolsurveyors.com) but by September 2017 (after the relevant date) was [www.bcsurv.com](http://www.bcsurv.com) and by February 2018 there was a new website [www.bcsapprovedinspectors.com](http://www.bcsapprovedinspectors.com) with the indication “T/A Building Control Surveyors Ltd”. The following sign (“the BCS square logo”) is visible on prints dated between 19 May 2014 and March 2016:



28. “BCS Approved Inspectors Ltd” appears at the bottom of a print dated 22 March 2016 as follows: “BCS Approved Inspectors Ltd and BCS Aviation Services Ltd are subsidiaries [incomplete]”.<sup>20</sup> The same print indicates that the company offers building regulation services and a building regulation approval process in the south east of England. Its surveyors are said to be connected with “numerous landmark projects, especially in London”. The company is said to have offices in Harrow, Upshire (Essex), Docklands and Stoke Newington. A further print shows a news and updates page on which there is a post dated March 2017 about a document produced by Local Authorities in Hertfordshire.

29. Financial statements and accounts for Docklands Developments Limited for the years ending September 2006 to September 2011 are also provided.<sup>21</sup> In 2006 the principal activity is given as surveying; in 2007, it is architect, structural engineer and surveyor services. Turnover is given as follows:

|      |         |
|------|---------|
| 2006 | £63,021 |
| 2007 | £87,764 |
| 2008 | £90,605 |
| 2009 | £88,991 |

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<sup>20</sup> PC7, p. 7.

<sup>21</sup> PC10.

30. The accounts for 2010 and 2011 do not show turnover. Current assets for these years are £5,942 and £5,228, respectively.

31. Also in evidence are the abbreviated accounts for the second proprietor for the years ending October 2012 to October 2016. There were no debtors for 2012; net assets were £4,286. Figures in subsequent years are as follows:

2013 Debtors: £25,831; net current assets: £14,804

2014 Debtors: £34,421; net current assets: £38,907

2015 Debtors: £50,422; net current assets: £70,776

2016 Debtors: not shown; net current assets: £48,493

32. Jason Cattell gives evidence for the applicants that on or around 12 September 2017 he received a telephone call from James Clifford L'Aimable, advising him that BCS APPROVED INSPECTORS was a registered trade mark and that Mr Cattell's company was no longer allowed to use it.<sup>22</sup>

#### Proprietor's evidence

33. The proprietors' evidence is provided by James Clifford L'Aimable, a director of both of the proprietors.

34. Mr L'Aimable states that the contested mark was first used by his company JCL Concepts Limited ("JCL") in 1993 in the provision of a range of architectural, design, surveying and regulation services, as well as database and software development services and consultancy services. He states that JCL used the mark to provide these services between July 1993 and May 1997. Exhibited are two images of building plans, dated November and December 1993, which bear the following roundel stamp (the

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<sup>22</sup> Jason Cattell, §3.

reproduction is not particularly clear but the upper part of the text reads “BCS Approved” and, underneath it, “Building Inspectors”:<sup>23</sup>



35. There are also two invoices for “Building Inspection- Structural calculations, specifications and plans”.<sup>24</sup> The first is dated July 1993 and is for £470, the second is dated November 1993 and is for £1,200. The clients’ details have been obscured. The second invoice bears a stamp which reads “BCS Approved”. It is not possible to make out the text beneath. A further, mainly handwritten, document is provided which bears the roundel stamp; there appears to be reference to foundations and concrete but the document is otherwise unexplained.<sup>25</sup> The same exhibit also contains two invoices dated 1993, both of which feature a device with the silhouette of a man at a desk under the words “BCS Approved Inspectors” (“the draughtsman logo”) and are for a feasibility study, plans and inspection work.<sup>26</sup> Invoice totals have been redacted.

36. It is said that JCL Concepts Limited assigned all of its intellectual property rights “including those relating to the registered mark” to Alex Joseph L’Aimable on 18 May 1997.<sup>27</sup> It is said that Mr Alex L’Aimable continued to use the contested mark on the same range of services until his retirement in 2005 and that Mr James L’Aimable assisted with technical systems, including source code development and publications, particularly regarding database software development, being used by other corporate bodies.<sup>28</sup>

37. A further assignment is said to have taken place in September 2005, when Mr Alex L’Aimable assigned all of the intellectual property rights acquired from JCL to Docklands

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<sup>23</sup> Exhibit JCL1, pp. 12-13.

<sup>24</sup> JCL1, pp. 13-14.

<sup>25</sup> JCL1, p. 15.

<sup>26</sup> pp. 16-18.

<sup>27</sup> §4.

<sup>28</sup> Ibid.

Developments Limited (“Docklands”). An affidavit is provided in which Mr Alex L’Aimable attests to his purchase from JCL as follows:<sup>29</sup>

“1. All the goods and intellectual property consisting of mixed media including instrumental & vocalised musically produced sounds, audio files, photographic imaging trademark titles, logos, and computer hardware shown in the schedule on page 2 of this document were legitimately purchased by me for a fixed sum from a company called [JCL] on 18 May 1997.

2. All rights including the re-sale, licensing to other parties was also my right to undertake without restriction”.

38. Schedule 2 includes the draughtsman logo, said to be “used on standard clauses Editions 1 to 14 1993 to 2006”. A “trademark used in embodied source code software in Building Control Surveyors Approved Inspectors manuals, eClip, eNews developments issue to the London Boroughs of Camden, Ealing, Islington, Southwark & Tower Hamlets 1993-2005” showing the words “BCS Approved Inspectors DataSystems vx” is also visible. The affidavit also confirms “upon signing of the sales transfer and assignment document a transfer and re-assignment of all my rights originally purchased from [JCL] to [Docklands]”.

39. The narrative evidence is that Docklands provided architectural services, building design services, building surveying services, building regulation services, Town & Country planning and planning-application-related services, database and software development services and consultancy and advisory services under the mark between 29 September 2005 and 14 November 2011.<sup>30</sup>

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<sup>29</sup> JCL2.

<sup>30</sup> L’Aimable, §6.

40. On 15 November 2011 Docklands is said to have assigned all of its intellectual property rights to Building Control Surveyors Limited (i.e. the second proprietor).<sup>31</sup> A copy of an agreement between the parties is exhibited which states that the goodwill acquired to date and the right to sue for passing off are included.<sup>32</sup> Database software and an internet streaming service, all with names including “BCS”, are mentioned in the agreement. Schedule 1 to the agreement includes a logo featuring “BCS” in white on a square black background, described as a “motion (mov) logo with mixed media and websites”. The words “BCS Approved Inspectors” are shown in “embedded header tags (websites), mixed media. Standard clauses development versions 1.0 to 3.3 year period 2003-2011” and embedded in a “motion graphic (mov) logo with mixed media and websites”. Mr L’Aimable confirms that the second proprietor offered the same services as Docklands had previously.<sup>33</sup> He also confirms that on 2 February 2012 the second proprietor became an Approved Inspector under the Buildings Act 1984.<sup>34</sup>

41. Five invoices are provided, dated February and March 2012.<sup>35</sup> They include at the top of the page the following logo (“the BCS square logo”):



At the bottom of the page, “BCS Approved Inspectors” appears in plain text as part of the company details. The details of the customers and works have been redacted but the invoices clearly indicate “Building Control Fee”. The amounts billed are between £360 and £4,200. The company is described as a “Private Sector Based Building Regulation Service Provider”.

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<sup>31</sup> §7.

<sup>32</sup> JCL3.

<sup>33</sup> §8.

<sup>34</sup> Ibid. and JCL4.

<sup>35</sup> JCL5.

42. Three further invoices, also dated February 2012 are exhibited.<sup>36</sup> Addressee details have been obscured; it is possible to make out only that one is in West Wickham. The words “BCS Approved Inspectors” appear beneath a figurative mark at the bottom of each invoice. They relate to “Building Control Plan Submission” as well as plan and compliance checking and site inspection. Deposit amounts are between £300 and £1,400, being 40% of the total payable.

43. There is also provided an “archived letter of typical communication” dated 2 March 2012.<sup>37</sup> It is an acknowledgement of an appointment to act, to a party in London. The words “BCS Approved Inspectors” appear in the letterhead beneath the same figurative mark as on the February 2012 invoices. The works concerned are structural alterations to a wall; the sum payable has been redacted. I note that there is also in evidence a letter dated May 2012 which features the same figurative mark and “BCS Approved Inspectors” wording, enclosing an Initial Notice to the Building Control Service at Barking Town Hall.<sup>38</sup>

44. In addition, there are photographs and invoices relating to the use on company vehicles of a logo featuring the words “BCS APPROVED INSPECTORS”.<sup>39</sup> There is some inconsistency in the dates claimed for this use. The letter enclosing the final design proofs is dated 26 March 2012 and the final designs appear identical to those on the vehicles photographed.

45. Mr L’Aimable states that he was not aware of the first applicant until late September 2017, i.e. after the application date.<sup>40</sup> The incident which gave rise to this discovery was contact from the London Borough of Barking & Dagenham council (Building Control) “asking whether [the proprietors] had relocated their Corporate main offices to Chelmsford, since their computer systems were showing another trading address for Building Control Surveyors Ltd”. Further, the proprietors also received an

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<sup>36</sup> JCL5, pp. 37-39.

<sup>37</sup> JCL5, p. 36.

<sup>38</sup> JCL7, p. 48.

<sup>39</sup> JCL5, pp. 40-43 and L’Aimable §9.

<sup>40</sup> §12.

acknowledgement of an Initial Notice from the same council, which ought to have been sent to the first applicant.<sup>41</sup> Mr L'Aimable states that the application was made to obtain legal protection for the mark and services in relation to which it had been used for 24 years.<sup>42</sup>

### **Section 5(4)(a)**

46. Section 5(4)(a), which has application in invalidity proceedings by virtue of s. 47(2), states:

“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”.

47. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or

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<sup>41</sup> §§15-16 and JCL6.

<sup>42</sup> §11.



a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)".

48. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the court stated:

"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".

49. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the

trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur”.

50. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application”.

51. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is

now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation”.

52. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience”.<sup>43</sup>

53. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s. 5(4)(a) of the Act and concluded:

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<sup>43</sup> See also *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

“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’.

54. The applicants must show that they had a protectable goodwill at least by the date of application for the contested mark, i.e. 11 May 2017. However, as the proprietors have claimed to be the senior users, I must also assess whether and, if so, by what date, the proprietors have established first use of a BCS mark and/or a protectable goodwill of their own under such a mark.

#### Applicants’ business

55. There is no evidence of a formal assignment of goodwill from the second to the first applicant. It is clear from the evidence that, irrespective of a formal transfer, one or other of the joint applicants owned any goodwill which did exist. The first applicant appears to have carried on the business initially operated by the second applicant. Given Paul Cattell’s apparently controlling role in the businesses and the seemingly seamless transition of the business from one entity to the next, I am prepared to accept that there was a de facto and consensual transfer of the business from the second applicant to the first and that any goodwill owned by the first applicant in March 2013 would have included the benefit of any goodwill previously generated by the second applicant.

56. There is not a vast amount of evidence of the use of the BCS sign. There is nothing to show advertising or publicity before the first invoice evidence. However, there are twenty-eight invoices dated between 5 May 2005 and 30 March 2013, all showing the BCS sign. I note that there is repeat business from the same customers. The evidence of turnover from 2006 and 2007 is not insignificant. The figures for subsequent years are small but not, in my view, trivial. There is little to provide a context or fuller explanation of the services offered. Those identified on the invoices strike me as services in connection with building regulations and plans, rather than services connected with the actual construction of properties. For example, “site inspections”, without further explanation and in the context of the evidence as a whole, suggests a service checking compliance, rather than a construction management service. I am satisfied that by May 2005 (the first confirmed sales), or if that is not right at the latest by June 2006 (the first annual turnover evidence), the second applicant had a protectable goodwill as a result of its provision of building inspection services, including advice regarding planning applications, of which the BCS sign was distinctive.

57. The BCS(AI) sign is shown on Initial Notices from March 2013, with supporting evidence of website use since May 2013. There are confirmed monthly sales from May 2013 (amounting to over £10,000 in the first month provided). I find that there was a business operating in the field of building control services, with a protectable goodwill from May 2013, of which the BCS(AI) sign was distinctive. However, given the non-distinctiveness of the words “Approved Inspectors”, coupled with the fact that the BCS(AI) sign uses the identical BCS device element, I am also satisfied that the relevant public would perceive the BCS device element as distinctive of the business when used as part of the BCS(AI) sign. Given my comments, above, regarding the transfer of the goodwill from the second applicant to the first, the use from March 2013 is likely to have represented in the mind of the relevant public a continuation of the existing goodwill. Further, the evidence in the form of sales, accounts and, although limited, advertising, is, when viewed alongside the invoice evidence, sufficient to show that by the date of application the business associated with the signs had a reasonable goodwill.

58. In terms of the geographical location of the applicants' goodwill, the second applicant's customers in 2005 were all located in London and Essex, though the sites of works had further reach. By 2013, the first applicant was also carrying out works in Hertfordshire, Cambridgeshire and Kent. I acknowledge that the addressee details are obscured. However, the work detailed includes the construction of cats' pens and alteration work to single dwellings and, whilst I accept that some of the projects (such as those relating to homes of multiple occupancy) may well be on the instruction of companies located outside the immediate areas, it is unlikely that all of this work was commissioned on that basis. I also note that previous projects detailed on the applicants' website at 2016 include work in Surrey and Buckinghamshire, as well as London and Essex. The applicant's goodwill by 2017 was in London and Essex but it is also likely, given the frequency of work in that area shown in the evidence, that the first applicant had also established goodwill in at least Hertfordshire.

#### Proprietors' business

59. The proprietors have shown that the sign "BCS Approved Building Inspectors" was present on building plans and two invoices, totalling £1,670, in 1993. There is also evidence that "BCS Approved Inspectors" appeared on invoices as part of the draughtsman logo in 1993. The parties' evidence shows that "Approved Inspector" is a defined term for private building control companies and is, therefore, entirely descriptive. The combination "Approved Building Inspector" is also likely to be considered entirely descriptive by the relevant public. It follows that "BCS" is the only distinctive part of the signs used ("BCS Approved Building Inspectors" and "BCS Approved Inspectors"), which will be relied upon by the relevant public to identify the proprietors' business.

60. I note that the proprietors submit that their evidence "does not seek to establish anything as grand as genuine use" and that "the probative thresholds which the Proprietors' evidence needs to meet are relatively low".<sup>44</sup> It is true that the onus is on

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<sup>44</sup> Submissions dated 1 October 2018, §5.2.

the applicants to show that they had a protectable goodwill on the date that the behaviour complained of (i.e. the proprietors' use) began, not on the proprietor to demonstrate that it had a non-trivial goodwill of its own by that date.<sup>45</sup> However, whilst it is not necessary for goodwill to have accrued to the proprietors at that date, what happened after the first alleged date of use is important. If the activity ceased or changed materially, that must be taken into account, because it may mean that the true date of commencement of the activity complained of is later, or that the activity cannot be said to have properly commenced at all.<sup>46</sup>

61. The affidavit of Alex L'Aimable makes no specific mention of the goodwill of the business nor indeed of the business itself being transferred. However, whilst there is no formal assignment document, the evidence is that Mr Alex L'Aimable continued using the mark on the same services as JCL had done previously, and that JCL itself was dissolved shortly after the assignment of the rights.<sup>47</sup> In these circumstances, it seems reasonable to conclude that Mr Alex L'Aimable did take ownership of the goodwill. I bear in mind that there is narrative evidence that the activities of JCL continued under Mr Alex L'Aimable. There is, however, no documentary evidence which shows "BCS" being used in relation to the claimed services. Although the draughtsman logo appears in the schedule to Mr Alex L'Aimable's affidavit, there is no explanation of what the "standard clauses Editions 1 to 14 1993 to 2006" are, on which the mark is said to have been used. The other mark ("BCS APPROVED INSPECTORS DataSystems vx") itself suggests a software good or service, or potentially a business service. The former would, however, be consistent with the statement of Mr James L'Aimable that he continued to offer technical support to the business, including regarding source code and publications on database software developments used by corporate bodies such as Local Authorities. I also note that the assignment of rights between Docklands and the second proprietor, discussed in more detail below, does not mention any building control or surveying services but that it does list internet streaming and database software, which appear alongside "BCS". On the evidence before me, I am not satisfied

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<sup>45</sup> *Roger Maier, Assos of Switzerland SA v ASOS plc, ASOS.com Limited* [2015] EWCA Civ 220 at [165].

<sup>46</sup> See the comments of the Appointed Person in *CASABLANCA Trade Mark* (O/349/16) at [35] to [37].

<sup>47</sup> L'Aimable, §4.

that any use of “BCS” in the period between 1997 and 2005 was in relation to the relevant services. The proprietor has not, therefore, shown continuous use of BCS between 1997 and 2005 and the claim to first user from 1993 must be rejected.

62. The applicants have provided turnover figures for the next assignee of the goodwill, Docklands. The sums are not trivial. In relation to the goods and services at issue, Mr L’Aimable again states that the mark was used in relation to a range of services, without providing documentary evidence in support of that claim. I note that the principal activity is given in the 2006 accounts as surveying and in 2007, it is architect, structural engineer and surveyor services. However, as with the previous owner of the goodwill, there is nothing to support the claim that the contested mark was used in relation to these services, barring the unsupported assertions on Mr L’Aimable’s part. As I have explained above, the only documentary evidence of the mark in connection with goods or services is in the assignment document. Those are streaming services and database software. There is also no evidence of how the mark may have been presented to the public, including on relevant services. My view is that broad claims to use must be substantiated in greater detail than has been provided; it would not have taken a great deal of evidence showing the mark in relation to relevant services to cross the threshold. There may have been a protectable goodwill by this date but the evidence is too insubstantial to support a conclusion that the contested mark was a sign distinctive of goodwill in a business conducting the relevant services.

63. The transfer of the goodwill from Docklands to the second proprietor in November 2011 is shown in the uncontested evidence of Mr L’Aimable. The next documentary evidence of use of the contested mark is alongside a device or in the BCS square logo on letters and invoices dated February to March 2012. The latter total a few thousand pounds. I also note that the accounts filed by the applicants record debtors owing the company small but not trivial amounts until 2015. Only assets are shown for 2016. The evidence filed by the applicants shows that the BCS square logo was present on the proprietors’ website between May 2014 and March 2016. Whilst not all of the uses are of the mark as registered, the letters “BCS” are the most distinctive part of the BCS



square logo: “building control surveyors” is non-distinctive and the black square background is likely to have little impact. As discussed above, “Approved Inspectors” is entirely descriptive. There is little evidence of the services provided. However, all of the services on the invoices/correspondence or the website might reasonably be described as building control services. There is no documentary evidence that the business operated in any other fields of activity; the narrative evidence of Mr L’Aimable is insufficient to support such a claim. Given all of the above, I am satisfied that the proprietors had a small but protectable goodwill by February 2012 (i.e. the first confirmed sales) in the field of building control services and that the sign “BCS” or “BCS Approved Inspectors” was distinctive of the goodwill. The proprietors’ business appears to have been in the Greater London area, though I note that there was one office in Upshire, Essex. While the evidence does not clearly show the picture as at the date of application, my view is that the level of sales up to 2015, combined with the continued use of the BCS square logo on the website, is likely to have maintained the protectable goodwill of the proprietors in the relatively short intervening period.

#### Senior user

64. In *Croom’s Trade Mark*, [2005] RPC 2, Geoffrey Hobbs Q.C., summarised the position where the parties claim to have competing rights as follows:

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user’s rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so”.

65. I have found, above, that both parties have traded in the field of building control services prior to the application date. The applicant had a protectable goodwill by, at the latest, June 2006. That is earlier than the first date of the proprietors' established and resumed use of BCS in 2012. The second applicant is, therefore, the senior user at common law.

### Misrepresentation and damage

66. The test for misrepresentation is that in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341, per Lord Oliver at page 407:

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”.

67. The requirements for damage in passing off cases was described by Millett L.J. in *Harrods Limited v Harrodian School Limited* [1996] RPC 697:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the

defendant. The danger in such a case is that the plaintiff loses control over his own reputation”.

68. Given that “BCS” is the only distinctive element of the contested mark, and that it is the most dominant element of the applicants’ signs, the potential for misrepresentation in respect of the highly similar signs when used for the same building inspection and advisory services is clear. I find that the same applies to all of the services applied for in class 42, which are all in the same field of activity and even where not strictly identical have a sufficiently close relationship with the services provided by the applicants to give rise to a misrepresentation. This was, in 2012, bound to lead to damage to the second applicant’s business through diversion of sales or loss of control of its reputation. The use of the contested mark was, therefore, liable to be restrained in 2012 in respect of the services applied for in class 42. I am not persuaded that the same applies to the services in class 35, either in 2012 or at the date of application. There is no evidence that the applicants have offered these services. Whilst I acknowledge the similarity between the mark and the signs, I do not think that there is, given the distance between building control services and administrative services, a likelihood that a substantial number of the applicants’ customers would be deceived by use in relation to the latter.

#### Concurrent user

69. Turning to the position at 11 May 2017, the parties have been trading concurrently since at least 2012. It is, therefore, possible as a matter of law that use which could have been restrained in 2012 can no longer be restrained because of established concurrent use. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, Iain Purvis Q.C., sitting as Deputy Judge, set out the following analysis of when honest concurrent use could provide a defence to an action in passing off:

“61. The authorities therefore seem to me to establish that a defence of honest concurrent use in a passing off action requires at least the following conditions to be satisfied:

(i) the first use of the sign complained of in the United Kingdom by the Defendant or his predecessor in title must have been entirely legitimate (not itself an act of passing off);

(ii) by the time of the acts alleged to amount to passing off, the Defendant or his predecessor in title must have made sufficient use of the sign complained of to establish a protectable goodwill of his own;

(iii) the acts alleged to amount to passing off must not be materially different from the way in which the Defendant had previously carried on business when the sign was originally and legitimately used, the test for materiality being that the difference will significantly increase the likelihood of deception”.

70. It seems likely that the proprietors’ use of the contested mark in 2012 amounted to passing off, for building control services. On the evidence before me, the first condition in Mr Purvis’s analysis is not satisfied. I should point out that this does not mean that the proprietors were deliberately trying to misrepresent themselves as the applicants. Indeed, it is entirely plausible that the adoption of “BCS” by companies which identify themselves as building control surveyors was coincidental. However, whilst intention is relevant, it is not determinative: an unintentional act of passing off is still passing off.

71. I have indicated, above, that the proprietors had by the date of application established their own independent passing off right. However, even if the proprietors’ use in 2012 did not amount to an act of passing off, the third condition is not satisfied. Although it appears that at the date of application the parties were both operating in London and, to a lesser extent, in Essex, the first applicant’s goodwill also extended to, at least, Hertfordshire, where the signs relied upon were exclusively distinctive of the applicant. There is no evidence that the proprietors have advertised their services to a geographically more widespread area. I have not overlooked the reference to Local Authority guidance in Hertfordshire. However, this is not clear evidence that the

proprietors themselves operated in that area. Without any context to assist me, and noting that the post directs any queries to the Local Authority concerned, the page at most indicates that the information might have been of interest to visitors to the website. On that basis, had the proprietors offered services in Hertfordshire, there would have been a misrepresentation to the public and resulting damage to the goodwill of the applicant's business. At the relevant date, the first applicant would have been entitled to restrain the proprietors under the law of passing off from trading in the same area. As the proprietors' trade mark is registered for the whole of the UK, this means that registration was contrary to s. 5(4)(a) of the Act.

72. The ground under s.5(4)(a) succeeds in relation to "advisory services relating to architecture; advisory services relating to building design; advisory services relating to design engineering; advisory services relating to energy efficiency; advisory services relating to industrial design; advisory services relating to planning applications". The application under s. 5(4)(a) fails in respect of the services in class 35.

### **Section 3(6)**

73. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

"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* [2008] 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)"".

74. The applicants' case under s. 3(6) is essentially that in full knowledge of the applicants' business, or as a result of a failure to enquire about other traders, the proprietors deliberately copied the applicants' marks or other aspects of their business (specifically the website). This, it is stated, was in order to gain from the applicants' goodwill, to prevent the applicant from exploiting their own goodwill or to prevent the applicants from using and/or registering their marks. It is also claimed that the proprietors had no intention to use the mark.

75. The burden is on the applicants to make good their case and, in cases of bad faith, the burden is not a light one. There is nothing in the evidence to suggest that the proprietors had any knowledge of the applicants or their business prior to the date of



application. Mr L'Aimable's evidence is that he had no knowledge of the applicants until after the relevant date. As no request to cross-examine him was made and there is no evidence which conflicts with his evidence on this point, the veracity of his evidence cannot be called into doubt. His explanation is also consistent with the evidence provided of the contact from Barking & Dagenham Council. I can see no similarities between the websites prior to the application date which are sufficient to sustain a claim of bad faith. Although the proprietor's alteration of the website address after the application date points more towards generating conflict than avoiding it, it is insufficient, in the absence of cogent evidence from before the relevant date and bearing in mind that there is no evidence of any alterations before September 2017 (when both parties claim to have discovered the other), to establish that the application, in May 2017, was made in bad faith.

76. I also dismiss the alternative claim that there was no intention to use. The application form requires a statement that there the mark has been used by the applicant, or with his consent, or that there is such an intention to use the mark. It is matters not whether one or both of the proprietors will use the mark, provided that there is an intention that the mark will be used by one of them or jointly, or with their consent. There is no evidence to support a claim that the proprietors, taken together, had no intention to use the mark; indeed the evidence shows that the proprietors have already been trading under the mark. The claim under this ground is dismissed.

## **Conclusion**

77. The application for invalidation has succeeded in part. Subject to appeal, the contested mark will remain registered for all services in class 35. It will be invalidated, with effect from 11 May 2017, for all services in class 42, namely "advisory services relating to architecture; advisory services relating to building design; advisory services relating to design engineering; advisory services relating to energy efficiency; advisory services relating to industrial design; advisory services relating to planning applications.

## **Costs**

78. The proprietors have made a request for costs off the scale. This is on the basis that they have “been forced to prepare two Counterstatements”, responding to “confused and unnecessarily overlaid, complex and mutually exclusive arguments”.<sup>48</sup> Further, they claim that the applicants’ evidence was “basically worthless evidence which widely misses the mark”.<sup>49</sup> I do not consider the proprietors’ criticisms to be well founded. The applicants did request leave to amend their pleadings but this was done in response to the first counterstatement, before the proprietors’ evidence period and it ought not, for a professional representative, to have resulted in great difficulty or a large amount of time spent on amendments. The applicants’ evidence was, in the main, not obviously irrelevant and any irrelevant material was limited. As far as the criticisms of repetition and complexity are concerned, the proprietors have not viewed their own counterstatement, evidence and submissions through the same critical lens. In short, I do not consider an award above the scale to be appropriate. I consider it appropriate that the award follows the normal scale and the overall outcome. Both parties have achieved a similar measure of success. I order that the parties bear their own costs.

**Dated 25 July 2019**

**Heather Harrison  
For the Registrar  
The Comptroller-General**

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<sup>48</sup> Counterstatement, §5.2.

<sup>49</sup> Submissions dated 21 February 2019, §4.1.