**O/0079/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003957495**
**BY JOB DECK LTD**
**TO REGISTER:**

# hiredeck

**AS A TRADE MARK IN CLASSES 35 AND 42**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**
**UNDER NO. 443806**
**BY ODRO LTD**

## BACKGROUND AND PLEADINGS

1. On 17 September 2023, Job Deck Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 06 October 2023 in respect of the following services:

> **Class 35:** *Employment recruitment; Recruitment (Personnel -); Recruitment of personnel; Personnel recruitment; Recruitment advertising; Staff recruitment; Recruitment services; Personnel recruitment advertising; Personnel recruitment consultancy; Consultancy of personnel recruitment; Personnel placement and recruitment; Recruitment and placement services; Recruitment of political volunteers; Interviewing services [for personnel recruitment]; Personnel recruitment services; Executive recruitment services; Recruitment consultancy services; Recruitment of temporary personnel; Staff recruitment services; Employment recruiting consultancy; Recruitment consultancy for lawyers; Consultancy relating to personnel recruitment; Permanent staff recruitment; Business recruitment consultancy; Employment recruiting consultation; Recruitment of executive staff; Staff recruitment consultancy services; Personnel recruitment agency services; Recruitment and personnel management services; Professional recruitment services; Employment recruiting services; Recruitment of high-level management personnel; Recruitment of computer staff; Advertising services relating to the recruitment of personnel; Recruitment of temporary technical personnel; Executive recruiting services; Human resources management and recruitment services; Personnel placement consultancy; Headhunting services; Employment consultancy; Job placement consultancy.*
>
> **Class 42:** *Software as a service [SaaS].*

2. On 25 October 2023, the application was opposed by Odro Ltd ("the opponent") based upon Section 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under Section 5(4)(a), the opponent relies upon the unregistered sign 'hiredeck' which it is said has been used throughout the UK since 16 March 2023 in relation to the same services for which the applicant seeks registration. In this connection, in answer to the question "*Q3. On which goods or services has the earlier right been used for?",* the opponent has copied and pasted the applicant's specification, though the terms *"recruitment of political volunteers"* and *"….and recruitment services; Personnel placement consultancy; Headhunting services; Employment consultancy; Job placement consultancy"* have been omitted as shown below:

**Q3. On which goods or services has the earlier right been used for?**

Class 42 - Software as a Service (SaaS)
Class 35 -Employment recruitment;Recruitment (Personnel -);Recruitment of personnel;Personnel recruitment; Recruitment advertising;Staff recruitment;Recruitment services;Personnel recruitment advertising;Personnel recruitment consultancy;Consultancy of personnel recruitment;Personnel placement and recruitment;Recruitment and placement services;Interviewing services [for personnel recruitment];Personnel recruitment services; Executive recruitment services;Recruitment consultancy services;Recruitment of temporary personnel;Staff recruitment services;Employment recruiting consultancy;Recruitment consultancy for lawyers;Consultancy relating to personnel recruitment;Permanent staff recruitment;Business recruitment consultancy;Employment recruiting consultation;Recruitment of executive staff;Staff recruitment consultancy services;Personnel recruitment agency services;Recruitment and personnel management services;Professional recruitment services;Employment recruiting services;Recruitment of high-level management personnel;Recruitment of computer staff;Advertising services relating to the recruitment of personnel;Executive recruiting services;Human resources management and

4. Notably, the opponent does not actually mention goodwill in its statement of grounds, but frames his passing off claim as follows:

> *"The use of the applicant's trademark would be in direct contravention of the law of passing off due to the substantial risk of consumer confusion and potential misrepresentation. Our product, Hiredeck, was officially launched on 16 March 2023 under the same name as the applicant's proposed trademark. Since its inception, Hiredeck has evolved into a well-established platform and brand in its own right. Notably, we have secured ownership of the domains Hiredeck.co.uk, Hiredeck.io, and Hiredeck.com.au, emphasising our commitment to this brand. Our dedication to establishing a prominent online presence for Hiredeck extends to robust social media engagement. Our active social media profiles have garnered a significant following, and we believe that the applicant, operating in the same industry and overlapping target market as ours, is well aware of our presence and the distinctiveness of our Hiredeck*

*brand. Moreover, we have documented instances of direct interaction between the applicant's employees and our company on social media platforms, where we regularly post updates, promotions, and information about Hiredeck. Notably, one of the applicant's employees attended one of our company's webinars on 23 August 2023. Remarkably, the applicant's trademark application was filed shortly after, on 17 September 2023. This sequence of events strongly suggests that the applicant's awareness of our Hiredeck brand and their subsequent application for a similar trademark is not coincidental. Granting the applicant the right to use an identical trademark could not only harm our brand but also potentially mislead consumers into believing in an affiliation between the applicant"* (paragraph stops here)

5. The applicant filed a defence and counterstatement, denying the opponent's claims. In particular, the applicant states that it has been using the contested mark since as early as 2021, significantly predating the opponent's first claimed date of use of 16 March 2023 and that as a result of such use, the applicant has generated its own goodwill in the contested sign.

6. The opponent is a litigant in person. The applicant is represented by Appleyard Lees IP LLP.

7. Both parties filed evidence and written submissions during the evidence rounds.

8. Neither party requested a hearing, nor did they file submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

**The evidence**

9. The opponent's evidence consists of a witness statement from Ryan McCabe dated 4 April 2024 and accompanied by seven exhibits being those labelled A-G. Mr McCabe is the CEO of the opponent's company, a position which he has held since 2015, and his evidence goes to the use of the earlier sign by the opponent.

10. The applicant's evidence consists of a witness statement from Richard McGawley dated 4 June 2024 and accompanied by six exhibits being those labelled RMEX01 – RMEX06. McGawley is the founder and director of the applicant's company, and his evidence goes to the use of the contested mark by the applicant.

11. I do not intend to summarise the parties' evidence (or their submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

**Relevance of EU Law**

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

**DECISION**

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

13. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> > (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."

14. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

15. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

16. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

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

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

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

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

**The relevant date for Section 5(4)(a)**

17. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

> "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.' "

18. The *prima facie* relevant date is the date the contested mark was filed, in this case 17 September 2023. However, the applicant has provided evidence aimed at establishing that it has used the contested mark prior to the application date. Accordingly, before proceeding any further, I must consider whether the applicant's evidence is such that there is an earlier relevant date for assessing whether Section 5(4)(a) applies.

19. In *Advanced Perimeter Systems* as aforesaid Mr Alexander considered the relevant date for the purposes of Section 5(4)(a) of the Act where one or both of the parties have used the mark(s) at issue prior to the date of the application to register the contested mark(s). He explained that:

> "41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the

Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

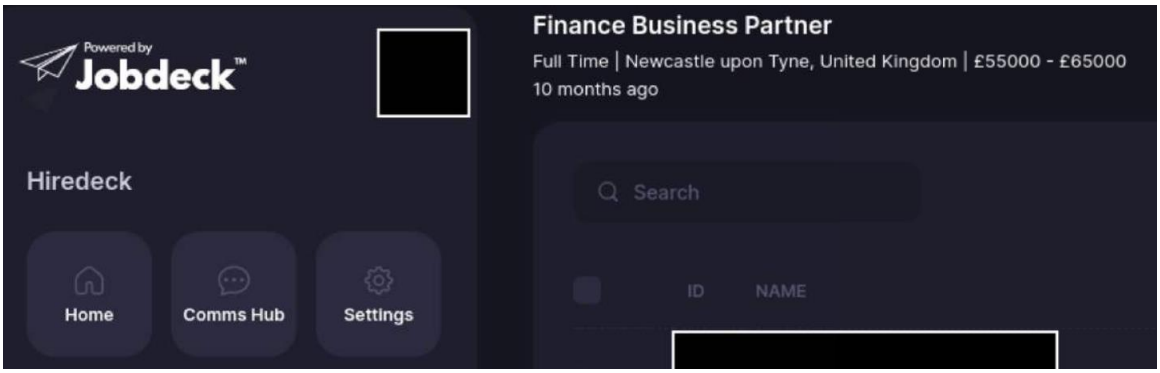
> (a) The right to protection conferred upon senior users at common law;
> (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
> (c) The potential for co-existence to be permitted in accordance with equitable principles.
>
> 42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application."

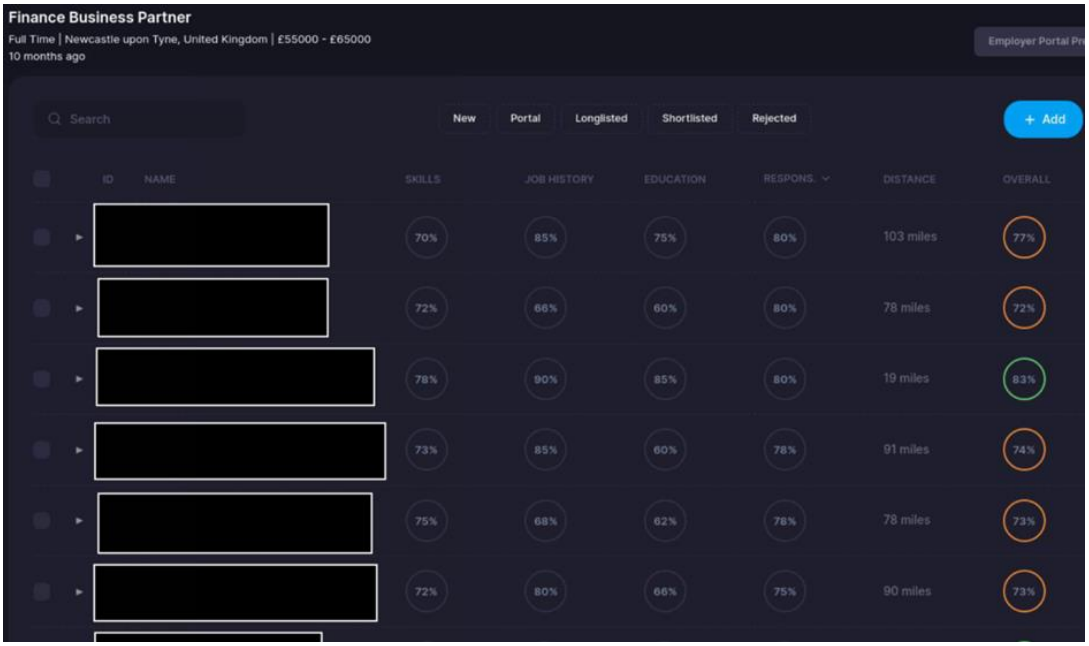
20. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC (now KC), as the Appointed Person, pointed out that *"the start of the behaviour complained about"* is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when the first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no one else had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

*The applicant's evidence*

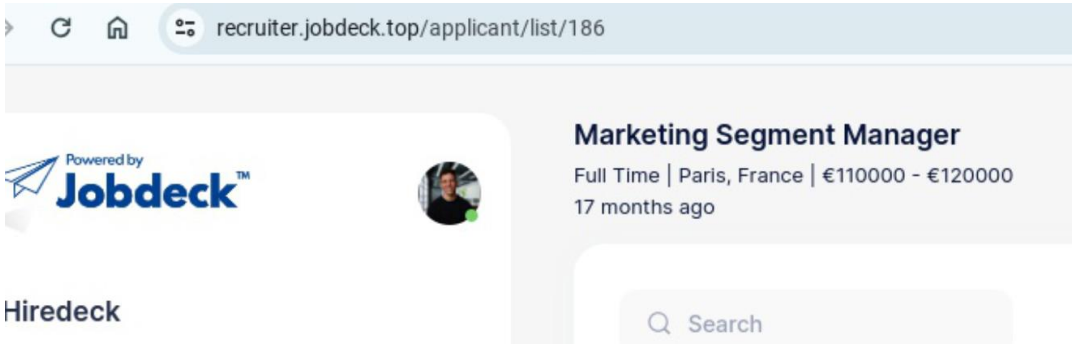
21. Mr McGawley gave evidence that the applicant is a UK company incorporated on 11 October 2019 and says that it has been trading since 2021. He states that the applicant was established to streamline recruitment by automating certain tasks, and that the applicant serves more than 100 paying customers globally, consisting of large corporate employers and recruiters, as well as thousands of candidates, and generates a turnover of approximately £300,000 per annum. Mr McGawley also says that the applicant has been using the mark 'Hiredeck' since 2021 and provides the following evidence in support:

- Exhibit RMEX5: this is said to be a screenshot taken in December 2023 and sent to the opponent as an attachment to a letter dated 8 December 2023 (i.e. after the *prima facie* relevant date of 17 September 2023) from the applicant's legal representative following receipt of the opposition. Mr McGawley says that the mark 'Hiredeck' is displayed in the navigation area of the applicant's platform and points out that the screenshot is dated *"10 months ago"* saying that this means that the applicant's use precedes the opponent's use. The relevant part of the screenshot looks like this:






- Exhibit REMEX6: this is said to show use of the mark 'Hiredeck' in relation to a job that was added to the applicant's platform in January 2023. The relevant part of the screenshot looks like this:




22. As it can be seen, the word 'Hiredeck' is shown in both screenshots beneath the words 'Powered by Jobdeck'.

23. As regards Exhibit REMEX6, admittedly, being 10 months prior to 8 December 2023 would be 8 February 2023 which is earlier than the filing date of 17 September 2023. However:

- The screenshot is undated and there is no evidence to prove that it was taken in December 2023. But even if it was, it is still after the relevant date of 17

September 2023 and there is no evidence that 10 months prior to December 2023 the website/platform displayed the webpage which has been exhibited. In this connection, it must be observed that "*10 months ago*" appears to refer to when the job *"Finance Business Partner*" was advertised. However, the screenshot produced in evidence is not from web archive and it cannot be excluded that the relevant webpage/platform was altered over time - hence, this evidence cannot establish that prior to the relevant date the mark 'Hiredeck' featured on the website/platform as it appears on the screenshot exhibited in evidence; and

- The screenshot appears to display the mark 'Hiredeck' on a software app for recruiters as it shows the score each job applicant achieved based on criteria such as skills, job history, education etc. Mr McGawley says that the applicant was established to streamline recruitment by automating certain tasks and that in turn, the applicant's Software-as-a-Service (SaaS) platform enables recruiters to focus on candidates and enhance their recruitment experience. However, there is no evidence that the relevant webpage/platform (or the software displaying it) was accessed by UK customers – in this connection, whilst Mr McGawley says that it has been trading since 2021 and that it trades globally, there are no invoices or turnover establishing that the applicant's goods and services were offered or sold under the contested mark in the UK prior to the relevant date.

24. The same goes for the other screenshot about the job advertised *"17 months ago"*.

25. Accordingly, I find that the above evidence is insufficient to establish that the applicant has used the contested mark 'hiredeck' before the date of the application, and I will proceed on the basis that the only relevant date for the purpose of assessing the opponent's passing off claim is 17 September 2023. With this in mind, I will now turn to the opponent's evidence.

**Goodwill**

26. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

> "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."

27. 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 of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

28. 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."

29. One of the requirements of passing off is that goodwill must be more than trivial in extent. 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."

30. In *Smart Planet*, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v*

*British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

31. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

> "The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.
>
> 37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.
>
> 38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

32. 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 goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the

trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, *"very limited",* the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.[1]

33. The opponent's evidence is as follows.

34. Mr McCabe says that the opponent officially announced the launch of its new product, 'Hiredeck', in March 2023 and has extensively used the mark "Hiredeck" in connection with its product and services since this announcement. As evidence of prelaunch activities, Mr McCabe exhibits an invoice dated 17 March 2023 issued by a digital design company to the opponent for the *"design and build of new website for Hiredeck including form building & integration"* amounting to £5,274.[2] Along with this invoice, Mr McCabe provides a copy of an email dated 22 December 2022 discussing quotations for the construction of the 'Hiredeck' website. Mr McCabe states that this evidence *"demonstrates substantial use, recognition, and goodwill associated with the Hiredeck mark in the relevant marketplace, prior to the Applicant's filing".* However, neither the invoice nor the email is capable of showing that the opponent had a fully functioning website through which it offered goods and services to the UK public prior to the relevant date of 17 September 2023, let alone goodwill and reputation. In this connection, it is not even clear whether the invoice, which is dated 6 months prior to the relevant date, was issued before or after the website was built.

35. Mr McCabe also mentions that the initial announcement of 'Hiredeck' was made through a LinkedIn post in March 2023, however, there is no evidence of this. As regards the website, Mr McCabe states that between March 2023 and September 2023, the opponent logged 9,321 sessions from 6,549 unique users "*showcasing the robust interest in Hiredeck prior to [the applicant]'s registration".* In support of these statements, Mr McCabe exhibits statistics from Google Analytics about the volume of traffic experienced by the opponent's website 'Hiredeck.io' between March 2023 and

[1] See also: *Stannard v Reay [1967] FSR 140 (HC); Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)
[2] Exhibit G

September 2023 and October 2023 and March 2024.[3] However, it is not clear what proportion of the figures for the period March 2023 - September 2023 falls prior to the relevant date of 17 September 2023, whereas the figures for October 2023 - March 2024 are after the relevant date and, as such, do not count. Additionally, as it can be seen below, there is no indication of where the visitors came from, and it is not obvious that the '.io' domain targets the UK – these points are particularly important given Mr McCabe's evidence (see below) that the opponent trades globally:

| Period | Sessions | Users |
|---|---|---|
| Mar 23 - Sep 23 | 9,321 | 6,549 |
| Oct 23 - Mar 24 | 8,406 | 6,600 |
| **Total** | **17,727** | **13,149** |

| | Sessions | Total Users | Rate (%) | Organic | Direct | Paid | Display | Referral | Social | Email | Other |
|---|---|---|---|---|---|---|---|---|---|---|---|
| Mar-23 | 1,470 | 959 | 36% | 71 | 1,057 | 0 | 0 | 27 | 189 | 126 | 1 |
| Apr-23 | 1,089 | 785 | 43% | 173 | 604 | 44 | 19 | 38 | 197 | 11 | 0 |
| May-23 | 1,043 | 622 | 56% | 177 | 472 | 116 | 134 | 59 | 38 | 9 | 7 |
| Jun-23 | 997 | 628 | 60% | 162 | 272 | 126 | 193 | 141 | 20 | 78 | 2 |
| Jul-23 | 1,598 | 1,159 | 66% | 376 | 459 | 129 | 300 | 273 | 34 | 2 | 22 |
| Aug-23 | 1,440 | 1,070 | 64% | 259 | 272 | 177 | 517 | 169 | 17 | 8 | 19 |
| Sept-23 | 1,684 | 1,326 | 58% | 273 | 221 | 131 | 278 | 122 | 304 | 182 | 173 |
| Oct-23 | 1,016 | 745 | 62% | 212 | 248 | 51 | 8 | 214 | 74 | 127 | 83 |
| Nov-23 | 1,086 | 864 | 68% | 208 | 184 | 18 | 2 | 114 | 351 | 133 | 66 |
| Dec-23 | 757 | 590 | 70% | 278 | 200 | 8 | 0 | 84 | 278 | 26 | 8 |
| Jan-24 | 1,493 | 1,216 | 77% | 229 | 174 | 897 | 0 | 124 | 29 | 3 | 37 |
| February-24 | 2,196 | 1,765 | 80% | 201 | 204 | 1,614 | 0 | 136 | 21 | 0 | 19 |
| Mar-24 | 1,858 | 1,420 | 32% | 222 | 222 | 1,173 | 0 | 150 | 13 | 68 | 11 |

36. It follows that, contrary to what Mr McCabe states in his witness statement, this evidence is not capable of showing that the opponent had acquired a strong reputation and had a market presence in the UK under the mark 'Hiredeck' prior to the relevant date.

37. As regards social media engagement, Mr McCabe says that 'Hiredeck' posts have achieved an impressive number of impressions, namely 625,267 from the opponent's corporate LinkedIn accounts Odro and 'Hiredeck', and 374,526 from 28 'Hiredeck' focussed LinkedIn posts shared via Mr McCabe's personal account *"since the brand was introduced in March 2023".* In support of these statements, Mr McCabe provides screenshots of posts mentioning 'Hiredeck'.[4] However, the evidence about the posts shared from Mr McCabe's account is not particularly helpful because the posts are undated and, as such, do not establish use prior to the relevant date of 17 September

[3] Exhibit A
[4] Exhibits B1 and B2

2023. Even taking into account that the posts indicate the date when they were published as “number + mo” and/or “number + d” which, I understand, says how old (in terms of months and days) the posts were when they were visualised and printed (for the purpose of being included in the exhibits), many posts shown in evidence seem to have been published after the relevant date of 17 September 2023 because they are attributable to a few day days or months prior to the printing date, which I can only assume is 4 April 2024 (this is the date of Mr McCabe’s witness statement). Further, bearing in mind that Mr McCabe refers to 28 LinkedIn posts published ***since*** March 2023, it is not clear how many of these posts were published (and corresponding impressions achieved) prior to the relevant date of 17 September 2023.

38. Admittedly, the evidence about the posts shared from the opponent’s corporate LinkedIn accounts Odro and Hiredeck is more detailed because it shows the date the campaigns were run, and the impressions that each campaign achieved. However, my understanding is that social media impressions measure visibility (i.e. how often content is displayed and appears on someone’s screen, even though the user scrolls past it) and does not demonstrate (or guarantee) engagement, let alone customers in the UK – and, again, the point about the opponent trading globally also raises the question of the geographic origin of the social media impressions.

39. Lastly, Mr McCabe says that since announcing ‘Hiredeck’, the opponent has expended £7,086 on promoting LinkedIn posts and an additional £3,156 on Google ads to bolster their online presence. Whilst it is not clear what proportion of this investment can be allocated to prior to the relevant date, the evidence about the posts shared on the opponent’s corporate account shows that between 9 April 2023 and 22 June 2023 (prior to the relevant date) the opponent spent £1,928.60 in promoting ‘Hiredeck’ related marketing material.

40. In addition to the above, Mr McCabe provides a Hiredeck Customer Waiting List[5] comprising 456 customers stating that it serves *“as a testament to the substantial interest and demand in the market for [the opponent’s] product, from its initial announcement in March 2023 to its official launch in July 2023”.* Notably, this sentence

[5] Exhibit C

reveals that the launch of the 'Hiredeck' software product occurred in July 2023 (although the exact date is not clear), which would be approximately two months prior to the relevant date. Mr McCabe also says that the list comprises *"customers from around the globe, showcasing the international appeal of Hiredeck"*, however, since details such as the company name, the telephone number, and the name of the country in which these customers are based have been redacted from the list, this evidence is not very helpful because it does not show (i) how many companies on the waiting list are UK companies and (ii) whether any of the companies listed had become a customer of the opponent's 'Hiredeck' product prior to the relevant date.

41. As regards the sales achieved under the mark 'Hiredeck' Mr McCabe states as follows:

> *"To date, we have generated over £70,000 in contractual revenue under the Hiredeck brand. This revenue is derived from a blend of 12 and 24-month agreements, underscoring the long-term commitment and trust our customers place in Hiredeck. The sales recognised to date do not only demonstrate the product's profitability but also its acceptance and value in the market. Detailed sales data and records that corroborate these achievements are provided in Exhibit D. This evidence of financial success is a clear indicator of the strong market presence and goodwill that Hiredeck has established".*

42. In addition, Mr McCabe provides the following sales figures:

**Breakdown of Hiredeck Sales**

| Month | Contracted Revenue (Sales) | Turnover |
|---|---|---|
| Jul-23 | £ 6,960 | £ 576 |
| Aug-23 | £ 696 | £ 639 |
| Sep-23 | £ 6,960 | £ 1,222 |
| Oct-23 | £ 2,088 | £ 1,399 |
| Nov-23 | £ 1,044 | £ 1,432 |
| Dec-23 | £ 17,400 | £ 3,426 |
| Jan-24 | £ 33,600 | £ 4,661 |
| Feb-24 | £ 1,872 | £ 4,722 |
| **Total** | **£ 70,620** | **£ 18,077** |

43. Bearing in mind that the relevant date is 17 September 2023 and that the sale figures for September 2023 are not broken down and cannot be taken into account (because it is impossible to know what proportion of the September 2023 sales were achieved prior to the relevant date), the most that can be said is that prior to the relevant date the opponent sold £7,656 worth of 'Hiredeck' products (£6,960 for July 2023 + £696 for August 2023). However, since Mr McCabe also says that the customer's waiting list include non-UK customers, it is impossible to establish that the sales achieved up to the relevant date are all sales to UK customers.

44. Admittedly, Mr McCabe provided copies of invoices but only 5 of which relate to sales to UK customers (customers' details have ben redacted) prior to the relevant date and are for the following amounts: £174 (18 units), £278 (17 units), £174 (18 units), £278 (17 units) and £69 (2 units) for a total value of £695 and 72 units sold. Within the exhibit Mr McCabe argues as follows:

> "*Included below are a sample of invoices that document the sales transactions of Hiredeck. It is pertinent to highlight that while some invoices relate to periods post the applicant's registration date, their inclusion is warranted. This is because they correspond to sales from engagements with customers initiated prior to the registration date, thus evidencing a continuity of business relations and goodwill buildup starting from before the product's launch in July 2023. The*

*notable increase in sales month over month, attributable to enhanced market visibility and the solidifying reputation of the Hiredeck brand, further underscores the established goodwill associated with our mark. This detail is critical to our counterargument in the ongoing trademark dispute, illustrating the sustained and growing market acceptance and recognition of Hiredeck."*

45. Whilst the argument made by Mr McCabe might be critical to the opponent's case, it cannot compensate for the scarcity of specific evidence of sales and marketing under the earlier sign in the UK prior to the relevant date. In my view, Mr McCabe's argument is simply an attempt to bolster the strength of opponent's claim in a way that is not reflected in the evidence and/or in the case law. Leaving aside the fact that Mr McCabe's reasoning does not reflect the principle that goodwill must subsist at the relevant date, there is no information or evidence about what sales generated after the relevant date are attributable to engagement with customers initiated prior to the relevant date.

46. The rest of the evidence produced by Mr McCabe relates to an online article dated 19 May 2023[6] about the opponent planned launch of 'Hiredeck' with the product being described in the article as a *"shortlisting portal".* The article is said to have been published on the 'TALiNT International Magazine' and by the 'AIM Group' in May 2023, however, it is unclear whether it was accessible in the UK (and, if so, how many UK users accessed it).

47. Finally, Mr McCabe talks about the carrying out of *"webinars aimed at promoting Hiredeck and enhancing the overall brand awareness of Odro Ltd."* In particular, he states that *"while not all webinars were exclusively focused on Hiredeck, each one is pertinent as they either directly mentioned the product or were associated with Hiredeck due to the strong link with Odro"* claiming that *"this aspect is crucial in bolstering [the opponent's] argument regarding the substantial goodwill accrued for Hiredeck."* As it can be seen from the table reproduced below, there were four webinars prior to the relevant date, however, only one relates to 'Hiredeck'. Further, there is nothing to indicate what proportion of the participants were UK-residents which

[6] Exhibit E

is particularly crucial given the opponent's evidence that it trades globally. Finally, it is not clear how much focus (if any) was given to the mark 'Hiredeck' in the context of the other webinars whose title does not refer to the mark:

| Webinar Title | Date | Attendees |
|---|---|---|
| Level Up Your Candidate Submissions with Hiredeck | 11th March 2023 | 150 |
| Back to the Future of BD | 29th March 2023 | 150 |
| Beware Robots, The Humans Are Coming | 15th June 2023 | 106 |
| How Recruiters Can Master the Art of Selling | 23rd Aug 2023 | 158 |
| Stop Selling Your Solution, Sell Your Value | 12th Oct 2023 | 168 |
| Get Brandy for Christmas | 28th Nov 2023 | 152 |
| The Perfect Pitch: Speccing for Success in 2024 | 31st Jan 2024 | 252 |
| | | **1,136** |

48. In his witness statement, Mr McCabe also mentions two further points.

49. First, he says that C. P., an employee of the applicant attended one of the opponent's webinars in August 2023 which occurred before the applicant applied for the contested mark 'Hiredeck'. This fact, Mr McCabe states, demonstrates that the applicant was aware of the opponent and its use of the sign 'Hiredeck'. In this connection, Mr McCabe states as follows:

> *"This participation underscores the recognition of Hiredeck within the industry and supports our position that substantial goodwill had been established in respect of Hiredeck prior to [the applicant]'s registration attempt. This context is essential in demonstrating the pre-existing knowledge and acknowledgment of the Hiredeck brand by [the applicant], thereby reinforcing our claim to the goodwill and market recognition garnered by Hiredeck. A summary of the webinars conducted, along with a breakdown of attendance, has been compiled and is included in Exhibit F".*

50. The key thing to note in relation to the above statements is that the evidence filed does not establish the basic facts that are alleged. Firstly, there is no evidence that an individual called C.P. attended the webinar that took place in August 2023. Secondly,

there is no evidence that such individual was employed by the applicant at the time he attended the seminar. Thirdly, the list of webinars exhibited by Mr McCabe indicates that only one seminar took place in August 2023 and that the title of that seminar was "*How Recruiters Can Master The Art Of Selling*" – hence, it is not even clear whether any reference to the mark 'Hiredeck' was made during the webinar in relation to the relevant product. In any event, even if the evidence was sufficient to establish that someone from the applicant's company had attended one of the opponent's webinars and copied/misappropriated the opponent's sign 'Hiredeck', that fact (1) does not establish goodwill and/or market recognition in the UK and (2) it is well establish that intention to deceive can be relied upon to infer misrepresentation, not goodwill.[7]

51. Another point mentioned by Mr McCabe is that the opponent spent a total of £764,550 in development-related costs linked to the brand 'Hiredeck'. This sum, Mr McCabe argues, includes expenditures on staff, utilities, and software, all pivotal in the creation and refinement of 'Hiredeck'. Whilst Mr McCabe says that these expenses are documented in the applicant's "*research and development claim submission to HMRC, covering the period from 1 February 2023 to 31 December 2023",* he provided no evidence of this, simply offering to supply a copy if required. I do not think that the evidence about development-related costs, even if present, would assist the opponent, because goodwill is created by customers and such evidence would not be about consumers. Further, as these are adversarial proceedings, it is neither my, nor the Tribunal's job, to request a party to provide additional evidence to support their case.

**Conclusions on goodwill**

52. There are some preliminary factual observations that are relevant to the issue of goodwill.

53. The first observation I would make is that Mr McCabe's witness statement contains a number of statements that clearly inflate what the evidence establishes. However, these claims do not really assist the opponent if are not supported by sufficiently solid

[7] *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL)

evidence. The second observation is that the evidence of use appears to relate to goods and services which do not fall within the services claimed.

54. I have set out the evidence at some length above. Based on what Mr McCabe states in his witness statement and the document filed, it can be concluded that the only product in relation to which the opponent has used the mark 'Hiredeck' is a software designed for recruiters[8]. Although the product was announced in March 2023, it was not lunched until July 2023 which is only two months prior to the relevant date.

55. Admittedly, the opponent sold a number of products in the UK prior to the relevant date for a total of just under £700 to five different consumers (this is the best scenario for the opponent as the consumers' details have been redacted and it is not possible to say whether the sales documented by the invoices were sales to different customers or repeat sales). The documented sales which are to UK customers and fall prior to the relevant date are for products described as 'Hiredeck Pro License' with a price tag of £29 per unit. Although the opponent does not explain how its business is operated, Mr McCabe's reference to the sales involving *"a blend of 12 and 24-month agreements"* and the description of the product on the invoices as 'Hiredeck Pro License' suggest that the revenue is generated by the provision of services which I would describe as the 'granting of software license'. However, such use is not use in relation to the claimed recruitment and employment services in class 35; neither is it use in relation to the claimed Software as a Service (SaaS) in class 42 because there is no evidence that the opponent provides its software product through a cloud-based software delivery model. This would be sufficient to find that the opponent has not demonstrated use and goodwill in relation to the services claimed.

56. However, even if the opponent had actually used the earlier sign in relation to the services claimed, the evidence does not establish sufficient goodwill to sustain a passing off action. The sales and unit figures are too low, the length of use is too short, and the number of consumers who have purchased the relevant services prior to the

[8] See for example a Twitter post (dated 22 May 2023) from a company called AIM group with non-UK addresses describes the opponent as "video recruitment software provider" corroborating my impression that the early sign has been used in relation to a software product.

relevant date is too minuscule. Even combined with the evidence of marketing and social media engagement this evidence does not establish a more than trivial goodwill. This is because first it is not clear whether an advertising campaign featuring a mark can create a protectable goodwill without any actual sales to UK customers and second the pre-launch activities consist of a number of social media posts and is far from being significant. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 66 of the judgment) that*:*

> "Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the "hard line", in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the "hard line", it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to "spike" a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises. Assuming that such an exception exists, I do not consider that the existence of such a limited, pragmatic exception to the "hard line" could begin to justify the major and fundamental departure from the clear, well-established and realistic principles which PCCM's case would involve. In this case, PCCM's plans for extending its service into the UK under the NOW TV mark were apparently pretty well advanced when Sky launched their NOW TV service, but the plans

were still not in the public domain, and therefore, even if the exception to the "hard line" is accepted, it would not assist PCCM.

57. It appears to be clear that advertising under a mark is not sufficient to create an actionable goodwill where there was no imminent prospect of trade commencing at the time: *Bernadin (Alain) et Cie v Pavilion Properties Ltd* [1967] RPC 581. Pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228, but as explained in paragraph 3-156 of *Wadlow on the Law of Passing Off,* 6th Ed., the plaintiffs in these cases had long established businesses and goodwill in the UK, which is not the case here. The real issue was whether their new marks had become distinctive of those businesses to their UK customers through advertising alone. Until the law is clarified, it is therefore doubtful whether a business with no sales to UK customers can establish a passing off right based solely on advertising.

58. Accordingly, the opponent having failed to establish sufficient goodwill to sustain its passing off action, the opposition fails at the first hurdle.

**OUTCOME**

59. The opposition has failed, and the application will proceed to registration.

**COSTS**

60. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,100 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a counterstatement and considering a notice of opposition: £400
Filing evidence
And considering the other party's evidence: £700
Total: £1,100

61. I therefore order Odro Ltd to pay Job Deck Ltd the sum of £1,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 30th day of January 2026**

**TERESA PINTO**
**For the Registrar**