

o/0188/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003928770

BY MARY-JANE PETTIT

FOR THE FOLLOWING TRADE MARK:

Pioneering People

IN CLASS 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507053

BY NET-RECRUIT.CO.UK LIMITED

TRADING AS PIONEERING PEOPLE

BACKGROUND AND PLEADINGS

1. Mary-Jane Pettit (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the Contested Mark”) in the UK on 30 June 2023. It was registered on 27 October 2023 for the following services:

Class 35 Recruitment (Personnel -); Recruitment of personnel; Personnel recruitment; Recruitment services; Recruitment and placement services; Temporary assignment of personnel; Placement of temporary personnel; Recruitment of temporary personnel; Temporary assignment of employees; Temporary personnel placement services; Temporary personnel employment services; Placement of staff.

2. On 27 February 2024, Net-Recruit.co.uk Limited trading as Pioneering People (“the applicant”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”) based upon sections 5(4)(a) and 5(4)(b).

3. Under section 5(4)(a), the applicant relies upon the following signs:

1. The **Pioneering People** sign which the applicant claims to have used throughout the UK since 2018 for the same services contained in paragraph 1 of this decision.
2. The following sign which the applicant claims to have used throughout the UK since 2022 for the same services contained in paragraph 1 of this decision:



4. The applicant claims that use of the proprietor’s mark would be contrary to the law of passing off.

5. Under section 5(4)(b), the applicant relies on the above two signs listed in paragraph 3, and the following 2 further signs:



6. The applicant claims that the **Pioneering People** word only sign was “devised in 2018” and “later developed and finalised in collaboration with a brand designer in November 2021”. The applicant claims that the remaining 3 word and device signs were “developed in collaboration with a brand designer between 2018 and 2022”, being “finalised in 2022”. The applicant claims that it is the owner of the works relied upon and that these are highly similar to the contested mark, which would “create confusion” and the “public will believe there is a connection” between the parties, which is “likely to cause damage to the applicant’s reputation”.

7. The proprietor filed a counterstatement denying the claims made.

8. The proprietor is represented by Jonathan Roy Waters and the applicant is represented by The Trademark Helpline. Only the applicant filed evidence in chief. Neither party requested a hearing, however, the proprietor filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

9. The applicant’s evidence consists of the witness statement of Les Warburton dated 23 September 2024. Mr Warburton is the Director of the applicant, a position he has held since 24 June 2005. His statement is accompanied by 10 exhibits (LW1-LW8).

10. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(4)(a)

11. Section 5(4)(a) of the Act states as follows:

“5(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”.

12. Subsection (4A) of section 5 of the Act 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.”

13. 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)."

Relevant date

14. 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, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated 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.'"

15. I note that within the proprietor's counterstatement they claim that "the name 'Pioneering People' has been used by them since, at least, 2015" and "therefore, considerably *predates* any use of the same name" by the applicant. However, the proprietor has not provided any evidence of use to support this.

16. I also bear in mind that section 4.5 of the Tribunal Section of the Trade Marks Manual considers defences in invalidation proceedings. The viability of a defence

based on the use of a trade mark under attack which predates the date of use of the attacker's mark (i.e. the applicant) was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O/-211/-09. Ms Carboni rejected the defence as being wrong in law.

17. Therefore, taking all of the above into account, I have only the prima facie relevant date to consider i.e. 30 June 2023.

Goodwill

18. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

19. 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; 54 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.”

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

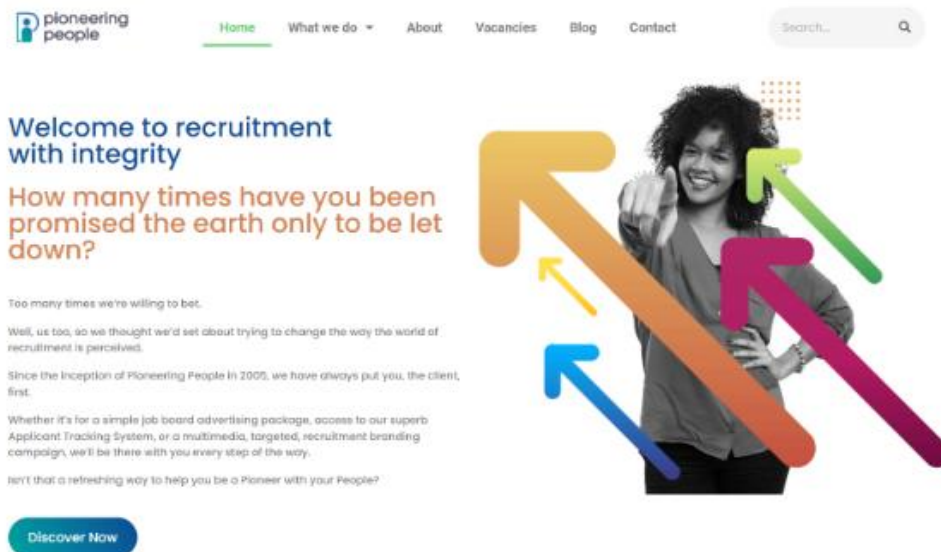
“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed 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.”

21. In his witness statement, Mr Warburton states that he has set out a timeline of the creation of Pioneering People in order to demonstrate their “earlier copyright”. There is nothing within the witness statement that mentions filing evidence in support of its claim under section 5(4)(a). Nevertheless, if the evidence filed in support of its copyright claim could pertain to its passing off claim, I would be entitled to review such evidence here.

22. I bear in mind that the entirety of Mr Warburton's evidence shows the evolution of the applicant's rebranding from “Net-Recruit” to “Pioneering People”. For example, **exhibits LW1 to LW5** contain rebranding presentations and evidence of the purchase and development of its new webpages. The proprietor highlights that this therefore is “purely internal and not in the public domain”.¹ Nevertheless, **exhibit LW5a** contains

¹ Point 2 of the proprietor's written submissions contained within an email dated 19 November 2024.

the following iteration of the applicant's pioneeringpeople.co.uk website, which was live to the public, dated 2 November 2022:



23. The above screenshot appears to be the earliest evidence of public facing use of the applicant's marks that could have generated custom in the UK.

24. Mr Warburton states that on 7 November 2022, a "draft email was created ahead of the soft launch of the new Pioneering People" website, and the "rebrand was communicated to all existing and new partners throughout November 2022". I note that **exhibit LW6** contains the draft email which confirms that "Net-recruit.co.uk is now Pioneering People" and that the website has been updated to go along with their new brand design.

25. **Exhibits LW5a** and **exhibit LW6** contain the only evidence which pertains to the applicant's public facing use of its mark. However, this evidence is extremely limited on the basis that;

- a) The applicant has not provided any supporting evidence to show UK user engagement with its website.
- b) The applicant has not confirmed how many UK customers were sent the email confirming the rename of its brand to "Pioneering People".

26. I also bear in mind that goodwill arises as a result of trading activities, and the most solid and sufficient evidence to demonstrate this would be to provide turnover figures and supporting invoice evidence, to show the sale of its services to its UK customers. However, I do not have any of this evidence before me, which should have been available and relatively easy to provide. Therefore, taking all of the above into account, I find that the applicant has failed to establish that they enjoyed any goodwill in their business at the relevant date. The applicant's reliance upon 5(4)(a) of the Act fails as, without goodwill, there can be no misrepresentation or damage.

27. The invalidation claim brought under section 5(4)(a) fails.

Section 5(4)(b)

28. Section 5(4)(b) of the Act 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 –

[...]

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.

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.”

29. The law of copyright in the United Kingdom is governed by the Copyright, Designs and Patents Act 1988 (“CDPA”), and in accordance with this, I must assess the following questions:

1. Is the earlier mark a work that is capable of being protected by copyright?
2. Who is the owner of the work and when was it created?

3. Does the work meet the qualification criteria for copyright protection?
4. Would use of the contested mark constitute an infringement of any copyright?

Is the earlier mark a work capable of being protected by copyright?

30. Section 1 of the CDPA states that:

“Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–

- (a) original literary, dramatic, musical or artistic works,
- (b) sound recordings, films or broadcasts, and
- (c) the typographical arrangement of published editions.”

31. Section 4 of the CDPA is as follows:

“(1) In this Part ‘artistic work’ means-

- (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
- (b) a work of architecture being a building or a model for a building, or
- (c) a work of artistic craftsmanship.

(2) In this Part –

[...]

graphic work’ includes –

- (a) any painting, drawing, diagram, map, chart or plan, and
- (b) any engraving, etching, lithograph, woodcut or similar work;

[...]”

32. As noted in paragraphs 3 and 5 above, the applicant relies upon 4 alleged works, that being the words “**Pioneering People**” and the following 3 logo devices:



33. In *Griggs Group Ltd v Evans*, [2003] EWHC 2914 (Ch), Peter Prescott QC, as a deputy judge of the High Court, said:

“17. Copyright law protects the skill and labour that has gone into the creation of an original work. A simple word or phrase, like ‘Dr Martens’, is not capable of being copyright, and for two reasons. First, it is not a ‘work’. Secondly, and in the ordinary way, its creation does not imply sufficient literary skill or labour. So no-one has ever had a copyright in the phrase ‘Dr Martens’, as such.

18. However, a drawing is capable of being a ‘work’. So if an artist uses his skills and labour to draw a word or phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law. Unauthorised persons are not entitled to copy it. This is so irrespective of whether the logo has ever been used by way of trade, and irrespective of whether it is known to any members of the public. Of course, the artist gets no copyright in the word or phrase, as such.”

34. In regard to the alleged work “**Pioneering People**”, this consists of two words, presented in a standard typeface, with no stylisation. Applying the case law cited above, I am not persuaded that it is an artistic work under the CDPA. On this basis, the claim under section 5(4)(b) based upon the words “**Pioneering People**” fails. However, in regard to the remaining 3 logos, I consider that these are graphic works capable of being protected by copyright. Therefore, I will proceed to consider the invalidation claim under section 5(4)(b) for the 3 logos only.

The creation and ownership of the work

35. In his witness statement, Mr Warburton states that “in late 2018 Clair Heaviside, a branding specialist, was contracted to work on rebranding Net-Recruit with the aim of evolving the brand”. Mr Warburton states that the outcome of this work is contained in **exhibits LW1** and **LW2**. **Exhibit LW1** contains a presentation which is titled “brand proposition”, which proposes the name “Pioneering People”. The last page of the presentation is signed off with the name “Clair Heaviside”. However, the logo works relied upon is not contained within this exhibit. **Exhibit LW2** contains an “identity development” presentation by “Studio Up North” for Net Recruit dated 30 November 2018. The presentation contains a “naming investigation” which presents the name “Pioneering People”, and the following branding “concepts” for the applicant which appears to be 3 potential logo ideas:



36. However, none of the above logos mirror the logo works that the applicant relies upon in these proceedings.

37. Mr Warburton states that as part of the rebranding process, “three domain names were secured by Clair Heaviside on behalf of the applicant” on 11 December 2018 which is exhibited in **LW3**. **Exhibit LW4** also contains an invoice from Clair Heaviside to the opponent due on 19 December 2018, which lists the purchase price for the

domain names as £51.55 and her “NR branding, proposition & web design” services are priced at £2,600.00.

38. Clair Heaviside carried out further branding development in November 2021, whilst she was employed by Serotonin Digital Ltd. The outcome of this is exhibited within **LW4a**, which contains a presentation titled “Brand Development and Web Proposal for Pioneering People”. However, there is nothing within this presentation which depicts the applicant’s logos, and there is also no mention of any plans to create a figurative logo. Nevertheless, the presentation makes reference to the web design of the applicant’s website, and an iteration for the proposed Pioneering People website was drafted and sent to the applicant on 23 March 2022. This is exhibited in **LW5**. However, again, there is no use of the applicant’s logos. The only evidence which depicts the applicant’s logos is contained within **exhibit LW5a**,² which shows the logo depicted at paragraph 32(1) being used on the applicant’s live website on 2 November 2022 (as shown in paragraph 22 above).

39. In its statement of grounds, the applicant states that its logos were developed in collaboration with a brand designer between 2018 to 2022, being finalised in 2022. This within itself does not clearly identify who created the works, and when they were specifically created or finalised. Moreover, none of the exhibits expressly shows who created the relied-on logos nor when they were created. However, this information is imperative in determining if the applicant owns the copyright of the works being relied upon.

40. For the sake of completeness, I note that the witness statement of Mr Warburton and his accompanying evidence makes it clear that the applicant hired Clair Heaviside for her brand designing services. She was “contracted” to make the brand presentation in late 2018,³ and when she was employed by Serotonin Digital Ltd, she carried out further branding development in November 2021.⁴ However, as noted above, neither of her presentations mention or depict the applicant’s logos. Nevertheless, it is

² **Exhibit LW1a** also contains depictions of the applicant’s logo, but this exhibit shows a list of what Mr Warburton states is “the earlier copyright belonging to the applicant”.

³ **Exhibit LW1**

⁴ **Exhibit LW4a**

important to bear in mind section 9 of the CDPA which sets out that the author of a copyrighted work is the person who creates it, and section 11(2) of the CDPA which states that;

Where a literary, dramatic, musical or artistic work [or a film,] is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to any agreement to the contrary.

41. Section 90 of the CDPA also confirms that copyright is transmissible by assignment, and it must be in writing signed by or on behalf of the assignor. The absence of such a deed does not mean that the applicant's claim must fail but I must be satisfied on the evidence that the applicant is the author of the work.

42. I have not been provided with any evidence such as a deed of assignment between either Serotonin Digital Ltd and the applicant, or Clair Heaviside and the applicant. While the invoice from Clair Heaviside dated December 2018 lists the "NR branding, proposition & web design service" which could have included the creation of the applicant's logo marks, I do not consider it reasonable to infer that this invoice would cover its creation (or its assignment), on the basis that:

- a) Mr Warburton does not confirm in his witness statement that Clair Heaviside created the logos.
- b) The 2018 presentation created by Clair Heaviside does not use or make reference to the applicant's logos.
- c) The invoice itself does not expressly mention the creation (and the assignment) of the logos.

43. I therefore find that based on all of the above, there is nothing before me that confirms or allows me to be satisfied that the applicant is the author of the 3 relied-on works. On this basis, the applicant is not permitted to rely on the logo works, and the invalidation claim fails under section 5(4)(b).

CONCLUSION

44. The application for a declaration of invalidity has failed in its entirety and the proprietor's trade mark will remain registered.

COSTS

45. The proprietor has been successful in these invalidation proceedings, and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the proprietor the sum of £350 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the application for invalidity and preparing a counterstatement	£250
Filing written submissions in lieu	£100 ⁵
Total	£350

46. I therefore order Net-Recruit.co.uk Limited trading as Pioneering People to pay Mary-Jane Pettit the sum of £350. 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 5th day of March 2026

L FAYTER

For the Registrar

⁵ This award is lower on the scale on the basis that the submissions provided were extremely short.