O/0207/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO.

4022943

BY SPEEDCRETE CP LTD

TO REGISTER THE TRADE MARK:

IN CLASSES 7, 8 AND 39

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 448266

BY S & G TRANSPORT

BACKGROUND AND PLEADINGS

1. On 7th March 2024, Speedcrete CP Ltd ("the applicant") applied to register the trade mark shown on the cover of this decision in the United Kingdom. The application was accepted and published in the Trade Marks Journal on 22nd March 2024, with specification amendments published on 21st June and 28th June of the same year. The specification, as it currently stands, is in respect of the following goods and services:

   Class 7: *Mechanical tools, all being work tools for use in construction.*

   Class 8: *Hand tools, namely construction tools.*

   Class 39: *Delivery of goods, all being work tools, equipment for use in construction, consumables, chemicals and ancillary products.*

2. On 21st June 2024, S & G Transport ("the opponent") opposed the application based on Section 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The oppositions are directed against all the goods and services. The opponent relies upon the mark shown below: [1]

3. The opponent claims to have used this sign throughout the UK since April 2018 in respect of *"Transport; Haulage services"* but also argues that, due to its customer base being in the construction industry, its use also touches upon goods in classes 7 and 8, namely *"Mechanical tools, all being work tools for use in construction"* and *"Hand tools, namely construction tools".*

4. The opponent claims that use of the applicant's mark on the above goods and services would amount to passing off due to the considerable reputation and

[1] The opponent's witness statements and written submissions depict its mark in greyscale. However, for clarity, my assessment of the mark is based on the mark as submitted with the TM7 form (as shown above).

goodwill it has accumulated, and that this use would cause damage to its goodwill, resulting in financial loss and reputational damage.[2]

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of goodwill. Further, it claims to have been using the contested mark since 2016, approximately two years earlier than the first use being relied upon by the opponent.

6. In these proceedings, the opponent is represented by Michelmores LLP and the applicant by Humphreys & Co.[3] Both parties filed evidence in these proceedings. No hearing was requested though both sides provided written submissions in lieu of a hearing. This decision is taken following careful consideration of all the papers before me. I have not summarised the evidence or submissions in full but will refer to these to the extent that is necessary.

7. 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.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the first witness statement of Iain Richard Connor, a partner and solicitor at the opponent's representative, Michelmores LLP. This is dated 13th November 2024 and is accompanied by 31 exhibits (Exhibits IC1 to IC31), the aim of which is to prove the opponent's protectable goodwill in its earlier mark. This evidence includes (but is not limited to) the liveries of the opponent's fleet of lorries, its signage, employee uniform, social media excerpts and invoices of sales. Mr Connor's statement also challenges the applicant's claims in relation to its use of the contested mark since 2016. I note that Mr Connor's first witness statement also contains submissions.

[2] Q5 of TM7 dated 21st June 2024.
[3] The applicant appointed its representative via TM33 on 9th September 2024.

However, I do not consider it too onerous a task to separate the opinions of Mr Connor from his statements of fact. Therefore, I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are conveyed in a witness statement accompanied by a statement of truth.[4]

9. The applicant filed evidence in the form of the witness statement of David Nathan Dod dated 17th February 2025, which is accompanied by one exhibit (Exhibit DND1). Mr Dod has worked for the applicant since September 2005 and was appointed a director in 2018. The purpose of the applicant's evidence is to support its claims of earlier use of the contested mark. Examples include details on the development of its mark, photographs to demonstrate use on vehicle liveries and packaging, screenshots of use online (such as on the applicant's website) and copies of email chains and customer invoices.

10. The opponent filed evidence in reply, in the form of the second witness statement of Iain Richard Connor, dated 14th March 2025, which is accompanied by four exhibits (Exhibits IC32 to IC35). This relates to the applicant's "get-up" and the creation of the contested mark. The exhibits comprise third party images of devices with the intertwined letters 'SC', which the opponent uses as a basis to challenge the originality of the contested mark.

PRELIMINARY ISSUE

11. As summarised above, the opponent claims Exhibits IC32 to IC35 show third party devices with the intertwined letters 'SC' which it deems are the same (or at least very similar) to the applicant's contested mark. It subsequently uses this as a basis to put the applicant to proof that its earlier mark "was an original work such that SO Marketing owned the purported rights in the Mark and was able to assign them to the Applicant", in reference to the copyright assignment provided by the applicant at Exhibits DND1 (pages 17-20).[5] However, the applicant's rights in its mark (and the originality of that mark) are not relevant to my assessment of the applicant's

[4] The same applies for Mr Connor's second witness statement, as introduced at paragraph 10.
[5] Paragraph 15 of Mr Connor's second witness statement dated 14th March 2025.

evidence – which is solely focussed on determining the relevant date for the purposes of section 5(4)(a). Therefore, these matters are not relevant to the case before me and I will not consider them further.

DECISION

12. 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."

13. 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."

The principles

14. 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)."

The relevant date

15. In *Maier & Anor* v *ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

> 165. … Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd* v *The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began."

16. The parties are in disagreement regarding the relevant date on which to assess the merits of the opposition. The opponent deems this as the date on which the application was made to register the contested mark and rejects the applicant's

"false premise" that its earlier trading with the mark is also relevant.[6] The filing date of the contested mark is 7th March 2024. However, the applicant claims that it has used its mark since 2016.

17. The onus is on the opponent to make out its prima facie case. Therefore, I will first consider the opponent's evidence to ascertain what protectable goodwill (if any) resided in its business to sustain its claim for passing off. Following this, I will turn to the applicant's claims regarding earlier use and what this means for the relevant date.

Goodwill

18. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in the sign relied upon as at the prima facie relevant date. I remind myself that the opponent claims that its sign enjoys goodwill through its use on the following goods and services:

> *Transport; Haulage services; Mechanical tools, all being work tools for use in construction; "Hand tools, namely construction tools"*

19. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

> "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."

20. 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

[6] Paragraph 15 of witness statement and paragraph 5.5 of written submissions.

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."

21. 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."

22. I also bear in mind the guidance 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."

23. 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.

24. Mr Connor's first witness statement details that the opponent has operated a haulage and transport business since at least April 2018. This is based in Devon, with a particular focus on the South West region, operating out of core distribution centres in Bridgwater and Avonmouth, but having carried out deliveries across the

UK, including Scotland.[7] Mr Connor states that there are currently 10 vehicles within the opponent's fleet. I have no indication regarding how many were operating from April 2018 (the opponent's earliest claimed use) to 7th March 2024 (the filing date of the contested mark), although Exhibit IC5 is dated 8th April 2018 and shows one of the opponent's lorries. This post is from the Facebook account of Stefan Maunder, who Mr Connor explains is one of the founding partners for the opponent and corroborates the existence of at least one lorry bearing the opponent's mark at that point in time.

25. Further photographs at Exhibits IC6 and IC7 also show vehicle liveries, dated from 2020 and 2023 respectively. The latter does not depict the mark on any of the three vehicles (lorry cabs only) shown, though it is present on an event gazebo in shot within the second image (also seen at Exhibit IC13). I note that the mark used in Exhibit IC5 and IC6 is in greyscale and therefore differs from the mark as claimed, though I do not consider this alters the distinctive nature of the mark, which remains in the 'S&G" letters and (albeit to a lesser extent) the word "TRANSPORT". [8] Similarly, the mark used at Exhibit IC7 is in a white and blue colourway (rather than the grey and blue claimed) but again, it is my view that nothing turns on this.

26. Mr Connor asserts that "A large amount of the Opponent's advertising is achieved by the fact that its liveried vehicles and the drivers wearing workwear featuring the Logo are seen not only in the Devon area but throughout the UK which generates business enquiries".[9] Exhibit IC8 is also provided in relation to vehicle liveries. It shows an estimate for signage and the opponent's expenditure to "AS Signs" between 2020 and 2024, although this does not give a clear indication of how many vehicles were operational during this time or which payments relate to vehicles only, not buildings. There is documentation at Exhibit IC8 which Mr Connor explains is "an estimate of their costs to replace the Logo on all of the Opponent's vehicles / trailer liveries and signage".[10] Though it is not clear from the exhibit or the narrative within Mr Connor's witness statement whether the 'replacement' work

[7] Paragraphs 12 and 19.1.
[8] This is also the case for the mark shown in Exhibits IC12 and IC17.
[9] Paragraph 18.4 of witness statement.
[10] Paragraph 17.2 of witness statement.

estimated was carried out. Even so, the estimate documentation is dated 8th November 2024 and therefore post-dates the application date of the contested mark (the prima facie relevant date).

27. Exhibits IC9 and IC10 relate to uniform. Exhibit IC9 is undated and the invoice at Exhibit IC10 falls after the application date of the contested mark so these do not assist the opponent. Other exhibits are also out of scope due to being after the prima facie relevant date or undated. Exhibits IC15 (branded merchandise), IC16 (business card) and IC18 (email footer) are undated, though I note the business card depicted at Exhibit IC16 belongs to Adam Day, who Mr Connor confirms was not hired by the opponent until June 2024, again post-dating the prima facie relevant date.[11] Similarly, Exhibit IC19 relating to the opponent's accreditation under the 'Fleet Operator Recognition Scheme' is valid only from 22nd October 2024.

28. The bulk of the remaining exhibits relate to social media. Exhibit IC11 is a social media post from 2019 showing the opponent's logo on signage outside of its offices in Devon and garnering 34 'likes' from Facebook users. I have no further figures regarding the reach of this particular post, though Exhibit IC17 shows the opponent's Facebook page was created on 25th October 2019 and had amassed 3,600 followers by 12th November 2024. Exhibits IC12 and IC14 pre-date the prima facie relevant date and relate to the opponent's sponsorship of sports teams local to Devon.

29. In terms of actual sales, the opponent provides information regarding annual turnover for 2019-2024. This is in the form of tax returns provided at Exhibits IC21 and IC28-31. These are summarised as follows:

Financial Year (1st April to 31st March)	**Turnover (GBP)**
2019-2020	427,553
2020-2021	697,696
2021-2022	1,087,242

[11] Paragraph 18.3 of witness statement.

2022-2023	1,421,059
2023-2024[12]	1,379,515

30. These figures are accompanied by evidence of sales in the form of 13 invoices at Exhibits IC22-27.[13] There is no further narrative regarding these in the witness statement, though they appear to be a sample covering 2019-2024 (three for 2019, then two per year following this). All relate to a single customer, "Gregory Distributions LTD" with the same "BILL TO" and "SHIP TO" address based in Devon. There appears to be multiple 'jobs' on each invoice, with unique reference numbers. I recall that Mr Connor confirmed within his witness statement that the opponent conducts deliveries across the UK, but the invoices to not feature any further information on other geographical locations (beyond the Devon address) or any other parties.

My assessment of the opponent's evidence – is there protectable goodwill?

31. In terms of advertising, the evidence focusses on vehicle liveries, staff uniforms (which the narrative evidence confirms are the main source of advertising) and social media presence. As highlighted a paragraph 27, the uniform evidence is not clearly dated prior to the prima facie relevant date so cannot assist the opponent. In terms of vehicles, the witness statement confirms the logo has been present on all vehicle liveries, with the evidence showing at least one lorry operating by 8th April 2018, at least three by 30th June 2023 and 10 lorries in the fleet at 13th November 2024.[14] On the social media presence, I recall the opponent's Facebook page was created on 25th October 2019, with 3,600 followers as of 12th November 2024. Of the Facebook posts prior to the prima facie relevant date, Exhibit IC13 has the most user interaction, with 187 'likes' and relates to the opponent's promotional gazebo being "truck show ready". I have already highlighted the date

[12] I note that this period runs until 31st March, whereas the prima facie relevant date is 7th March 2024. By including March in its entirety, these figures are generous in favour of the opponent. Though I have no means to break them down further, and I do not consider this significant in the context of the assessment as a whole.
[13] The opponent's mark on invoices in Exhibits IC22-26 are in greyscale and in Exhibit IC27 are in a blue and black colourway. Nothing turns on this, for the same reasoning provided at paragraph 25.
[14] Exhibit IC5, Exhibit IC7 and Mr Connor's first witness statement, respectively. I have already noted it is not clear precisely how many of the 10 vehicles were operating at the prima facie relevant date and have taken this into account.

for this count of 3,600 followers is beyond the prima facie relevant date, and even so (and working on the assumption that these are all UK-based users), I consider this a small following. This is especially so, considering the social media posts are the only evidence provided regarding the opponent's online presence.

32. It is the sales figures which are particularly compelling in favour of the opponent's case. I am satisfied the turnover figures are indicative of a reasonable level of trade, with consistent growth, that would not be considered trivial. As detailed above, the invoices relate to a single customer and appear limited in geographical scope, however they are indicative of repeat custom, which in itself is a factor that can help demonstrate a level of goodwill.

33. Taking all of this into account, I find that the goodwill associated with the opponent's business sits at a protectable level and is sufficient to sustain a claim for passing off. From the evidence provided, in particular the turnover figures and invoices, I am satisfied that the evidence points to this goodwill being established from August 2019, but no earlier.[15] With respect to the goods and services in which the goodwill is vested in, the evidence focusses solely on transport and haulage services (with nothing to substantiate the opponent's claims of a customer base in the construction industry), therefore it is only upon these services that the opposition may proceed. In terms of geographical spread, the invoices of sales relate to a single customer based in Devon and give no further information on the geographical scope of the transport provided. Whilst Mr Connor's witness statement states the opponent has conducted deliveries throughout the UK, I have no corroborating evidence to support this is a frequent (or typical) occurrence, especially since he also confirms the opponent's "particular focus on the Southwest of England".[16] The example advertisements provided (in the form of Facebook posts) relate to sports sponsorship in the Devon area and an event in Malvern, therefore pointing towards localised goodwill. However, as will become apparent, this is not a determinative factor within this opposition therefore I have not considered it further.

[15] I have used Invoice Number 107 at page 2 of Exhibit IC22 as the basis for this.
[16] Paragraph 12 of Mr Connor's first witness statement.

The relevant date (revisited)

34. Having identified the presence and scope of the opponent's protectable goodwill, I will now consider in more detail the issue of the relevant date for this opposition. The applicant acknowledges, prima facie, the relevant date is the date of application (a priority date not being applicable in this case) but directs me to *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 (as also referenced within *Maier & Anor* v *ASOS plc & Anor* which I have already quoted at paragraph 15 above) and *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O/410/11.[17] I bear in mind that, in the latter, Mr Daniel Alexander KC, sitting as the Appointed Person, stated:

> "42. …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 (omitting case references): "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."

35. The applicant also quotes from the same decision, highlighting it endorsed the registrar's assessment of the relevant date 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

[17] Paragraphs 14 and 15 of written submissions.

the position would have been any different at the later date when the application was made.' "

36. I note that the opponent references the exact same extract from the *SWORDERS* case in paragraph 5.20 of its written submissions. Thus, the parties are aligned with regards to the broad principles upon which the relevant date must be determined. Helpfully, the opponent also directs me to relevant caselaw in the form of *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20). As quoted from paragraph 5.21 of the opponent's written submissions:

> "Mr Thomas Mitcheson QC, sitting 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 (here the Applicant) 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 (here the Opponent) could have complained (if it knew about it) as an act of actual or threatened passing off."

37. In relation to the "start of the behaviour complained about", 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. In *Smart Planet Technologies,* Mr Mitcheson KC suggests examples such as the offer to sell goods under the mark or the existence of a branded website with the mark, as considerations. Subsequently (as per *Advanced Perimeter Systems Limited v Multisys Computers Limited*), 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), they will not normally be passing off by continuing to use the mark.

38. As already identified, the prima facie relevant date is the date of application of the contested mark, 7th March 2024. However, the applicant claims to have used its mark much earlier than this – in 2016. Therefore, in line with the above authorities, an earlier relevant date may be applicable, if the behaviour complained of (i.e. this

earlier use by the applicant) commenced prior to the filing date for the contested mark.

39. However, this is not the end of the matter. Despite directing me to *Smart Planet Technologies,* the opponent does not accept that the relevant date for this opposition is the date at which the applicant began trading with the mark. At paragraph 5.22 of its written submissions, the opponent seeks to distinguish this opposition from the *Smart Planet Technologies* case on the basis that the applicant "did not put any goods or services on the market under the applied for Mark in a manner about which the Opponent could complain because the applicant's evidence is that it put goods and services on the market under the Applicant's Get-Up".[18] Further, that the trade mark application was the "first public-facing indication by the Applicant that sales were proposed to be made under the Mark in future".[19]

40. I turn now to the applicant's evidence in relation to its claims regarding its earlier (antecedent) use of the mark, in line with the caselaw above, and in order to determine whether this indeed identifies a date indicating the start of the behaviour being complained about. I will also consider the opponent's criticisms of the evidence during this assessment.

My assessment of the applicant's evidence – is there antecedent use?

41. Mr Dod, within his witness statement, identifies that the applicant's 'SC' logo was created in 2015 as part of a brand refresh exercise and used externally on the applicant's website in early 2016. Screenshots have been provided at Exhibit DND1 via 'The Wayback Machine' Internet archive, with the earliest dated 22nd May 2016.[20] A reasonably modest advertising spend of £4,310 is given for 2016. This stands at £7,101 for 2017. Turnover figures for 2016 are stated at £2,465,215, 95% of which Mr Dod estimates relates to the UK. He identifies that approximately 5-10% of this figure would relate to the applicant's delivery service.[21] Taking 5-10%

[18] Paragraph 5.22 of written submissions.
[19] Ibid.
[20] Page 21.
[21] See paragraphs 9, 10 and 14 of witness statement.

of the estimate for UK turnover, gives a figure in the range of £117,098 to £234,195.[22] The same estimate for 2017 is £126,194 to £252,388. Mr Dod believes that the applicant has three or four direct competitors and estimates a market share of around 10%.[23] A selection of invoices are provided, in relation to sales and hire of goods, spanning 2016-2024.

42. Within Exhibit DND1, there are 21 invoices from 2016, showing a breadth of customers and deliveries across the UK and representing over £18,000 of sales. There are 16 invoices from 2017 also totalling in excess of £18,000. All but two of the invoices from 2016-2017 specifically reference the applicant providing delivery and/or collection services. The earliest invoice is dated 18th April 2016.[24] The applicant draws my attention to two instances where deliveries were made to "Hitchcocks Business Park" (where the opponent's business offices are located). These are dated October 2016 and May 2018, falling either side of the April 2018 date quoted by the opponent regarding first use of its mark. [25]

43. In terms of the opponent's objections to the applicant's evidence, I recall the opponent's primary complaints are that:
    - The applicant "did not put any goods or services on the market under the applied for Mark in a manner about which the Opponent could complain".
    - The applicant's evidence is only that "it put goods and services on the market under the Applicant's Get-Up".
    - The trade mark application was the "first public-facing indication by the Applicant that sales were proposed to be made under the Mark in future".

44. I disagree with the submission that the application date of the contested mark is the first public-facing indication of sales, especially in light of the evidence detailing actual sales of goods and services within the UK from 2016 onwards. The opponent's argument here appears to be that it does not consider it had grounds to complain about the contested mark when used as part of the applicant's wider

[22] Rounded to the nearest £.
[23] Paragraph 22 of witness statement.
[24] Invoice number 54490 on 119 of Exhibit DND1.
[25] An invoice and two delivery notes relating to this can be found at pages 117, 242 and 243 of Exhibit DND1.

branding (what it deems its "get-up") but instead only when used alone, which it claims occurred only at the point of application. It states:

> "…save for one or two exceptions, the Opponent's [sic] use of the mark is always in combination with the word "Speedcrete" or with the word "Speedcrete" in very close proximity. I shall refer to the Mark in combination with the "Speedcrete" branding as the "Applicant's Get-Up".[26]

45. I take this statement as acceptance from the opponent that there was trading activity taking place by the applicant in 2016, though the criticism being that this activity was predominately (I note, not exclusively) using the "Applicant's Get-Up", rather than the mark as applied for. The use which the opponent is objecting to, is focussed on use of the SC logo with additional matter, such as the stylised text "SPEEDCRETE" and slogan. An example is below, as found on the applicant's invoice evidence.

It is not clear to me why the opponent believes only the 'SC' mark being used solus constituted behaviour about which it could complain (other than this being used as its argument for a later relevant date).

46. On this, I bear in mind the following excerpt from *Wadlow on the Law of Passing-Off* 6th Ed., which reads:

> "**5-310**: Needless to say, the conduct complained of must mean the whole course of the defendant's conduct and not just that of which the claimant was aware or chose to plead."

Therefore, the fact that the opponent does not consider the applicant's earlier use as placement of goods or services on the market in a manner about which it could complain, is not a sufficient basis for me to rule this use out.

[26] Paragraph 9 of Mr Connor's second witness statement.

47. I am also mindful that in *CASABLANCA* (BL O/349/16), Mr Thomas Mitcheson KC, acting as the Appointed Person briefly considered the type of use which may amount to antecedent use. This included non-distinctive use, which it was deemed would rarely give rise to antecedent rights.[27] Use of the phrase "Our tea is from Casablanca" in relation to the mark "Casablanca" for goods including tea was provided by the opponent by way of example. However, the applicant's use cannot be considered akin to this, as its 'SC' mark is not descriptive of the goods and services provided.

48. Therefore, I do not find compelling the opponent's argument that only use of the contested mark solus would constitute 'the behaviour complained about', whereas use as part of its larger get-up would not. However, even if I am incorrect in this view, I am still satisfied that the applicant has demonstrated use of its mark, amounting to external acts about which the other party could have complained, from at least 2017. Thus, the applicant's use still pre-dates the opponent's claims regarding first use. I summarise this below:

- Pages 266, 300 and 310 of Exhibit DND1 include email chains dated from 2017.[28] The 'SC' mark can be found within Mr Dod's email signature at the bottom of each of his replies. These emails relate to the procurement of vehicle graphics, advertising and external signage, respectively. I note they are not customer-facing or relating to the sales of goods or services and have therefore weighted this evidence accordingly. Though I have no reason to believe the corporate email signature used would be any different for customer-facing enquiries versus those aimed at suppliers and this particular point is unchallenged by the opponent.

- Page 246 of Exhibit DND1 shows the applicant's Facebook page which details a creation date of 1st March 2017. The 'SC' mark is seen in two instances on

[27] Other types of use were also considered but, again, none are applicable to this case. This included use on goods and services different to those upon which the opposition is based, use outside of the UK and, with an emphasis on the particular facts of the case, internal and sporadic use.
[28] I note the opponent's comments regarding pages 281-291 of Exhibit DND1 detailing correspondence between the applicant and parties outside of the jurisdiction and have excluded this.

the supplied screenshot (taken in 2025). I note that it is possible for the images used within the social media profile to change over time, however use of the 'SC' mark can also be found within a post uploaded on 31st August 2017 (page 248 of DND1), so I am satisfied this instance definitively shows use within 2017.

- Page 270 of DND1 details use on an HGV lorry. This photograph shows two instances of the 'SC' mark being used, one towards the rear of the cab and another near the tailgate. The photo itself is undated, however Mr Dod confirms (at paragraph 18 of his witness statement) that the image is representative of its mark being on vehicles operating across the UK from 2016.

- Finally, I note use of the mark solus on the applicant's website. The earliest example can be found at page 32 of Exhibit DND1, showing an excerpt from the Wayback Machine from 4th January 2017. The mark appears in greyscale though this does not alter the dominant and distinctive character of the mark, which resides in the "SC" device.

49. My assessment of the applicant's evidence has inherently focussed on earliest use of its mark, with an emphasis on 2016-17 in respect of identifying the earliest relevant date. *CASABLANCA* (at paragraph 38) makes clear that if the applicant's activities ceased or changed materially between the date of first use and the date of application of the contested mark then this must be taken into account. For completeness, I am satisfied that this does not apply. The applicant's evidence portrays consistent use beyond 2017, with turnover figures and advertising spends for years spanning 2018 to 2023, and sample invoices from 2018 to 2024.

50. To summarise, I am content that the applicant has demonstrated public-facing use of its mark, marketing and evidence of sales of its transport services from 18th April 2016, which is the date of the earliest evidenced invoice. I do not find the opponent's arguments that only use of the contested mark solus would constitute the behaviour complained of in relation to the caselaw set out at paragraphs 15 and 34 to 36 above. However, even if I am wrong in this finding, I am satisfied that the applicant has demonstrated use of its mark solus from 4th January 2017, the

date of the earliest screenshot depicting the mark solus on the applicant's website. Due to my finding that the opponent's goodwill was established from August 2019, nothing turns on these two dates. Further, had I found in favour of the opponent's best case, with acquired goodwill from the earliest date claimed of April 2018, this would still post-date either of the dates regarding the applicant's antecedent use.

51. The opponent's remaining arguments focus on the applicant having failed to establish sufficient goodwill in its 'SC' mark in order to defend the opposition. In particular that:

- "the Applicant's evidence is not directed at demonstrating goodwill in the Mark it has applied to register but rather the Applicant's Get-Up".[29]
- ""the Applicant has not established…any (or at least sufficient) goodwill in the Mark solo to prevent the Opponent from using its Logo".[30]
- "the Applicant's goodwill / reputation in its goods or services is inextricably linked to the Applicant's Get-Up as it trades almost exclusively by association to the same."[31]
- "If and to the extent that there is any merit in the Applicant's argument that it has goodwill in the Mark solo, no attempt has been made to establish what proportion of its turnover…relates to sales by reference to the Mark exclusively…"[32]

52. On this, the applicant directs me back to the *Smart Planet Technologies* case *(*BL O/304/20 which it refers to as *RECUP)*, where Mr Mitcheson KC details that the test regarding the commencement of activities which could be complained about is different to the test regarding the acquisition of goodwill.[33] In this regard, I also recall *CASABLANCA*, which states:

> "35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill by the applicant is not required. This is because he

[29] Paragraph 5.10 of opponent's written submissions.
[30] Ibid. (Paragraph 5.13)
[31] Paragraph 19 of Mr Connor's second witness statement.
[32] Paragraph 5.11 of the opponent's written submissions.
[33] As per paragraph 22 of the decision.

goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable on the date that it (i.e. the applicant's use) began.

36. […]

37. Accordingly, the relevance of the activities of the applicant is limited to establishment of the date that the actionable use began. Once that date is established, the only question of goodwill arises in respect of the opponent's activities. As the Applicant in the present case pointed out, self-evidently it would only be in very exceptional circumstances that a party would have established goodwill at the point in time at which it commenced the use complained of. The establishment of goodwill would take much longer. But the authorities recognise that it is the date that the activity commenced which is the crucial one, and so in my judgment it cannot be necessary for goodwill to have been accrued at that time." (my emphasis)

53. The applicant argues that goodwill in its mark is not in issue in these proceedings. I agree. The caselaw is clear that its evidence does not need to establish goodwill and the relevance of the applicant's activities goes only so far as to ascertaining when the behaviour complained of commenced.

CONCLUSION

54. The applicant has demonstrated antecedent use of the contested mark from at least January 2017. Whilst the prima facie relevant date is the application date of the contested mark, the applicant's earlier use of its mark (i.e. the behaviour complained of) becomes the earlier relevant date for assessing the passing off claim. The applicant's antecedent use pre-dates the opponent acquiring protectable goodwill in its mark (and the date claimed for its earliest use). Since the opponent's protectable goodwill and, indeed all its use, post-dates the applicant's antecedent use, the opponent's passing off claim must fail because it was not entitled to restrain the use of the applicant's mark at the earlier relevant date under the law of passing off, nor at the later relevant date.

55. The opposition under section 5(4)(a) is dismissed, and the mark may be registered in respect of all the goods and services.

COSTS

56. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. I award the applicant the sum of £2300, calculated as follows:

Preparing a statement and considering the other side's statement	£600
Preparing evidence and considering the other side's evidence	£1200
Preparing written submissions in lieu of a hearing	£500
Total	**£2300**

57. I therefore order S & G Transport to pay Speedcrete CP Ltd the sum of **£2300.00**. This sum should 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 12th day of March 2026

C IRELAND

For the Registrar