

O/0093/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00003479429

BY HAMID SHEIKH

FOR THE FOLLOWING TRADE MARK:



IN CLASS 39

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507034

BY JUST AIRPORTS CHAUFFEUR SERVICES LIMITED

BACKGROUND AND PLEADINGS

1. HAMID SHEIKH (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK on 05 April 2020. It was registered on 14 August 2020 in respect of the following services:

Class 39: *AIRPORT TRANSFER SERVICE; Agency services for arranging the transportation of persons; Airport transfer services; Arrangement of transportation of passengers by cars.*

2. On 22 February 2024, Just Airports Chauffeur Services Limited (“the applicant”) applied to have the contested mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”) based on Sections 5(4)(a) and 3(6) of the Act.

3. Under Section 5(4)(a), the applicant relies on the sign ‘JUST AIRPORTS’ which it claims to have used since October 2000 in London in relation to *taxi services* and *chauffeur services*. The applicant claims that use of the proprietor’s mark in relation to the registered services would be contrary to the law of passing off.

4. Under Section 3(6), the applicant claims that the proprietor filed its mark in bad faith. In particular, the applicant states:

“The Applicant and the Registered Proprietor were parties to previous opposition proceedings, namely Opposition No. OP000412242 which resulted in a Decision dated 17th July 2019 and an Appeal Decision dated 14th February 2020. These opposition proceedings were filed by the Applicant on the grounds that there was a likelihood of confusion between its earlier UK00002248049 JUST AIRPORTS Chauffeur Service (fig) and UK00003271967 JUST AIRPORTS LONDON (fig) filed by the Registered Proprietor on 21 November 2017. The Hearing Officer concluded, which was supported by the Appointed Person within the Appeal Decision, that the common elements between the marks were JUSTAIRPORTS and that consumers will mistake one for the other. The Hearing Officer also concluded that the words JUST AIRPORTS had

the greatest impact on the overall impression of the trade marks. Subsequently, there was a likelihood of confusion between the trade marks”.

5. The applicant also alleged that the proprietor had failed to pay the costs relating to the previous proceedings (OP000412242) and required security for costs. However, the proprietor subsequently supplied proof that costs were paid in full on the 6 March 2020 and the matter was closed.

6. The proprietor filed a defence and counterstatement, denying the applicant’s claims. In response to the passing off claim, the proprietor argued that there cannot be misrepresentation because the common element ‘JUST AIRPORTS is descriptive. It stated:

“Given that the Trade Mark is a figurative mark with a very distinctive image of a person alongside the following words "JUST AIRPORTS LONDON TRANSFER SERVICE", the Trade Mark is significantly distinctive to the words "JUST AIRPORTS" alone which the Opponent relies upon to argue misrepresentation. The Registered Proprietor submits that there is only a low level of similarity between the Trade Mark and the Opponent's suggested unregistered name.

Furthermore, the services provided by the Registered Proprietor and alleged to be provided by the Opponent are of transportation of passengers and/or goods. In this context, the Opponent's suggestion that they own a unregistered monopoly right to the words JUST AIRPORTS and that anyone else's use of those words, even alongside other words and distinctive imagery, will mislead the public is incorrect. The Registered Proprietor notes that the average consumer when faced by the words JUST AIRPORTS as advertised by a business offering transportation, would simply view those words to describe the transportation being limited to just airports and not immediately think of any one company. Indeed it is the Registered Proprietor's position that it's Trade Mark is distinctive of those words alone and would not mislead consumers in any manner.”

7. In response to the bad faith claim, the proprietor contended that it is not true that the proprietor and the applicant were parties to previous opposition proceedings submitting that the opponent in the previous proceedings was 'Just Airports Chauffeur Services Limited' whereas the applicant in the present cancellation action is 'Just Airport Transfer Services Limited' – however, this is incorrect as the applicant in these proceedings is also Just Airports Chauffeur Services Limited.

8. The proprietor also argued that it had no prior knowledge or correspondence with the applicant other than that which relates to this cancellation, and that the decision which the applicant mentioned relates to completely different facts, background and grounds which cannot be used to set any precedent in the present cancellation.

9. Lastly, the proprietor argued that the earlier trade mark which was relied upon in the previous opposition proceedings no longer exists, and that the proprietor has significant goodwill resulting from prolonged use of the contested mark over a number of years, and is the reason for the proprietor's legitimate trade mark registration.

10. The proprietor is represented by TMS R US. The applicant is represented by National Business Register Group Ltd.

11. Both parties filed evidence during the evidence rounds. Neither party requested a hearing, but they both filed 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

12. The applicant's evidence consists of a witness statement from Ajit Kaur Mangat dated 12 August 2024 and accompanied by 99 exhibits being those labelled AKM001-AKM099. Mrs Mangat is the managing director of applicant, and her evidence goes to the applicant's use of the earlier sign.

13. The proprietor's evidence consists of a witness statement from Hamid Sheikh dated 11 October 2024 and accompanied by 4 exhibits being those labelled HS1-HS4.

Mr Sheikh is the proprietor himself and his evidence goes to his use of the registered mark and the descriptiveness of the words 'JUST AIRPORTS'.

14. I do not intend to summarise the parties evidence 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

15. 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)

16. 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.”

17. 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.”

18. 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).”

19. 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)

20. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, 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.’ ”

21. The *prima facie* relevant date is the date the proprietor's registered mark was filed, in this case 5 April 2020. However, the proprietor has provided evidence aimed at establishing that it has used the contested mark. Accordingly, before proceeding any further, I must consider whether the proprietor's evidence is such that there is an earlier relevant date for assessing whether Section 5(4)(a) applies.

22. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC) as the Appointed Person 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. 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."

23. 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 contested 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 the 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 contested 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 proprietor's evidence

24. Mr Hamid Sheikh's witness statement contains some legal submissions about the descriptiveness of the applicant's earlier sign 'JUST AIRPORTS', in addition to the following exhibits:

- **HS1:** Mr Sheikh says that this exhibit includes evidence of some of his marketing spend and of its success in terms of clicks to his website. The screenshot exhibited appears to show one activity from 18 March 2013 to 10 October 2024, however, it is not clear whether the activity was a marketing campaign which was run prior to the relevant date or not.
- **HS2:** Mr Sheikh says that this exhibit includes evidence of positive reviews which he received from his customers, pointing out that some customers who have been long standing customers for a number of years recognise the proprietor's company, and clearly do not confuse the proprietor for others. The screenshot exhibited shows only 5 reviews which are undated; however, as the reviews display the text "4 weeks ago" and "5 weeks ago" it is likely that they have been published 4-5 weeks prior to the witness statement being signed, which is after the relevant date.
- **HS3:** Mr Sheikh says that this exhibit includes a list of domains showing that other businesses use the 'JUST AIRPORTS' name in their business. Mr Sheikh argues that customers differentiate between businesses in such matters due to their logo, location, number and website rather than just their descriptive name. However, such evidence does not show use of its own mark prior to the prima facie relevant date.
- **HS4:** Mr Sheikh says this exhibit includes information relating to his domain and evidence that he has been trading as 'JUST AIRPORTS' under his domain for almost 10 years. The exhibit contains a screenshot from 'who.is' showing that the domain 'justairports.london' was registered on 11 November 2011. Whilst the proprietor says that he has been trading under the domain

'justairports.london' and that the latter was registered since 2011, there is no evidence that the domain identified as registered since 2011 was used and presented to consumers as part of a fully functioning website promoting the registered services.

25. Accordingly, I find that the above evidence is insufficient to establish that the proprietor has used the contested mark before the date of the application (i.e. the *prima facie* relevant date), and I will proceed on the basis that the only relevant date for the purpose of assessing the applicant's passing off claim is 05 April 2020. With this in mind, I will now turn to the issue of goodwill.

Goodwill

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

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

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 than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C.*

472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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. 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 Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), 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

The applicant's evidence

33. Mrs Mangat says that the applicant was incorporated on 25 August 1999, under the Companies Act 1985 as a private company, with company no. 03834175.² She was appointed Managing Director of the applicant on 23 August 2023.³ Mrs Mangat says that since its incorporation, the applicant has provided taxi and chauffeur services under the term 'JUST AIRPORTS' to and from any London airport to any postcode in the UK. She also says that the applicant advertises its services online through its website www.justairports.com as the best London airport transfer service, and has been trusted by customers for over two decades as the most reliable car service. A copy of a screenshot from the public database called 'whois' is provided in evidence⁴ showing that the domain 'justairports.com' belonging to the applicant was registered

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

² Exhibit AKM001

³ Exhibit AKM002

⁴ Exhibit AKM003

on 26 January 2000. There is also a screenshot which Mrs Mangat says is from the digital archive Wayback Machine purportedly showing the website www.justairports.com as it appeared in October 1999. The screenshot shows airport transfer services being offered under the sign 'JUST AIRPORTS',⁵ however, this is at odds with the evidence that the website was registered after October 1999, in January 2000 (so it could not have existed in October 1999). A similar screenshot purportedly showing the same website as it appeared on 6 December 2000⁶ (prior to the relevant date) is produced. Other screenshots (undated) purportedly showing the website as it appeared on 12 August 2024 (after the relevant date) is exhibited.⁷ All three screenshots indicate that the visual and text of the website have been amended over time, however, they consistently show use of the sign 'JUSTAIRPORTS' in relation to airport transfer services.

34. The rest of the evidence includes 16 sales invoices⁸ and 75 invoices⁹ relating to money which are said were paid by the applicant for online advertising services through Google AdWords to promote its website.

35. The sales invoices are said to have been issued by the applicant to its customers in respect of the provision of taxi and chauffeur services. The ones exhibited are dated between 10 November 2008 and 30 June 2024, but only 12 are prior to the relevant date being those dated between 2008 and 2019 (only one invoice per year has been provided) and are for the following amounts: £526 (2008); £175 (2009); £55.23 (2010); £452.40 (2011); £240 (2012); £1,143.60 (2013); £831.60 (2014); £67.20 (2015); £94.80 (2016); £126 (2017); £122.40 (2018) and £224.40 (2019) for a total of £4,058.63.

36. The invoices about marketing spend are dated between September 2017 and 29 February 2024, however, those dated after the relevant date of 5 April 2020 cannot be taken into account. There are in total some 30 invoices dated prior to the relevant date

⁵ Exhibit AKM004

⁶ Exhibit AKM005

⁷ Exhibit AKM006-7

⁸ Exhibits AKM008 – AKM024

⁹ Exhibits AKM025 – AKM099

(one invoice per month have been provided) and are for the following amounts: £2,608.36; £3,610.11; £5,289.96; £3,686.88; £1,964.36; £3,465.97; £3,590.50; £3,968.55; £4,778.63; £5,870.11; £3,325.18; £4,822.47; £5,961.99; £5,165.89; £4,532.43; £4,130.76; £3,973.53; £6,079.97; £3,376.90; £3,040; £3,039.99; £3,039.12; £3,035.13; £3,038.76; £3,040.00; £3,039.37; £4,172.08; £4,554.53; £2,897.69 and £2,414.75; they cover the period September 2017- March 2020 and amount to a combined total of over £115,500.

37. The applicant's evidence has not been challenged and it must be taken at face value. Although it is sufficiently clear that the applicant is a long-standing business insofar its company was incorporated in 1999 and its website www.justairports.com appears to have been fully functioning and in operation by April 2000 (i.e. about 20 years prior to the relevant date), the only evidence of customers in the UK that counts towards goodwill are the 12 invoices (which equate to 12 consumers) that are dated prior to the relevant date amounting to just over £4K. The burden lies on the applicant to prove goodwill, and the 12 invoices filed are clearly insufficient to establish a more than trivial goodwill at the relevant date. Whilst I accept that in passing off cases not every sale or transaction must be supported by documentary evidence, in cases like the present where no turnover figures have been provided, the real difficulty facing the applicant is proving that it has traded much more than it has shown.

38. Indeed, an assumption could be made that, at the relevant date, the applicant had had more than 12 clients or customers in the UK for the services in question on inferences drawn from the length of use and from the advertising spent (which is over £115K in the three years prior to the relevant date), both facts suggesting that the applicant had sufficient trading activity to keep its business going for many years and invest a reasonable amount of money in promoting its website. However, I do not think that it would be fair, or just, or reasonable for me to attempt to guess how much more trade and customers the applicant enjoyed based on the evidence about promotional activity and length of use. In the absence of information about turnover and/or sales, it is not my job to fill the gap or make assumptions about basic facts that the applicant was required to prove. In reaching this conclusion I bear in mind that the most important thing a claimant for passing off must establish is that it has actual goodwill in the UK and such goodwill involves the presence of clients or customers for the

products or services in question.¹⁰ I am also fortified in this conclusion by the fact that the sign relied upon by the applicant 'JUSTAIRPORTS' is wholly descriptive in relation to airport taxi transfer services as it is likely to be understood as describing the destination or intended purpose of the services for which the sign has been used, namely the provision of a taxi services to be provided at or near to UK airports. But even if the applicant sign would likely to be regarded as weakly distinctive (as opposed to totally descriptive) its distinctiveness would be at the lower end of the spectrum. In those circumstances, I consider that the descriptive or very weakly distinctive character of the sign 'JUSTAIRPORTS' used by the applicant in the context of the relevant airport taxi transfer services combined with the absence of evidence about turnover means that it is unlikely that the sign had become distinctive of the applicant and that the applicant had sufficient goodwill to sustain an action for passing off.¹¹ In other words, since the applicant has used a descriptive/weakly distinctive sign, it was all the more important to provide clear evidence about turnover from which the extent of its goodwill could have been properly assessed.

39. Accordingly, the applicant having failed to establish sufficient goodwill to sustain its passing off action, the invalidation fails at the first hurdle.

Section 3(6)

40. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

41. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* (“*SkyKick*”) [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

¹⁰ *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

¹¹ BL-O/304/20

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*[Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker (C-320/12) EU:C:2013:435 ("Malaysia Dairy")*], para 29; *[Sky plc v SkyKick UK Ltd (C-371/18) EU:C:2020:45 ("Sky CJEU")*], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *[Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 ("Koton")*], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial

authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

42. The essence of a bad faith objection is that the proprietor’s intended conduct is a departure from accepted principles of ethical behaviour or honest commercial practices. Earlier in *SkyKick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...].”

43. The correct approach to assessing bad faith was set out in *Alexander Trade Mark*, BL O/036/18, where Mr Geoffrey Hobbs sitting as the Appointed Person stated that the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

44. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

45. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

46. The caselaw shows that the initial evidential burden falls upon the applicant: the applicant must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If it does that, then the burden shifts to the proprietor to rebut the allegation.

47. The applicant has not filed any evidence of bad faith. The only relevant information the applicant has provided in relation to its bad faith claim is the reference number of the previous opposition whereby an application for the mark shown below was filed by the proprietor in these proceedings and refused based on an opposition brought by the applicant in these proceedings:



48. In that case the opposition was brought on the basis of Section 5(2)(b) based on the earlier mark no. 2248049 shown below:



49. The applicant's mark was an earlier valid mark at the time when the previous opposition was brought. However, it is now expired, the expiration date being 09 October 2020.

50. Even if the applicant's earlier mark no. 2248049 was a valid mark at the relevant date of 5 April 2020, the contested mark is different from that which was refused in the previous opposition. Whilst the proprietor had been refused registration of a previous mark which contained the words 'JUST AIRPORTS LONDON', all that the Hearing Officer (and the Appointed Person) could have held (as they did) in that case, was that the previous application could not be registered because there was a likelihood of confusion with the earlier right no. 2248049 owned by the opponent (which is the applicant in these proceedings). It seems to me that it is open to a party that has been previously refused a trade mark application to subsequently apply for another trade mark. Admittedly, it might be possible to invoke the doctrine of estoppel to prevent an applicant from continuously filing applications to register the same trade mark when another party has successfully objected to the same mark in previous proceedings - this seems to me it is the substance of the applicant's bad faith claim, i.e. that the application for the contested mark is an abuse of process because of the doctrine of estoppel. However, this presupposes that the same issue is relevant in the subsequent proceedings involving the later applied-for mark (or a sufficiently close mark) and the same parties. In this case, whilst the newly applied trade mark includes components incorporated in the previously refused trade mark application, i.e. the words 'JUST AIRPORTS', the issues are not the same, because the applicant here (i.e. the opponent in previous proceedings) is relying on different grounds (i.e. passing off

versus an earlier registered trade mark). This, in turn, means that the fact that when the proprietor applied for the mark was aware of the applicant's earlier mark no. 2248049 is not really pertinent, as the applicant did not rely on that earlier mark in the present proceedings. As there is no other ground on the basis of which bad faith is alleged, this ground also fails.

OUTCOME

51. The application for invalidity is refused the proprietor's trade mark no. UK00003479429 will remain registered.

COSTS

52. The proprietor has been successful, and it is, therefore, entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award HAMID SHEIKH the sum of £1,400 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a counterstatement and considering the notice of opposition: £400

Filing evidence and considering the other party's evidence: £600

Filing submissions in lieu: £400

Total: £1,400

53. I therefore order Just Airports Chauffeur Services Limited to pay HAMID SHEIKH the sum of £1,400. 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 4th day of February 2026

TERESA PINTO

For the Registrar