

**O-290-22**

**TRADE MARKS ACT 1994**

**1. IN THE MATTER OF TRADE MARK APPLICATION NO. 3488635  
BY 99HOME LIMITED TO REGISTER THE TRADE  
MARK**



**IN CLASS 35**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421222 BY JUST  
SOLD LIMITED**

**AND**

**2. IN THE MATTER OF APPLICATION NO. 3485829 IN THE NAME OF JUST  
SOLD LIMITED IN RESPECT OF THE TRADE MARK**

**Just Sold**

**IN CLASS 36**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421431 BY  
99HOME LIMITED**

## **Background and pleadings**

1. 99Home Limited (“Party B”) applied to register the trade mark no. 3488635 in the UK on 11 May 2020. It was accepted and published in the Trade Marks Journal on 5 June 2020 in respect of the following services:

**Class 35:** *Auctioneering of property.*

2. Just Sold Limited (“Party A”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of a pending earlier UK Trade Mark no. 3485829, the relevant details of which are:

Mark: Just Sold

Filing date: 30 April 2020

Date of publication: 12 June 2020

**Class 36:** *Estate agencies; Estate agencies (Real -); Estate agency; Estate agency services; Estate agency services for sale and rental of buildings; Estate agent services; Estate brokerage.*

3. Party A submits that because of the similarities between the respective marks and services there exists a likelihood of confusion and that the application should be refused registration.

4. Party B filed a counterstatement asserting that:

- a. the earlier mark relied upon by Party B is still pending and that it has filed an opposition to it, and it puts Party A to proof of the claimed use of its earlier right;
- b. it has used its mark since 15 June 2019 and “significantly used” it after 30 July 2019;
- c. its opposition is based upon sections 5(4)(a), sections 3(1)(b), 3(1)(c), 3(1)(d) and section 3(6). The latter was not pursued at the hearing and I need say no more about it.

5. More detail regarding the grounds of opposition (No. 421431) referred to in Party B's counterstatement are provided in its statement of grounds in respect of its subsequent opposition. These are summarised as follows:

*Section 5(4)(a)*

- The earlier right relied upon is goodwill identified by two signs. The first mirrors its 3488635 figurative mark. The second sign is "just-sold.co.uk";
- First use is claimed as 15 June 2019 throughout the UK, particularly in England and Wales;
- The claimed goodwill that these signs identify is auctioning services;
- "The Platform" was created on 15 June 2019 and Party B "has a significant acquired reputation for providing the services under its [signs]";
- Party B has invested significantly in promoting its [signs];
- It has a significant client base and following;
- Party A was not incorporated until 12 February 2020, well after Party B started trading.

*Section 3(1)*

- Party A's mark is devoid of distinctive character under section 3(1)(b) and consists of words that are "usually used in describing the sale of goods, particularly to convey the stage not the transaction in the real-estate market and/or describing completed transaction of goods on the web;
- The words "Just Sold" is commonly used particularly by estate agents, developers and property auctioneers to inform the public that a property has been sold and/or a transaction completed and is, therefore, open to objection under section 3(1)(c);
- The words "Just Sold" are generic and have become customary in the current language of the trade in properties to designate the services covered by the mark.

6. Party A filed a counterstatement denying the claims made. In respect of the section 5(4)(a) grounds and in response to Party B's claim that its earlier right dates back to 15 June 2019, Party A claims to be the senior user with its mark being put to use in the UK as early as 6 June 2018. In respect of the grounds based upon section 3(1) of the Act, it relies upon the fact that no such objections were taken during the examination process. It asserts that its mark is inherently distinctive but that it has also acquired distinctive character as a result of use made of its mark since 6 June 2018.

7. The two cases were subsequently consolidated.

8. The parties both filed evidence in these proceedings. I will refer to this in my decision to the extent that I consider it relevant.

9. A Hearing took place on 1 February 2022, with Party B represented by Ms Shobana Iyer of Counsel, appointed under the Bar Council direct access rules. Party A was not represented but it filed written submissions in lieu of attending.

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Evidence**

11. Party A's evidence consists of the witness statement of Zoheb Diamond Shariff, director of Party A together with Exhibit ZDS1 – Exhibit ZDS10. He provides evidence on the history and background of Party A.

12. Party B's evidence consists of the following:

- a. a witness statement Vijayant Vashista, founder director and Chief Operating Officer of Party B and Exhibits VV2 T1 – VV2 T13. This provides background to Party B, its activities and the formulation of its mark;

- b. two witness statements of Puja Mehra, operations manager of Party B, Exhibits PM1 T1 – PM1 T9 and Exhibits PM2. This provides information regarding the activities of Party B and the use of its mark and also alleged non-compliance issues regarding Party A;
- c. the witness statement of Sachinkumar Rajendrakumar Guta, Founding Director and Chief Executive Officer of Party B

## **DECISION**

13. Party B's opposition is against Party A's mark relied upon as the earlier mark in its opposition to Party B's mark. Therefore, the outcome of Party B's opposition has the potential to impact upon the outcome of Party A's opposition. Consequently, I will begin by considering the merits of Party B's opposition.

### ***PARTY B'S OPPOSITION***

14. Party B's grounds of opposition are based upon sections 3(1)(b), 3(1)(c), 3(1)(d), 3(6) and 5(4)(a). I begin by considering the various section 3(1) grounds.

15. The relevant parts of section 3 state:

"3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) ...

(b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

### **Section 3(1)(b)**

16. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been

applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17. Party B claims that Party A's mark is devoid of distinctive character because it consists of words that are "usually used in describing the sale of goods, particularly to convey the stage of the transaction in the real-estate market and/or describing complete transaction of goods on the web".<sup>1</sup>

18. Party A relies upon the fact that no such objections were taken during the examination process. It asserts that its mark is inherently distinctive but that it has also acquired distinctive character as a result of use made of its mark since 6 June 2018.

19. Firstly, I should point out that I am in no way bound by the decision of the Registry to accept Party A's application for publication. The purpose of publication in the Trade Mark Journal is to provide an opportunity for third parties to challenge a mark otherwise accepted by the Registry. This is a case here and I must consider the case before me.

---

<sup>1</sup> Annex 1 to the Form TM7, page 4

20. In order to understand the merits of the ground it is necessary to know the exact meaning of the words:

**Just:** Very recently; in the immediate past. *'I've just seen the local paper'*<sup>2</sup>

**Sold:** *past participle verb* sold ... Give or hand over (something) in exchange for money. *'they had sold the car'*<sup>3</sup>

21. These are two words that will be readily understood by the relevant public, being individuals and businesses in the UK who wish to buy or sell property. When these two words are combined the term will be understood, by the relevant consumer, as indicating that something has been very recently sold. I also note the following from Party B's evidence that Ms Iyer drew to my attention:

- A number of images illustrating use of JUST SOLD in the trade to indicate a recently sold property. The following three examples are typical of those provided<sup>4</sup>:



<sup>2</sup> [JUST | Meaning & Definition for UK English | Lexico.com](#)

<sup>3</sup> [SELL | Meaning & Definition for UK English | Lexico.com](#)

<sup>4</sup> See Exhibit SRG1/Tab 5



- The first page of undated results of a Google search for “just sold England and Wales”. The first three results are for the website “Just-sold.co.uk” (presumably Party B’s own website). The remaining three results do not contain the term “just sold”;<sup>5</sup>

<sup>5</sup> Exhibit VV2, Page 40

- An online survey where the participants were asked “what you think of the phrase Just Sold? 74.78% of respondents indicated that it was a “common phrase”<sup>6</sup>

22. The second and third points do not advance Party B’s case. This Google search fails to assist in demonstrating that the term “Just Sold” is either used in the trade or lacking in distinctive character. Rather it only illustrates its use as part of a domain name. The third point relies upon a survey where leave to undertake and admit it was not sought by Party B, nor given by the Registry. In line with Tribunal Practice Notice 2/2012, it is not admissible. Further, even if it was admissible, it would not assist because it is not clear what the participants were told about the survey or who the participants were. This renders the survey unhelpful and I attribute no weight to it.

23. The images referred to in the first point are consistent with Party B’s claim that the term “Just Sold” is commonly used to indicate that a particular property has been sold. I must assess the position at the relevant date, namely the filing date of Party A’s mark, being 30 April 2020. These images are not dated but it is reasonable to assume they were obtained for the purposes of Mr Gupta’s witness statement that is dated 28 April 2021.<sup>7</sup> This is nearly one year after the relevant date. Whilst they are only representative of what the evidence shows, there is still only a small number of examples showing “Just Sold” being used. Taking all of this into account, I conclude that they add little by way of support for Party B’s case. However, the use they do show is in a way that is consistent with the normal meaning that would be attributed by the relevant public to the term “Just Sold”. They are ordinary words that are readily understood and combining them in this way creates a term that will be equally easily understood by the relevant public.

24. In its written submissions, Party A rightly points out that distinctive character must be assessed by reference to the services and by reference to the perception of the relevant public. It also points out the shortcomings of Party B’s evidence that I have discussed above. Thirdly, I am directed to certain judgments of the CJEU. I identify these below:

---

<sup>6</sup> Exhibit VV2, Tab 13, page 44

<sup>7</sup> It was subsequently amended at the direction of the Registry but the original date of its filing is relevant for the current purpose

- *Eurohypo v OHIM* [2008], Case C-304/06 P AT [41]: The court identified that the evaluation of each of the words in the mark cannot be undertaken in isolation but the evaluation must be based on the overall perception of the mark by the relevant public. I note and agree with this;
- I am directed to paragraph 34 and 38 of a case merely identified as “Alpha”. Without further information, I am unable to comment on the particular point being made;
- *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, C-265/09 P: It is not clear which point is being made in respect of this case but, as I have summarised in paragraph 16, above, I keep in mind the principles set out in that judgment.

25. When applying the principles set out in the authorities referred to, the words “Just” and “Sold”, combine to form a term that when used in respect of estate agency services, will immediately inform the relevant public that a property sales transaction has been recently completed. This message is direct and immediate. It does not identify the services as originating from a particular undertaking. Consequently, the mark is devoid of any distinctive character in respect of the services of Party A’s application and fails to serve to identify the services as originating from a particular undertaking. It therefore does not act as an indication of origin.

26. Although no explanation has been provided, I note that Party A has exhibited<sup>8</sup> an article from Property Industry Eye, dated 8 May 2017, discussing a decision of the Property Ombudsman when making a finding that there is no difference in meaning between the terms “Sale Agreed”, “Under Offer” or “Sold Subject to Contract”. There appears to be no reference to the term “Just Sold” and this evidence appears irrelevant to the issue before me and I say nothing more about it.

27. In summary, because of its inherent qualities, the mark is devoid of any distinctive character and is debarred registration under section 3(1)(b).

---

<sup>8</sup> At Exhibit ZDS9

28. Party A also claims that because of its use of the mark, it has acquired distinctive character. The relevant date for assessing distinctive character is 30 April 2020, being the date Party A's mark was applied for. Evidence is provided by Mr Shariff in his witness statement and accompanying exhibits. He states that Party A was formed on 12 February 2020 but that preparations to use the mark began on 6 June 2018 in the provision of estate agency services<sup>9</sup>. The relevant evidence of use can be summarised as follows:

- The domain name www.just-sold.co was registered on 6 June 2018;<sup>10</sup>
- An approach to a website design company was made by email on 2 June 2018 to design the website;<sup>11</sup>
- The same exhibit also contains undated screen shots of pages from the website showing the use of the following mark:



- The trading name JUST SOLD was registered onto the National Business Register on 4 June 2018;<sup>12</sup>
- Letterheads, business cards and envelopes were ordered on 13 June 2018;<sup>13</sup>
- A company was commissioned to design the company logo (shown in the third bullet point, above) on 13 June 2018;<sup>14</sup>
- 15,000 flyers were ordered on 25 March 2020. The invoice exhibited indicates a delivery date of 15 May 2020 (i.e. two weeks after the relevant date);<sup>15</sup>

---

<sup>9</sup> Mr Shariff's witness statement, para 4

<sup>10</sup> Ditto, para 5 and Exhibit ZDS1

<sup>11</sup> Ditto, para 6 and Exhibit ZDS2 and Exhibit ZDS2a

<sup>12</sup> Ditto, para 7 and Exhibit ZDS3

<sup>13</sup> Ditto, para 8

<sup>14</sup> Ditto, para 9 and Exhibit ZDS5

<sup>15</sup> Ditto, para 11 and Exhibit ZDS7

- Printouts from Party A's Facebook page, created on 9 November 2019, illustrating that it has been promoting "Just Sold Estate Agent" since that date. It has 825 likes and 861 followers.<sup>16</sup>

29. Only the last of these shows that Party A has been engaging with relevant consumers to promote its estate agency services. All the remaining evidence relates to preparations that did not involve bringing the mark into contact with relevant consumers. Consequently, the preparations to begin trading do not illustrate that the mark has acquired any distinctive character in the minds of the relevant consumer. The highpoint of Party A's case is that it began promoting itself on Facebook less than 5 months before the relevant date. I have nothing before me to illustrate the scale or geographically extent of any use or what the level of sales are (if any). I conclude that this evidence illustrates use that falls a long way below that required to indicate that Party A's mark has acquired a distinctive character because of the use made of it.

30. In summary, the evidence fails to disturb my finding that the mark "Just Sold" is devoid of distinctive character. The ground based upon section 3(1)(b) succeeds.

### **Section 3(1)(c)**

31. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

---

<sup>16</sup> Ditto, para 14 and Exhibit ZDS10

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient

that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of

distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

32. I can deal with this ground briefly. At the hearing, Ms Iyer submitted that the words “just sold” describe a common point in the transaction of the sale of goods and, in particular, in the field of estate agency services and the property sector. She submitted that the words are commonly used by the public to state that a particular property has been sold. I agree with these submissions. However, the descriptive message identified by Ms Iyer does not designate any particular characteristic of estate agency services. Rather, in respect of these services, the term indicates that a property sales transaction has been recently completed. Therefore, although it does not indicate a specific undertaking (and is devoid of distinctive character), neither does it designate any characteristic of the services themselves. Therefore, when considering the normal and fair use of the mark in relation to the estate agency and taking account of the perception of the relevant public in the UK, who are reasonably well informed, observant and circumspect,<sup>17</sup> I find that mark does not designate a characteristic of the services and the ground based upon section 3(1)(c) fails.

### **Section 3(1)(d)**

33. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is

---

<sup>17</sup> *Matratzen Concord AG v Hukla Germany SA*, Case 421/04 at [24]

sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40).”

34. Again, I can deal with this ground briefly. In order for me to find that a sign has become customary in the trade, there must be clear and cogent evidence that this is the case. As I have already found, the evidence, whilst consistent with my finding in respect of the ground based upon section 3(1)(b), suffers from a number of deficiencies and is far from conclusive. It is wholly insufficient to demonstrate that the

term “Just Sold” has become customary in the trade. I, therefore, find that the ground based upon section 3(1)(d) fails.

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

35. As I have already noted, at the hearing, Ms Iyer indicated that, having had an opportunity to review Party A’s evidence, Party B was no longer pursuing this ground.

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

36. 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).”

37. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

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

(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 confusion or 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.”

38. Lord Macnaghten’s classic definition in *IRC v Muller & Co’s Margerine Ltd* [1901] AC 217:

“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.”

39. 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.’ ”

40. The relevant date in the current proceedings is the filing date of the contested mark, namely, 30 April 2020. Party A claims an earlier goodwill from 15 June 2019, but it is clear from my discussion and conclusions set out at paragraphs 28 and 29, above, that the evidence is wholly insufficient to demonstrate acquired distinctiveness. Whilst I recognise that the hurdle of demonstrating goodwill may be lower than that

required for demonstrating acquired distinctive character, nevertheless the evidence falls far short of illustrating this and I conclude that there is only one relevant date to consider, being the filing date of the contested application.

41. Party B relies upon a claimed goodwill in respect of the following two signs:



and

just-sold.co.uk

42. Party B's evidence of potential relevance to the issue of goodwill is summarised below:

- www.just-sold.co.uk is the online auctioneering business of Party B<sup>18</sup> that was launched to its investors on 22 January 2020;<sup>19</sup>
- The name www.just-sold.co.uk was added as a trading name with The Property Ombudsman on 28 January 2020;<sup>20</sup>
- The domain name has been used extensively on social media and in email signatures and on banners at physical meet ups;<sup>21</sup>

---

<sup>18</sup> Mr Vashistha's witness statement of 21 April 2021, paras 8 and 10

<sup>19</sup> Ditto, para 11 and Exhibit VV2/T6, page 19

<sup>20</sup> Ditto, para 12

<sup>21</sup> Ditto, para 13 and Exhibit VV2/T7, page 22 showing one email from March 2020 where the domain name appears in the auto signature and also a list of emails dated in February 2020 but they are unclear

- Between 1 January 2020 and 31 December 2020, just-sold.co.uk consistently had over 200 users “engaging” with the site;<sup>22</sup>
- A significant amount has been spent promoting the business as well as through the website www.just-sold.co.uk.<sup>23</sup> This includes sponsorship with a trade magazine, Property Industry Eye, using the brand for international newsletters, investing in Google ads;<sup>24</sup>
- A significant following and acquired representation is claimed based upon a Trustpilot ranking of 4.9/5 and over 2000 followers on Facebook, a client base of over 1200 and 400 visitors to the website each month;<sup>25</sup>
- In 2020/21, the website generated sales of “over £500,000”.<sup>26</sup> Two memorandums of sale or shown, one relating to a property in Wakefield with an “agreed price” of £550,000 and a freehold plot in Hertsmere for an agreed price of £10,000.<sup>27</sup> These are dated “15/12/2020” and “13/01/2021”, respectively;

43. At the hearing, Ms Iyer submitted that this evidence supports Party B’s claim to the requisite goodwill. Party A, in its written submissions, points out that most of this evidence is after the relevant date.

44. In assessing the evidence, I am mindful of the following comments of Thomas Mitcheson QC, sitting as the Appointed Person in *RECUP Trade Mark*, BL O/304/20:

“30. As Lord Neuberger explained in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*, [2015] F.S.R. 29 at §47, a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction. He went on at §52 to point out (emphasis added):

52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited at [21]–[26] and [32]–[36] above establish. **The claimant must show that**

---

<sup>22</sup> Ditto, para 14 and Exhibit VV2/T8, page 24

<sup>23</sup> Ditto, para 15

<sup>24</sup> Ditto. The sums disclosed are very small (£700 for the sponsorship with Property Industry Eye and £330 in total for the other forms of promotion mentioned)

<sup>25</sup> Ditto, para 16

<sup>26</sup> Ditto, para 17

<sup>27</sup> See Exhibit VV2/T10, pages 37 and 38

**it has a significant goodwill, in the form of customers, in the jurisdiction**, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere.

31. As can be seen from the extract from the Decision I have quoted above, the Hearing Officer's conclusions as to goodwill were expressed very briefly. It was almost as if he had determined that the possession of any goodwill by Party A was automatically sufficient to allow a finding of passing off. I do not consider this to be a correct statement of the law. As Lord Neuberger made clear in the paragraph cited above, it is necessary for a claimant to demonstrate that it has "a significant goodwill, in the form of customers" in the United Kingdom.

32. Lord Oliver put it this way in *Jif* (emphasis added):

First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying "get-up" (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, **such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.**

33. Lord Fraser had explained it as follows in the *Advocaat* case (*Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd.* [1980] R.P.C. 31) in his fourth and fifth probanda (bold emphasis added):

(4) That he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England **which is of substantial value;**

(5) That he has suffered, **or is really likely to suffer, substantial damage to his property** in the goodwill by reason of the defendants

selling goods which are falsely described by the trade name to which the goodwill is attached.

34. So, 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.”

45. In *The Medical Cannabis Clinic Trade Mark*, BL O/377/21, Emma Himsworth Q.C., sitting as the Appointed Person referred to the above comments made in the *RECUP* case and stated (my emphasis):

“... as highlighted in paragraphs [30] to [34] of *RECUP* TM this requires the party seeking to establish the right to show inter alia (1) that it **has significant, or at least more than nominal goodwill**, in the form of customers in the jurisdiction ...”

46. In the *RECUP* case, the evidence was in the form of 10 invoices, two of which were dated before the relevant date that related to sales of just over €3000 for about 40,000 paper cups. The Appointed Person concluded that when considered within the size of the market for paper cups, this was only a tiny proportion of the market and that it was not substantial goodwill.

47. In the current case, Party B’s evidence identifies only two sales before the relevant date. The first is a reasonably expensive sale of a £550,000 property. The second was the sale of a freehold plot of land for £10,000. These were made approximately five and four months prior to the relevant date, respectively.

48. Party B also points out that, between 1 January 2020 and 31 December 2020, its website consistently had over 200 users “engaging” with the site. It is unclear from this statement whether this figure was a constant or whether it was increasing (or even decreasing) over time and if so, what the number were in the first four months of this period (being before the relevant date). Further, there is no explanation as to what is

meant by “engaging”. Certainly, such engaging did not translate into sales, other than the two already mentioned, prior to the relevant date. There is also a statement that Party B has over 2000 followers on Facebook, a client base of over 1200 and 400 visitors to its website each month. It is not stated in what time frame this figures relate and I cannot assume that this was the state of play at the relevant date.

49. Party B also relies upon, what it states to be a significant amount having been spent on promoting its business in ways than other through its website. This significant amount is, in fact, only about £1000 in total. This consists of a payment of £700 relating to sponsorship with a trade magazine and £330 attributed for all the other forms of promotion mentioned.

50. Taking all of the above into account, I conclude that the use shown is not sufficient to establish significant, or at least more than nominal goodwill. Two transactions in the context of, what is, self-evidently an enormous size of the property market in the UK can amount to no more than a very small or negligible goodwill. Having considered Party B’s activities through its website, Facebook and other forms of promotion, these are also of a scale that is very small, and I conclude that Party B does not have sufficient goodwill. As this is a prerequisite of a claim of passing off, it follows that the ground based upon section 5(4)(a) fails in its entirety.

### **Summary of findings and outcome of Party B’s opposition**

51. Party B’s opposition succeeds in its entirety insofar that it is based upon section 3(1)(b) of the Act. It fails in respect of its grounds based upon sections 3(1)(c), 3(1)(d) and section 5(4)(a). Party B did not pursue the section 3(6) ground and that, therefore, fails.

52. In light of Party B’s success under section 3(1)(b), Party A’s mark is refused in its entirety.

### ***PARTY A’S OPPOSITION***

53. I have found that Party B’s opposition to Party A’s earlier mark has succeeded and, therefore, it cannot be relied upon for the purposes of the opposition to Party B’s

mark. Party A's opposition is based upon a single ground under section 5(2)(b). In the absence of a valid earlier mark, its opposition must fail and Party B's mark may proceed to registration.

## **Outcome**

54. Party B's opposition succeeds, and Party A's mark is refused.

55. Party A's opposition fails in its entirety and Party B's mark may proceed to registration.

## **COSTS**

56. Party B has been successful, and it is entitled to a contribution towards its costs. At the hearing, Ms Iyer requested scale costs. Party B appointed counsel to represent it at the hearing but was otherwise unrepresented in the proceedings. As a litigant-in-person, Party B was offered an opportunity to submit a completed costs proforma to ensure a fair contributory award is made and that it does not receive an award greater than its actual expenses. Consequently, it was invited by the Registry to complete a proforma. This was duly completed and filed on 28 January 2022.

57. Party B identifies the following number of hours in preparing its case (with further detail provided in a schedule of costs provided with the completed costs proforma):

- Preparation of Mr Vashistha's witness statement: 112 hours 45 minutes
- Preparation of Ms Mahra's witness statement: 99 hours 45 minutes
- Preparation of Mr Gupta's witness statement: 90 hours 45 minutes
- Preparation of a statement by a Joy Charles<sup>28</sup>: 65 hours
- Preparing for, and attending the hearing: 12 hours

---

<sup>28</sup> There is no evidence from someone named Joy Charles but there is a second witness statement from Ms Mehra and I proceed on the basis that this is a typographical error and should be a reference to Mr Mehra's second statement

58. In addition, the official fee of £200 is requested in respect of filing its opposition and disbursements (being Counsel's fees) of "at least £14,000 + VAT". As I explained at the hearing, the Registry operates a contributory costs regime and awards are normally made based on the published scale (but because a litigant-in-person does not have legal costs, an award may be made below the normal scale costs and taking account of a completed costs proforma). There was no application for off-scale costs (rightly so, in my opinion) and, therefore, I approach the issue in this way.

59. The number of hours recorded for the preparation appears excessive. None of the witness statements are of an usual length or complexity and I consider that 10 hours is an appropriate time for the preparation of each one. This is a total 40 hours. The Litigants in Person (Costs and Expenses) Act 1975 and the Civil Procedure Rules set the rate at £19 per hour (Practice Direction 46, 3.4).

60. The proforma makes no reference to the time taken in preparing the Form TM7 and statement of case nor considering Party A's Form TM8 and counterstatement. Neither is there reference to the time taken in considering party A's opposition and filing Party B's Form TM8 and counterstatement in that case. However, I proceed on the basis that these items must have been included in the hours identified in respect of the preparation of the evidence because this could not have been prepared without reference to these documents. I consider 10 hours is sufficient to do this.

61. For the hearing, Party B appointed Counsel and, therefore, it is appropriate to refer to the published scale rather than the costs proforma in respect of this element of the costs award. In the circumstances I award Party B the following costs as a contribution towards the cost of the proceedings:

Official fee (in Party B's opposition):	£200
---	------

Preparing and filing TM7 and considering the counterstatement in its opposition and considering the TM7 and preparing and filing counterstatement in Party A's opposition (10 hours):	£190
---	------

Preparing and filing evidence and considering Party A's evidence (40 hours):	£760
Preparing for, and attending hearing:	£700
<b>Total:</b>	<b>£1850</b>

62. I therefore order Just Sold Limited to pay 99Home Limited the sum of £1850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5<sup>th</sup> day of April 2022**

**Mark Bryant**  
**For the Registrar**