

**O-109-17**

**REDACTED VERSION FOR PUBLIC INSPECTION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3122309**

**BY LET ME LTD**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 36 & 37:**

**Let Me**

**AND**

**OPPOSITION THERETO (NO. 405373) BY RICHMOND GROUP**

## **Background and pleadings**

1. This dispute concerns whether the following trade mark should be registered:

### **Let Me**

**Class 36:** Estate agency services; estate agencies; estate agencies (real-); estate agency; estate agency services for sale and rental of buildings; estate agency services for sale and rental of businesses; estate agent services; property (real estate-) appraisal [financial]; property (real estate-) brokerage services; property (real estate-) consultancy services; property (real estate-) evaluations; property (real estate-) finance; property (real estate-) insurance; property (real estate-) investment; property (real estate-) management; property leasing [real estate property only]; property portfolio management; property valuation.

**Class 37:** Property development; property maintenance; property development services [construction].

2. The mark was filed on 13 August 2015 by Let Me Ltd (the applicant”) and was published for opposition purposes on 4 September 2015.

3. Richmond Group (“the opponent”) oppose registration on a single ground under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It claims to have used the signs: **LetMe**, **Let Me** and **Let Me Property Ltd** since 27 February 2015. It claims that it has a goodwill associated with those signs and that the use of the applicant’s mark would constitute a misrepresentation preventable under the law of passing-off.

4. The applicant filed a counterstatement denying the claims. The primary basis for its defence is that, in actual fact, the opponent is passing itself off as the applicant given that the applicant used its mark prior to the commencement of any use by the opponent. The applicant claims to have been trading under the names **LET ME** and **LET ME PROPERTIES** since 2008.

5. Both sides are professionally represented, the opponent by ipconsult, the applicant by Scott & York IP Law. Both sides filed evidence. Neither side requested a hearing. The applicant filed written submissions, the opponent did not.

### **The legislation and leading case-law**

6. Section 5(4)(a) of the Act reads:

“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, or

(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.”

7. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

8. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 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.”

9. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“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.”

10. In *Hart v Relentless Records* [2003] FSR 36, 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.”

11. 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 reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

12. In terms of what is required to establish goodwill, I note that 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.”

13. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. 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.”

14. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, stated:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the

application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

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.

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.’ ”

### **The evidence**

15. This is a case where both parties claim to own goodwill. I will, therefore, begin by summarising the evidence about the respective business operations. The applicant also claims that there has already been confusion and, further, that the opponent’s business has some negative connotations which could impact upon the applicant’s goodwill; I will summarise the evidence about these issues separately. I should stress that the evidence as a whole contains a lot of what are, effectively, tit-for-tat comments about each other’s businesses and critiques thereof. I will not detail everything, although it is all bore in mind. What I set out below represents what I consider to be the most pertinent evidence. It should also be noted that some of the evidence has been granted confidentiality and, so, is redacted from the public version of this decision.

### ***The opponent’s business***

16. The opponent’s witness is Mr Samuel Wells, a director of a company called LetMe Property Ltd (“LMP”). He states that LMP have used the marks **LetMe**, **Let Me** and **Let Me Property Ltd** since 27 February 2015.

17. Mr Wells lists a range of services in classes 36 and 37 in respect of which he says the marks have been used, but he then goes on to state that they “relate strictly to a revolutionary lettings service”. The revolutionary aspect of the service is explained as one where the service provider pays 12 months’ rent upfront to its landlords together with offering them a property condition guarantee, so reducing the landlord’s risk. The service provider then sources and manages tenants for each property. Mr Wells adds that LMP has not, and will not, offer “general generic letting services” such as those offered by the applicant. He considers that because of LMP’s unusual approach, the services the parties offer are significantly different and are not in direct competition.

18. Mr Wells states that he is not aware of any instances of confusion. He states that whilst the actual services offered by the parties are not in direct competition, he is concerned that the services as covered by the applicant’s specification could include the specialised type his company offers and he would expect, at the very least, that a limitation be added to exclude its specific type of lettings service.

19. At Exhibit SW1, Mr Wells provides extracts from LMP’s website. It is not an archived print. It uses the words **LetMe** multiple times. This is sometimes alongside a square tile containing a picture of a house. It is also used within the phrase **LetMe for Landlords**. There is no use of **Let Me** or **Let Me Property Ltd**. I note in some small print that “LetMe is part of the Richmond Group”. There are also some letting listings for properties in multiple parts of England.

20. In terms of the origin of the mark, Mr Wells states that it was coined as a play on the dual meaning of “let me”, alluding to the intended services and a common English expression for seeking permission.

21. Mr Wells states that although the use only commenced six months before the applicant filed its mark, it still had a significant protectable goodwill by the date of filing on 13 August 2015. He states that £1.5 million has been invested in acquiring property from landlords. He states that the property portfolio spans the UK and that 33 staff are employed with a database of over 20,000 customers. There are 600 active customers renting properties, and this is growing by around 70-100 per month. Annual turnover/value of sales between first use and 13 August 2015 is said to be £2 million,

with around £30,000 being spent on promoting the business. He adds that heavy investment has been made in search engine optimisation which has resulted in the business being the most searched for company online under the name Let Me. It is also claimed that radio and television advertising has taken place and company promotions and billboards have been used.

22. Mr Wells states that he does not believe that the applicant can demonstrate a higher turnover or advertising effort and is unlikely to have a more substantial goodwill.

23. The above represents what the opponent said in relation to its business. But, I also need to consider the applicant's evidence, to the extent that it deals with the opponents business. The applicant has two witnesses, Ms Catherine Ayers, its trade mark attorney, and Mr Gregory Moulton, its director.

24. Mr Moulton focuses primarily on the applicant's use. Where he gives evidence about the opponent's business this relates to:

- Statements that the service the opponent offers is not revolutionary, reference is made to another business, Northwoods, who do something similar (see Exhibit GM/5).
- A statement that when the applicant became aware of the opponent's business it expected it to soon fail due to the upfront payments it was making to landlords.
- A statement that in order to succeed, the opponent would have been charging tenants higher than market value rent (Mr Mouton estimates by around 33%) which means that many properties would be left unoccupied.
- Evidence comprising a search of the opponent's website in July 2016 showing that some properties had been listed since February that year.
- Statements that the opponent's business model could damage the applicant (I will come back to this).

- Statements that there has been confusion in the marketplace (I will, again, come back to this).

### ***The applicant's business***

25. The primary evidence on this comes from Mr Moulton, who has provided two witness statements.

26. Mr Moulton states that the opponent began trading on 16 June 2008. Exhibit GM/1 contains a print from Companies House showing the registration of the opponent as a company on this date. The domain name letmeproperties.co.uk was registered the following day. Exhibit GM/2 contains an extract from the WayBackMachine for this domain name showing that the website was saved 32 times between 12 July 2008 and March 4 2016. There is also an archive print from the website dated 4 May 2010; it is headed Let Me Properties, but it also depicts the words LET ME as part of a simple logo of an outline of a house. A photograph of the applicant's business premises is also depicted which features the domain name prominently on the sign above the office. Mr Moulton states that the applicant wanted to obtain the domain name letme.com but it was unavailable at the time.

27. Mr Moulton explains that the opponent specialises in the lettings business in the St Albans area, but it deals with landlords from all over the UK and overseas. He adds that St Albans is only 19 minutes from London by train and is a popular place to live. House prices, he says, are high. Exhibit GM/3 contains a web print showing a property in St Albans (a two bedroom apartment) with a monthly rental of just under £1200. This is from September 2016. The words LET ME PROPERTIES appear prominently within a house logo. Further web prints are provided in GM/4 which depict the same LET ME PROPERTIES logo. These pages contain some testimonials, mainly from people in St Albans, although one is from an overseas landlord and another simply identifies his location as Hertfordshire. Mr Moulton states that the fact that the opponent operates in Bournemouth is not enough to distinguish the businesses as it is common for letting agencies to operate in multiple towns or cities.

28. The rental income handled by the applicant has grown from just over £100k in 2010/11 to over £1 million in both 2014/15 and 2015/16. Advertising costs have grown from £8k to £27k in the same period, but Mr Moulton states that these are not the full figures as advertising costs have not been recorded in great detail. They do not cover, for example, board management, per click advertising, website costs and sponsorship. The applicant also pays for inclusion in property portals such as Right Move. He adds that the applicant does not rely on local newspaper advertising, but instead on its customer service and internet publicity on platforms such as Facebook, LinkedIn and Yelp. Various prints are provided, although none are archived. The Facebook pages show 540 likes, the Twitter page has 1757 followers. The main use is of LET ME PROPERTIES (logo), although there is some use of LET ME (logo) (see, for example, the print from the website UK Letting Agent at page 6 of Exhibit GM/5).

29. Mr Moulton states that the applicant undertakes a lot of work in connection with search engine optimisation. He attaches a screen print from Goggle (for the term “let me properties”) on the side bar of which are Google reviews of the business, with a rating of 4.7 out of 5 (from 30 reviews). Mr Mouton considers this to be a high score and he is concerned about reviews intended for the opponent being placed on the applicant’s Google Places page by mistake (due to the fact that the opponent does not have its own Google Places presence). I note that the hits on the Google search lists the applicant a number of times (including the first two hits), but the opponent is also found on the first page of the search, as is another company which uses the domain letmelettings.co.uk.

30. In his evidence, Mr Wells is critical of the applicant’s evidence. The main thrust of his points are that the applicant’s evidence is of a small business with a limited geographical footprint. He also states that LET ME is not a very distinctive name so the applicant ought not to be granted an exclusive monopoly in it. The latter point has limited relevance because the opponent has not opposed the mark under absolute grounds, its claim, instead, is that deception could arise.

### ***Claimed instances of confusion***

31. The evidence the applicant relies on is as follows:

- Exhibit GM/8 contains an example of what Mr Moulton believes to be a misplaced review. It is a one star review which begins with the words “We have contacted Let me multiple...” (the rest of the text is not shown on the print). A further print shows the user then correcting this to a five star review with the words “Error”. The print is not dated.
- In his second witness statement Mr Moulton provides commentary (but no supporting evidence) about an email (dated after the relevant date) received from the mother (who he assumes was a guarantor) of a tenant who wished to terminate an agreement in respect of a property in Bradford. The issues experienced included that the property was being used as a squat. Mr Moulton assumes that the email was meant for the opponent because it has been active in the Bradford area.
- Also in his second witness statement Mr Moulton provides exhibit GM/15, a print from Twitter posted on 8 August (I assume 2016) by Simply Business. The tweet is about the opponent’s business model (offering one year’s rent) but it used the words “@LetMeProperties” which I assume Mr Moulton considers to be a reference to the applicant’s business due the use of those words in its domain name and its most used business name.
- Confidential Exhibit CA/1 to Ms Ayres witness statement contains details of two calls she made to allegedly confused people. REDACTED.....  
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- Confidential Exhibit GM/9 contains what is said to be various instances of confusion.

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32. Mr Well's evidence comments on the above in a number of ways including that the telephone conversations held by Ms Ayres were leading, that, in fact, his company was the first one listed in a Google search he conducted (Exhibit SW2 refers) (although, in submission, the applicant states that Google searches can be skewed by the user's location and previous browsing history) and that if anything this shows that the applicant is being confused for the opponent.

### ***Damaging conduct***

33. In his second witness statement Mr Moulton states that the opponent has increased its activities and includes evidence of what he says is increased PR, evidence which makes reference to the opponent's claimed unique selling points such as the one years' rent upfront. Examples include PR in Property Industry Eye, Property Hawk, Twitter, This is Money, Letting Agent Today & Mail Online. Mr Moulton states that comments left by readers on some of these pages are disparaging and could therefore impact negatively on the applicant's business. It is fair to say that a good number of the comments express reservation about the opponent's business model and its chances of success.

34. Exhibit GM/10 contains a print of some form of Facebook discussion about one of the opponent's properties which includes what Mr Moulton considers to be misleading information the writer was given regarding the keeping of pets in the property. He also provides prints from the opponent's listings which show, in his view, poor quality listings, with mis-oriented photographs and no information about pets which, he says, is a required part of the Key Facts in this industry.

35. Exhibit GM/11 contains evidence about the opponent's links to a business called Amigo Loans. He states that the opponent may be taking business methods from that sector and applying them to the lettings industry. Ms Ayres comments briefly on this relationship in her evidence. She refers to a related company of the opponent, Amigo Loans Limited, who previously applied for a trade mark – her point appears to be that the opponent should be well versed in common law-searching and should have found the applicant's business before applying.

## **Findings of fact**

### ***Applicant's business***

36. In terms of the applicant's business, there is no reason to doubt the veracity of its date of first use. It has established when it was incorporated and when it registered its domain name and has shown archived evidence of activity on its website. It has also provided archive prints of the website going back as far as 2010. The applicant has provided evidence in terms of the rental income it handles and evidence of promotional spend (which it says is not complete). The opponent argues that the applicant's use is too small. However, in my view, whilst the evidence does not demonstrate a massive goodwill, it is nevertheless far more than a trivial level and easily demonstrates the operation of an ongoing business with a protectable goodwill. Of course, to be relevant in these proceedings, the sign it has put forward for registration, **Let Me**, must be one of the signs associated with its goodwill. In my view, it clearly is. Although the name most often used is **Let Me Properties**, the wholly descriptive nature of the word PROPERTIES means that the distinctive part of the name is Let Me. In any event, there are some uses of the name Let Me alone. I do not consider this finding to be undermined by the fact that the name is most often used as part of a logo. The name itself still forms part of the fabric of the applicant's goodwill. My finding is that the applicant has established goodwill in association with the name **Let Me** in connection with letting agency services. I accept that the use began in 2008 and that by at least 2010 (the earliest evidence of income and the archive web print) it had established a protectable goodwill.

### ***Opponent's business***

37. The applicant does not deny that the opponent has operated a business associated with the name **LetMe**. Indeed, part of its case is that confusion has arisen. Confusion can only arise if parties are operating. I bear in mind that much of the claimed confusion took place after the relevant date. That said, I have no reason to doubt the veracity of the evidence that trade began around 6 months before the applicant filed its trade mark, nor to doubt the claimed value of sales which have been generated. Even if some of the properties were unoccupied (as claimed by Mr Moulton,

along with highlighting some other inconsistencies) they would still have been on the market, and it is unlikely to be the case that no properties were leased at all. I accept that the use began in February 2015. Although six months is a short period of time in which to establish goodwill, I am satisfied that by the time the applicant filed its trade mark application, the opponent too would have established a protectable goodwill as against third parties.

38. I note that the opponent is Richmond Group whereas the use appears to have been made by LMP (as explained by Mr Wells in his witness statement). However, as noted earlier, the small print on some of the opponent's materials identifies that the former is part of the latter. As no issue has been raised in relation to this by the applicant, I am prepared to accept that the opponent owns, or at least jointly owns, the requisite goodwill.

### ***Evidence of confusion***

39. The applicant's evidence of confusion could have been presented more cogently. At times, it is not particularly clear what was said and whether it was truly evidence of confusion. There are, though, two accounts from Ms Ayres after she contacted two of the claimed confused people. That said, it would have been better for the claimed confused people to have provided their own evidence; the evidence from Ms Ayres is just hearsay. I also accept some of the criticisms made by the opponent which again re-enforce that it would have been better for the individuals to simply provide their own account of what happened. Nevertheless, there does appear to be a pattern of numerous people contacting the applicant, be it by telephone or email, when they intended to contact another business. It is reasonable to infer from all of the evidence that the business they were intending to contact was the opponent. In terms of what led to this, there seems to be a common theme of the applicant's business appearing to be the most prominent (or at least one of the most prominent) results on Google searches, with the enquirer/customer who was intending to contact the opponent contacting the applicant instead. The debate about whose results would be most prominent is not helpful. This is because, as the applicant submits, results can vary due to the search algorithms used by Google, the timing of the search and, potentially, browsing history. However, it is logical to assume that the claimed confused people

contacted the company that was prominently identified to them. That is as much as can be said about this, beyond highlighting that it is not clear how much, if any, of this type of confusion took place before the applicant filed its trade mark application.

### ***Damaging conduct***

40. The applicant's evidence touches on the manner in which the opponent does business. Its selling points are that it offers landlords one years' rent upfront, together with a guarantee that the property will be returned in a good state of repair. A point is also taken by the applicant about the relationship of the opponent with the lending company Amigo Loans.

41. In terms of Amigo Loans, there is no reason to believe that the relationship that exists will become known to any material extent, and then, even if it did, whether this would translate into any form of negative association. This argument does not assist.

42. In terms of the business model, whilst I accept that the some people have commented in a fairly cynical manner about the business model and its likely success, there may be many more people who see it as a good opportunity. This is a case where the proof will be in the pudding. There is nothing to suggest that the opponent's business has a negative reputation. The best one can take from the evidence is that due to the unusual business method being used there is potential, if things do not work out, that a negative reputation could arise, but that can be said of any new business venture.

### **Application of facts - conclusions**

43. This is a somewhat unusual case because both parties claim that confusion could arise. The opponent considers that this will be particularly so if the applicant started offering a service with the same (or similar) features to that it offers. The applicant considers that confusion has already arisen. Given this, there can be no doubt that the respective signs, both being used in the field of lettings, have the clear potential to cause confusion in the marketplace. The question though, in terms of these proceedings, is whether the opponent can prevent the use of the applicant. This is

where the issue of competing goodwills comes into play. At paragraph 14 above I set out some guidance provided by Mr Alexander QC in the *Multisys* case dealing with pre-application use made by an applicant for a trade mark. Part of that guidance reads:

“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. “

44. In the *Croom’s TM* case Mr Hobbs QC put it like this:

“I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user’s rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

45. Based upon the findings of fact I have already made, the applicant is the senior user at common law. Indeed, it is the senior user by a good number of years. I note that the opponent submitted that the applicant’s income and promotional spend would be no greater than it’s – however, this is not pertinent in terms of assessing who the

senior user of the mark is. Given all this, and on face value, the facts would require the opposition to be rejected because the senior user (the applicant) ought to prevail over the junior user (the opponent). I say on face value because there are two further issues to consider.

46. First, I have considered what impact the geographical locations of the respective businesses have on the matter. The evidence shows that the applicant is based in St Albans (albeit with a claim that it has customers from around the country) whereas the opponent is based in Bournemouth, but has provided evidence showing listings from other parts of the UK, although, how many were from before the relevant date is not clear. The applicant is of course seeking a national registration. However, I do not consider that the geographical footprint of its business means that it ought not to be considered the senior user in the context of these proceedings. This is because lettings agencies routinely have customers based outside of the locale of the physical location of its office. People from outside the location will be looking at its listings, particularly in a case such as this with St Albans being in the London commuter belt. Further, it is clear that both businesses use property portals such as Right Move which inevitably means that customers from outside the locale of the location of the office will become aware of the business names being used.

47. The second issue relates to the nature of the services, in that the applicant offers a traditional lettings service whereas the opponent has a slightly different form of offering. I do not consider this to be significant as such differences would not avoid confusion. It follows from this that such a difference is not pertinent on the senior user status of the applicant. It is sufficient to say that the applicant is the senior user in respect of lettings agency services. Nor, therefore, would it be right to require the applicant to apply any form of limitation to its specification.

48. In consequence of the above, the applicant is the senior user and must therefore prevail over the junior user of the mark. The opponent cannot prevent the use of the mark by the applicant on account of this senior user status. The opposition is therefore rejected.

## **Conclusion**

49. The opposition fails and, subject to appeal, the application may proceed to registration.

## **Costs**

50. The applicant has been successful and is entitled to a contribution towards its costs. My assessment is set out below.

Considering the *statement of case and preparing a counter-statement* - £300

*Filing and considering evidence* - £800

Written submissions - £400

***Total* - £1500**

51. I order Richmond Group to pay Let Me Ltd the sum of £1500 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 10<sup>th</sup> day of March 2017**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**