

O-775-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3539135**

SOJON

IN THE NAME OF BAYLEY WHITEOAK-DOOLEY

AND

AN APPLICATION FOR INVALIDATION

UNDER NO. 503616

BY SOJON LTD

Background and pleadings

1. Bayley Whiteoak-Dooley (“the proprietor”) owns the trade mark shown on the cover page of this decision.
2. The registration covers the following goods:

Class 9 Electrical travel adaptors; plug adaptors; travel adaptors for electric plugs; adapter plugs; electric plug adaptors.
3. The application to register the mark was filed on 30 September 2020, and it was entered in the register on 22 January 2021.
4. Sojon Ltd (“the applicant”) applied for a declaration of invalidity against all the goods in the registration by filing a form TM26(I) based on section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
5. Under section 5(4)(a), the applicant claims goodwill in the sign Sojon. The applicant further claims that it first used the sign as early as June 2016 throughout the UK. The goodwill is claimed in respect of goods set out in the annex of this decision. Consequently, the applicant submits that it is entitled to prevent the use of the contested mark under the law of passing off.
6. The proprietor filed a counterstatement denying the grounds of invalidation.
7. The applicant is represented by Herrington Carmichael LLP and the proprietor is unrepresented. Both parties filed evidence. I make this decision after a careful reading of all the papers filed by the parties.
8. Although the UK has left the European Union (“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

9. The applicant's evidence comes in the form of 2 witness statements of Mr Mohamed Akhtar together with 3 exhibits. The witness statements are dated 26 July 2021 and 13 December 2021, respectively. Mr Akhtar is the sole director of the applicant company. The proprietor's evidence comes in the form of a witness statement of the proprietor dated 27 September 2021, together with 1 exhibit. The witness statements of both parties mostly consist of submissions which I confirm I have read and shall bear in mind while making my decision. I will return to the evidence later in the decision.

Preliminary Remarks

10. In his witness statement, the proprietor states that he is the director and the shareholder of Global Shopdreams Ltd ("Global"). Global sells various products, including plug adaptors, on Amazon.co.uk. The proprietor explains that when a customer searches for 'adaptor plugs' on Amazon, the customer is presented with a list of products, including adaptor plugs sold by the applicant. Once the customer selects the applicant's goods, the customer is presented with an option to search for other sellers who sell adaptor plugs under the applicant's "listing". According to the proprietor, Global is listed as one of the "other sellers" and began selling adaptor plugs since August 2020 using an existing listing created by the applicant. The proprietor provides the following screenshot to explain how the goods are listed on Amazon:

The screenshot displays an Amazon product listing for a 'White UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver/Toothbrush by Sojon Ltd'. The product image on the left shows a white plastic plug with two gold pins. The product details on the right include the price (£5.15), delivery options (FREE delivery Wednesday, May 26), and a 'Click for other sellers' callout box pointing to the 'Add to List' button. The listing also features customer ratings by feature and a 'Buy Now' button.

White UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver/Toothbrush by Sojon Ltd

Brand: Sojon

★★★★★ 10,973 ratings | 28 answered questions

#1 Best Seller in International Power Adaptors

Was: £6.49
Price: £5.15
You Save: £0.34 (6%)

Pay £5.15 £0.00: get a £20 Amazon Gift Card on approval for the Amazon Platinum Mastercard. Terms apply.

Note: This item is eligible for FREE click and collect without a minimum order. Details

New (2) from £5.15 & FREE Delivery on your first eligible order to UK or Ireland.

- UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver / toothbrush
- Allows you to change an electric shaver or toothbrush from a normal 5 pin UK socket
- Plug is made to Applicable UK standards. Design, shape and color may vary
- This plug adapter comes with a 1 amp fuse fitted

See more product details

Customer ratings by feature

Easy to use	★★★★★	4.5
For travelling	★★★★★	4.3
Value for money	★★★★★	4.2
Sturdiness	★★★★★	4.2

See all reviews

£5.15

FREE delivery: Wednesday, May 26 on your first eligible order to UK or Ireland.

Fastest delivery: Tomorrow
Order within 7 hrs 26 mins
Details

Deliver to MR - Husham RH10 3UL

In stock.

Quantity: 1

Add to Basket

Buy Now

Secure transaction

Sold by SOJON and Fulfilled by Amazon.

Add gift options

Add to List

New (2) from £5.15 & FREE Delivery on your first eligible order to UK or Ireland.

Share

Click off-weather

11. The proprietor further submits:

“5. This claim relates to a trademark I registered on 30/09/2020 Trademark number UK00003539135 for the purpose of protecting a particular listing on Amazon for a ‘2 pin to three pin’ plug adaptor..

...

6. As the product wasn’t branded and neither were the photos in the listing (also known as a white label item), Global sourced the adapter independently and began selling the adapter plug abiding by Amazon terms and conditions. After a period of time the adaptor sales were increasing however, many Chinese sellers were coming on the listing selling faulty adaptors and damaging margins for ourselves and I predict Sojon Ltd alike, so I looked to protect the listing for Global and Sojon by registering the trademark. This was the primary reason for registering the trademark. This has resulted in secured sales eliminating competition for both Global and Sojon.”¹

12. It appears that the proprietor applied to register the mark Sojon under a misconception that by registering the mark in its name, the proprietor could protect the “listing” for plug adaptors by the applicant and Global on Amazon. I will clarify for the sake of the proprietor that by registering the trade mark Sojon in the proprietor’s name, the proprietor gained an exclusive right to use the mark in relation to various adaptor plugs and, in the absence of an agreement, prevent the use of the mark by any third party including the applicant. At present even if the proprietor or Global do not sell adaptor plugs under the sign Sojon, the proprietor has five years within which it can put the mark to use in relation to various adaptors covered by the registration. Therefore, I must determine the invalidation proceedings upon the hypothesis of normal and fair use by the proprietor of the mark Sojon in relation to adaptors. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

¹ Proprietor’s witness statement

"22.It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

Section 5(4)(a)

13. Section 5(4)(a) of the Act reads as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, 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".

14. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

15. There is no evidence that the proprietor’s mark was used in the UK prior to the date of application. That being the case, the matter must be assessed only at the application date of that mark (30 September 2020).

Goodwill

16. The applicant claims goodwill in the sign Sojon. The goodwill depends on the existence of customers in the UK for Sojon goods at the relevant date.² The goodwill must also be more than trivial in extent.³

17. The applicant was incorporated in 2016. It sells various household items on Amazon.co.uk.⁴ The applicant’s “best and fast selling item” on Amazon is its

² *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

³ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

⁴ 1st witness statement of Mr Akhtar, para 7.

fuse adaptor plugs.⁵ Following is a screenshot from Amazon of the applicant's adaptor sold under the brand Sojon:

The screenshot shows the Amazon.co.uk product page for a white UK 2-pin to 3-pin 1A fuse adaptor plug. The product is shown in a 3D perspective view. The page includes the Amazon navigation bar, a search bar, and various category links. The product title is 'White UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver/Toothbrush by Sojon Ltd'. The brand is 'Sojon'. The product has a 4-star rating from 9,016 ratings and 23 answered questions. It is marked as 'Amazon's Choice' for 'plug adapter'. The price is £5.79, with a 'You Save' of £0.16 (3%). The product is available in a 'Single Pack' size. The description includes: 'UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver / toothbrush', 'Allows you to charge an electric shaver or toothbrush from a normal 3 pin UK socket', 'Plug is made to Applicable Uk standards. Design, shape and color may vary', and 'This plug adapter comes with a 1 amp fuse fitted'. There is a 'Free delivery on your first order' badge and a 'Click to open expanded view' link.

The screenshot shows the 'Product details' and 'Products related to this item' section of the Amazon product page. The 'Product details' section includes: 'Is Discontinued By Manufacturer: No', 'Package Dimensions: 6.6 x 6.3 x 4.8 cm; 30 Grams', 'Date First Available: 1 May 2018', 'Manufacturer: Sojon', 'ASIN: B07CS469FD', 'Item model number: WEBAAM-07', 'Best Sellers Rank: 33 in Electronics & Photo (See Top 100 in Electronics & Photo)', '2 in International Power Adapters', and 'Customer reviews: 4.5 stars (9,016 ratings)'. The 'Products related to this item' section shows a carousel of related products with their titles and prices: 'Toothbrush Adaptor Plug UK Charger/Adapter Shaver Socket 2 Pin to 3 Pin Electric Co. £5.29', 'VIGARD 1A Fuse Adaptor Plug (2 Pack) UK Adapter Plug 2 Pin (round or flat) to 3 Pin. £6.49', 'Heavy Duty UK 1A Electric Shaver Razor Adaptor Toothbrush Plug Socket Converts 2 T... £4.89', 'EU 2 Pin To UK 3 Pin Travel AC Power Shaver Toothbrush G4US Adapter Plug £5.99', 'Sojon® 2X Pack of Shaver Adaptor UK 3 Pin to 2 Pin Socket Plug Fuse Ideal for Elect... £6.89', 'UK 2 to 3 Pin Fuse Adaptor Plug 1 Amp For Toothbrushes Only £4.99', and '3 Plug Adapters Socket Europe, Italy, Germany, France, United Kingdom, Spain, Unit... £3.69'.

⁵ Ibid, para 12

18. According to the screenshot, the adaptor plugs appear to have been first made available in May 2018. The applicant has provided a copy of its most recent business report which consists of 2 pages.⁶ The first page shows that 5,699 units of adaptor plugs were ordered. The second page refers to the sale of an item identified with a code B2B and no assistance has been provided to understand what it refers to. As the report is undated, I cannot ascertain if the sales shown pre-date the relevant date. Therefore, I place limited reliance on this report.

19. Mr Akhtar states that the applicant sells its products via private labelling wherein the products are physically labelled with the sign Sojon before the sale. The proprietor disputes the applicant's claim about labelling the products with the sign Sojon. However, it is clear from the screenshots provided by both parties that the applicant's adaptor plugs were identified on Amazon as Sojon. The evidence indicates that the adaptor plugs were labelled as "Amazon choice". According to Mr Akhtar, Amazon Choice label means that the applicant's adaptor plugs are among the top 20 selling fuse adaptors on Amazon. In the absence of cross-examination, I accept Mr Akhtar's statement on the point. However, it is not clear when the products were labelled as "Amazon choice". Even if the label was granted after the relevant date, I am of the view that there must have been a considerable sale in the past in order for the product to get relevant recognition among the consumers. Mr Akhtar also gives evidence that the applicant has spent over £100,000, which resulted in the product becoming a top seller on Amazon.⁷ Mr Akhtar also states that the adaptors have received 11,980 positive feedbacks on Amazon until July 2021.⁸ As the relevant date to demonstrate goodwill is 30 September 2020, I infer that some of the reviews must have been received after the relevant date. The evidence could have been presented better. Nonetheless, on the balance of probabilities, I conclude that the applicant has generated protectable goodwill in adaptor plugs under the sign Sojon. Although the applicant claims goodwill in a number of other

⁶ Exhibit MA-WS2

⁷ Mr Akhtar's first witness statement, para 12.

⁸ *Ibid*, para 16.

household items listed in the annex of this decision, the evidence is insufficient for me to conclude that the applicant has generated protectable goodwill in the trade of any other goods.

Misrepresentation and damage

20. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides 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.”

21. The goods covered by the contested mark are electrical travel adaptors, plug adaptors, travel adaptors for electric plugs, adapter plugs, and electric plug adapters. These goods are identical to adaptor plugs for which the applicant has demonstrated goodwill.
22. The contested mark and the sign in which the applicant has an earlier right are identical.
23. The relevant public consists of members of the public. Adaptor plugs are relatively cheap and are unlikely to be purchased frequently. When purchasing the product, the consumer is likely to check the compatibility with various charging points. These factors suggest that the average consumer is likely to pay a degree of attention that could range between low and medium. Visual considerations are likely to dominate the selection process, although I do not discount the possibility of an aural element, particularly when advice is sought from other users, for example.

24. The question of whether the use of the contested mark would amount to a misrepresentation depends on an overall assessment of all relevant factors. No one such factor automatically trumps the others. It is also necessary to keep in mind that passing-off does not require deception amongst all, or even a majority, of the applicant's Sojon customers. It is sufficient if a substantial number are deceived.

25. Mr Akhtar in his witness statement states that if the proprietor sells products labelled with Sojon on Amazon, the consumers would assume that they are purchasing goods from the applicant. I agree. The contested mark is identical to the applicant's sign. In those circumstances, I find it likely that the use of the contested mark will confuse and deceive a substantial number of the applicant's customers or potential customers if the contested mark is used in relation to identical goods. The consumers are likely to think that the goods are the responsibility of the same undertaking.

26. I must now go on to consider if the applicant has suffered, or is likely to suffer, damage as a result of this misrepresentation. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the claimant must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill".

27. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

"But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in

the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

28. The level of confusion and deception will be sufficient to damage the applicant’s goodwill by way of loss of brand control. I note the applicant’s evidence that Amazon removed the listing of the product by a third party, who was authorised to sell the applicant’s products, as the ‘right owner of trade mark’ alleged an infringement.⁹ It, therefore, follows that damage can arise through loss of sale if/when the applicant or any third parties authorised by the applicant are prevented from selling the products under the sign Sojon. Accordingly, I conclude that the use of the contested mark in relation to the goods covered by its specification would amount to passing off.

29. The application for invalidation succeeds under section 5(4)(a).

Conclusion

30. The application for invalidation has succeeded and the contested mark may hereby declared invalid in respect of all the goods for which it was registered. Under section 47(6) of the Act, the registration may deem never to have been made.

Costs

31. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I award costs to the applicant on the following basis:

Preparing statements and

⁹ Exhibit MA3.

considering the proprietor's statement:	£200
Filing evidence	£300
Official fee	£200
Total	£700

32. I, therefore, order Bayley Whiteoak-Dooley to pay Sojon Ltd the sum of **£700**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of September 2022

**Karol Thomas
For the Registrar
The Comptroller-General**

Annex

Item.	Description
1.	Sojon® 2X Pack of Shaver Adaptor UK 3 Pin to 2 Pin Socket Plug Fuse Ideal for Electric Toothbrush, Bathroom Shaving and More - White
2.	Sojon® 2X Pack of Shaver Adaptor UK 3 Pin to 2 Pin Socket Plug Fuse Ideal for Electric Toothbrush, Bathroom Shaving and More – White
3.	White UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver/Toothbrush by Sojon Ltd
4.	Sojon 4X Set of Kitchen Dry Food Storage Plastic Tub Containers with Scoop Ideal for Pasta, Cereal, Rice, Pet Food and More
5.	Sojon 2x Batteries for Nissan Navara X-Trail Juke Qashqai Note Key Fob cr2032
6.	Sojon Sports Posture Corrector Spinal Support - Physical Therapy Posture Brace for Men or Women - Back, Shoulder, and Neck Pain Relief - Spinal Cord Posture Support Black Medium (M) 36-42 in (Black)
7.	Sojon Sports Posture Corrector Spinal Support - Physical Therapy Posture Brace for Men or Women - Back, Shoulder, and Neck Pain Relief - Spinal Cord Posture Support Black Medium (M) 36-42 in (Black)
8.	Sojon 2x Pack of UK to Australia Australian New Zealand Tourist Travel Plug Power Mains Adaptor – White
9.	<u>Brand: Sojon</u> 4 Piece Set of Plastic Kitchen Storage Box Dry Food Dispenser Container 2.5L with Air Tight Lid Ideal for Cereals, Rice, Pasta and Much More
10.	<u>Brand: Sojon</u> Dry Food Storage containers 4.8 litres with lid Perfect for Storing Food Such as Cereals Dog Food pet Treats Cookies Chocolate and Great for Saving Space in The Kitchen. Comes as a Pack of 4.
11.	<u>Brand: Sojon</u> Ice Lolly Moulds, Popsicle Maker Set, 6 Ice Lolly Moulds and Sticks Silicone, LFGB Certified BPA Free Ice Cream Moulds Reusable Ice Pop Mould for Kids Adults DIY Popsicle Mold
12.	<u>Brand: Sojon</u> 2x Batteries For BMW 1 3 5 Series Remote Key Fob E60 E90 E87 2004 CR2032
13.	<u>Brand: Sojon</u> Sojon White UK 2 Pin To 3 Pin 1A Fuse Adaptor Plug For Shaver/Toothbrush - 2 Pack
14.	<u>Brand: Sojon</u> 240ML Coffee Tall Clear Glass Cafe Latte Cappuccino Mug Cup Pack of 6
15.	<u>Brand: Sojon</u> 2x Batteries for Audi A1 A3 A4 A5 A7 A8 S3 S4 S5 RS3 RS4 RS5 RS6 KEY FOB CR2032

16.	<u>Brand: Sojon</u> Sojon 2x Batteries for Mini Cooper S D Clubman JCW Countryman Key Fob CR2032
17.	<u>Brand: Sojon</u> 2x Batteries for Seat ibiza Leon Mii Toledo Remote Key Fob CR2032
18.	<u>Brand: Sojon</u> 5x UK to AUS Australia New Zealand Tourist Travel Plug Power Mains Adaptor White
19.	<u>Brand: Sojon</u> 2 X UK to US Travel Adaptor suitable for USA, Canada, Mexico, Thailand - Refer to Description for country list
20.	<u>Brand: Sojon</u> 2x Set of Round Non-Stick Quick-Release 9 Inch Spring Form Deep Cake Bake Tins Oven Tray
21.	<u>Brand: Sojon</u> Sojon Rose Gold Ultra Thin Gel Bling Glitter Detachable TPU Case For iPhone 5 5S SE
22.	<u>Brand: Sojon</u> Sojon BL-T16 BATTERY FOR G FLEX 2 H955 2920 mAh
23.	<u>Brand: Sojon</u> 3x 940 ml MICROWAVEABLE PLASTIC FOOD CONTAINER BOWLS LUNCH SOUP HANDLE WITH LID
24.	<u>Brand: Sojon</u> Sojon Google Pixel 3 CHARGER CABLE USB Type C Sync CABLE Charging Cable Lead
25.	<u>Brand: Sojon</u> SOJON New TomTom Easyport Window Mount for TomTom ONE V4 / V5 / XL/XXL / XL2 / IQ