O/0034/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003407713 AND UK00003407698

BY NUCLEI LIMITED

TO REGISTER THE FOLLOWING TRADE MARKS:

EASYOFFICES

IN CLASS 36

AND OPPOSITIONS THERETO UNDER NOS. 418616 AND 418617

BY EASYGROUP LIMITED

BACKGROUND AND PLEADINGS

1. On 18 June 2019, Nuclei Limited ("the applicant") applied to register UKTM no. 3407713 ("the First Application") and UKTM no. 3407698 ("the Second Application"), as shown on the cover page of this decision, in the UK. The applications were published for opposition purposes on 30 August 2019 and protection is sought for the following services:

Class 36	Management, brokerage, leasing and appraisal of real estate; real estate affairs; rental, brokerage, leasing and management of commercial property, offices and office space; rental of property; arranging leases for the rental of property; property development services; advice, information and consultancy relating to these services.

2. On 2 December 2019, the applications were opposed by easyGroup Limited ("the opponent") based upon sections 5(3) and 3(6) of the Trade Marks Act 1994 ("the Act").[1]

3. Under section 5(3) of the Act, the opponent relies upon EUTM no. 010584001 for the trade mark EASYJET.[2] The opponent relies upon some of the services for which the earlier mark is registered, as follows:[3]

Class 39	Transport, packaging and storage of goods; travel arrangement; travel information; provision of car parking facilities; transportation of goods, passengers and travelers by air, land, sea and rail; airline and shipping services; airport check-in services; arranging of transportation of goods, passengers and travelers by land and sear; airline services; baggage

[1] The opposition was also originally reliant upon section 5(2)(b) of the Act and other marks owned by the opponent. However, due to other ongoing proceedings between the parties, this case proceeds on the sections and marks listed here only. In this regard, see paragraph 13 of the opponent's written submissions in lieu. Further, although the claim originally included a 'family of marks' argument, this aspect of the opponent's claim can also not proceed in circumstances where only one earlier mark is relied upon.

[2] The opponent is permitted to rely upon an EUTM because these opposition proceedings were launched prior to IP Completion Day (being 31 December 2020).

[3] Although the specification of this mark is currently narrower than the specification listed here, this is by virtue of a revocation action which took effect from 28 July 2020. As such, the specification listed here was in force at the relevant date, being the date of application for the contested marks.

handling services; cargo handling and freight services; arranging, operating and providing facilities for cruises, tours, excursions and vacations; chartering of aircraft; rental and hire of aircraft, vehicles and boats; chauffeur services; taxi services; bus services; coach services; rail services; airport transfer services; airport parking services; aircraft parking services; escorting of travelers; travel agency services; tourist office services; advisory and information services relating to the aforesaid services; information services relating to transportation services, travel information and travel booking services provided on-line from a computer database or the internet.

4. The opponent claims to have a reputation for the above services and claims that use of the applications would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character, and/or repute of the earlier mark.

5. The section 3(6) claim brought by the opponent is based upon the applicant's alleged prior knowledge of the opponent's trade mark rights.

6. The applicant filed counterstatements denying the grounds of opposition and stating that it has been trading under the name EASYOFFICES continuously since around May 2000 in relation to the rental of serviced office space and providing advice in relation to the same.[4]

7. Neither party requested a hearing and so this decision is taken following careful consideration of the papers on file.

REPRESENTATION

8. The applicant is represented by Mischon de Reya LLP.

9. The opponent is represented by Kilburn & Strode LLP.

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[4] Whilst proof of use was requested for some of the other marks originally relied upon by the opponent, the applicant did not request proof of use of the EUTM relied upon here.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in the form of the witness statement of Ryan Edward Pixton dated 13 May 2024, which is accompanied by 11 exhibits (REP1 to REP11). Mr Pixton is a Chartered Trade Mark Attorney acting on behalf of the opponent in these proceedings.

11. The applicant did not file evidence.

12. Both parties filed written submissions in lieu on 16 December 2024.

RELEVANCE OF EU LAW

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

<u>Section 5(3)</u>

14. Section 5(3) of the Act states:

> "5(3) A trade mark which -
>
> > (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be

detrimental to, the distinctive character or repute of the earlier trade mark."

15. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair

advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

16. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark and the applicant's marks are similar. Secondly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier mark being called to mind by the later marks. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Similarity of the marks

17. The applications both include the word EASY, as does the earlier mark. I will compare the marks in further detail below, but suffice to say, there is sufficient similarity between them to meet this requirement.

Reputation

18. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

19. I note that the applicant has raised issues with the opponent's evidence, such as the reliability of Sir Haji-Ioannou as a witness. However, for reasons that will become clear later on in this decision, nothing will turn on this. Consequently, I will proceed on the basis that I can take the opponent's evidence at face value. With that in mind, I have reviewed the opponent's evidence in its entirety. In particular, I note the following:

a. The opponent started using the earlier mark in the UK in 1995 in relation to airline services.[5]

b. In 2017, over 74million passengers flew with easyJet.[6]

c. The airline services a number of European Union member states including Germany, Spain, Greece, Italy, France, Austria and Belgium.[7]

d. The website www.easyJet.com had 3,797,300,717 page views from the UK between 2011 and 2016.[8]

e. There is also evidence of the opponent providing accommodation booking services under the earlier mark.[9]

[5] Exhibit REP1
[6] Exhibit REP1
[7] Exhibit REP1
[8] Exhibit REP1
[9] Exhibit REP1

f. Public awareness of the easyJet brand was raised by a television programme called *Airline* which was broadcast on ITV between 1999 and 2006. The fourth series, which ran in 2001, had around 9million viewers per episode.[10]

g. For the year ending 30 September 2016, easyJet's market share was 20% in the UK, 14% in France, 12% in Italy, 4% in Germany, 13% in Portugal, 8% in Spain and 10% in the Netherlands.[11]

h. Total revenue for the year ending 30 September 2019 was £6,385million, although no breakdown is provided as to what proportion of this relates to the European Union (or UK).[12] Although some of this would have related to the period after the relevant date it is likely that most of it would have been prior to it given that there is only a three month gap between the relevant date and the end of the financial year in question.

i. In June 2018, over 7.9million passengers flew with easyJet. In July 2019, only one month after the relevant date, over 9.4million passengers flew with easyJet.[13] It is not clear what proportion of these were located in the European Union.

j. The opponent had won a number of awards for its airline services in European Union member states prior to the relevant date.[14]

20. Whilst I recognise that there are some points in the evidence that could have been further particularised in terms of where customers were located, I have no doubt in concluding that the opponent had a significant reputation for airline services under the earlier mark at the relevant date. Whilst I note that there is some evidence of use for travel arrangement, the details of this are very limited. I cannot be satisfied, on the evidence before me, that the use in relation to travel arrangement is sufficient to satisfy

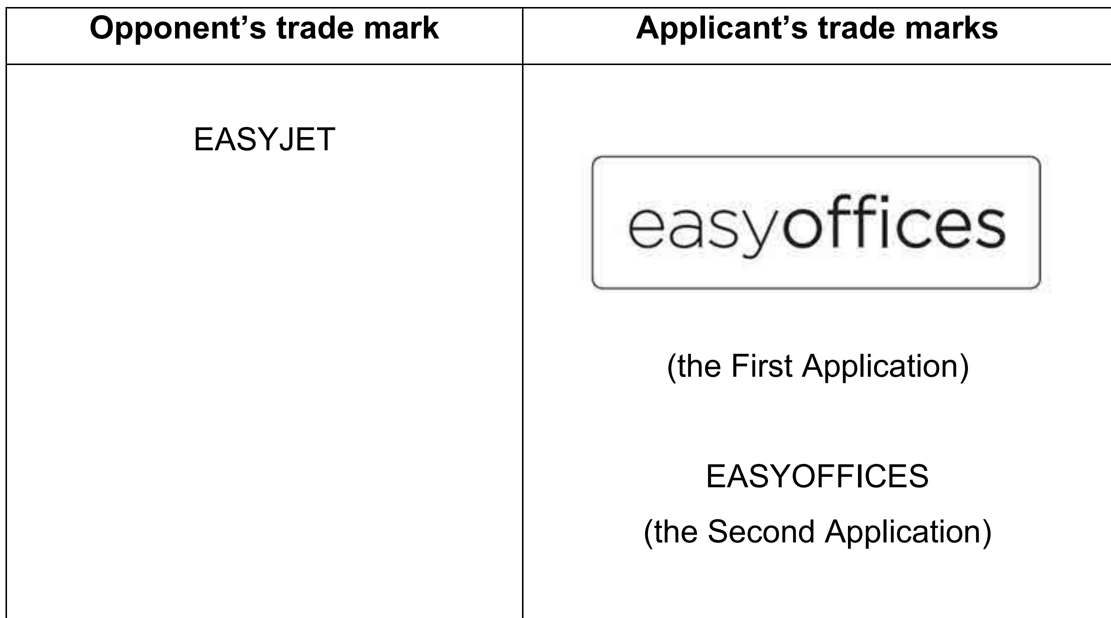
[10] Exhibit REP1
[11] Exhibit REP5
[12] Exhibit REP5
[13]Exhibit REP7
[14] Exhibit REP8

the requirements of reputation. The same is also true in relation to services such as information and booking. Consequently, I will proceed on the basis that the opponent had a strong reputation for *airline services* at the relevant date.

Link

21. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

> <u>The degree of similarity between the conflicting marks</u>
>
> It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:
>
>> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."
>
> It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
>
> The respective trade marks are shown below:



Opponent's trade mark	Applicant's trade marks
EASYJET	easyoffices (the First Application) EASYOFFICES (the Second Application)

Overall Impression

The opponent's mark consists of the conjoined words EASYJET. The overall impression of the mark lies in the combination of these words.

The Second Application consists of the conjoined words EASYOFFICES. The overall impression of the mark lies in the combination of these words.

The First Application consists of the same conjoined words as the Second Application, but in a slightly stylised font and presented in a rectangular border with curved corners. The word OFFICES appears in a slightly bolder font than the word EASY. In my view, the overall impression lies in the combination of the words with the stylisation/border playing a lesser role.

Visual Comparison

The earlier mark and the Second Application overlap in that they both contain the word EASY as the first of the conjoined words in each mark. I bear in mind that the beginnings of marks tend to make more of an impact than the ends, and this is where the similarity lies in this case.[15] The marks differ in that the

[15] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

second word in the earlier mark is JET and in the Second Application is OFFICES, neither of which are visually similar to each other. In my view, the marks as a whole are visually similar to a medium degree.

The same is true of the comparison with the First Application. I bear in mind that the earlier mark is a word only mark and so could be used in any font. The border in the First Application is a point of visual difference, albeit a minimal one. In my view, the marks are visually similar to a slightly lower than medium degree.

Aural Comparison

The word EASY will be pronounced identically in all three marks. The word JET in the earlier mark and OFFICES in the applications are aurally different. In my view, the marks as a whole are aurally similar to a medium degree.

Conceptual Comparison

The word EASY will have the same meaning in each mark. It's meaning is clearly laudatory. The differing suffixes will be a point of conceptual difference because the thing that is being described as easy in each mark is different (JET vs OFFICES). In my view, the marks are conceptually similar to between a low and medium degree.

<u>The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public</u>

When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In its written submissions in lieu, the opponent states as follows:

"50. The Opponent holds a reputation for easyJet in relation to airline and travel-related services, and operates in airports tied to key business

> hubs, where consumers may wish to utilize lounge, or office services in order to work when they travel on business. It is of course common for airlines to offer business travellers lounge access as part of its services. Those lounges often contain business facilities to enable business travellers to work.
>
> 51. It is also common for providers of serviced offices to offer such facilities at airports, where their marks would appear alongside those of airlines. There is a clear and obvious link between airlines and the provision of serviced offices in that sense – even if the nature of the services differs, the marks appear in the same settings to the same consumers, and are complementary."

I have no evidence to support any of these contentions. I am not convinced that the provision of business facilities in an airport lounge is the same as the services covered by the applicant's specification (which relate to leasing, brokerage, management and rental of commercial spaces). However, even if that were true, the fact that business travellers use both airline services and business facilities in airport lounges does nothing more than demonstrate that there is an overlap in user. It does not demonstrate an overlap in trade channels, as I have no reason to find that the same undertakings would offer the rental, brokerage, leasing or management of commercial space (whether in an airport or elsewhere) and airline services, nor do I consider that to be a matter of which I can take judicial notice. There is plainly no overlap in nature, method of use or purpose of the services. Given the differing purposes, there can be no competition. I do not consider there to be complementarity because one service is not important or indispensable for the other, nor would the relevant public consider that the same undertaking is responsible for both. I do not consider that the overlap in user alone is sufficient for a finding of similarity. In my view, the services are dissimilar.

The relevant public will include both members of the general public and professional users. For the opponent's services, factors such as safety records, reliability, range of destinations on offer and timeliness are all likely to be

considered. For the applicant's services, reputation of service provider, range of facilities available and location are all likely to be considered. I find that the level of attention paid during the purchasing process is likely to be above medium and, in some cases, high.

The marks are likely to be encountered on advertisements, on websites and on physical premises. Consequently, the purchasing process will be predominantly visual, although I do not discount an aural component given that word-of-mouth recommendations may play a part.

<u>The strength of the earlier mark's reputation</u>

The earlier mark has a strong reputation in the UK.

<u>The degree of the earlier mark's distinctive character, whether inherent or acquired through use</u>

In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark

has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

The word EASY in the earlier mark is laudatory and, inherently, descriptive. The word JET will also be descriptive or non-distinctive for the services for which the opponent has a reputation. The inherent distinctive character of the earlier mark lies in the combination of these words as a whole. I find the earlier mark to be inherently distinctive to between a low and medium degree.

I have summarised the opponent's evidence of use above. I find that the distinctive character of the earlier mark has been enhanced through use to a high degree for airline services.

Whether there is a likelihood of confusion

Given the distance between the parties' services, I do not consider there to be a likelihood of direct or indirect confusion. This is particularly the case given that the distinctiveness of the opponent's mark lies in the combination of the words EASY and JET as a whole. I do not consider that the relevant public would believe that anyone using the word EASY and another dictionary word in combination must be connected with the opponent.

Conclusions on link

22. Taking all of the above factors into account, particularly the descriptive/non-distinctive nature of the common element and the distance between the parties' respective services, I find that despite the strength of the earlier mark's reputation, the relevant public is unlikely to make a link between the respective marks. If a link was made, it would be too fleeting for damage to occur.

23. The opposition based upon section 5(3) of the Act is dismissed.

Section 3(6)

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

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

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

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those

goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

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

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

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

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

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

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

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

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

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

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

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to

the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

26. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

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

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

28. The opponent's bad faith claim is pleaded as follows:

"12. Despite its previous applications opposed by the Opponent, the Revocations and the Related Proceedings, on 18 June 2019 the Applicant filed the current application in full knowledge of the Opponent's earlier registered trade mark rights and the grounds outlined in detail in Sections A and B of this TM7.

13. The Opponent therefore maintains that the Applicant has filed this application in bad faith and, in accordance with section 3(6) of the Trade Marks Act 1994, this trade mark application should be refused."

29. In its written submissions in lieu, the opponent states:

"33. In an overall assessment of all the facts, it can be concluded that when filing the Contested Applications, the Applicant's aim was to compete unfairly by taking advantage of the Opponent's renowned and attempting to remove its earlier rights by acquiring the BAA Marks, which pre-dated the Opponent's but had not been used. As such, the objective circumstances of the facts, combined with the specific circumstances, must inevitably lead to a conclusion of bad faith in respect of all services covered by the Contested Applications."

30. The opponent's bad faith claim appears to be focused upon the rights that the opponent had at the time of filing the opposition in the mark easyOffice. That mark is no longer relied upon in these proceedings. However, there is evidence that the opponent first registered the mark easyOffice in 2002 and first started using it in 2007.[16] There were physical office spaces that were rented under the mark, but there was also a booking service through which users could book office space elsewhere.

31. I have no evidence before me regarding the applicant's activities, but their pleaded case is that they began operating the EASYOFFICES business in 2000. The parties (or entities associated with them) have been in dispute regarding these marks for a number of years. It seems to me that the fact that the applicant knew that the opponent was claiming to have competing rights does not render its application for the marks in issue bad faith. Knowledge alone is not enough: *Lindt, Koton* (paragraph 55). The burden is on the opponent to prove that the application has been filed with the intention claimed (i.e. taking advantage of the opponent's renown and attempting to remove its earlier rights). I acknowledge the opponent's submission that the applicant has not filed any evidence to rebut the opponent's case. However, the opponent must first prove a prima facie case of bad faith before the question of whether the applicant has

[16] REP1

sufficiently rebutted that case arises. There does not appear to be anything in the evidence before me to suggest a motive on the part of the applicant that is not consistent with the essential function of a trade mark. In my view, the opponent has fallen well short of establishing a prima facie case. Consequently, I dismiss the bad faith claim.

32. I am fortified in this finding by the fact that the evidence in this case confirms that the opponent's easyOffice business was wound up in 2012 and, since then, no rental of physical premises has taken place.[17] The opponent's evidence is that the website aspect of the business was continuing as of the date of Sir Haji-Ioannou's statement (i.e. 2017). However, in the judgment relied upon by the applicant, Bacon J confirms that this ceased in January 2019, with the business carrying on trading under the name easyHub from September 2019.[18] I note that the timing of this change coincides with the filing of the applications in the present case. Whilst not determinative in my finding above, the timing of these applications to coincide with that cessation of business on the party of the opponent, seems to me to add legitimacy to the applicant's position.

33. The opposition based upon section 3(6) of the Act is dismissed.

CONCLUSION

34. The oppositions are unsuccessful and, subject to appeal, the applications may proceed to registration.

COSTS

35. The applicant has been successful and is, therefore, entitled to a contribution towards its costs. In its written submissions in lieu, the applicant indicated an intention to seek an award of off-scale costs in this case. Consequently, I direct as follows:

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[17] Exhibit REP1

[18] See paragraph 23 of the judgment of Bacon J.

a. The applicant has 14 days in which to make submissions on costs. Any request for off-scale costs should be accompanied by a full breakdown of the costs incurred.

b. The opponent will then have 14 days from receipt of those submissions in which to respond.

36. I will then issue a supplementary decision on costs.

APPEAL PERIOD

37. The appeal period for this decision will not begin to run until the date of my supplementary decision on costs.

Dated this 21st day of January 2026

S WILSON
For the Registrar