

O/0303/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. UK00003366391

IN THE NAME OF EAST LOTHIAN COUNCIL

FOR THE FOLLOWING TRADE MARK:



AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 507162

BY SCOTLAND'S GOLF COAST LIMITED

## BACKGROUND AND PLEADINGS

1. East Lothian Council (“ELC”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK on 11 January 2019. It was registered on 29 March 2019 for the following services:

**Class 41:** *Arranging and conducting of entertainment events; Arranging and conducting of meetings in the field of entertainment; Arranging of conferences relating to entertainment; Arranging of displays for entertainment purposes; Arranging of entertainment shows; Arranging of exhibitions for entertainment purposes; Arranging of festivals for entertainment purposes; Sports entertainment services.*

2. On 18 April 2024, Scotland's Golf Coast Limited (“SGCL”) applied to have the contested mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”) based upon Section 3(6) of the Act.

3. In its statement of grounds, the applicant states as follows:

*“The Council have never owned the Scotland's Golf Coast logo/brand. Therefore, when making its original trademark registration application (UK00003127442 in 2015) its subsequent re-submission (UK00003366391 in 2019) and its current filing of a Notice of Threatened Opposition to our own trade mark registration application (UK00003985448) the Council has clearly misrepresented the ownership status to the Intellectual Property Office. Scotland's Golf Coast Ltd (logo/brand owners) has offered the most straightforward means by which to address the matter by requesting the transfer of the Trade mark Registration. The Council has refused to do so and so the misrepresentation of ownership is brought to the attention of the Intellectual Property Office in support of this application to invalidate the current trademark registration.”*

4. Notably, our records show that the trade mark no. UK00003127442 was another trade mark owned by ELC which is nearly identical to the one at issue (i.e. the

contested mark); it was filed on 17 September 2015, registered on 18 December 2015 and it has been removed from the registry on 25 March 2026, having expired on 18 September 2025. Indeed, the trade mark no. UK00003366391 is the one at issue. Lastly, the trade mark UK00003985448 is a trade mark owned by SGCL which is nearly identical to the one at issue; it was applied for on 29 November 2023 and registered on 05 April 2024.

5. SGCL further expands on its claim as follows:

*“1. East Lothian Golf Tourism Alliance (trading as Scotland’s Golf Coast (SGC)) was established in 2005 as a marketing alliance – including golf clubs, accommodation providers and other local businesses – working together with the aim of developing and promoting golf tourism in/around East Lothian: Scotland’s Golf Coast. Scotland’s Golf Coast Limited (SC464840) was incorporated on 29 November 2013.*

*2. For a number of years, East Lothian Council was a Member of Scotland’s Golf Coast with their membership governed by a Partnership Agreement. The Council withdrew in 2019. Since their withdrawal, the Council has had no involvement with SGC apart from providing limited grant funding in the same manner as that provided to other tourism focussed groups in East Lothian.*

*3. We understand that the Council made a trade mark registration application (UK00003127442) in 2015 and a further submission (UK00003366391) in 2019. Both submissions were made without consultation or notification to ourselves as logo/brand/trade mark owners. We only became aware of these submissions when the Council filed a Notice of Threatened Opposition to our own trade mark registration application (UK00003985448) submitted in November last year.*

*Current Position*

*4. The Council have never owned the Scotland’s Golf Coast logo/brand. Therefore, when making its original trade mark registration application*

*(UK00003127442 in 2015) its subsequent resubmission (UK00003366391 in 2019) and its current filing of a Notice of Threatened Opposition to our own trade mark registration application (UK00003985448) the Council has clearly misrepresented the ownership status to the Intellectual Property Office.*

*5. We consider that the Council has made the above applications in bad faith and, as such, Registered Trade mark UK00003366391 (and UK00003127442) should be invalidated.*

*6. Scotland's Golf Coast Ltd – as logo/brand/trademark owners has offered the most straightforward means by which to address the matter by requesting the Council to transfer the Trade mark Registration. The Council has repeatedly refused to do so and so the misrepresentation of ownership is brought to the attention of the Intellectual Property Office in support of this application to invalidate the current trademark registration(s).*

#### *Additional Information*

*The following further information is available in support of this application:*

- The Scotland's Golf Coast logo – in the form first trade mark registered by the Council - was commissioned by East Lothian Golf Tourism Alliance (ELGTA) trading as Scotland's Golf Coast and designed by Nettl.*
- In 2015, Nettl formally assigned the ownership of the logo to ELGTA – letter dated 16 September 2015.*
- Whereas the Council was a Member of ELGTA/SGC until 2019, their membership was governed by a Partnership Agreement – Clause 6 clearly states that the ownership of the Scotland's Golf Coast brand rests with the East Lothian Golf Tourism Alliance.*

- *The scotlandsgolfcoast.com website domain is owned and used by SGC – this was established in 2020 following the Council’s withdrawal.*
- *On its withdrawal, the Council refused to transfer the ownership of the group’s previous website (golfeastlothian.com) domain that it had assisted in setting up – however, the Council did agree to set up a redirection from this website to the new website which we understand remains in place.*
- *In addition, the Council transferred the administration of all social media accounts – Facebook, Instagram, Twitter and YouTube.*
- *The website redirect and transfer of social media accounts were included in a legal letter of undertaking provided by the Council – when these arrangements were put in place, the Council did not declare that it had registered and re-registered the SGC logo/brand with the IPO; had we been aware of the Council’s activities then the trade mark registration transfer would have been addressed at the same time.”*

6. ELC filed a defence and counterstatement, denying the grounds. In its counterstatement, ELC explains its position as follows:

*The relationship between ELC, ELGTA and SGCL*

- ELC (i.e. the proprietor in these proceedings), as a public body, led on the establishment of a golf marketing association, the East Lothian Golf Tourism Alliance (ELGTA) as part of its sector specific tourism activities. ELGTA was established in 2005 as a non-profit organisation and a constitution document was created. The structure of ELGTA was based on a similar association, the East Lothian Tourism Attractions Group. This was also established by ELC in 2003.

- By 2012/13 the term 'Scotland's Golf Coast' was being used in ELGTA's branding and ELGTA became publicly known as Scotland's Golf Coast. In 2013, some members of ELGTA established the company, Scotland's Golf Coast Limited (i.e. the applicant in these proceedings), incorporated with Companies House. However, ELC was not involved in this matter. Although SGCL was incorporated, it has never traded and ELGTA continued as the means around which collaboration of organisations to market the golf sector in East Lothian was coordinated.
  
- ELC provided significant funding and time and the expertise of one of its officers to consult with and approach the industry to bring together a number of supporting members of the golf sector to create ELGTA. ELC delivered ELGTA's activities via its officer and additional staff resource. Other supports to ELGTA included but were not limited to, financial, in-kind support such as being part of ELGTA's Management Committee (and subsequent similar structures). While direct financial support has not been available since 2023 due to ELC's budgetary constraints, ELC continues to support and promote the sector via its Economic Development remit. This includes golf sector activities such as support for major golfing tournaments, trade shows, expos, events, travel trade and general marketing and promotion in support of the sector, which in turn also benefit ELGTA and its members. In this connection, the following information is provided:
  - i. Golf plays an important part in East Lothian's economy. ELC continues to value and to support this sector and its partners within it. An arm's length organisation (ALEO) of the Council, owns and operates golf courses and ELC exerts influence over these golf courses through its influence over the ALEO. These golf courses are members of ELGTA and so, ELC continues its involvement as members of ELGTA as a result of this. The wider golf sector is supported and promoted as part of ELC's Economic Development activities.

- ii. ELC can best protect and coordinate the promotion of the ELGTA brand and the mark on behalf of the sector. ELC will continue to pay for the costs associated with the mark as part of its support for the sector, allowing for continued use by SGCL and other third parties, where it is reasonable to do so.
- The partnership between ELC and ELGTA was not governed by a partnership agreement. A draft partnership agreement was prepared around the time there were changes in ELGTA's management structure, however, the contents were never finalised by the parties and the partnership continued on a good faith basis.

*The design of the contested mark was the result of collaborative working*

- The current design of the contested mark is the result of previous versions of the design, spanning a number of years from around 2010, all of which were developed by ELC and ELGTA collaboratively. The development of ELGTA's logo from 2010 was key to the various activities undertaken collaboratively by ELC and ELGTA in support of the golfing sector. This demonstrates historic collaborative working, including work by ELC to brand part of its coast road as "*Scotland's Golf Coast Road*". Scotland's Golf Coast Road was officially opened by the then Minister with responsibility for tourism in June 2013. This new brand identity and the Golf Coast Road are areas in which the ELGTA continues to collaborate on.
- ELC denies that SGCL are the owners of the ELGTA logo, brand or trade mark. As the contested mark was designed by Nettle, they owned the copyright. Further the mark was based on historic collaborative designs, with input from both ELC and ELGTA. The mark was not created for SGCL's benefit or ownership. Nettle granted an indefinite, non-exclusive, royalty-free licence to ELGTA and all its partners, including ELC and SGCL. This included the right to sub-licence the logo to any third-party subject. In the licence Nettle assigned the copyright in the mark to ELGTA.

*The registration of the contested mark*

- ELC denies that the contested mark was registered without consultation with SGCL or that ELC acted in bad faith. ELC registered the mark with the agreement of ELGTA following email exchanges. There is an email from the ELGTA's treasurer, who is also a director of SGCL, dated 9 September 2015, which states that they will ask ELC's officer to "*proceed with the process of registering our trade mark.*" As the licence was in favour of ELC, ELGTA and its partners, combined with the assignation of the copyright to ELGTA, ELC viewed this request to be for ELC to register the mark. This was a reasonable view to take as ELC was working very closely in collaboration with ELGTA, providing funding, a substantial amount of ELC's officer time and other support. Furthermore, the wording used in the licence was drafted by ELC's legal department with agreement from ELGTA, showing the close proximity of the parties involved which worked together in this matter, and the licence is also addressed to the Golf Officer of ELC.
- All action taken by ELC following this email exchange was completed with no bad faith and in line with the understanding of collective aims, namely to protect the mark for use by ELGTA, its partners and ELC for the purposes under class 41 such as promotion of golf and golf tourism within East Lothian and to prevent other geographical areas or unauthorised third parties from using the mark.
- ELC's aim in continuing to hold a registration for the mark is to ensure this continues to be associated with the East Lothian geography and to use it in the public interest, in line with the original understanding of shared goals. These include advertising the various golfing opportunities in East Lothian, including but not limited to, those offered via the activities of ELGTA, whilst supporting other partners to do the same. For clarity, ELC has no issues with the ELGTA, its members, or SGCL continuing to use the contested mark, and indeed the other registered trade mark number UK00003127442. All parties continue to benefit from the non-exclusive licence granted to the parties by Nettl.

### SGCL's application

- Paragraph 6 of SGCL's statement of grounds is accepted but it is necessary to explain that when ELC were notified of a new application by SGCL closely related to the contested mark, ELC filed a notice of threatened opposition to extend the period ELC had for a possible objection to the application and to provide more time for engagement between ELC and SGCL. Although ELC were not satisfied that the application was necessary (as SGCL are free to use the mark), ELC subsequently advised SGCL that it would not oppose their application to register their mark and that both can run in tandem. SGCL did not agree to this and requested the transfer of the mark despite conflicting views on the position that the registration of the contested mark was a result of a collaborative process which resulted in an agreement that ELC would register the mark.
- ELG seeks to ensure ongoing protection of the mark to be used in the public interest. The concern with the mark being transferred to SGCL, a private company, is that use of the mark would be for the benefit of the company as opposed to the public interest. ELC additionally has concerns that should SGCL cease to be a company, use of the mark would also cease, alongside the demise of the company.

7. Both parties filed evidence during the evidence rounds. They also filed written submissions. Neither party requested a hearing, but they both filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

### **The evidence**

8. SGCL's evidence consists of a witness statement from Robert Gunning dated 4 November 2024, accompanied by eight exhibits being those labelled BG1-BG8. Mr Gunning is the Director of SGCL. Along with its evidence, SGCL also filed written submission on 19 November 2024.

9. ELC's evidence consists of three witness statements from Jamie Baker, Elaine Carmichael and Jackie Gardiner. Mr Baker is the Service Manager in the Economic Development department at ELC; his statement is dated 22 January 2025 and is accompanied by 17 exhibits being those labelled JB1-JB17. Ms Carmichael is the Team Manager in the Economic Development department at ELC; her statement is dated 22 January 2025 and is accompanied by 10 exhibits being those labelled EC1-EC10. Ms Gardiner is the Tourism/ED Projects Assistant officer in the Economic Development team at ELC; her statement is dated 22 January 2025. Along with its evidence, ELC also filed written submissions on 22 January 2025.

10. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

### **Relevance of EU Law**

11. 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**

12. Section 3(6) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act, which states as follows:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has

been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made. Provided that this shall not affect transactions past and closed.”

13. 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.”

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

“(i) [...]

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

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*[Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker*

(C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

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

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

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

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

objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

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

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

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

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

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

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the

application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

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

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

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

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

by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

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

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

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

17. 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).

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

19. The caselaw shows that the initial evidential burden falls upon the opponent/applicant for invalidity: it must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If it does that, then the burden shifts to the owner of the application/trade mark registration to rebut the allegation.

20. The date to be used for the assessment of Section 3(6) is the filing date of the contested mark, i.e. 11 January 2019.

21. With this in mind, I now turn to SGCL's evidence.

### SGCL's evidence

22. Mr Gunning's evidence sets out that as well as being a director of SGCL, he is a past chair of ELGTA and has been a member of its steering group since its inception in 2005. There is very little narrative in Mr Gunning's witness statement, which is only a vehicle for introducing the following exhibits:

- a) **Exhibit BG1-BG2:** these exhibits are merely copies of documents on file, consisting of copies of SGCL's statement of grounds and written submissions of 19 November 2024.
- b) **Exhibit BG3:** this exhibit consists of a copy of Nettle's letter to ELGTA dated 16 September 2015. The letter is from Alan Gunning, a partner at Nettle, and it is addressed to Mr Gunning himself as the chairman of ELGTA. It states as follows (my emphasis):

*“Dear Bob*

*I hereby grant the East Lothian Golf Tourism Alliance and all of its partners including Scotland's Golf Coast Limited, an indefinite, non-exclusive, royalty-free licence to use the Scotland's Golf Coast logo (including the right to sub-license the same to any third-party subject). From this point onwards, the East Lothian Golf Tourism Alliance owns and/or controls the use and granting of right to others to use the Scotland's Golf Coast logo”*

Mr Gunning states that this letter *“formally assign the ownership and use of SGCL logo to ELGTA”*. However, this is not accurate, as the license does not transfer the ownership of the Scotland's Golf Coast logo, but it is a license to use it – whilst the term *“owns”* is used, it says *“owns and controls the use and granting of right to others to use”* the logo (as opposed to saying that it transfers the ownership of the logo). Further, the license is non-exclusive and extends to all ELGTA's partners including (which means not limited to) SGCL (i.e. the applicant in these proceedings).

- c) **Exhibit BG4:** this exhibit consists of a copy of the constitution document for ELGTA. It confirms that ELGTA was constituted on 1 September 2005, as a non-profit organisation whose overall aim was *“to represent the golf tourism industry in East Lothian as the body involved in the development of [the] overall strategy and in determining specific public/private partnership activities relating to the development and marketing of golf tourism.”* However, the copy exhibited is neither signed nor dated.
- d) **Exhibit BG5:** this exhibit consists of a copy of the partnership agreement between ELC and ELGTA. Mr Gunning points out that clause 6 clearly states that the ownership of the Scotland's Golf Coast brand rests with ELGTA. This is clearly misleading since (a) the document contains track-changed comments and therefore is not a final version and (b) similarly to the document exhibited at BG4, it is neither signed nor dated. Significantly, clause 6 contains a track-changed comment which adds the word *“partners”* after the reference to

ELGTA. This suggests that the change was added by ELC to clarify that the ownership of the brand was vested in ELGTA as well as in its partners. For ease of reference, I reproduce the clause here:

## **6. Ownership and use of branding**

Ownership of the Scotland's Golf Coast brand rests with the East Lothian Golf Tourism Alliance [partners](#).

A similar track-changed comment was added to the section dealing with the purpose and scope of the agreement. As it can be seen, the track-changed comment adds a reference to the use of the Scotland's Golf Coast brand being by all members:

The Agreement covers the services agreed by the parties, to be designed and delivered within the partnership. The agreed services to be delivered are:

- Marketing activities
- Marketing materials, including the East Lothian Golf Guide?
- Use of the Scotland's Golf Coast brand [by all members](#)
- Management of [golfeastlothian.com](http://golfeastlothian.com) [and social media channels](#)

This corroborates ELC's account that the partnership agreement was never finalised. It also gives the impression that there was a tension between ELGTA's and ELC's strategic approaches to the ownership of the Scotland's Golf Coast brand, with ELGTA seeking to monopolise the brand for its own benefit, and ELC pressuring ELGTA to recognise that all the members of the alliance also own the brand and were entitled to use it.

- e) **Exhibit BG6:** this exhibit consists of a copy of a letter from ELC to ELGTA dated 28 February 2020. It is headed "*Letter of undertaking*" and states that ELC agreed to grant ELGTA the administration rights to the social media accounts and YouTube channels associated with Scotland's Golf Coast' and 'Golf East Lothian' and to redirect all users of the domain platform [www.golfeastlothian.com](http://www.golfeastlothian.com) to a domain nominated by ELGTA ([www.scotlandsgolfcoast.com](http://www.scotlandsgolfcoast.com)). Notably, there is no reference to any assignment of trade mark rights. In this connection, Mr Gunning seems to

acknowledge this, as he states that when these arrangements were put in place, ELC did not declare that it had registered SGC's logo/brand as a trade mark. He also adds that had SGC been aware of ELC's activities, the trade mark registration transfer would have been addressed at the same time.

- f) **Exhibit BG7:** this exhibit consists of a copy of a letter from the Scottish Government to Mr Gunning as the chairman of ELGTA dated 25 November 2013. It merely confirms that Scottish Ministers had no objections to the proposed use of "*Scotland's Golf Coast*" as a company name by ELGTA (at this stage it is worth pointing out that having obtained such clearance, some members of ELGTA, including Mr Gunning, then proceeded to incorporate SGCL, i.e. the applicant in these proceedings).
- g) **Exhibit BG8:** this exhibit consists of copies of emails exchanged between ELGTA and ELC. Mr Gunning says that this correspondence relates to "*ELC's use and misuse of SGC's logo/brand*" and that "*three separate exchanges of correspondence are included from 2022 and 2023 all clearly show[ing] blatant disregard by [ELC] to the rightful ownership of the SGC logo/brand*". I am not really sure which part of the emails Mr Gunning had in mind when he said that they show "*blatant disregard by ELC to the rightful ownership of the SGC logo/brand*". The tone of the emails is in fact mutually collaborative throughout, discussing collaborative work and funding. The email that better sets the scene is dated 9 June 2023, it is from Scotland's Golf Coast Steering Group to members of ELC and states as follows:

*"When the Council stepped away from its involvement with the golf group (ELGTA/SGC) back in 2020, this was to enable those Member businesses more closely involved with golf tourism to better market the Scotland's Golf Coast proposition – and, at the same time allow the Council to focus on the wider marketing of East Lothian under its Visit East Lothian banner. Based on our results, as shown in our Annual Review presentations for the past three years, I am sure that you will agree that this model has been extremely successful.*

*As you know, SGC have always been keen to work in partnership with the Council and other bodies including Visit Scotland and Scotland Where Golf Began – to promote East Lothian as a golf tourism destination. It is for this reason that the Steering Group have continued to be proactive in reaching out to the Council to keep both Elected Members and Council Officers up to date with our activities – and, as discussed in our meeting back in February, to make suggestions on areas of improvement eg VEL website enhancements.*

*However, it has come as quite a surprise to learn that the Council is now looking to become actively engaged in golf tourism marketing and promotion – something that the Council had moved away from – and to do so without discussion or consultation with the golf group.*

*In my initial response (see below), I suggested that there seemed little point in the Council/Fairground duplicating SGC's marketing activity over the coming weeks – and proposed a quick call to discuss. Disappointingly, this was met with Elaine's response indicating that there was no need to discuss. The following points would have been presented face-to-face but the Steering Group have now requested that I write to you to outline the following:*

*Although the Steering Group have reservations about the Council becoming involved with golf tourism marketing, the benefits of working in partnership to maximise exposure of Scotland's Golf Coast/East Lothian as a golf tourism destination remain, provided that there is a clear framework in place*

*The focus of any/all marketing initiatives undertaken by the Council should be to secure legacy benefits for local businesses from the Scottish Open being hosted by The Renaissance in East Lothian i.e. content should not depart from this and should not attempt any form of Top Five Courses narrative (as proposed) or similar – it is really important that there is a consistent market narrative*

*The Steering Group are happy to provide the Council with marketing material/collateral including access to use SGC branding subject to:*

- *SGC Steering Group to approve each individual Council post, press release or other marketing activity/initiative prior to publication/release*
- *Council to adhere to SGC brand use framework (including the name ‘Scotland’s Golf Coast’, the SGC logo and SGC brand colours/format)*
- *The period of co-operation is to be for a fixed period of one month i.e. up to/during the Scottish Open 2023 only – the position can then be re-assessed*

*You will recall from our meeting in February, the use of the SGC name/brand/logo was discussed with an acknowledgement by you that the Council’s use should (a) only take place following notification and discussion with ourselves and (b) be in line with SGC brand guidelines (including brand colours, format etc.) – the above provides a logical extension to this in an effort to provide a framework in which SGC and the Council can work together on a specific, time-limited basis to promote golf tourism in East Lothian.*

*Can you please confirm on behalf of the Council your agreement to the above so that we can put Grey Nickel and Fairground together to get things moving?”*

Indeed, any reference in the email to the Council is a reference to ELC.

I would make three points here. First, the email confirms that ELC stepped away from its involvement with ELGTA/SGCL in 2020 which is after the relevant date of 11 January 2019. Second, the email is also dated after the relevant date. Third, the email states that in a previous meeting ELC acknowledged that it should use the Scotland’s Golf Coast’s logo only after notification to and discussion with Scotland’s Golf Coast Steering Group; however, no minute of such meeting is provided. Further, in the last paragraph of the email, the writer seeks confirmation from ELC that it agreed with that approach.

Lastly, in its submissions in lieu, SGCL points out that an email from ELC dated 5 August 2022<sup>1</sup> refers to SGCL’s assets. The text of the email is as follows:

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<sup>1</sup> BG8.2

*“Hi David – apologies, I had completely forgotten about this until Jackie reminded me yesterday!”*

*We’re not using any SGC assets just the ‘Visit East Lothian – Scotland’s Golf Coast’ wording.*

*I’ll be on site today and will grab some photos for you.”*

23. That is the totality of SGCL’s evidence.

24. In reply to this evidence, ELC filed the following evidence.

*ELC’s evidence*

25. Mr Baker works for ELC. He produces copies of various documents, most of which are emails and letters. However, since Mr Baker does not explain the relevance of each document for the purpose of ELC’s defence, I will outline only the documents whose relevance is obvious to me. The first thing to be noted about those emails and letters is that some of them are from Bob Gunning (i.e. the same person who gave evidence on behalf of SGCL). It is also worth noting that Mr Gunning signed the emails in his capacity as General Manager & Company Secretary of Longniddry Golf Club Limited, a golf club that was a member of the alliance ELGTA; however, in his own company email signature, he used a mark nearly identical to the contested mark (which SGCL - i.e. the applicant in these proceedings – claims is ELGTA’s property), as shown below:



26. This was back in 2013. Conversely, an email from ELC's golf development officer from 2011 uses a different logo in the email signature – this is the same as that used in the action plan for the 2013 Open Championship, a copy of which is attached to the email:<sup>2</sup>



27. The action plan reveals that both ELC and Mr Gunning's company (i.e. Longniddry Golf Club) were present at the workshop following which the action plan was devised by ELC. It also reveals that the main benefit of the championship (an event which was going to be held at Muirfield in East Lothian in July 2013) was regarded by those attending the workshop as the opportunity *"to raise the profile of golf tourism in East Lothian to build on its assets as "The Golf Coast"*. Copy of a draft media invitation attached to another email from a ELC's officer confirms that on 7 June 2013 the Minister for Energy, Enterprise and Tourism was going to officially open Scotland's Golf Coast Road.<sup>3</sup> A further email dated 25 May 2012 from another ELC's officer attaches a report about ELC's support for golf tourism.<sup>4</sup> The report reveals that (i) ELC worked with industry representatives to establish ELGTA; (ii) ELGTA was supported by ELC's full-time golf tourism officer; and (iii) ELGTA comprises most of the golf clubs in the county as well as a number of hotels; other businesses such as travel operators and smaller accommodation establishments would also have been able to join. In addition, the report states that ELGTA together with VisitScotland, EventScotland, Visit East Lothian and East Lothian Tourism Attractions Group had responsibility for

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<sup>2</sup> JB2

<sup>3</sup> JB3

<sup>4</sup> JB5

marketing during 2012 and 2013, and that ELC provided marketing activities additional to ELGTA's marketing. In this connection, an email dated 20 January 2014<sup>5</sup> refers to ELC booking an annual campaign for ELGTA at a total cost of £3,000 which ELGTA requested to be split into two payments. Lastly, multiple references are made within the report to a partnership approach. Another email dated 20 April 2017<sup>6</sup> sent by an ELC's officer to Mr Gunning refers to ELC's funding to the partnership and to the distinction between ELC and ELGTA's contribution as follows:

*"In relation to the Council contribution to the partnership, max £25,000, we expect to know what we will be paying-for at the outset and for ease I've copied and adapted the procedures previously sent, outlined below. There will have to be some thought given as to the separation of ELGTA and ELC contributions, ie who pays for what, as highlighted. The rules for payment remain, as you will see. The Marketing Plan that was developed for 2016-17 could be reviewed and that would inform the prioritisation of activities and thus spend. The evaluation of the impact of activity should be always undertaken in order to see where partnership intervention can make the biggest difference. Print costs, for example, if internal will be paid- for by ELC.*

*Quarterly reports on expenditure (April-June, July-Sept, Oct-Dec, Jan-Mar) from ELGTA bank account and council budget line should be reported to Steering Group, say during July, October, January and April, for clarity".*

28. The above email was sent in response to an email from Mr Gunning discussing reimbursement of costs and how expenses relating to marketing activities should be split between ELC and ELGTA. Whilst Mr Gunning signed the email in his capacity as the General Manager & Company Secretary of Longniddry Golf Club Limited, he appears to be leading in the discussion about ELC's funding to ELGTA.

29. Another interesting document exhibited by Mr Baker is a copy of an application form submitted by ELC's officer on behalf of ELGTA to get funds from Visit Scotland

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<sup>5</sup> JB6

<sup>6</sup> JB7

Growth Fund for the launch of golf passes, a product designed to promote golf in the East Lothian area.<sup>7</sup> The application is dated 17 February 2010. In response to the question “Please outline how you will address any negative cash flow highlighted above” the application form states “There may be a small negative cash flow in the final month before our final claim is made but the East Lothian Golf Tourism Alliance membership fees are due at the end of December 2010 and sufficient funds will be available to cover the full cost of our contribution. Membership renewals will boost their funds by a minimum of £25,000”. This suggests that all members of ELGTA paid membership fees which were used to raise funds for marketing projects/activities aimed at promoting golf tourism in East Lothian. The application also states that ELC and ELGTA contributed on a voluntary and discretionary basis (public and private respectively) to the project.

30. Notably, similarly to the letter exhibited by Mr Gunning at BG3, Mr Baker also exhibits an identical letter dated 1 September 2015 addressed to the Tourism Projects Officer - Golf and Events Economic Development & Strategic Investment at ELC.<sup>8</sup> It states:

*“Dear John*

*I hereby grant the East Lothian Golf Tourism Alliance and all of its partners including Scotland’s Golf Coast Limited, an indefinite, non-exclusive, royalty-free licence to use the Scotland’s Golf Coast logo (including the right to sub-license the same to any third party subject). From this point onwards, the East Lothian Golf Tourism Alliance owns and/or controls the use and granting of right to others to use the Scotland’s Golf Coast logo.”*

31. The letter is signed by Alan Gunning, a partner at Nettle and was sent by Mr Gunning himself (i.e. the individual who gave evidence on behalf of SGCL) under the cover of an email dated 9 September 2015 titled “Golf Coast Logo ownership”. The email states (my emphasis):

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<sup>7</sup> JB8

<sup>8</sup> JB9

*“All*

*I hope the attached letter meets your expectations. The wording came from the Council's Legal Dept which is why I suggested to my son that the letter should be addressed to Jon Brown who I'll ask to proceed with the process of registering our trade mark.”*

32. This might shed some light on the tension I have anticipated between what Nettle's letter states, and Mr Gunning's attempt to monopolise the ownership of the Scotland's Golf Coast's logo beyond the wording of Nettle's letter (which were suggested by ELC).

33. Drawing the threads together, it appears that Mr Gunning was associated with ELGTA because his company Longniddry Golf Club Limited was one of the golf clubs that participated in the ELGTA alliance. It also appears that Mr Gunning became heavily involved in the work of the alliance – in his witness statement he states, in fact, that he is a Past Chair of the ELGTA and has been a member of its Steering Group since its inception in 2005; further, the emails produced in evidence show that he took a leading role within the alliance, as he was the point of contact in the discussions with ELC about public funding (who was also a member of ELGTA). In addition, the evidence reveals that Mr Gunning's son also became involved in the business of the alliance, because his company (i.e. Nettle) designed the Scotland's Golf Coast logo (which is the subject of the mark at issue), and he is the individual who signed the letters that granted the license to use such logo to ELGTA and its partners. Further, Mr Gunning says that he is the director of the private company SGCL which brought this invalidity action, and which was established in 2013 by some members of ELGTA.

34. Based on this evidence, my impression is that Mr Gunning's attitude reveals an intent to move ELGTA away from its original ethos of being an alliance set up to promote a public interest, namely that of marketing and promoting golf tourism in the geographical area of East Lothian, which falls within the geographical borders of the ELC Council. Instead, it seems to me that Mr Gunning's intention was to treat the alliance as a private/personal project as demonstrated by the fact that, in 2013, some members of ELGTA set up a private company (i.e. SGCL) of which Mr Gunning is a director and whose purpose (or additional benefit) is not clear. If anything, Mr Baker

filed evidence that SGCL is, and has always been, a dormant company, which would beg the question as to why it was set up in the first place.<sup>9</sup>

35. This might in turn explain why, against the clear words of Nettle's letter which granted a non-exclusive license to use the Scotland's Golf Coast logo/brand to both ELGTA and its partners (including SGCL), Mr Gunning and other directors of SGCL<sup>10</sup> insists that ELGTA and SGCL are the exclusive owners of the Scotland's Golf Coast logo/brand. In this connection, the fact that the Nettle's letter was drafted by ELC's legal department is an indicator of the tension between ELGTA's and ELC's strategic approaches to the ownership of the Scotland's Golf Coast brand and, I think, the wording of Nettle's letter was meant to put a barrier against ELGTA's inclination to monopolise the Scotland's Golf Coast brand (which became obvious to ELC as shown by the track-changed comments to the draft partnership agreement).

36. I will now turn to Ms Carmichael's evidence, before going back to Mr Baker's evidence insofar as they are both helpful to establish facts relating to the origin and use of the Scotland's Golf Coast logo/brand.

37. As noted above, Nettle's license to use Scotland's Golf Coast logo to ELGTA and its partners is dated in 2015.

38. Also, as it will be recalled, Mr Gunning used the Scotland's Golf Coast logo in his company email signature as early as 2013:



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<sup>9</sup> JB15

<sup>10</sup> EC10

39. The same logo was also used in the email signature of another individual called MD<sup>11</sup> who appears to be another member of the ELGTA in 2013.<sup>12</sup>

40. Further, Ms Carmichael provided copies of ELGTA's notes of meetings from 2005 and 2011. The notes from two meetings held in 2011 feature the Scotland's Golf Coast logo as it can be seen below:<sup>13</sup>



41. There are also examples of the Scotland's Golf Coast logo being used in the email signature of ELC's golf tourism officer in 2012:<sup>14</sup>



42. The same logo is also used by "the directors of SGCL" (i.e. the applicant in these proceedings) in more recent email correspondence with ELC, whereby they requested that ELC transfer the trade mark at issue to SGCL:<sup>15</sup>

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<sup>11</sup> JB1 and EC1

<sup>12</sup> EC1-2

<sup>13</sup> EC3

<sup>14</sup> JB14

<sup>15</sup> EC10



43. Admittedly, it is not clear when the design of the Scotland's Golf Coast logo was developed (as it was used by ELC as early as 2011), but it seems to be common ground that the final version of the logo was finalised by Nettle - this appears to be an advertising and/or marketing agency in which Mr Gunning's son was a partner. Further, in an email dated 17 April 2012 (i.e. prior to Nettle's letter) which is addressed to what appears to be a printing company, an ELC's officer referred to "*our new Scotland's Golf Coast logo*", attaching the examples shown below and stating as follows (my emphasis):<sup>16</sup>

*"We are sponsoring the Ladies Scottish Open and have 8 banners out on the golf course promoting the area and I'll be using our new Scotland's Golf Coast logo. The organisers have indicated in the past that dark blue is a good colour to use as a background but we might lose the effect of the Bass Rock image, as it's mainly dark blue too. Do you have any ideas on how it would be best to get over that hurdle? The banners will be wide and the organisers have mocked up the image below using the white background but I don't really like Golf East Lothian stuck at both ends.*

*The logo actually looks really good on navy shirts and sweaters we had produced so maybe the attached example would work OK although I'd prefer the Golf East Lothian text in white too, as it isn't as visible against the dark background. I think the organisers will be printing the banners within the next couple of days so any advice would be very welcome."*

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<sup>16</sup> JB11



44. In another email dated 2 May 2012,<sup>17</sup> the same ELC officer mentioned that Mr Gunning contributed to pulling together the press launch of the new Scotland's Golf Coast brand. The email appears to be addressed to members of the ELGTA alliance and invite them to use the new brand in order to associate themselves with Scotland's Golf Coast in promotional material. It states:

*"Dear All*

*I wanted to say a big thanks to Malcolm, Gary and Bob for pulling together yesterday's press launch of the new Scotland's Golf Coast brand. It was great to see so many members attend and there's already a first class article by Martin Dempster published in this morning's Scotsman. ...*

*Just a reminder that you are all welcome to use the new brand to associate yourself with Scotland's Golf Coast in any promotional materials, websites etc..."*

45. Finally, some evidence dated 2004 refers to the copyright in the golfeastlothian logo being assigned from Donaldson Boyce Limited to ECL.<sup>18</sup> Whilst the logo is not

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<sup>17</sup> JB14

<sup>18</sup> JB16-JB16.1

reproduced (which means that I cannot say how similar it was to the Scotland's Golf Coast) that is irrelevant as the assignment document is not signed.

46. I will now apply the relevant case-law to these facts.

47. I have already made some general observations about this claim in the context of summarising the evidence.

48. I said that the evidence demonstrates that there was a tension between ELGTA's and ELC's approaches to the ownership of the Scotland's Golf Coast logo/brand (which is incorporated in ELC's contested mark), with ELGTA alliance seeking to monopolise the logo/brand exclusively for its own benefit, and ELC trying to ensure that ELGTA recognised that all the members of the alliance were also entitled to use the brand. This was reflected in the words used in the licence granted by Nettl which incorporates words drafted by ELC's legal department as confirmed by Mr Gunning in his email of 9 September 2015. In this connection, I have also observed that contrary to ELGTA's contention, the license did not formally assign the ownership of the Scotland's Golf Coast logo to ELGTA. Instead, it was a license to use the logo which extended to all ELGTA's partners including SGCL (i.e. the applicant in these proceedings). This means that SGCL was recognised as one of ELGTA's partners, but it did not exclude the granting of the license to other partners of the ELGTA alliance. This is the meaning I attribute to the license because the meaning of the word "including" is that it is used as a word of inclusion in legislative drafting or legal documents. In this case, the license included those partners which were declared to be included (i.e. SGCL) but did not exclude the other partners which were not named. This is consistent with the amendments suggested by ELC (who drafted the wording of the license) to the partnership agreement, insofar as it added a reference to the ownership of the Scotland's Golf Coast logo resting with ELGTA partners – though the partnership agreement was never signed and finalised, the suggested amendments corroborate the interpretation I gave.

49. Further, the existence of a document called "Partnership Agreement" between ELGTA and ELC means that, effectively, ELC was a partner of ELGTA even though the relationship was never formalised into a written agreement. Neither party made

any submissions as to what type of partnership existed between ELGTA and ELC. However, in my view, in the absence of a document which governed the partnership, it is likely that it became a partnership at will.

50. But regardless of the type of partnership, I am of the view that in the absence of a written agreement about the termination of the partnership, the general principle would apply that any partner can bring the partnership to an end on giving notice at any time.<sup>19</sup> Lastly, I consider that the partnership between ELGTA and ELC must have started before the license was granted in 2015 (because the collaboration started back in 2005); further, since the partnership was never formally terminated, it must have been still in place when ELC applied for the trade mark at issue on 11 January 2019. At that point, by virtue of Nettle's license, both ELC and SGCL enjoyed a right to use the Scotland's Golf Coast logo. However, as I have observed earlier, Nettle's letter did not transfer of the ownership of the logo. This is probably because ELGTA being an alliance it did not have a separate legal personality from its partners and could not own any property. It is also likely that this is the reason why some of ELGTA members incorporated SGCL, a limited company with a legal personality which would have been able to apply to register Scotland's Golf Coast logo as a trade mark (and it did so).

51. Proceeding on the basis that (a) based on Nettle's license, ELGTA and its partners (including ELC and SGCL) were entitled to use the Scotland's Golf Coast logo without being the owners of the logo (I will not consider at this stage whether any member of the alliance had acquired any unregistered right in the logo by virtue of use as this case does not involve any claim for passing off), and (b) by applying for the contested mark, ELC became the proprietor of (and acquired a monopoly right) in the same logo, does ELC action of registering the logo in its own name amount to bad faith? In my view, the answer is not. I say this for two reasons.

52. First, SGCL's pleaded case is that SGCL is the owner of the Scotland's Golf Coast logo, however, there is no evidence that the ownership of the Scotland's Golf Coast

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<sup>19</sup> The draft exhibited contained a clause which stated that "If either of the Parties wishes to dissolve the partnership, a minimum of three months' notice must be given in writing to the other Party, with reasons for the termination".

logo belongs to SGCL (of that it ever did). Further, there is no evidence that ELGTA was structured as a formal alliance and, consequently, I must conclude that it was an informal alliance with no legal personality: as such, it could not own any property. The only thing SGCL enjoyed was the right to use the Scotland's Golf Coast logo by virtue of the license granted by Nettle. Further, there is no evidence that the ownership of the Scotland's Golf Coast logo was ever transferred by Nettle (or by anyone else) to SGCL and as ELC correctly points out, even if ELGTA was the owner of the logo (which it is not) SGCL and ELGTA are separate entities. Consequently, there is no misrepresentation of ownership as claimed by SGCL in its statement of ground. That would be enough for this ground to fail.

53. But, at a more general level, ELC is a Council and a local authority, and has been historically a partner/member of the ELGTA alliance. As ELC pointed out in its written submissions, this is demonstrated by a Membership List 2005/2006 of East Lothian Golf Tourism Alliance which lists ELC as a member.<sup>20</sup> ELC also argues that at some point, ELC's position changed from "member" to "partner" although there is no evidence to show when exactly this happened – however, I do not think that that is material since a copy of Nettle's letter granting the license was sent to ELC, meaning that by that point (in 2015) ELC was considered to be a partner. Since ELGTA has no legal personality to own a property, and since the Scotland's Golf Coast logo was used by its partners (including ELC itself) to pursue a public aim, namely that of promoting the golf tourism in the geographical area falling within ELC's boundaries (i.e. East Lothian), it made sense for ELC to apply for the contested mark, to ensure that those working with the alliance would be able to continue to use the mark, as opposed to a private company such as SGCL acquiring a monopoly right over the logo, and preventing other partners of the alliance to use it.

54. I would add, for completeness, that the evidence indicates that ELC stopped funding ELGTA in 2020 after the contested application was filed, meaning that when the application was filed in 2019, it was still a funding partner of the alliance. The fact that ELC stopped the funding shortly after registering the mark is neither here nor

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<sup>20</sup> ECG

there, and, even if such a point was capable of casting light backwards,<sup>21</sup> as confirmed by some emails in evidence,<sup>22</sup> ELC's approach has always been that it would not oppose other partners/members registering the Scotland's Golf Coast logo or using it whilst ensuring ongoing protection of the brand, its association with East Lothian, and its use in the public interest. Lastly, if ELC filing the application in its own name was contrary to SGCL's expectation that the application would have been made in its own name, that was down to misunderstanding or miscommunication, not bad faith.

55. The Section 3(6) claim fails.

## **OUTCOME**

56. The invalidity action has failed and ELC's trade mark no. UK00003366391 will remain on the register.

## **COSTS**

57. ELC has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award ELC the sum of £1,600 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing the counterstatement and considering the application: £300

Filing evidence: £1000

Submissions in lieu: £300

Total: £1,600

58. I therefore order Scotland's Golf Coast Limited to pay East Lothian Council the sum of £1,600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

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<sup>21</sup> See *Hotel Cipriani*, cited at paragraph 16 above

<sup>22</sup> EC10

**Dated this 8<sup>th</sup> day of April 2026**

**TERESA PINTO**  
**For the Registrar**