O/0379/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3916979 & 3924977
IN THE NAME OF ENNISMORE INTERNATIONAL MANAGEMENT LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS:

DISLOYALTY

DISLOYALTY

IN CLASSES 35 & 43

AND

IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 443128 & 443522
BY SION O'CONNOR

Background and pleadings

1. This decision concerns applications by Ennismore International Management Limited ("the applicant") to register the following trade marks in the UK (together, "the applicant's marks"):

(i) 

UK application no. 3916979
Filing date: 30 May 2023
Publication date: 16 June 2023
("the '979 mark")

(ii) 

UK application no. 3924977
Filing date: 20 June 2023
Publication date: 7 July 2023
("the '977 mark")[1]

2. Registration of the applicant's marks is sought for the following services:

Class 35: Loyalty scheme services; administration of loyalty card services and loyalty reward programmes; sales promotions through customer loyalty programmes; incentive award programs; promoting hotel, resort, time share, travel, co-working and vacation services through incentive and loyalty programs.

[1] It should be noted that this mark consists of a five-second motion which ends with the still image I have reproduced. Whilst it will be described in further detail later in this decision, the mark can be viewed in full on the register: https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003924977.

Class 43: Rental of temporary accommodation; reservations for temporary accommodation; hotel and resort services; hotel catering services; provision of temporary accommodation services; hotel services featuring frequent guest reward program which allow participants to earn free or discounted lodging, hotel services and other travel-related benefits and amenities; bar, cafe, restaurant, banqueting and catering services; provision of premises and facilities for holding presentations, conferences, concerts, discos, fitness classes, yoga classes, exhibitions, functions, conventions, seminars and meetings; hotel restaurant services; restaurant services; cafeterias; snack bars; bars; bar services; services for the provision of food and drink; temporary accommodation reservations; rental of meeting rooms; rental of rooms, marquees and pavilions for social functions; rental of holiday accommodation; provision of conference facilities; booking services for hotels; providing information and booking services for hotels via the internet and social media platforms; travel agency services for reserving hotel accommodation; reservation of hotel accommodation and restaurant services; holiday planning (accommodation); information, advisory and consultancy services relating to all the aforesaid services.

3. On 18 September 2023 and 9 October 2023, respectively, the applications were opposed by Sion O'Connor under sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(6) of the Trade Marks Act 1994 ("the Act").

4. Under sections 3(1)(b) and 3(1)(c), Mr O'Connor submits that the applicant's marks consist of the generic word 'loyalty' and the generic prefix 'dis'. He argues that the resulting combination 'disloyalty' is descriptive of loyalty programmes offered in connection with the applied-for services and is devoid of any distinctive character. He adds that the stylisation of the applicant's marks and the motion component of the '977 mark fail to introduce the necessary level of distinctiveness.

5. Under section 3(1)(d), Mr O'Connor submits that the word 'disloyalty' is widely understood, both in everyday language and the specific contexts of the applied-for services. He argues that the word is a customary expression in the business management and hospitality industries.

6. As for section 3(6), Mr O'Connor repeats his claim that the applicant's marks consist of the generic word 'loyalty' and the generic prefix 'dis'. He argues that the word 'loyalty' is descriptive in relation to the applied-for services and should be kept free for use by others in trade. Mr O'Connor's pleaded case on bad faith appears to be that the applications were filed as an attempt to monopolise generic terms in order to block fair use thereof by third parties.

7. The applicant filed counterstatements denying the grounds of opposition. The applicant submits that the word 'disloyalty' refers to disloyal or negative behaviour and will be perceived as a whole, rather than being dissected into 'dis' and 'loyalty' as suggested by Mr O'Connor. It submits that the relationship between its marks and the applied-for services is not sufficiently direct or specific to result in the relevant public immediately perceiving them as descriptive. The applicant also denies that the word 'disloyalty' has become customary in the current language for the applied-for services. It reiterates that the word will be perceived as a whole and not dissected into 'dis' and 'loyalty'. Finally, the applicant denies that the applications were filed in bad faith, submitting that Mr O'Connor's claims are misconceived.

8. Only Mr O'Connor filed evidence, though I note that both parties filed written submissions during the evidence rounds. A hearing was requested and held before me, by video conference, on 9 April 2025. Mr O'Connor represented himself. The applicant was represented by Michael Hicks of Counsel, instructed by Wedlake Bell LLP.

Relevance of EU law

9. 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.

Evidence and submissions

10. Mr O'Connor's evidence is given in two witness statements, dated 11 March 2024 and 31 October 2024, together with 33 exhibits.[2] Mr O'Connor also filed written submissions dated 11 March 2024 and 31 October 2024.

11. The applicant filed written submissions dated 16 May 2024.

12. In advance of the hearing, Mr Hicks filed a skeleton argument, whereas Mr O'Connor filed further written submissions.

13. I have taken all the evidence and submissions (including those made orally at the hearing) into account in reaching my decision and will refer to them below where necessary.

Procedural developments

14. On 7 April 2025, Mr O'Connor made an application to file additional evidence, consisting of a third witness statement and Exhibit SO175. The former was simply a vehicle for introducing the latter, which was a statement of grounds from the applicant regarding a 'HOXTON YARDS' trade mark. I dealt with this issue at the beginning of the hearing.

15. Mr O'Connor did not wish to add anything to the reasons provided at the time of making the request. Within the request, Mr O'Connor submitted that the evidence could not have been submitted previously; it only came to his attention in the context of a separate set of proceedings and its relevance had not been clear until he began

[2] These being labelled SO01, SO24, SO105, SO130-SO133, SO137-SO139, SO142, SO151-SO156, SO160-SO164, SO166, SO170-SO174, SO180-SO182 and SO190-SO191.

preparing for the hearing. He argued that the evidence was critical and of particular importance to his claim under section 3(6) that the applicant is engaged in a pattern of dishonest conduct. Excluding the document, it was argued, would risk a decision being reached without sight of all the facts relating to the applicant's intentions.

16. Mr Hicks resisted the application on the basis that it was a document that clearly could have been filed earlier and that it was irrelevant to the matters to be determined. Although he was nonetheless content for me to take it into account for the purposes of allowing the hearing to proceed effectively, I considered it appropriate to provide the parties with an oral decision on its admissibility for the sake of clarity as to what evidence could and could not be relied upon.

17. After hearing from both parties, I refused Mr O'Connor's request to file additional evidence. In arriving at this decision, I had regard to the factors outlined in *Property Renaissance Ltd v Stanley Dock Hotel & Ors* (2016) EWHC 3103 (CH). Firstly, whilst I considered that the evidence may be material to Mr O'Connor's claim under section 3(6), an extremely similar and earlier dated version of the document was already in evidence under Exhibit SO164. I also considered that the evidence could have been filed sooner; the statement of grounds was from October 2023 and there were no compelling reasons why it could not have been filed in the evidence rounds. Although Mr Hicks' willingness to continue with the hearing as scheduled removed the risk of delays, I still considered it unfair to subject the applicant to it at such a late stage in the proceedings.

Preliminary remarks

18. In his submissions, both at the hearing and in writing, Mr O'Connor repeatedly referred to what he described as the warning from Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. The referred-to passage and Jacob J's subsequent commentary appear at the outset of the judgement and are as follows:[3]

[3] Footnotes are omitted.

"In 1909 Sir Herbert Cozens-Hardy MR said:

> 'Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure'

The trade mark registration Acts up until 1994 stood firmly in the way of wealthy traders. Where they adopted marks which other traders were likely to want to use descriptively they found it either difficult or impossible to register their marks. The same applied to laudatory words and to important geographical marks, such as York. In some cases this policy may have gone too far: registration was denied even to marks which were '100% distinctive', i.e. those which had, through both use and recognition as trademarks, come to be taken by all concerned as denoting the proprietor's goods. The Trade Marks Act 1994, implementing an EC Directive, has swept away the old law. A mark which is 100% distinctive will almost certainly be registered now. I am not concerned with such a case. I am concerned with a much commoner sort of case: where a trader has made some use of a common laudatory word along with a distinctive mark. He can show that the word has achieved some recognition (quaere as really denoting trade origin on its own) but no more. Can he then avail himself of the Act to get a monopoly in the common word? If he can, then the 1994 Act enables big business to buy ordinary words of the English language as trade marks at comparatively little cost."

19. It is important to bear in mind that this was an introduction to Jacob J's consideration of the facts and the law. It has no precedential value. As such, it will not be taken into account in the decision that follows.

Decision

20. The relevant parts of section 3 of the Act read as follows:

"3(1) The following shall not be registered—

[…]

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

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

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

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

[…]

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

Sections 3(1)(b) and 3(1)(c)

21. Given that much of Mr O'Connor's case rests on whether the applicant's marks are descriptive, it is convenient to first deal with section 3(1)(c). Moreover, whilst I bear in mind that the above grounds are independent and have differing general interests,[4] descriptive marks necessarily lack the required distinctiveness to avoid objection under section 3(1)(b). Mr O'Connor's pleaded case under section 3(1)(b) is inextricably linked to that under section 3(1)(c), i.e. that the applicant's marks are descriptive. Therefore, I will assess both grounds of opposition together. As there is no other basis

[4] It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM,* Case C-329/02 P, paragraph 25.

for Mr O'Connor's claims that the applicant's marks are non-distinctive, if his claims under section 3(1)(c) fail, so too will his claims under section 3(1)(b).

22. In its counterstatements, the applicant highlights that its marks passed the assessment and threshold for distinctiveness by the registry. Moreover, in its written submissions, it refers to other registered trade marks containing the word 'loyalty'. However, these are not relevant factors. I must assess Mr O'Connor's claims for what they are worth, based upon the law and the evidence before me.

23. The case law under section 3(1)(c)[5] was set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

[5] Corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation.

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

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

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

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

same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

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

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality,

quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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

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

24. Whether the applicant's marks are descriptive must be assessed from the perspective of the relevant parties; the relevant parties are in trade or the average consumers of the goods or services in question, deemed to be reasonably well-informed, observant and circumspect.[6] Here, the applied-for services broadly consist of a range of loyalty scheme services, accommodation and hotel services, the provision of facilities, the provision of food and drink, and associated advisory services. The average consumer will largely be a member of the general public. However, some

[6] *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, paragraph 24

of the services, such as, for example, *rental of meeting rooms* and *provision of conference facilities*, may be purchased by businesses. Considering the nature of the services, the average consumer is likely to exhibit a normal (medium) level of attention during the purchasing process.

25. The assessment must also be made as of the relevant date, which is the date on which the application was filed. For the '979 mark, that is 30 May 2023. For the '977 mark, that is 20 June 2023.

26. There is no claim on the applicant's part that its marks have acquired distinctiveness through use. In any event, it filed no evidence. Accordingly, I have only the inherent position to consider.

27. Given that Mr O'Connor's case focuses on loyalty reward programmes, I will focus on the applied-for services which cover these commercial activities (such as, for example, *loyalty scheme services*). If Mr O'Connor's claims fail in respect of those services, they will also fail in relation to the other applied-for services.

28. The '979 mark is figurative and consists of the word 'DISLOYALTY', presented in a black script typeface on a white background. Part of the word, i.e. 'LOYALTY', has been struck through with a thick black line.

29. The '977 mark is a motion mark. The motion sequence is five-seconds long. The word 'DISLOYALTY' emerges in a white script font on a black background (from 0:00 to 0:02). Part of the word, i.e. 'LOYALTY', is then struck through with a thick white line (from 0:02 to 0:03). A 'motion mark' is a trade mark consisting of, or extending to, a movement or a change in position of the elements of the mark.[7] The term 'extending to' means that these marks cover not only the motion per se but also movements that contain word or figurative elements. Therefore, the '977 mark covers not only the motion elements described above but also the end result: the word 'DISLOYALTY', presented in a white script typeface on a black background, with part of the word, i.e. 'LOYALTY', struck through by a thick white line (shown from 0:03 to 0:05).

[7] Article 3(3)(h) of EU Implementing Regulation 2018/626.

30. Mr O'Connor's pleaded position is that the applicant's marks consist of the generic word 'loyalty' and the generic prefix 'dis-'. At the hearing, he submitted that the applicant has styled the word as 'DIS-LOYALTY', thereby giving greater prominence to the descriptive word 'loyalty'. In support of this contention, he referred me to the following:

(i) An undated printout from the dis-loyalty.com website, showing the programme branded as 'DIS-LOYALTY';[8]

(ii) Undated printouts from the ennismore.com website, showing use of the term 'Dis-loyalty' in connection with the applicant's travel and food membership;[9]

(iii) A press release from the applicant, via *PR Newswire* (27 July 2023), in which it uses the term 'Dis-loyalty' when referring to the launch of its travel and food membership;[10]

(iv) Printouts from the ennismore.com website (6 November 2023), describing the applicant's travel and food membership as 'Dis-loyalty';[11]

(v) An article from *Business Traveller* (27 July 2023), in which the founder and CEO of the applicant is quoted referring to the programme as 'Dis-loyalty'; and

(vi) Articles from *Fast Company* (1 August 2023), *Travel Weekly* (27 July 2023), *PYMNTS* (29 July 2023), *Loyalty Summit* (via LinkedIn, undated), *Business Traveller* (27 July 2023), *Boutique Hotelier* (6 November 2023), *The Points Guy* (25 July 2023), *Globetrender* (undated), *hospitalitynet* (27 July 2023), *Corporate Travel Community* (1 August 2023), *Hotel & Catering News Middle East* (2 August 2023), *Breaking Travel News* (28 July 2023) and *One Mile at a Time* (undated), referring to the programme as 'Dis-loyalty'.[12]

[8] Exhibit SO154.2
[9] Exhibit SO191.3
[10] Exhibit SO191.4
[11] Exhibit SO191.5
[12] Exhibits SO190.2-SO190.3, SO190.6-SO190.8, and SO190.11-SO190.19

31. I accept that this evidence shows the applicant and third-party press outlets using the term ‘Dis-loyalty’. However, it does not establish that the marks at issue in these proceedings would be perceived by the average consumer as the combination of two individual elements. The evidence is either undated or from after the relevant dates, so cannot be relied upon as showing the position at the relevant dates. In addition, it is not clear that any of the websites or articles were targeted at consumers in the UK. Crucially, the term ‘Dis-loyalty’ is not at issue in these proceedings. How the applicant or third parties refer to its travel and food programme in some circumstances (mainly where it is impractical to use figurative, or even motion, versions of marks, such as in bodies of text) does not impact on the way in which the marks at issue will, themselves, be perceived by the average consumer.

32. The word ‘disloyalty’ is a dictionary defined word, which will be readily understood by the average consumer. Although the ‘LOYALTY’ part of the word is struck through, it is my view that the average consumer would still identify the full word; it would not be dissected into two identifiable elements. To my mind, the word ‘DISLOYALTY’ is most dominant in the applicant’s marks, with the strikethrough, stylisation, use of colour and motion elements (where applicable) playing lesser roles.

33. In his written submissions, Mr O’Connor argues that the word ‘loyalty’ is descriptive in relation to the services at issue. Whilst I note these submissions, along with the evidence referred to therein, they do not assist Mr O’Connor.[13] The word ‘loyalty’ would clearly be descriptive in respect of loyalty reward programmes. However, the applicant’s marks do not consist of the word ‘loyalty’.

34. As outlined above, the word ‘DISLOYALTY’ is a dictionary word. The Oxford English Dictionary defines it as meaning ‘the quality of being disloyal; unfaithfulness, falseness”.[14]

35. Mr O’Connor argues that this word directly describes a type of loyalty programme and that it clearly and unambiguously designates the kind, purpose and characteristics

[13] Exhibits SO180, SO181.1, SO181.2, SO182.1 and SO182.2.
[14] https://www.oed.com/dictionary/disloyalty_n?tab=meaning_and_use#6589707

of the services in question. In support of this, he points to statements made by the applicant itself. These include, *inter alia*:

(i) “Dis-loyalty is a game-changing travel and food membership that takes a different approach to loyalty by actively encouraging members to explore new destinations and rewarding them for being disloyal”. This appears in (undated) printouts from the ennismore.com website.[15] As Mr O’Connor also highlights, the website states that the programme gives members bigger discounts for going somewhere new, offers the highest discount for just-opened hotels, and offers lower discounts for return stays;

(ii) “This is designed for folks who love to try new things […] If you want to go to the same hotel, knock yourself out. But if you go to one of our 30 openings every year from the Paris to Singapore, the savings will add up.” This quote was attributed to the founder and CEO of the applicant in the aforementioned article in *Fast Company* (1 August 2023);

(iii) “We want to break the traditional loyalty model by not rewarding members for how often they stay with us, but by encouraging them to discover the new. Dis-loyalty encourages our brand fans to discover hotels, restaurants, and bars in a new, digitally immersive, and editorial way”. This quote was attributed to the founder and CEO of the applicant in the aforementioned article in *Boutique Hotelier* (6 November 2023);

(iv) “Ennismore, the global lifestyle hospitality company, launches Dis-loyalty – a game-changing travel and food membership that takes a different approach to loyalty by actively encouraging members to explore new destinations and rewarding them for being disloyal.” This is in the aforementioned press release via *PR Newswire* (27 July 2023). It was also reproduced in an article from *Business Insider* (27 July 2023);[16] and

[15] Exhibit SO191.3
[16] Exhibit SO190.10

(v) “Each drop celebrates what it means to be Dis-loyal – freeing members from routine by rewarding firsts”. This appears in the aforementioned printouts from ennismore.com (6 November 2023).

36. The above, it is argued, confirms that the applicant’s programme rewards disloyalty to individual hotels but loyalty to the hotel group overall, showing that the word ‘disloyalty’ accurately describes the applicant’s services: a commercial membership programme that provides benefits for not remaining loyal to a specific hotel. In Mr O’Connor’s view, the word informs consumers what the programme is, but not its commercial origin.

37. Mr O’Connor also claims that numerous third-party articles about the applicant’s loyalty programme support that the word ‘disloyalty’ is descriptive. These include, *inter alia*:

(i) “The group is billing the new programme as “A game -changing membership that encourages disloyalty” – although of course members will need to be loyal as whole [sic] to Ennismore’s portfolio of hotels and F&B venues to get maximum benefit”. This is in the aforementioned article from *Business Traveller* (27 July 2023);

(ii) “Ennismore expands ‘game-changing’ loyalty programme with new activation. Following the launch of the ‘Dis-loyalty’ food and travel membership earlier this year, members can now win prizes as part of limited-edition ‘drops’ on social media”. This appears in the aforementioned article in *Boutique Hotelier* (6 November 2023);

(iii) “You've heard of loyalty programs — but have you heard of programs that reward you for being disloyal, in a roundabout way? Accor's Ennismore collection — a group of lifestyle hotel brands that includes 21c Museum Hotels, The Hoxton, Mondrian, SLS, SO/ and Delano — is embracing the idea of disloyalty by launching an all-new paid membership program, cheekily called Dis-loyalty, that gives discounts to people who sign up and stay and eat at 10

of the 14 brands in the collection". This appears in the aforementioned *The Points Guy* article (25 July 2023); and

(iv) "The term "disloyalty program" is not what it may seem (a program designed to lose credibility in the eyes of your customers). Instead, and perhaps surprisingly, it is a form of effective loyalty-building based on a partnership premise and exploration. People are not being rewarded through some complicated points tiers, but rather this different kind of food and travel membership for a new generation that does not want to be limited to the same experiences and destinations repeatedly. Those who are tired of a lack of variety and exploration will be drawn to the way members of this membership are encouraged to be adventurous and actively rewarded for being disloyal". This appears in a *Retailing Africa* article (29 November 2023).[17] I note that the article also states that "The term disloyalty reared its head back in 2013. A disloyalty program first gained traction in the coffee shop market, when a group of 10 indie brands decided to take on the might of the Starbucks chain in the Greater Boston / DC area. The brands came together to reward people for visiting different stores. And surprisingly, it worked. For SMEs this can be a great way to partner with like-minded businesses to garner interest and support".

38. To my mind, none of the above establishes that the word 'disloyalty' is descriptive. Mr O'Connor's arguments, and the evidence provided in support, appear to go to proving that the applicant's offering under the 'DISLOYALTY' brand is in fact a loyalty reward programme. That is not sufficient. A particular mark being used for the provision of a particular service, and the proprietor explaining what is offered under that mark, does not automatically render it descriptive. The question is not whether the applicant is providing a loyalty reward programme but, rather, whether the word 'disloyalty' (for the time being) is descriptive of the services in the applications or a characteristic thereof.

[17] Exhibit SO190.9

39. The majority of the evidence outlined above consists of quotes and press releases from the applicant about its own service offering, as well as third-party coverage of the same. This evidence, alleging to show descriptive use of the word 'disloyalty', actually shows descriptions of the applicant's loyalty reward programme offered under this word. The service offering is being explained. It seems unlikely that such repeated and extensive explanations of what the 'DISLOYALTY' brand is would be required if the word itself was an appropriate, clear and recognisable description of a kind of loyalty reward programme. I also note that none of the materials provided by Mr O'Connor about the different types of loyalty programmes and reward schemes mention 'disloyalty' as a kind of loyalty programme.[18] If the word represented a description of a kind of loyalty programme, one would expect the articles from academics and professionals in the trade, specifically about this topic, to include some reference to it.

40. I acknowledge that the article from *Retailing Africa* does appear to refer to disloyalty as a kind of loyalty reward programme. Although not specifically referred to by Mr O'Connor in this context, I also note that he has provided printouts from the peetsdisloyalty.com and hunter.marketing websites which arguably show use of the word in a descriptive sense.[19] However, the two website printouts are not dated, so cannot be relied upon as showing the position at the relevant dates. Moreover, this evidence is all from global websites, with no indication that they relate to the UK.

41. In addition, Mr O'Connor has evidenced an article from the *Daily Mail* (8 January 2014), entitled 'Disloyalty rewarded: Independent Washington D.C. coffee shops offer up anti-Starbucks cards'.[20] The article reports on the 'disloyalty card' scheme involving six independent coffee shops as a 'riff' on Starbucks loyalty card scheme. This is, of course, a UK-based publication. Moreover, it is dated well before the relevant dates. I am also aware that the *Daily Mail* is a major news outlet in the UK. However, the article relates to activities in the USA. Moreover, it is a news article about a particular commercial partnership/collaboration. To my mind, it does not unequivocally show descriptive use of the word 'disloyalty'. In any event, I do not consider this one example

[18] Exhibits SO180.8, SO181 and SO182
[19] Exhibits SO190.20 and SO190.21
[20] Exhibit SO190.22

to be sufficient for the purposes of establishing that the average UK consumer would perceive the word ‘disloyalty’ as a description of the applicant’s services.

42. To my mind, it has not been shown that the word ‘disloyalty’ is descriptive in the context of loyalty reward programmes. I appreciate that it is not necessary that the sign in question is actually used in a way that is descriptive for it to fall foul of section 3(1)(c); it is sufficient, by virtue of the wording of the provision, if the sign could be used for such purposes. However, that a mark may become descriptive in the future must be reasonably foreseeable. I do not consider it to be. As outlined above, the word ‘disloyalty’ refers to the quality of being disloyal, unfaithfulness, or falseness. It is quite unusual in the context of a trade mark in that it typically has negative connotations. Moreover, whilst it may be allusive of the loyalty reward programme operated by the applicant, without further thought or explanation it is not obvious how the word itself directly relates to the services. Given the meaning of the word, there is, in my view, no real risk of the word becoming descriptive in the future, and no need to keep the word free for other traders in the sector to use.

43. In addition, the applicant’s marks do not consist exclusively of the word element. The ‘979 mark is presented in a script typeface, and part of the word has been struck through. This is also true of the end result of the ‘977 mark. The script typeface and use of black and white in the marks are unremarkable; I am not satisfied that these elements would suffice to avoid an objection under section 3(1)(c) of the Act if the word ‘DISLOYALTY’ was descriptive. Moreover, I am not convinced that the motion element of the ‘977 mark itself could identify the services for which registration is sought as originating from a particular undertaking. However, the strikethrough element would, in my view, take the marks outside the scope of being exclusively descriptive. Although there is a tentative connection between the act of striking through the ‘loyalty’ part of the word ‘disloyalty’ and the meaning of the latter, I do not believe that the figurative element merely reinforces the meaning the word element. It would not be immediately apparent to the average consumer; arriving at such a conclusion would require a level or thought or analysis which is not attributed to the average consumer when encountering a trade mark. The strikethrough, therefore, creates an impression which is sufficiently removed from the word element alone.

44. Mr O'Connor's claims under sections 3(1)(b) and 3(1)(c) are dismissed.

Section 3(1)(d)

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

> "49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).
>
> 50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).
>
> 51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

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

46. The question to be determined is whether, at the relevant dates of 30 May 2023 and 20 June 2023, the applicant's marks had become customary in the current language or in the *bona fide* and established practices of the trade to designate the applied-for services. This must be based upon the perception of the average consumer of the services in the UK. My findings at paragraph 24 are equally applicable here.

47. Mr O'Connor's pleaded case is that the term 'disloyalty' is widely used in trade to describe a type of loyalty programme. At the hearing, Mr O'Connor argued that the term has entered usage as a category descriptor in the hospitality and marketing industries. I have already found that I do not consider that the average consumer would perceive the applicant's marks as descriptive of any of the applied-for services (most notably, loyalty reward programmes and schemes). In my view, there is also insufficient evidence to establish that the term 'disloyalty' had, at the relevant dates, become customary in the current language or established practices in the trade of any of the applied-for services.

48. At the hearing, Mr O'Connor referred me to the aforementioned printouts from the peetsdisloyalty.com and hunter.marketing websites, as well as the aforementioned *Daily Mail* article, in support of this ground. However, as previously outlined, the website printouts are not dated, and there is no indication that they reflect the position in the UK. In addition, the *Daily Mail* article relates to activities in the USA and is not sufficient, in and of itself, to demonstrate that the applicant's marks or the word 'disloyalty' have become customary in this territory. Moreover, Mr O'Connor referred to what he described as generic use of the word 'disloyalty' by journalists, commentators, trade participants and industry experts.[21] Much of this evidence has

[21] Exhibits SO190 and SO191

been discussed above in the context of Mr O'Connor's section 3(1)(c) ground. However, for the avoidance of doubt, I consider that it falls a long way short of demonstrating that the word 'disloyalty' has become customary. Firstly, much of the evidence relates to the applicant's own use of the term in a trade mark sense, and references thereto by third parties. Secondly, there is no indication that the aforementioned article in *Retailing Africa* relates to the UK. It is also from after the relevant dates. Whilst I have reviewed the remaining evidence not specifically referred to in full, there is nothing which establishes that the word 'disloyalty' or the applicant's marks had become customary at the relevant dates.

49. Mr O'Connor's claims under section 3(1)(d) are dismissed.

Section 3(6)

50. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) ("SkyKick")* [2024] UKSC 36, Lord Kitchin SCJ 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 Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

51. Later in *SkyKick* (at paragraph 240), Lord Kitchin summarised the general principles applicable to bad faith 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)."

52. An allegation of bad faith is a serious one 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.[22] It is necessary to ascertain what the applicant knew at the relevant date, that being 30 May 2023 for the '979 mark and 20 June 2023 for the '977 mark. Evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.[23]

53. Mr O'Connor's case as pleaded appears to be that the applicant has applied for its marks with the intention of blocking other parties from using the generic word 'loyalty', as it has allegedly done with other generic words. Reference was made to the CJEU's judgement in *Lindt*,[24] the operative part of which is as follows:

"53. Having regard to all the foregoing, the answer to the questions referred is that, in order to determine whether the applicant is acting in bad faith within the meaning of Article 51(1)(b) of Regulation No. 40/94, the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:

[22] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)
[23] *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)
[24] *Chocoladenfabriken Lindt & Sprüngli*, Case C-529/07

- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;

- the applicant's intention to prevent that third party from continuing to use such a sign; and

- the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought."

54. At the hearing, Mr O'Connor submitted that the applicant has shown a persistent pattern of applying to register descriptive and generic terms with a view to monopolising such terms and has refused to include disclaimers with respect to generic elements in the marks. He argued that the pattern of behaviour mirrors that identified in *Trump International Limited v DDTM Operations LLC ("Trump International")* [2019] EWHC 769 (Ch).

55. I have already found that neither of the applicant's marks is descriptive of the applied-for services. Therefore, whilst I have considered all of the evidence and Mr O'Connor's submissions in full, his pleaded case under this ground, such that it is, is rejected. As the applicant's marks are not descriptive, they were not filed in bad faith; any previous attempts by the applicant to register descriptive or generic terms, even if proven, are not relevant here.

56. Even if the applicant's marks were descriptive, it is my view that the evidence falls a long way short of establishing a pattern of behaviour of the kind that was shown in *Trump International*. In the decision under appeal,[25] the contested mark included the distinctive name of a very high-profile individual. There was a finding that the applicant had no *bona fide* intention to use the mark. The applicant did not answer the opponent's case that the applicant's motivation was to interfere with its legitimate interest in its mark. There was evidence that the controlling mind of the applicant had,

[25] BL O/409/18

through an extremely large number of corporate entities, made a very large number of trade mark applications, which included the targeting of famous trade marks associated with third parties.

57. In this case, Mr O'Connor relies on the applicant's alleged conduct in relation to its 'HOXTON' trade marks and previous dealings between the parties in respect of the same. He argues that 'Hoxton' is the name of a geographic area in East London, and that the applicant has used four marks which include this geographic indication to oppose "legitimate geographically descriptive trade marks applications" by others, namely himself. Much of Mr O'Connor's case on this issue appears to represent a re-run of arguments brought in previous proceedings between the parties.[26] The present proceedings are not an opportunity to relitigate those proceedings and the purpose of the present decision is not to reassess Mr O'Connor's previous claims.

58. Insofar as the materials relating to 'THE HOXTON' are considered relevant to the present proceedings, I note that Mr O'Connor points to him having previously applied for a number of trade marks which were opposed (or threatened to be opposed) by the applicant, in which it relied upon its earlier registered and unregistered rights in 'HOXTON' and 'THE HOXTON'.[27] As I have already outlined, bad faith is a serious allegation and must be properly supported by cogent evidence. Moreover, it is not sufficient to show facts which are just as consistent with good faith. In my view, the evidence of the applicant's previous oppositions to Mr O'Connor's applications are consistent with a trade mark proprietor attempting to protect its rights, as is permitted under the law. In addition, the correspondence sent from the applicant to Mr O'Connor appears to represent typical pre-action communications between parties in legal disputes.[28] To my mind, there is nothing in the evidence which establishes that the applicant has previously monopolised descriptive terms and utilised them to block fair use by third parties. There is also no evidence that the present applications were filed

[26] See decision no. BL O/0908/25, in which Mr O'Connor sought to invalidate four 'THE HOXTON' trade marks owned by the applicant. The grounds of invalidity included sections 3(1)(b), 3(1)(c), 3(3)(b) and 3(6). The basis for those claims broadly reflects that in the present proceedings, namely that the applicant's marks were descriptive and that the applicant had made the applications in bad faith as it was attempting to block third party use of the allegedly descriptive term. Mr O'Connor was unsuccessful on all grounds. At the time of writing, that decision was under appeal.
[27] Exhibits SO130, SO160-SO164 and SO170-SO174
[28] Exhibit SO131

with the intention to block fair use of any descriptive term. It is important to bear in mind that the applicant's marks do not consist of the word 'loyalty'. There is also no evidence of the applicant using its marks to prevent others from using the word 'loyalty' descriptively in the course of trade. Contrary to Mr O'Connor's position, there is evidence, albeit limited, which indicates that the applicant has used the 'DISLOYALTY' brand for commercial purposes and the '979 mark, in particular, in accordance with the essential function of a trade mark.

59. Mr O'Connor's reliance on *Lindt* does not take his case on bad faith any further. Having reviewed the evidence and all of his submissions in full, I do not consider there to be any evidence that, at the relevant dates, the applicant knew or must have known that a third party was using an identical or similar sign capable of being confused with the applicant's marks.

60. Finally, I note that Mr O'Connor has argued that the applicant has no intention of using the marks but, rather, that the applications were filed for a purpose other than the essential function of a trade mark and that they lacked commercial logic or involved a dishonest intention.[29] This line of argument did not form part of Mr O'Connor's pleaded case, and no application has been made to amend his pleadings to include it. Therefore, it is not strictly necessary for me to determine it. However, I will consider it for the sake of completeness. It is clear from the Supreme Court's summary of the law in *SkyKick* cited above that applying for a trade mark without any intention of using it may constitute bad faith where there is no rationale for the application. However, such a finding can only be made where there are objective, relevant and consistent indicia showing that the applicant had the intention of undermining the interests of third parties or of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark. In this case, there is no evidence indicating that the applicant sought to undermine the interests of third parties or that it wished to register its marks for purposes other than those falling within the functions of a trade mark. If this line of argument was included in Mr O'Connor's pleadings, I would have rejected it.

[29] In this regard, reference was made to *Sky Ltd v SkyKick UK Ltd* [2020] EWHC 990 (Ch) and *Koton Mağazacilik v EUIPO*, Case C-104/18 P.

61. Mr O'Connor's claims under section 3(6) are dismissed.

Conclusion

62. The oppositions under sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(6) of the Act have been unsuccessful. Subject to any appeal against this decision, the applicant's marks will proceed to registration in the UK.

Costs

63. The applicant has been successful and is entitled to a contribution towards its costs. In his skeleton argument, Mr Hicks submitted as follows

> "36. […] these two oppositions are part of a wider attack made by the Opponent on the Applicant or companies associated with the Applicant.
>
> 37. The Opponent does not suggest that he has any commercial interest in opposing the applications. Rather it appears that these oppositions have been launched in order to put the Applicant to trouble and expense, with a view to furthering the Opponent's wider agenda. Yet further, the oppositions have been burdened by the Opponent with a mass of irrelevant material, putting the Applicant to unnecessary cost in having to consider that material.
>
> 38. In those circumstances it is submitted that an off-scale award of costs would be appropriate in the event that it is determined that these oppositions should be dismissed.
>
> 39. The Applicant suggests that the most convenient way of dealing with the issue of costs and their amount, would be for the IPO to permit written submissions to be made on these issues following the handing down of the decision. This will enable the IPO to see these two oppositions in the context of the Opponent's wider agenda."

64. The substantive matters now having been determined, the applicant is invited to file submissions on costs within 14 days of the date of this decision. Mr O'Connor will have 14 days from receipt of those submissions to make his own submissions on costs. Those submissions should respond to the submissions of the applicant and be limited to the issue of costs only.

65. Once the parties' submissions have been received, a supplementary decision dealing with the matter of costs will be issued. The appeal period for this decision, as well as the decision on costs, will run from the date of that supplementary decision.

Dated this 1st day of May 2026

James Hopkins
For the Registrar