

O/0909/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NOS.
UK00905480298 AND UK00916347502
BY ENNISMORE INTERNATIONAL MANAGEMENT
LIMITED

FOR THE TRADE MARKS:

THE HOXTON

IN CLASS 43

AND

the hoxton

IN CLASSES 16, 20, 25, 35 AND 36

AND

AN APPLICATION FOR REVOCATION
UNDER NOS. 506372 AND 506373
BY SION O'CONNOR

BACKGROUND AND PLEADINGS

1. Ennismore International Management Limited is the registered proprietor (“the proprietor”) of the following trade marks:

UK registration no. **UK00905480298**

THE HOXTON

Filing date: 9 November 2006

Registration date: 15 November 2007

Registered for services in:

Class 43: Rental of temporary accommodation; reservations (temporary accommodation), hotel, resort, motel, bar, cafe, restaurant, banqueting and catering services; provision of premises and facilities for holding functions, conferences, conventions, exhibitions, seminars and meetings.

(The “first registered mark”)

UK registration no. **UK00916347502**

the hoxton

Filing date: 10 February 2017

Registration date: 14 July 2017

Registered for goods and services in:

Class 16: Paper, printed matter, stationery.

Class 20: Furniture, mirrors, picture frames, armchairs, cabinets, chests, closets, coatstands, desks, tables.

Class 25: Clothing, footwear, headgear.

Class 35: Retail services, shop retail services and retail services provided over the internet all relating to paper, printed matter, stationery,

furniture, mirrors, picture frames, armchairs, cabinets, chests, closets, coatstands, desks, tables, clothing, footwear, headgear.

Class 36: Real estate services; real estate affairs; real estate management; provision of housing accommodation; rental of offices; rental of office spaces.

(The “second registered mark”)

2. Sion O’Connor (“the applicant”) made an application to revoke the first registered mark and partially revoke the second registered mark on 31 July 2023. The applicant seeks revocation of the first registered mark under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”); the application is directed against all of the registered services. As for the second registered mark the applicant seeks revocation of all the goods in classes 16 and the following services in class 36: *“Real estate services; real estate affairs; real estate management; provision of housing accommodation”* under sections 46(1)(a) and 46(1)(b) of the Act.
3. In respect of the first registered mark the applicant claims non-use under section 46(1)(b) for the five-year period between 10 July 2018 and 9 July 2023, seeking an effective revocation dated from 10 July 2023.¹
4. As for the second registered mark, the applicant claims non-use under section 46(1)(a) in the five-year period following the date on which the mark was registered, i.e. 15 July 2017 to 14 July 2022 (the “first relevant period”). The applicant requests an effective date of revocation of 15 July 2022. Non-use is also alleged under section 46(1)(b) for the five-year period between 30 June 2018 and 29 June 2023 (the “second relevant period”), seeking an effective revocation date from 30 June 2023.

¹ Originally the dates pleaded were 19 July 2018 to 18 July 2023 with a revocation date effective from 19 July 2023, however, the applicant wrote to the Tribunal on 27 December 2023 explaining that the dates had been submitted in error and requested permission to amend these dates, which was granted.

5. The proprietor filed counterstatements defending its registered marks for all the goods and services for which non-use is claimed, claiming use since at least 2006.² No claim is made to there being any proper reasons for non-use.
6. On 14 February 2024 the revocation proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 (“the Rules”).
7. Both parties filed evidence in these proceedings. During the evidence rounds, the parties also filed written submissions; I will refer to these within this decision as the respective parties’ “first written submissions”. The proprietor also filed further written submissions during the evidence in reply stage of the proceedings (“the proprietor’s second written submissions”).
8. The applicant represents itself; the proprietor is professionally represented by Wedlake Bell.
9. No hearing was requested; however, the applicant chose to file written submissions in lieu of a hearing (the “applicant’s second written submissions”). Therefore, this decision is taken following a careful consideration of the papers before me.

RELEVANCE OF EU LAW

10. 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

11. The proprietor’s evidence comprises the witness statement of Kevin Rockey, dated 9 May 2024, together with Exhibits KR1 to KR22. Kevin Rockey is the

² Form TM8(N), question 8.

Deputy Brand Chief Operating Officer of Northern & Eastern Europe at Ennismore International Management Limited ("Ennismore"). The purpose of the evidence is to provide the background of the proprietor's company and to demonstrate use of its registered trade marks which are subject to this revocation.

12. The applicant's evidence consists of the witness statement of Sion O'Connor dated 7 August 2024, together with Exhibits SO-1, SO-14 to SO-17, SO-30, SO-88, SO-96 to SO-97, SO-137, SO-195 and SO-200 to SO-202. The purpose of Mr O'Connor's witness statement is to provide information about the geographical area of Hoxton, its businesses, and why the word Hoxton is not distinctive, amongst other things.

PRELIMINARY ISSUE

13. As a primary matter, whilst I have read in addition to the pleadings all of the evidence and submissions provided, much relates to evidence that is not relevant to the issues that I must decide. Consequently, I will not refer to every piece of evidence that has been submitted, nor will I address every submission that has been advanced.

LEGISLATIVE PROVISIONS

14. Section 46 of the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five-year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five-year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

15. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. As all the marks at issue are comparable marks, created from EUTMs, paragraph 8 of Schedule 2A of the Act is also relevant. It reads:

“(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the notifications set out below.

[...]

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.”

CASE LAW

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. Further, proven use of a mark which fails to establish that the “commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

19. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

[...]

22. The burden lies on the registered proprietor to prove use [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the

proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a

tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

21. Furthermore, as the contested marks are comparable UK trade marks, use needs to be shown in the relevant periods, with EU use being relevant up to 31 December 2020.

22. I keep in mind that the Court of Justice of the European Union ("CJEU") noted in *Leno Merken BV v Hagelkruis Beheer BV*³ that:

"36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the

³ Case C-149/11

reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

23. I observe that since *Leno* the General Court (“GC”) has held that genuine use may apply to a contested mark in circumstances where genuine use has been made in relation to services in the London and Thames Valley area,⁴ and where genuine

⁴ Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* upheld at [47]

use concerned national use of a EUTM in only one member state.⁵ Consequently, I accept that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM.

DECISION

Genuine use

History and background of THE HOXTON brand

24. As referenced above, Kevin Rockey is the Deputy Brand Chief Operating Officer of Northern & Eastern Europe at Ennismore International Management Limited ("Ennismore"). He states that the proprietor's company, Ennismore, own a portfolio of brands for 130 hotels and resorts worldwide, and as co-working spaces. These brands include amongst others THE HOXTON.⁶ Mr Rockey confirms within his witness statement that THE HOXTON brand was created and used in the UK since 2006 and that it is still in use to date.⁷ He explains that the brand was originally founded by Sinclair Beecham (co-founder of Pret A Manger) in 2006 and that the first hotel under THE HOXTON brand was opened in Shoreditch.⁸ This is supported in the evidence by the 'about us' page of the proprietor's website <https://thehoxton.com/about-us/>.⁹ Whilst I acknowledge that this evidence post-dates the relevant periods outlined above, the information provides a clear timeline of THE HOXTON brand, from its inception in 2006 to the years spanning the relevant periods, with reference to the opening of both its UK and international hotels. On THE HOXTON's website, there is mention of its bar and restaurant services, with a dedicated tab option for 'Restaurants & Bars',¹⁰ indicating that they are offered under THE HOXTON brand.

⁵ Case T-398/13, *TVR Automotive Ltd v OHIM*

⁶ The witness statement of Kevin Rockey, paragraphs 7-8

⁷ Ibid paragraph 11

⁸ Ibid, paragraph 12

⁹ Exhibit KR4, pages 39-42

¹⁰ Ibid, page 37 - 38

Purchase of THE HOXTON brand by the proprietor and consent for use by third parties.

25. Mr. Rockey confirms that in 2012, the proprietor, Ennismore, acquired THE HOXTON hotel in Shoreditch and the brand.¹¹ This is affirmed by a third-party article published on the website www.hospitalitynet.org/news/4956251.html entitled 'The Hoxton Hotel Acquired By Ennismore Capital'. The article is dated 30 May 2012 and discusses Ennismore's acquisition of what is described as 'the award winning The Hoxton hotel based in Shoreditch.'¹² Kevin Rockey confirms that Ennismore is a management company and does not generally own the hotels.¹³ He explains that Ennismore have contractual arrangements in place with the owners of the hotels under which it manages the operations of those hotels and earns fees for doing so. Mr. Rockey continues to explain that Ennismore set the prices charged by the hotels, provide booking services through which customers can book their rooms (whether directly to THE HOXTON or via third parties such as travel operators), procure supplies of consumables and other goods needed for the hotels, oversee human resources functions, control and produce relevant marketing and promotional materials for the hotels, deal with maintenance contractors, regulatory compliance, insurance, and all the aspects of the day to day running of the hotels.¹⁴ It is clarified that under the management arrangements in place for each hotel, Ennismore earns fees based upon an agreed percentage figure calculated in relation to various categories of services provided to the owner which include, inter alia, a percentage of the revenues earned by the hotel from its operations and a percentage for providing the reservation services. Mr. Rockey states that the arrangements provide that the hotel owners have the right to use the marks.¹⁵ On this point, I accept that in accordance with the legislation referred to above use can include use made by the proprietor or by a third party with the proprietor's consent. Therefore, the presence of a contractual agreement for the owners of the hotels to use THE HOXTON mark does not present any obstacle to the evidence of use provided.

¹¹ The witness statement of Kevin Rockey, paragraphs 12

¹² Exhibit KR5, page 44

¹³ Witness statement of Kevin Rockey, paragraph 12

¹⁴ Ibid, paragraph 13

¹⁵ Ibid, paragraph 14

Details of hotels under THE HOXTON brand

26. In relation to use within the UK, Mr Rockey claims that the first THE HOXTON hotel opened in Shoreditch in 2006, before expanding to Holborn in 2014, a third UK hotel was opened under the brand in 2019 in Southwark London, and in 2022 another hotel was opened at Shepherd's Bush.¹⁶ Further, at the time Mr Rockey's statement was written, a new location was expected to open in Edinburgh in 2024,¹⁷ although I accept that this is outside the relevant periods and I have nothing to confirm that the opening took place. Whilst I acknowledge reference to hotels situated in Europe under THE HOXTON brand, such as one opening in Amsterdam in 2015¹⁸ and another in Paris in 2017,¹⁹ I do not have any further information for these hotels, such as the number of guests, turnover and marketing figures, etc, therefore, I will focus my assessment of use on use made of the brand in the UK.

Third party article references to the hotels, restaurants, cafes and bars under THE HOXTON brand.

27. Mr Rockey asserts that hotels with THE HOXTON brand are regularly recognised in the category of 'Best Hotels' in the UK and elsewhere and refers to the following examples in support of this claim:²⁰ a Guardian article, entitled '10 of Britain's best work/stay hotels'²¹ and a National Geographic article entitled '39 of the world's best new hotels in 2021',²² both of which are dated 2021. However, I note that the latter refers to a hotel under THE HOXTON brand based in Rome after 1 January 2021, i.e. outside the period for which I can consider use in the EU. Nevertheless, within the evidence I note the existence of a number of other third-party articles that refer to hotels under THE HOXTON brand that are based in the UK. The are listed below:

¹⁶ Ibid, paragraph 15 and exhibit KR4

¹⁷ Ibid, paragraph 15 and exhibit KR7

¹⁸ Exhibit KR4, page 39

¹⁹ Ibid

²⁰ Witness statement of Kevin Rockey, paragraph 16

²¹ Exhibit KR6, page 58 -59

²² Exhibit KR14, pages 240 – 242

- The Standard, dated 4 September 2019, entitled ‘First look: The Hoxton Southwark makes a play for London’s coolest hotel south of the river,²³ which provides information about THE HOXTON’s hotel rooms, and its restaurants and bar.
- The Times, dated Saturday 21 September 2019, entitled ‘The cool hotel guide: The Hoxton, Southwark, London.’²⁴
- The Sunday Times, dated 13 October 2019, entitled ‘Travel: Best Places to Stay in 2019’, which lists THE HOXTON Southwark hotel as the winner.²⁵
- Forbes, dated 30 August 2020, entitled ‘Ennismore CEO Sharan Pasricha On Keeping Hoxton Hotels Hip, Safe, And Social For Guests’.²⁶
- The Telegraph, dated 1 September 2022, entitled ‘The Hoxton, Southwark’ in which the hotel was reviewed, and an overall rating provided of 8/10.²⁷
- CN Traveller, dated 13 December 2022, entitled ‘First in: The Hoxton Shepherd’s Bush’ where information about THE HOXTON brand of hotels and information about the hotel itself is provided.²⁸
- The Times, dated Wednesday, 1 February 2023, entitled ‘20 of the best romantic hotels in London’, in which THE HOXTON hotel in Southwark is listed at number 2.²⁹

28. Overall, the articles refer to hotels under THE HOXTON brand positively, providing reputable reviews and often praising the brand for its hotel, restaurant, café and bar services. The purpose of the articles is to inform the reader of hotels under THE HOXTON brand and recommend them to readers. There are also references within the articles to restaurants based within hotels under THE HOXTON brand, such as the restaurant ‘Seabird’ or restaurant ‘Albie’. For example, the Guardian article referred to above, states: *“The top floor houses a cafe with an outdoor terrace that has views across London. Next door, the hotel offers a fun range of urban joys, including Seabird, Hoxton’s 14th-floor restaurant and terrace, or try*

²³ Exhibit KR6, pages 49-53

²⁴ Exhibit KR6, page 54

²⁵ Exhibit KB14, page 237

²⁶ Exhibit KR6, pages 55-57

²⁷ Ibid, pages 60-62

²⁸ Ibid, pages 63-66

²⁹ Ibid, pages 67-68

out the rotating set of street food-inspired menus at Albies on the ground floor.”³⁰ While The Standard article states: ‘Londoner’s looking for an after work tipple at the lobby bar or who want to enjoy views from the rooftop restaurant will also find The Hoxton Southwark easy to get to [...],’³¹ before talking about the names of the restaurants located at THE HOXTON hotel. Whilst I do not have precise information regarding the number of readers for each of the third-party press articles it can be safely assumed that as most are national newspapers such as the Times or the Guardian, they would have reached a substantial number of readers.

The number of staying guests at the UK hotels during the relevant periods and customer reviews

29. Below is a table taken from Kevin Rockey’s witness statement. Mr Rockey explains that it represents the approximate number of guests staying in “THE HOXTON” hotels in the UK.³²

	2018	2019	2020	2021	2022	2023
THEHOXTON Shoreditch	17,558	95,839	26,873	42,756	87,717	90,463
THEHOXTON Holborn	14,114	76,239	23,442	45,387	98,820	98,285
THEHOXTON Southwark		34,187	25,812	41,937	86,990	92,429
THEHOXTON Shepherd's Bush					3,271	84,598
Total	31,672	206,265	76,127	130,080	276,798	365,775

30. This is accompanied by evidence of customer reviews on the Trip Advisor website.³³ Mr Rockey, provides a breakdown of the number of reviews that have

³⁰ Ibid, page 59

³¹ Ibid, page 50

³² Witness statement of Kevin Rockey, paragraph 18

³³ Exhibit KR8.

been provided for each UK hotel under THE HOXTON brand.³⁴ These are as follows:

Shoreditch: 6300+

Holborn: 3000+

Southwark: 1000+

Shepherd's bush: 400+

31. He explains that the lower numbers are reflective of hotels that have opened more recently and believes the number of reviews to evidence the popularity of the hotels. I note he does not confirm over which years these reviews have taken place; however, having viewed the evidence it is clear from the use of the 'way back machine' that a number of the reviews span a period from at least 2017 to 2023, with some referring to stays in 2024. Further, these reviews appear to be from users situated from different regions of the UK, but also from the EU and internationally.

32. It is clear from the evidence that consumers can book rooms to stay in THE HOXTON hotels through either THE HOXTON's own website,³⁵ or through third party platforms such as booking.com.³⁶

Awards and recognition of THE HOXTON brand in relation to its hotel services.

33. Included within the evidence are third party articles that refer to THE HOXTON branded hotels receiving awards and recognition.³⁷ Whilst many of these predate the relevant periods in question, or refer to hotels based in the EU, i.e. Rome in Italy, after 1 January 2023, I acknowledge that THE HOXTON hotel in Southwark did win 'RIBA London award' in 2022 as reported by Lifschitz Davidson Sandilands on the webpage *www.archetecture.com*. Within the article it refers to 'The Hoxton, Southwark', describing it as '*an ambitious mixed-use scheme that integrates 192 hotel rooms, restaurants, bars and function rooms plus 4,000m² of flexible co-*

³⁴ Witness statement of Kevin Rockey, paragraph 20

³⁵ Exhibit KR10.3, page 2018, and Exhibit KR11, page 226

³⁶ Exhibit KR11, page 225

³⁷ Exhibit KR14

working office space, all stacked within the same slender 17-storey building. It is a welcoming blend of space where workers, guests, locals and diners overlap day and night. Furthermore, a 'Fast Company' article dated 3 October 2020, entitled 'The 10 most innovative travel companies of 2020', ranks Ennismore in second place 'for creating a hotel experience distinct enough to drive direct bookings'. Whilst Ennismore owns many brands, the body of the text refers only to Ennismore's 'Hoxton hotels'.³⁸ These appear to be more industry focused, than the national newspaper reviews discussed above which target the public at large.

'THE HOXTON' website and social media pages

34. Mr Rockey states that THE HOXTON domain name (<https://thehoxton.com/>) was registered in 2004,³⁹ this is supported by the exhibit evidence.⁴⁰ Within the evidence, Mr Rockey has provided a table of the Google Analytics data for the years 2017 to 2023.⁴¹ It is claimed that this shows the number of visitors and sessions achieved by THE HOXTON website.⁴² The figures can be seen from the table copied below:

Google Analytics

UK Yearly Sessions		
Year	Sums of Sessions	Sums of Users
2017	741,754	577,502
2018	789,975	589,217
2019	924,162	683,714
2020	670,400	487,549
2021	1,062,477	778,049
2022	1,466,218	1,081,295
2023	1,590,715	1,153,016
Total	7,245,701	5,350,342

³⁸ Ibid, pages 238-239

³⁹ Witness statement of Kevin Rockey, paragraph 48

⁴⁰ Exhibit KR16, page 254

⁴¹ Ibid, page 255

⁴² Witness statement of Kevin Rockey, paragraph 50

35. The narrative evidence along with the exhibits show that in addition to ENNISMORE having its own website and social media accounts, THE HOXTON brand has a separate webpage and social media accounts, which include the following: Instagram, Facebook, X (previously known as Twitter) and LinkedIn. This narrative evidence includes the number of followers for each page or account both at a date around which the statement was signed as well as at the date of 21 June 2023.⁴³ This is all verified by the exhibited evidence accompanying the witness statement of Kevin Rockey.⁴⁴ The evidence confirms the following for each site:

Instagram; total followers on 21 June 2023, 309,000; total followers after relevant periods: 345,000

Facebook; total followers on 21 June 2023, 29,765; total followers after relevant periods: 30,000

X (formerly Twitter); total followers on 21 June 2023, 20,300; total followers after relevant periods: 19,900

LinkedIn; total followers on 21 June 2023, 33,261; total followers after relevant periods: 43,166

36. Also included within the evidence is the number of UK followers for Instagram, Facebook and LinkedIn, however, these figures are for dates in 2024, i.e. after the relevant period. Nevertheless, in accordance with the pattern for the total number of followers for the social media accounts both within the relevant periods and after, I find that it can be inferred that the number of UK followers for the relevant periods include a significant number of the figures provided below:

Instagram: 80,511

Facebook: 14,860

LinkedIn: 7,788

⁴³ Ibid, paragraphs 53-58

⁴⁴ Exhibits KR18-KR21

37. Mr Rockey claims that THE HOXTON Instagram account predominantly features photographs, images and videos of THE HOXTON goods and services under THE HOXTON trade mark,⁴⁵ but he does not specifically state which goods and services, and I am mindful that there are many goods and services registered under THE HOXTON brand that are not subject to this revocation that the author may be referring to. However, from the limited Instagram images that are within the evidence, they appear to be of hotel, food and drink services under THE HOXTON brand

Total UK gross sales figures

38. Within the narrative evidence are the total UK gross sales figures for the goods and services sold under THE HOXTON brand spanning the years 2017 to 2022, including a breakdown of the UK gross sales figures for the different types of goods and services sold under THE HOXTON brand for the years 2018 onwards.⁴⁶ This is reproduced below.

UK Revenue for goods and services under THE HOXTON brand

Year	2017	2018	2019	2020	2021	2022	2023
Room booking	Breakdown not available Total £25,262,876	£22,136,105	£23,694,772	£6,762,830	£13,465,476	£39,581,533	£52,894,357
Food & Drink		£5,209,741	£6,623,863	£4,237,291	£8,283,731	£14,262,111	£17,815,394
Office space rental				£1,024,231	£3,520,788	£6,052,379	£6,422,568
Other income		£1,879,482	£1,721,072	£4,216,036	£2,021,246	£1,728,664	£1,536,940
Notebooks/stationery		-	£540	£275	£245	£300	£120
Meeting and Event Hire	£1,845,658	£2,034,436	£1,477,264	£340,091	£1,185,686	£2,282,965	£2,947,841
TOTAL	£27,108,534	£31,259,764	£33,517,511	£16,580,754	£28,477,172	£63,907,952	£81,617,220

39. Further, Mr Rockey provides the approximate price of the following goods and services:

- A) Room booking – from £329 per night
- B) Meeting room rentals – from £75 per hour
- C) Event venue hire – from £6,000 (for intimate wedding package)

⁴⁵ Witness statement of Kevin Rockey, paragraph 54

⁴⁶ Exhibit KR12

D) Notebooks sales – from £10

E) Stationery pouch – from £15

Total UK marketing figures

40. The proprietor has provided its marketing figures for each UK hotel under THE HOXTON brand. This has been separated into cultural and digital marketing spending for the years 2018 to 2023, but also includes the projected 2024 budget.⁴⁷ The breakdown of marketing figures can be found below:

Cultural Marketing				
Year	Hoxton Holborn	Hoxton Shoreditch	Hoxton Southwark	Hoxton Shepherds Bush
2024 Budget	64,250	35,450	76,050	50,970
2023 Actual	61,038	13,161	57,267	61,914
2022 Actual	23,872	21,270	40,025	-
2021 Actual	9,438	2,193	5,782	-
2020 Actual	7,184	5,651	4,613	-
2019 Actual	1,402	144	19,149	-
2018 Actual	540	90	-	-

Digital				
Year	Hoxton Holborn	Hoxton Shoreditch	Hoxton Southwark	Hoxton Shepherds Bush
2024 Budget	100,024	86,995	146,314	84,759
2023 Actual	95,955	75,464	143,533	84,759
2022 Actual	49,415	44,927	90,548	5,309
2021 Actual	52,408	57,090	90,403	-
2020 Actual	52,517	35,272	78,689	-
2019 Actual	24,735	25,568	-	-
2018 Actual	-	-	-	-

41. It is unclear exactly what is meant by cultural marketing, but in any event, it is clear that this is the figures all relate to marketing. Overall, the total UK spending on marketing has steadily increased year on year from tens of thousands to hundreds of thousands of pounds. However, while the market expenditure is broken down for the different UK hotels, it is not broken down by the goods and services subject to this revocation. From the context of the location, it can be inferred that the marketing is predominantly focused in services under THE HOXTON brand rather than goods.

⁴⁷ Exhibit KR13

42. There is also extensive brochure evidence taken from THE HOXTON's website and dated within the relevant periods. These promote hotel rooms, bars and restaurants, and function rooms for hosting meetings and events, all under THE HOXTON brand which appears in the corner of each page of the brochures.⁴⁸ These are brochures dated in June 2020, June 2022 and March 2023.

Sufficient use

43. For use to be genuine, it must have been real commercial exploitation of the mark in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant periods, within the EU prior to 1 January 2021, and in the UK following that date. In making my assessment I am required to consider all the relevant factors listed above, i.e. the scale and frequency of the use shown, the nature of the use shown, the goods and services for which use had been shown, the nature of the goods and services and the markets for them, and the geographical extent of the use shown. I will address each of the classes within the specification and group the terms accordingly.

Class 43 Services

44. Taking first the class 43 services:

Rental of temporary accommodation; reservations (temporary accommodation), hotel, resort, motel, [...]; provision of premises and facilities for holding functions, conferences, conventions, exhibitions, seminars and meetings.

45. The evidence shows that the UK gross annual sales figures for the years 2018 to 2023 for room bookings for the hotel range from over £6 million to £52 million, and that meeting and event hire figures range from over £340,000 to, in excess of £2 million. Whilst I do not have evidence relating to the UK or EU market share held by THE HOXTON brand for these services, these figures are far from insignificant, particularly as the lower figures reflect the period in which the UK was in lockdown due to COVID and these services could not always be accessed by the public. Despite there being no direct documentary sales evidence in the form of invoices

⁴⁸ Exhibit KR10.3, pages 192-202, 211-217 and 219-224

for example, in their absence I accept the unchallenged figures for the number of guests staying at UK hotels for the years 2018 to 2013 showing tens of thousands expanding into hundreds of thousands of guests staying at the hotels annually. This is accompanied by the narrative evidence that confirms that the price of a room in a hotel starts from £329 per night. Further, there are the marketing figures which overall range from tens of thousands to hundreds of thousands with an increase year on year, this demonstrates a genuine attempt to market the brand in relation to the hotels.

46. I note from Google Analytics information that THE HOXTON's own website, which promotes the hotel and event services, amongst others, under THE HOXTON brand was visited by over 5 million users between the years 2017 and 2023. Its social media pages/accounts, each have thousands and sometimes hundreds of thousands of followers, in addition to the Trip Advisor customer reviews and the numerous national press articles, this all indicates the popularity of the hotel services and contributes to the overall evidential picture of the scale and frequency of use for these services.

47. From the narrative and exhibit evidence it can be seen that the graphical extent of the hotel services found under THE HOXTON brand includes not simply the UK but also hotels in the EU, in Amsterdam (Netherlands) and Paris (France) that were opened prior, or during, the relevant periods and before 1 January 2021. However, I have no sales figures or visitor numbers for services operating in these locations as the evidence appears to focus mainly on revenue and users generated from use in the UK. Nevertheless, given the type of services at issue, it is reasonable to expect that the users of those services would be located across the UK and even EU and that is supported by the Trip Advisor evidence, although I accept that largely the evidence of use for the hotel services extends only to the UK. Despite this, use in the UK may still constitute use in the EU particularly where the scale and frequency of use is significant as is the case here.

48. Overall, I accept that the proprietor has made a genuine attempt to create and maintain a market for THE HOXTON brand within the EU and UK in relation to the hotel services including services for the provision of various functions and meeting

rooms. Consequently, I am satisfied that the proprietor has demonstrated genuine use of THE HOXTON brand for these services within the relevant periods.

[...] Bar, cafe, restaurant, banqueting and catering services

49. The evidence shows that UK gross annual sales figures for food and drink services under THE HOXTON brand for the years 2018 to 2023 range from: over £4 million to £17 million. However, I note that the lower figure covers sales in 2020 when there were restrictions on food and drink services, such as bars and restaurants. Whilst I do not have figures relating to market share, I do not consider these sums to be trivial. Further, bars and restaurants are also promoted within THE HOXTON's brochures found on its website. As discussed above the website was visited by over 5 million users between the years 2017 and 2023. Alongside this evidence are independent, third-party articles, including from national newspapers referring to THE HOXTON's bars and restaurants. I observe that the restaurants themselves may have specific names such as 'Albie' or 'Seabird' as referenced within its brochure and some of the third-party articles, however, it is clear from the evidence that these are provided under THE HOXTON name and within its hotels under the brand. The food and drink services also appear to be marketed on social media under THE HOXTON brand, which as discussed above have thousands, or in the case of Instagram, hundreds of thousands of followers. In addition to its bars, restaurants and cafes, the evidence shows that offered under the mark are function rooms for holding events, whether they are weddings⁴⁹ and other events, or business functions. From the brochure evidence, these event spaces appear to be catered for, offering dinner or stocked pantries.⁵⁰ I find it reasonable to assume that THE HOXTON caters for these event spaces, however, even if this is not the case, consumers would perceive THE HOXTON to have some responsibility for the quality of the catering services provided, even if another party is responsible for these services. From the overall evidential picture, I am satisfied that THE HOXTON brand has received national exposure for these services and that there has been a genuine attempt to create and maintain a market for these services under THE HOXTON brand within the EU

⁴⁹ Exhibit KR10.3, page 190

⁵⁰ Ibid, page 195

and UK, as such, it follows that there has been genuine use of THE HOXTON brand for these services.

Class 36

Real estate services; real estate affairs; real estate management; provision of housing accommodation

50. I acknowledge that UK gross annual sales figures have been provided for 'office space rental' for the years 2020 to 2023. This shows figures that range from over 1 million to over 6 million which are not insignificant sums and moreover show an increase year on year. In addition to the UK gross annual figures, the evidence shows a post on THE HOXTON's Linked in page, promoting "*Introducing Working From_ A new coworking space, where home comforts meet hotel living. The comfy sofas at The Hoxton have been the unofficial workspace of choice since we opened in 2006 and now it's time to step it up a level Like working from home without the distractions Opening in Loop Chicago and Southwark London in October 2019.*"⁵¹ Whilst the evidence is dated after the relevant periods, it refers to events within them.

51. Using the 'way back machine' there are screenshots from the website *workingfrom.thehoxton.com* that appear to be dated 24 December 2020. The website states: "working from_ a new workspace by The Hoxton".⁵² The evidence advertises the services available displaying pictures of the space and facilities offered, with pricing information. There is also evidence using the 'way back machine' dated 2022 and 2023 of the website *workingfrom.thehoxton.com* displaying the Work From_ mark in the top left corner and with the words "A coworking space by The Hoxton" in the centre of the page.⁵³

52. Alongside the website information is a pdf brochure, dated 2021, entitled "*Office rental – WF_ Southwark-Brochure.pdf (thehoxton.com)*".⁵⁴ The brochure appears

⁵¹ Exhibit KR10.2, page 143.

⁵² Ibid, pages 144 – 147

⁵³ Ibid, pages 160- 167

⁵⁴ Ibid, pages 148 - 159

to be taken from THE HOXTON website and advertises the office rental spaces at THE HOXTON Southwark hotel under the mark Working from_. The brochure like the website appears to be offering the rental of office spaces within THE HOXTON hotel in Southwark, with details of the memberships offered for the rental spaces, specifics about the meeting rooms, breakout rooms and other facilities offered as part of the services. An update version of this online pdf brochure is also provided for the year 2023 (June).⁵⁵

53. I bear in mind that, although criticisms can be made of individual items of evidence, the registrar must stand back and take a view of the evidence in its entirety.⁵⁶ Whilst the evidence is not without its limitations: In light of the smaller UK gross annual sales figures there are no invoices or third party articles referring to THE HOXTON's coworking space under the mark Working From_. Nevertheless, when the evidence is viewed as a whole it is clear that THE HOXTON offers the rental of office spaces within its hotel premises and, through its website and brochures it has tried to promote these services with the aim of creating and maintaining a market for them within the UK. However, at its highest I find that the evidence only shows use of rental of office spaces or office space rental.

Class 16

Paper, printed matter, stationery.

54. In relation to these goods Mr Rockey states:

“The goods sold under the Registrations tend to change according to various collaborations and customer demand. Sometimes the goods will be provided as part of a package to complement the various services being provided at the hotel. For example, where services such as the rental of meeting rooms or office space is offered, this may be accompanied by the provision of relevant articles such as clipboards, pens, pencils and notebooks. The price of some of

⁵⁵ Ibid, pages 169-179

⁵⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

*these will be incorporated in the overall rental price charged and cannot be broken down to show individual figures for specific items”.*⁵⁷

55. To support the fact that these goods are included within the services for office space rental, screenshots have been provided from “THE HOXTON” website thehoxton.com/London/Shoreditch/meeting-spaces/;⁵⁸ using the ‘way back machine’, these are dated 20 January 2021 and 30 June 2022. The webpage poses the question ‘what comes as standard?’ below is a list of goods provided, including ‘printing’ and ‘flip charts with pens’. On this point I refer to *Claridge’s Hotel Ltd v Claridge Candles Ltd* [2019] EWHC 2003 (IPEC), where Mr Recorder Campbell QC reiterated that the effect of use relied on was to create or maintain a market for the goods/services covered by the registration. Consequently, he held that even though the claimant in *Claridge’s* had applied that mark to toiletries, it had not sought to create a market for those goods; it had provided them free of separate charge to create or maintain the market for its hotel services. I find this to be the case here. Goods such as pens, flip charts, notebooks and paper offered as part of services for the rental of office spaces without a separate charge are not used to create or maintain a market for those goods, instead they are offered as to entice consumers to use the rental of office space services for the purpose of maintaining a market for these services.

56. In contrast to the goods, I note within this case that the judge held that the claimant’s mark had been put to genuine use in relation to restaurant, café, and bar services, as well as conference, business and health club services, notwithstanding the fact that these services were marketed only in connection with its hotel.

57. Within the evidence is an article dated 16 November 2018, from the website www.sesameletterpress.com/journal/the-hoxton-collaboration this discusses a collaboration between THE HOXTON and SESAME LETTER PRESS for stationery items.⁵⁹ However, it is unclear from this article whether the goods are

⁵⁷ Witness statement of Kevin Rockey, paragraph 32

⁵⁸ Exhibit KR10.1, page 127 and 128

⁵⁹ *Ibid*, pages 123 – 124.

for sale to the public or provided as part of the hotel services. Further, even if the items are for sale the article refers to them being available at “THE HOXTON” hotel in Williamsburg which is in America, therefore, these sales would have no bearing on use within the UK and EU markets.

58. Using the ‘way back machine’ there is evidence dated 20 September 2020 from shop.thehoxton.com/collections/best-of/products/notebooks-by-field-notes of notebooks being offered under “THE HOXTON” brand in partnership with ‘FIELD NOTES’ (as displayed below):⁶⁰



These are offered for £12 for a set of three, however, it is clear that these are sold out from the screenshot provided. There is also evidence dated 29 June 2022, 27 January 2023 displaying the ‘notebooks by Field Notes’ on the shop page of “THE HOXTON” website, however it is sold out.⁶¹

59. There is also undated evidence of a pen,⁶² flip chart,⁶³ notebook,⁶⁴ stickers,⁶⁵ gift bags and gift tags,⁶⁶ and curiosity cards,⁶⁷ under “THE HOXTON” brand. However, there is no evidence of these goods for sale on the website to a UK or EU market during the relevant periods, other than the field notes collaboration notebooks discussed above. I note that the UK gross sales figures for these goods are tiny in comparison to the likely size of the EU or UK market with the highest

⁶⁰ Ibid, page 125.

⁶¹ Ibid, page 129.

⁶² Ibid, page 131

⁶³ Ibid, pages 132-133

⁶⁴ Ibid, pages 133-134 and 141

⁶⁵ Ibid, page 137

⁶⁶ Ibid, page 140

⁶⁷ Ibid, page 139

annual sales being £540 in 2019, given that the above evidence shows that the price of a set of three notebooks under the mark is £12, this provides a maximum sale of 45 sets of notebooks in 2019. The sales figures along with the fact that in many screenshots of the goods the items were sold out creates the impression that there has not been a real commercial exploitation of the mark for these goods which are only available some of the time. In support of this, I am mindful that in *Memory Opticians Ltd's Application*,⁶⁸ the Appointed Person, upheld the Hearing Officer's decision to revoke the protection of the mark 'STRADA' for spectacles which only sold circa 40 pairs of spectacles which were also only displayed in store on occasions. I keep in mind that Arnold LJ explained that the GC has held on numerous occasions that "the smaller the commercial volume of the exploitation of the mark, the more necessary it is for [the proprietor] to produce additional evidence to dispel any doubts as to the genuineness of its use".⁶⁹ In absence of additional evidence to dispel these doubts, whilst I acknowledge that there is no de minimis level of sales, I remind myself that the mere fact of commercial use of a mark may not automatically mean that genuine use has been shown. Therefore, I consider that the proprietor has not demonstrated that it has made genuine use of the earlier marks for the above class 16 goods.

Form of the marks

60. Section 46(2) of the Act states that use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. The marks under attack are both figurative marks that include the words "THE HOXTON", depicted as follows:

The first registered mark	The second registered mark
THE HOXTON	the hoxton

⁶⁸ BL O/528/15

⁶⁹ Including in the Case T-334/01.

61. As can be seen, the first registered mark is presented in upper case in bold standard font with a reverse letter N at the end of the mark. The second registered mark is presented in lower case, in a standardised font with a slight stylisation of the letter x.

62. I keep in mind that in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EUIPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS

registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

63. In relation to the second registered mark, this is found as registered on THE HOXTON website and the brochures promoting the hotel rooms, bars, restaurants, and function rooms for meetings and events. It is also displayed on some of THE HOXTON social media pages, such as its twitter page (now known as X) and its LinkedIn page within the relevant periods. This is clearly use of the mark as registered.

64. As for the first registered mark, the mark as registered is not displayed in full, anywhere within the evidence. Indeed, the only sight of the reverse letter N is in a screenshot of a picture from THE HOXTON website that appears to cut off the full word ‘HOXTON’.⁷⁰ Instead, use is shown of either the second registered mark (as discussed above), or the words THE HOXTON in word only format whether presented in upper, lower or mixed case.

65. Use in word only format is found throughout its brochures and on its website where it is often found alongside the second registered mark. It also appears in third party articles, where I acknowledge that figurative marks are not typically inserted when referring to the names of brands and as such use in word only format is to be expected. Further, some of its social media pages contain THE HOXTON in word only format; on Instagram and Facebook the words are presented alongside an image of the stylised letter x.

⁷⁰ Exhibit KR4, page 32

66. I acknowledge the applicant's submissions which argue that *'the word mark and the figurative mark are not interchangeable.'* He asserts:

"The TM Holder's assertion that the word mark is merely a variant of the figurative marks ignores the distinctiveness imbued by the specific stylization of the registered marks.

- *In NIRVANA Trade Mark, O/262/06, the UK High Court held that use of a word in plain typeface was not sufficient to demonstrate use of a mark registered with distinctive graphical elements.*
- *Here, use of "THE HOXTON" in plain typeface (or as a word mark) fails to capture the visual and distinctive character of the reversed "N" or the specific typeface associated with the figurative marks."⁷¹*

67. In contrast the proprietor argues,

"Nevertheless, the use of the registration no. 298 in a word form or in the amended stylised form does not alter the distinctive character of the mark. The registration will still be viewed and pronounced as THE HOXTON and nothing more or less.

The Applicant's claims of non-distinctiveness of the earlier registration no. 298 do not play any part in relation to use of the mark in trade within the period, subject to this revocation action. Therefore, the Applicant's claim that there is no proof of genuine use because the mark is non-distinctive is denied and unsupported by any relevant evidence or law."⁷²

68. For clarity in *NIRVANA, O/262/06*, Richard Arnold Q.C (as he then was) sitting as the Appointed Person, upheld the Hearing Officer's decision that use of *NIRVANA NATURAL* constituted use of the registered word only mark *NIRVANA* as the word *NATURAL* was found to be descriptive of the goods. Indeed, *NIRVANA* was

⁷¹ Applicant's second written submissions, section C: Variant Logos at paragraph 1.2

⁷² The proprietor's second written submissions, paragraphs 36 and 37.

considered in the case law cited above at paragraph 62 which clarifies the current position.

69. Throughout the applicant's submissions it is emphasised that the distinctive character of the first registered mark cannot rest in the words themselves as he believes them to be descriptive of a geographical location. However, for the purposes of my assessment, I must proceed on the basis that registered marks must be assumed to have at least some level of distinctiveness.⁷³ In my view, there is nothing to suggest that the word "HOXTON", although a geographical location, has any relation to the goods or services registered under this mark. Further, the addition of the definite article "THE" provides a unitary meaning that separates it from being perceived as purely referring to the geographical location. As such, I consider the word element of the mark to be fairly distinctive.

70. Further, on the matter of the impact of the reverse letter N, I note the applicant's conflicting position on this point. Whilst in its first written submissions the applicant appears to make the following concession:

"In relation to UK00905480298, the TM Holder appears to admit that the letter 'N' being in reverse is a "small and insignificant" variation to the standard presentation of the letter 'N' in 'Hoxton'. This admission is accepted".⁷⁴

71. However, in its later submissions it takes the contrary position stating:

"1.1 The Figurative Elements are Integral to the Registered Marks.

The trade marks in question, particularly UK00905480298, include distinctive figurative elements, such as the reversed "N" in the word "HOXTON". These elements contribute to the mark's overall distinctive character and distinguish it from a standard word mark.

- *Case Reference: Colloseum Holding AG v Levi Strauss & Co. (C-12/12) established that figurative elements in composite marks can constitute*

⁷³ *Formula One Licensing BV v OHIM*, Case C-196/11P,

⁷⁴ The applicant's first written submissions, page 3

distinctive features, and their omission or alteration can result in a material change to the mark's character.

- *The reversed "N" in the mark cannot be dismissed as "insignificant." Its removal alters the visual perception of the mark and its distinctiveness."*⁷⁵

72. The proprietor has maintained throughout these proceedings that the presence/omission of the reversed letter N does not alter the distinctive character of the mark and therefore use should be found for the proprietor's first registered mark.

73. Given that the applicant's position in the initial concession appears to have changed, I will provide a full assessment of the impact of the differences between the mark used and the first registered mark as registered.

74. In accordance with the above case law, what I must assess is the mark as registered and the mark as used and whether the differences alter the distinctive character of the mark in the form in which it was registered. The difference between the word only format and the first registered mark is the use of the reversed letter N, and the bold font as the first registered mark is presented in standard typeface. As I have found the words themselves to be fairly distinctive, in my view, neither the use of the letter N in its standard position (as opposed to its reverse position) or the omission of bold font are significant enough to alter the distinctive character of the first registered mark. This is because consumers will immediately identify the letter N whether it is in its typical position or reversed. It will merely be seen as a creative way of expressing the same letter. Equally whether the typeface is presented in bold or not does not detract from the distinctiveness of the words themselves. As such, I am satisfied that use of the words THE HOXTON in word only format constitutes use of the first registered mark.

75. As for the matter of whether the use of the second registered mark constitutes use of the first registered mark; I am aware that the GC has ruled that "*the proprietor*

⁷⁵ The applicant's second written submissions, page 8, section C, at 1.1.

*of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark”.*⁷⁶ Applying this principle to the case in question, use of the second registered mark may also constitute use for the first earlier mark provided the distinctive character of the mark is not altered.

76. Whilst the first registered mark and the second registered mark differ in the stylisation and case used, and the position of the letter N. None of this alters the distinctive character of the first registered mark which rests in the words themselves. Consequently, I find that use of the second registered mark constitutes acceptable variant use of the first registered mark.

Use with, or as part of, another mark

77. In *Colloseum Holdings AG v Levi Strauss & Co.*⁷⁷ the CJEU found that:

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

[...]

35 [...] a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).” (emphasis added)

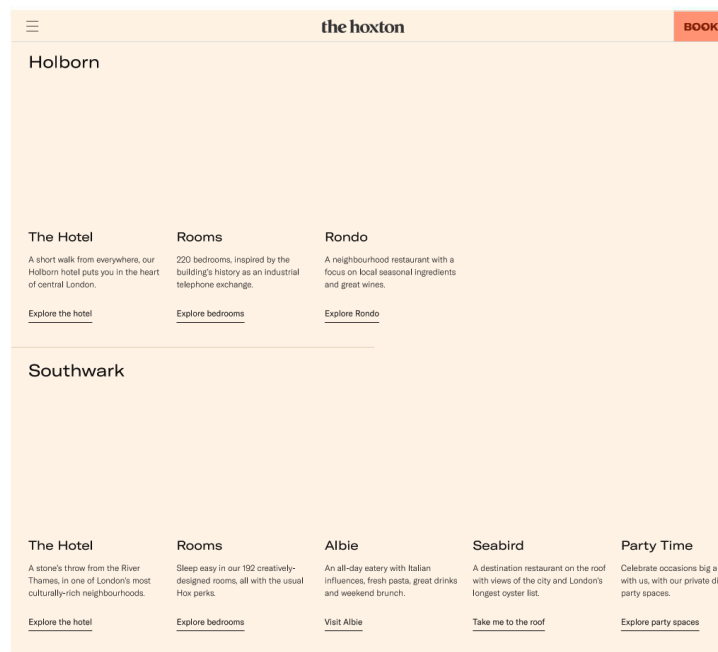
78. In relation to bars and restaurants the applicant raises that “[*The*] Evidence appears to prove that Ennismore uses bespoke brands for their restaurant and

⁷⁶ *Bernhard Rintisch v Klaus Eder* Case C-553/11 at [30]

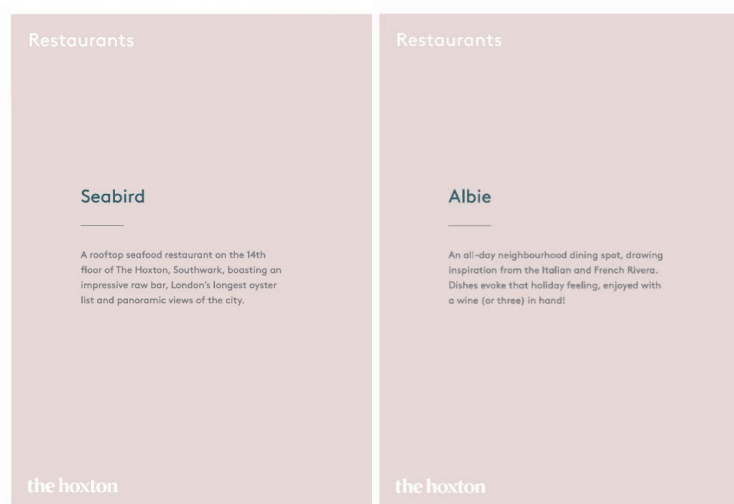
⁷⁷ Case C-12/12

bars, indicating that there is no genuine use of any Hoxton related trade mark for any services associated with restaurants and bars”.⁷⁸

79. Whilst I appreciate that Exhibit KR3 gives that impression, when the evidence is viewed as a whole it is clear that the ‘Seabird’ and ‘Albie’ restaurants referred to are not only located within THE HOXTON hotel but are marketed as being offered under THE HOXTON brand, for example in its website:⁷⁹



And within its brochures:⁸⁰



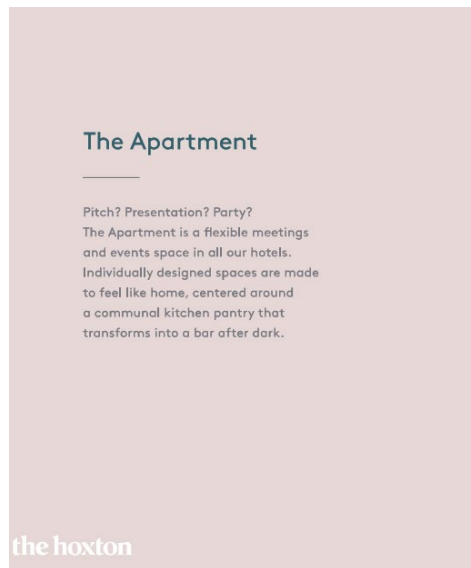
⁷⁸ Applicant's first written submissions, table, row entitled "Exhibit KR3 Restaurants and Bars".

⁷⁹ Exhibit KR10.3, pages 188.

⁸⁰ Ibid, pages 201 and 202.

It is clear to the public that they originate from THE HOXTON brand which is the responsible undertaking for these bar and restaurant services.

80. The same applies to THE HOXTON's function room which is called 'The Apartment', which as can be seen below displays THE HOXTON mark in the bottom left corner:⁸¹

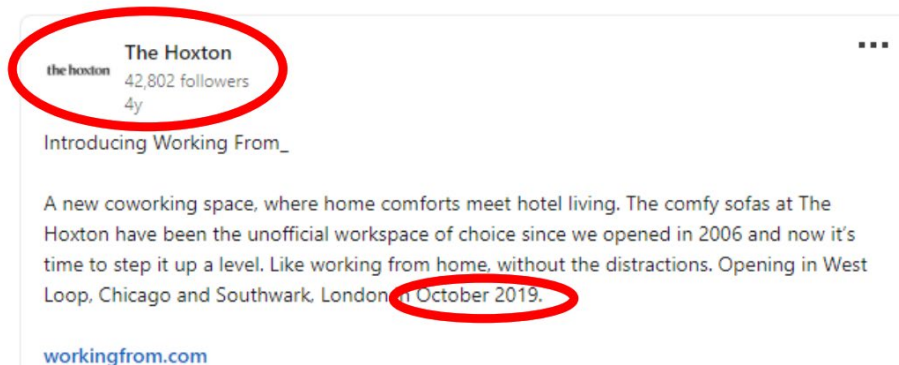


81. As for use of THE HOXTON mark and the mark WORKING FROM_ for its class 36 services, the proprietor argues that this is use of the mark in conjunction with another mark and as such would still constitute use of THE HOXTON. Within the evidence is a screenshot from THE HOXTON's LinkedIn page replicated below:⁸²

⁸¹ Ibid, page 198

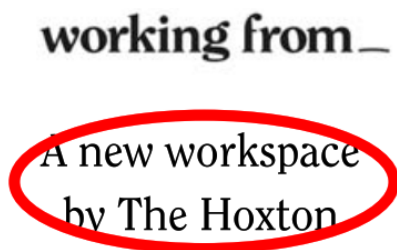
⁸² Exhibit KR10.2, page 143

The Hoxton's Post



It can be seen that under THE HOXTON mark it says introducing Working From_. The post then goes on to discuss a new coworking space again referring to THE HOXTON and with mention of an opening in October 2019 it is clear that this is use within the relevant periods.

82. Further, on the webpage workingfrom.thehoxton.com the marks are used as follows before displaying pictures of the new workspace alongside information and pricing:⁸³



83. Also, within its brochures dated 2021 and 2023 respectively, it states:⁸⁴

⁸³ Exhibit KR10.2, pages 144 - 147

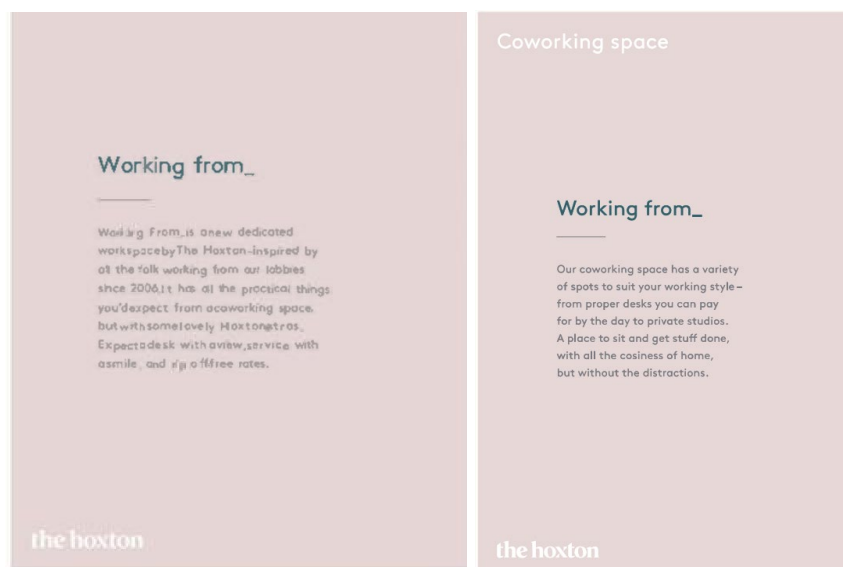
⁸⁴ Ibid, pages 148 and 168

A coworking space by The Hoxton

The Hoxton's comfy lobbies have been the unofficial workspace of-choice for laptop warriors since 2006.

We figured it was time to step it up a level, so we launched Working From_, offering all the practical things you'd expect from a coworking space, but with some lovely Hoxton extras. Expect a desk with a view, service with a smile, and rip-off free rates.

84. Moreover, within THE HOXTON's hotel brochure the Working From_ mark is displayed with THE HOXTON mark appearing in the bottom left corner.⁸⁵



85. As the case law above sets out, it is permissible for a registered mark to be used in conjunction with another mark, and indeed it is relatively common. I consider the use of the proprietor's THE HOXTON marks alongside WORKING FROM_ to be relevant actual use in the present case as consumers have clearly been educated through the website and brochures that THE HOXTON is still the responsible undertaking for these services.

⁸⁵ Exhibit KR10.3, pages 195 and 202

Fair Specification

86. I must now consider whether, or the extent to which, the evidence shows use of the registered marks in relation to the services relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of services for which there has been genuine use, but, rather, the particular categories of services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the services concerned.⁸⁶ In arriving at a fair specification, I must consider how the average consumer would fairly describe the services shown in evidence; the task is not to describe the use made of the registered marks in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular covered by the registrations.⁸⁷

87. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 Kitchin LJ (as he then was) sitting in the Court of Appeal set out the proper approach for considering partial revocation which equally applies to framing a fair specification; he set out the following:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

⁸⁶ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

⁸⁷ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

88. Taking firstly the class 43 services. I have found there to be genuine use for hotel services, bar and restaurant services, services for holding functions and events whether they be in relation to business or leisure. I find that the average consumer for these services would be the general public as well as business users.

89. In relation to the hotel, resort and motel services for which I have found use, I am minded that the average consumer identified above would most likely refer to these services as hotel, resort and motel services and hotel reservation services (temporary accommodation), rather than rental of temporary accommodation services, which covers a far more wide ranging set of services such as short stay holiday apartment rentals. As such, I find that a fair specification is “Hotel, resort

and motel services; Hotel, resort and motel reservation (temporary accommodation) services”.

90. As for “*provision of premises and facilities for holding functions, conferences, conventions, exhibitions, seminars and meetings*”, I observe that the proprietor has shown use for hotel services, including not only the room reservations but room hire for events and functions, such as wedding receptions or business use. I have borne in mind that the proprietor should not be expected to demonstrate use for all possible variations of the services covered by its registration and in my view the registered terms all cover or are covered by the services for which use has been demonstrated.

91. With regards to “[...] *Bar, cafe, restaurant, banqueting and catering services*”, I have found genuine use for bar, café and restaurant services and it would be impossible to fairly describe these terms in any other way. As for banqueting and catering services, I have discussed at paragraph 49 that the evidence shows that THE HOXTON provides dinners and stocked pantries for their event spaces. Therefore, I am satisfied that the average consumer would describe this as banqueting and catering services and to limit these services in any other way would be artificial and contrary to the principles of framing a fair specification.

92. Moving on to the class 36 services, “*Real estate services; real estate affairs; real estate management; provision of housing accommodation*” I note that the proprietor argues, “*Nevertheless, the evidence provided in relation to Class 36 also includes evidence of use in relation to rental of co-working and office space. These services will fall within the broad category of real estate services.*”⁸⁸

93. Typically, real estate services would refer to a wide range of services, including estate agents, letting agents, and other real estate management companies, as such, it would not be fair to allow the proprietor to have a term that provided a broad protection for services that are not covered by the evidence. As discussed above, I must consider how the average consumer would fairly describe the services shown in evidence. In my view, the average consumer of the services

⁸⁸ Proprietor’s second written submissions, paragraph 25

(which includes the public) is unlikely to refer to the services evidenced as real estate services or any such variation. Rather consumers would refer to the services as services for the rental of office space(s) or office space rental. Consequently, I find a fair specification of the class 36 services under the second registered mark to be “rental of office spaces”.

OUTCOME

94. The applications for revocation are partially successful.

95. With effect from 10 July 2023, Class 43 of comparable UKTM No. UK00905480298 (the first registered mark) is as follows:

Class 43: Hotel, resort and motel services; Hotel, resort and motel reservation (temporary accommodation) services; Bar, cafe, restaurant, banqueting and catering services; provision of premises and facilities for holding functions, conferences, conventions, exhibitions, seminars and meetings.

96. With effect from 15 July 2022, Class 16 of comparable UKTM No. UK00916347502 (the second registered mark) is revoked entirely, and class 36 is as follows:

Class 36: Rental of office spaces

CONCLUSION

97. The first registered mark shall be revised to reflect the services outlined above in paragraph 95, whilst the second registered mark shall be revised to reflect the services listed at paragraph 96 above.

98. In line with sections 46(1)(a) and (b) and subject to any appeal against my decision, the changes will operate from, 10 July 2023, for the first registered mark and 15 July 2022 (the earliest date requested) for the second registered mark.

COSTS

99. Both parties have enjoyed a roughly equal measure of success, as the proprietor had more success in relation to the first registered mark and the applicant had more success in relation to the second registered mark. Therefore, I direct that the parties bear their own costs.

Dated this 29th day of September 2025

Sarah Wallace
For the Registrar