

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK No. 908149941 SKYCLUB

IN THE NAME OF ONTRO LIMITED

AND AN APPLICATION FOR CANCELLATION CA503328

BY DELTA AIR LINES, INC.

DECISION

1. This an appeal against a case management decision made during the course of a dispute between Ontro Limited (“Ontro”, the Appellant in this appeal) and Delta Air Lines, Inc. (“Delta”, the Respondent) relating to the registration of marks including the words SKYCLUB.
2. The background to the dispute is not straightforward¹. In essence, both parties are attempting to cancel the marks of the other in parallel cancellation actions. This appeal arises as part of Delta’s application to cancel Ontro’s SKYCLUB mark (“the Delta Cancellation Action”) but as will be explained, it also affects the course of Ontro’s application to cancel Delta’s DELTA SKY CLUB mark (“the Ontro Cancellation Action”, CA505823).
3. This appeal concerns the Hearing Officer’s decision to refuse to suspend the Delta Cancellation Action pending the outcome of the Ontro Cancellation Action.
4. The Delta Cancellation Action was originally filed on 03 September 2020. This sought to invalidate the Ontro’s UK Trade Mark Registration No. 2552169 SKYCLUB on the basis of Delta’s EUTM Registration No. 8149941 DELTA SKY CLUB & Device (the “Delta EUTM”). Ontro resists cancellation of its mark on the grounds that it has earlier rights in the sign “SKYCLUB” (the “Ontro Sign”) dating from around 2004.
5. In retaliation, on 01 December 2020 Ontro filed a cancellation action against the Delta EUTM (the “EU Cancellation Action”), based on its earlier, unregistered rights

¹ I attach a helpful chronology prepared by the Appellant as an Annex to this decision.

in all member states in the EU (including the UK), and bad faith. This resulted in the suspension of the current proceedings on 8 December 2020.

6. On 01 January 2021, following the UK's departure from the EU and the end of the Transition Period, a clone right was created from the Delta EUTM, under UK Registration No. 908149941 (the "Delta UK Registration").
7. The EUIPO reached its decision in the EU Cancellation Action on 09 June 2021. The portion of the EU Cancellation Action relating to Ontro's UK unregistered rights in the UK was held to be inadmissible on the grounds that UK rights had ceased to be earlier rights for the purpose of proceedings before the EUIPO, as of 01 January 2021. The Cancellation Division expressed itself as follows:

A2. Non-registered trade mark 'SKYCLUB' in the UK

On 01/02/2020, the United Kingdom (UK) withdrew from the EU subject to a transition period until 31/12/2020. During this transition period EU law remained applicable in the UK. As from 01/01/2021, UK rights ceased ex-lege to be earlier rights protected 'in a Member State' for the 'in State' purposes of proceedings based on relative grounds. The conditions for applying Article 60(1)(c) EUTMR in conjunction with Article 8(4) EUTMR, worded in the present tense, must also be fulfilled at the time of taking the decision. As the invalidity application no longer has a valid basis, it must be dismissed insofar as based on a non-registered trade mark 'SKYCLUB' claimed to have been used in the course of trade of more than mere local significance in the UK.

8. Whilst Ontro appealed the decision in the EU Cancellation Action, no statement of grounds was filed, and the appeal was subsequently withdrawn on 11 October 2021.
9. The present proceedings were restarted on 16 May 2022 following the conclusion of some related non-use proceedings.
10. On 23 January 2023, Ontro filed evidence in defence of the Delta Cancellation Action. This included evidence of its alleged goodwill attached to the Ontro Sign to substantiate its claim of prior user.
11. On 10 February 2023, Ontro filed the Ontro Cancellation Action against the Delta UK Registration, based on the Ontro Sign. At the same time, it requested that the Registry suspend the Delta Cancellation Action pending the outcome of the Ontro Cancellation Action, in accordance with the practice set out in Tribunal Practice Note TPN 1/2021. In summary, the TPN provides that where a trade mark is subject to invalidation proceedings based on a European Union trade mark, if the proprietor

has lodged proceedings against the comparable mark to that EUTM, the original invalidation proceedings may be suspended and the EUTM subsequently enforced only to the extent that the comparable mark survives.

12. The Examiner refused the Appellant's suspension request on 27 March 2023 on a preliminary basis. Following a CMC, a decision of Hearing Officer Teresa Perks confirming this was issued on 8 June 2023. Ontro was granted permission to appeal the Decision on 4 July 2023.
13. On this appeal I was asked to reverse the decision not to suspend the Delta Cancellation Action, alternatively to consolidate the two actions so that the parties' asserted rights could be assessed together.
14. At the hearing before me on 13 November 2023 Ontro was represented by Becky Knott instructed by Potter Clarkson LLP. Delta was represented by Simon Malynicz KC and Nick Zweck instructed by Kilburn & Strode LLP. I am grateful to all the parties for their able submissions and also for the provision of agreed bundles of documents and authorities in advance of the hearing.

Standard of Appeal

15. There was no dispute before me as to the standard of appeal, and I was referred to the standard and familiar authorities which apply (e.g. *Axogen Corp v. AVIV Scientific Ltd* [2022] EWHC 95 (Ch)). I was also reminded that this was a case management decision which carries with it additional strictures discouraging interference in the absence of clear error (e.g. *Tanfern Ltd v Cameron-MacDonald* [2000] 1 W.L.R. 1311). I bear all those issues in mind.

The Appeal

16. Ontro has two grounds of appeal. Under the first, it is said that the Hearing Officer failed to give sufficient weight to Ontro's inability to rely on its UK rights, erred in law and failed to apply the criteria set out in TPN 1/2021 correctly alternatively attributed insufficient weight to the injustice which would occur. Under the second, it is said that she was wrong to conclude that there was *res judicata* as a result of the EU Cancellation Action.
17. At the outset it is worth commenting on the status of Tribunal Practice Notes. As their title suggests, there are an indicator of good practice in the Registry and are issued in order to assist parties and the Registry in achieving consistency and efficiency in proceedings. However, they are not binding, either as to their specific

application to the facts of any case which might appear to fall within their ambit, nor as to their non-application to cases appearing to fall outside their ambit. In the end TPNs exist to assist with sensible case management and the guidance within them is to be treated as such.

18. TPN 1/2021 came into force on 26 November 2021, i.e. after Ontro had withdrawn its appeal in the EU Cancellation Action.

19. As for the specific content of TPN 1/2021, I observe as follows.

20. First, TPN is intended to provide guidance to users arising out of the transitional arrangements following Brexit. As paragraph 1, What?, explains:

This notice is to explain to users of the IPO's Trade Marks Tribunal Service the impact of some legal changes being made to the end of the Transition Period transitional arrangements. The changes are set out in The Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021 which amend the transitional provisions contained in The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 and The Designs and International Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. We expect the changes to impact only a small number of proceedings. Except for cases which have already been the subject of a decision on their substantive grounds, the changes have the potential to impact only in the following circumstances, and then, only if those proceedings rely (in whole or in part) on an EU trade mark (whether an EUTM or an IR (EU), or an application for such a mark:

UK opposition or invalidation proceedings launched before IP Completion Day (i.e. before 11pm on 31 December 2020), or
UK opposition proceedings filed on, or after, IP Completion Day against trade mark applications filed before IP Completion Day

21. It seems that the prediction was right as neither of the parties appearing before me had been able to identify any other case in which it has been applied.

22. Paragraph 2, Why?, went on to explain the purpose of the TPN:

The changes seek to correct an unfair imbalance which has arisen from the way in which the existing transitional provisions interact with a practice adopted by the European Union Intellectual Property Office (EUIPO) in relation to proceedings before it. In summary, despite EU trade marks still being applicable earlier marks in the types of UK opposition/invalidation proceedings identified above, the practice of the EUIPO has prevented those earlier marks from being challenged by the owners of even earlier UK marks and rights. This leaves UK mark/rights owners without an

effective means of challenging the EU mark relied upon and potentially meaning that an opposition/invalidation in the UK could succeed even though the EU trade mark on which it is based may not be valid.

23. This explanation is correct. As of 1 January 2021 EUIPO will not consider UK rights as part of opposition procedures. This is in spite of the fact that EU rights can be relevant to UK applications (the recognised imbalance). As the TPN notes, this could result in EU rights being relied on in the UK which should not be held valid, but which cannot be challenged in EUIPO.
24. That is the situation in which Ontro submits it finds itself here. It says it has prior unregistered UK rights which could be used to knock out part or all of Delta's registered mark, leaving Ontro's registered mark as the earliest valid registration. If Ontro is unable to rely on its prior UK rights against Delta's registered mark (following EUIPO practice) it says that an injustice will occur.
25. The TPN continues by giving examples of where it applies in paragraph 3, The new law. Ontro says that the second example in the table is the relevant one in the present case, and I quote that below:

The new law provides that if an EU trade mark is relied upon in one of the above sets of UK opposition/invalidation proceedings, its enforceability in those proceedings will, in principle, be tied to the fate of the comparable mark derived from the relevant EU mark, or in the case of a pending EU mark, the fate of any re-filed UK application made during the 9 month window provided by law for doing so. The new law only applies to proceedings which have yet to be determined by the Tribunal by way of final decision. The following table sets out the main effects:

Status (at the end of the transition period) of the EU mark pleaded in the UK opposition or invalidation	Current status of the comparable mark or re-filed UK application	Consequence (but only if an application is made under these new provisions)
...	Invalidation or revocation proceedings have been lodged against the comparable mark, but not yet determined	The Tribunal may decide to only determine the UK opposition/invalidation proceedings after the challenge against the comparable mark has been determined; and may further decide that the EU mark should then only be enforced to the extent to which it survives that challenge
Registered EU mark		

26. Paragraphs 4 and 5 conclude by providing guidance as to the circumstances under which the TPN should apply (emphasis added):

4. The new practice and required behaviour

The Tribunal will not limit the enforceability of a relied upon EU mark of its own motion. A party who wishes the Tribunal to take any of the actions set out below must, therefore, make an application (in writing) to the Tribunal at the earliest opportunity, the actions being:

1. To wait for any challenge against the comparable mark or refiled UK mark to be determined, and/or
2. To wait for any pending re-filed UK application to be determined, and/or
3. To request that the Tribunal does not enforce the EU mark at all, or only in part.

For absolute clarity, if no application is received, the UK opposition/invalidation proceedings will continue without reference to the status of the comparable mark or re-filed UK mark. The party making any application under these new provisions should identify the number of any comparable/re-filed UK mark and, where applicable, the cancellation/revocation number of any proceedings which have been launched against the comparable/re-filed UK mark. The Tribunal will only consider requests to stay proceedings to await the outcome of invalidation or revocation proceedings if those challenges have already been lodged.

Parties should note that the Tribunal will look to consider favourably any requests made under these new provisions. However, there may be circumstances where the Tribunal does not consider it appropriate to grant such requests. For example, if a challenge against a comparable/re-filed UK mark stands no real prospect of success, this will be seen as a delaying tactic and the request will likely be refused.

Where it is determined that the Tribunal should wait until any challenge to the comparable mark/re-filed UK mark has been decided, or until the registrability of a pending re-filed UK application has been determined, this may result in the original UK opposition/invalidation proceedings being stayed or, alternatively, in certain proceedings, being consolidated. **Which course of action to follow will be decided on a case-by-case basis, using the Tribunal's case-management powers. The parties can request a case management conference if they do not agree.**

5. Timing

The new law came into force on 26 November 2021. A party can now avail itself of the new law by making an application in accordance with the above practice. **As stated above, applications should be made as soon as is practical.**

27. In her decision, the Hearing Officer first recorded the submissions of the parties (§5). In particular she noted the submissions of Ontro's representative that Ontro was not aware of the TPN when it withdrew its appeal in the EUIPO, but that it had understood that it could pursue further challenges against the EUTM because the EUIPO decision did not give rise to *res judicata*. Delta's representative argued that there was no unfair imbalance that needed correcting, that the EUIPO had issued a final decision in which it rejected the proprietor's claim based on lack of evidence, and that the purpose of the TPN is to assist those who can no longer apply to invalidate an earlier EUTM.
28. The Hearing Officer then went on to set out the contents of the TPN and summarise the EUIPO decision. She noted that the origins of the EUIPO's refusal to take into account UK unregistered rights was first signalled in Communication 2/2020 of 20 September 2020 from the Executive Director of EUIPO, before Ontro filed its EU Cancellation Action on 1 December 2020.
29. Accordingly, the Hearing Officer held in §12 that Ontro should have known that its earlier UK use of the sign was not capable of forming the basis for an invalidity action in EUIPO. However, she also found that this was not something relied upon by Ontro in its decision to withdraw its appeal in EUIPO, and instead that it withdrew because it recognised that it did not have enough evidence to win.
30. Pausing there, I agree with the Hearing Officer that, with hindsight, it can be said that Ontro or its representatives should have known about the EUIPO Communication in advance of the filing of the EU Cancellation Action, albeit that at the time there was a general degree of uncertainty about how post-Brexit arrangements would work. Given that Ontro did not apparently know, it is perhaps unsurprising that it did not rely on it, although there was a dispute before me as to precisely what was said to the Hearing Officer regarding the reasons for Ontro's withdrawal of the appeal. I do not find it necessary to determine that for reasons which I will come to.
31. In addition, the Hearing Officer explained in §12 that she could not understand why Ontro might think its position could be better in the UK when more evidence became available, as a UK Court could never invalidate the EUTM after Brexit and the

relevant date would be the same in any event, so its position could not be improved. I find this reasoning difficult to follow. Given that Ontro did not file evidence in the EUIPO of its UK use of the sign, and given that there is no doctrine of res judicata as between EUIPO and national proceedings (see further below), Ontro was entitled to think that it may have more success with better evidence asserting its UK unregistered rights in the UK in relation to the UK portion of any later mark.

32. Nevertheless, the Hearing Officer found in §§13-14:

13. It therefore appears to me that the proprietor's decision not to file any evidence in the EUIPO proceedings was not influenced by the EUIPO's position on UK rights. It also appears to me that whatever the reasons behind the proprietor's decision to discontinue the EU invalidity action, it overlooked the implications for its own trade mark application/registration in the UK - implications that the proprietor is now trying to remedy by relying on TPN 1/2021.

14. Lastly, when the proprietor dropped the appeal, it should have known that it would not be able to bring fresh EUIPO proceedings because the EUIPO had already stated their position on UK rights. I therefore struggle to see why the proprietor should now be able to rely on the fact that when it dropped the appeal it did not know that the TPN 1/2021 would be published as a reason for applying the TPN beyond the circumstances for which it was introduced – circumstances which, in my view, do not cover cases where the party concerned has filed an application for invalidity against the relevant EUTM but has subsequently decided to discontinue the action.

33. She concluded in §15 that whilst the EU Cancellation Action was likely to be rejected from the outset insofar as it relied upon a UK unregistered right, this was not the reason why Ontro did not pursue it (as evidenced by the fact that it also did not pursue other arguments, including bad faith). Accordingly, she found that there was no detriment arising from EUIPO's practice which it is right to remedy. As she explained:

In this connection, it must be stressed that the TPN 1/2021 was introduced to "correct an unfair imbalance" resulting from the EUIPO's practice preventing owners of UK rights to challenge EUTMs relied upon in UK opposition/invalidation proceedings; it does not, in my view, entitle parties who have failed to challenge EUTMs based on reasons other than the EUIPO's practice on UK rights to have "a second bite of the cherry". Finally, based on the arguments submitted by the proprietor in this case, the EUIPO invalidity action would have failed regardless of the EUIPO's practice which the TPN 1/2021 was introduced to remedy.

34. In short, she refused to apply TPN 1/2021 because she considered that Ontro had had an opportunity to challenge Delta's mark in EUIPO, and that it would have failed in any event regardless of EUIPO's stance on UK unregistered rights. Accordingly, applying TPN 1/2021 would amount to giving Ontro a second bite at the cherry.
35. In my view this is to ignore the true purpose of TPN 1/2021. It also assumes that there is something wrong with pursuing parallel EUIPO and UK proceedings when there is no *res judicata* or *Henderson v Henderson* principle to be applied.
36. Dealing with the purpose of TPN 1/2021 first, which mirrors Ontro's first ground of appeal, I do not consider that it was intended to be applied only to cases where the party seeking to rely on it had not made an application to the EUIPO or where, if it had, that the TPN required an assessment to be made of the strength of the evidence in the EUIPO. As Ms Knott submitted, there is nothing in the TPN about the timing of any application. The Hearing Officer seems to have read into the TPN an implication that the applicant should not have had an opportunity to apply to EUIPO already, but I do not think this is justified. This is because whether or not an application to EUIPO has been made makes no difference to the potential for injustice. The TPN is based upon the fact that the EUIPO will not consider evidence that would be admissible in the UK.
37. As for the strength of the evidence, it is correct that the practice in the TPN is not intended to be applied to cases which do not have a real prospect of success. This is expressly referred to in §4 quoted above. But this must be a real prospect of success *in the UK proceedings*, not elsewhere, because it is the UK proceedings which the earlier proceedings are to be stayed for, not the EUIPO case. Mr Malynicz conceded on behalf of Delta that it should be assumed for the purposes of this appeal that Ontro did have at least a real prospect of success. He was right to so in my judgment (having had an opportunity to review the evidence filed in both Cancellation Actions, which passes this threshold test). The Hearing Officer does not appear to have taken this into account at all, even though the issue of prospects of success (in the UK) is referred to in the TPN. I consider that she should have done, not least to rule out the possibility that there were no prospects of success in the UK proceedings.
38. Indeed, the Hearing Officer went further in her decision of 4 July 2023 on leave to appeal and explained that she thought that the case did not have a realistic chance of success and that this was a factor which weighed in the exercise of her discretion. Mr Malynicz tried to downplay the importance of this follow up decision, but, just as

the Court of Appeal may take into account explanatory statements made by the lower court on decisions on permission to appeal, I think it is permissible to consider it. It shows that the Hearing Officer fell into error by determining, contrary to Delta's correct concession on this appeal, that there was no real prospect of success.

39. Most importantly, I do not think the intention of the TPN is to require the Registry to try to weigh up the merits of evidence filed in EUIPO proceedings and compare it with the effect of Communication 2/2020, as the Hearing Officer has done. That is to put the cart before the horse, and indeed the wrong cart (as I have explained, it is the merits of the UK application which matter, not those in EUIPO). It is accepted by everyone that there is a potential imbalance now that EUIPO has indicated that it will not take into account UK rights, but where EU rights can be asserted in the UK. The fact that EUIPO will not admit evidence of UK rights, as it made clear in the decision in the EU Cancellation Action, is the starting point (i.e. the horse) and the end point (unless there is no prospect of success in the UK) for seeking to avoid the injustice that might occur.
40. As Ms Knott submitted as her first ground of appeal, the Hearing Officer did not appear to take account of the overriding principle underlying the TPN. Instead, she adopted what Ms Knott described as a circular argument, in pointing out that Ontro were bound to lose anyway on the merits of the case in EUIPO and so the TPN could not apply. I agree that this argument is circular because Ontro was also bound to lose as a result of EUIPO's refusal to consider Ontro's UK rights. Importantly, that is the consideration addressed by the TPN and the one which the Hearing Officer should therefore have had in the forefront of her mind, but she displaced with a (wrong) consideration of the merits in the EUIPO. If she had started instead with the EUIPO practice I consider that she would and should have agreed that the TPN should apply. She was in my judgment also wrong to take into account the relative timings of the EU Cancellation Action and Ontro's attempted reliance on the TPN when this is not something which the TPN suggests is relevant. As I have pointed out above, the potential injustice still exists whether or not Ontro had already attempted to cancel the mark in the EUIPO.
41. Mr Malynicz for Delta had no real answer to this. He suggested that any injustice could be minimised by Ontro relying on its unregistered rights in the Ontro Cancellation Action and filing a new application in lieu of being able to take the point in the Delta Cancellation Action. But as Ms Knott pointed out, there might be very real knock-on effects as a result of Ontro losing the application date for its original registered mark.

42. Mr Malynicz also suggested that Ontro should have sought to appeal EUIPO's practice all the way up to the General Court and possibly beyond, as he explained other parties have. This is in my view unrealistic and also not contemplated by the TPN, which assumes that the EUIPO practice is enforceable.
43. Mr Malynicz sought to emphasise the prejudice to Delta in the delay resulting from the application of the TPN. I agree that these proceedings have taken a long time to get this far, which is regrettable. In particular, it would have been better if Ontro had not waited until after the evidence deadline in the Delta Cancellation Action before launching the Ontro Cancellation Action, and gathered its evidence of UK use much earlier. But the delay due to the EU Cancellation Action (as opposed to various non-use attacks made in parallel) was only 10 months between the suspension of the Delta Cancellation Action in December 2020 and the withdrawal of the appeal in October 2021. I do not think this delay outweighs the considerable possible prejudice to Ontro in not being able to rely on its alleged UK unregistered rights. It is also considerably less than any delay which might have been introduced by Mr Malynicz's suggestion that Ontro should have appealed the EUIPO all the way to the General Court and beyond.
44. For all these reasons I agree with Ms Knott that the Hearing Officer fell into error, even bearing in mind the high hurdle for showing this in case management decisions. Although there are factors which apply to the present case which are not expressly referred to in the TPN, they do not undermine the policy and purpose underlying it. The only way to address the potential imbalance which applies regardless of any case brought in EUIPO is to allow a decision to be made about the alleged earlier UK right before or at the same time as consideration of the later EU mark. In order to do justice the Hearing Officer should therefore have acceded to the application of the TPN.
45. I turn now to Ontro's second ground of appeal, the alleged error made by the Hearing Officer in relation to res judicata. I can deal with this briefly as I have already found for Ontro on the first ground.
46. Delta submitted that this was bound to fail because the Hearing Officer did not make any findings in relation to res judicata at all. I do not accept that given her reference to it in Ontro's submissions in §5 and her use of the phrase "second bite of the cherry" in §15, which is often used to describe a *Henderson v Henderson* situation and which was used by Lloyd LJ in the well-known trade mark authority on the point, *Special Effects v L'Oreal SA* [2007] EWCA Civ 1 at §73.

47. Ms Knott cited Lord Sumption's explanation of the various flavours of UK res judicata in *Virgin Atlantic Airways Ltd v Zodiac Seats UK Ltd (formerly Contour Aerospace Ltd)* [2013] UKSC 46; [2014] A.C. 160 at §§17-26. She also referred to the EU concept as explained in *Apple and Pear Australia Ltd v EUIPO (C-226/15P)* EU-C-2016-582. In the latter case the CJEU held at §§62-64 that there was no res judicata such that EUIPO was bound by a national court. Ms Knott submitted that the same must apply in reverse – a national court is not generally bound by EUIPO – although she accepted that in certain circumstances (which did not apply here) there could be binding effect from a decision of the Cancellation Division of EUIPO, citing *Special Effects* at §61.
48. As there was no decision on the merits in relation to Ontro's unregistered rights in the UK, there can be no estoppel in the present case. Mr Malynicz did not seriously dispute this. The parties instead focussed on *Henderson v Henderson* abuse and the Hearing Officer's reference to a second bite of the cherry. But for the same reason – that there was no finding on the merits – it cannot be said that Ontro were availing themselves of a second bite. The change of practice in EUIPO meant that they were not permitted a first bite there, regardless of how effective that bite might have been. I therefore conclude that the Hearing Officer was wrong to rely on the potential for abuse in her §15. I would therefore also allow Ontro's second ground of appeal.
49. Having found that the Hearing Officer fell into error I also stand back and consider the overall merits of the parties' respective positions. Regardless of TPN 1/2021, these cases – with competing marks owned by different parties and challenged in different proceedings – are crying out for a degree of case management which should aim to minimise the risk of injustice and duplication. That would be achieved by determining the case which relies on the earliest mark first, or at least at the same time as the later cases. When the purpose of TPN 1/2021 is also taken into account, I consider the sensible path is clear – to suspend the Delta Cancellation Action or have it consolidated with the Ontro Cancellation Action.
50. As to which would be better in the circumstances in which the parties find themselves, Mr Malynicz accepted that consolidation would be preferable. I agree. I am going to order that the two actions be consolidated and heard together. The Delta Cancellation Action is apparently ready to be determined, so the Ontro Cancellation Action needs to catch up. I am not going to order that timescales be shortened, because that would affect the winner below, Delta, most as it is presently having to compile evidence in response. However, I would encourage both parties to file

responsive evidence before the deadlines if possible, so as to shorten the overall time to a hearing, and I would not expect any requests for extensions of time to be granted without very good reason. This dispute has been going on long enough, and it is time for it to be determined on the merits.

51. In summary, I allow Ontro's appeal and direct that Cancellation Actions CA503328 and CA505823 be consolidated and heard together.

Costs

52. The Hearing Officer did not make a costs award below. Both parties asked for an award of costs on this appeal, and Ontro asked for costs below in addition. I am not going to impose a costs order in respect of the hearing below, made at a case management conference. But given that both parties have asked for their costs on appeal, I will make an award in Ontro's favour. Given the tasks involved – seeking and getting permission to appeal, dealing with the Respondent's Notice and attending a contested ½ day hearing, I will make an award of £1200 in Ontro's favour, to be paid by Delta by 4pm on 30 November 2023.

Thomas Mitcheson KC
The Appointed Person
15 November 2023

Annex 1 – Chronology¹

Date	Event	
Around 2004	Claimed date of first use by the Appellant for Ontro Sign in the UK.	
05 March 2009	Priority date for the Delta EUTM and the Delta UK Registration.	
06 July 2010	Filing date for the Ontro Registration.	
31 January 2020	UK withdrawal from the EU.	
03 September 2020	Delta Cancellation Action filed (No. 503328), based solely on the Delta EUTM, relying on 5(2)(b) and 5(3) of the Act.	
18 September 2020	Revised form for the Delta Cancellation Action filed (No. 503328).	
18 November 2020	Defence and Counterstatement filed by the Appellant in the Delta Cancellation Action.	
01 December 2020	EU Cancellation Action filed (No. C 47 826).	
08 December 2020	Suspension of the Delta Cancellation Action, pending the outcome of the EU Cancellation Action and an additional non-use action.	
31 December 2020	End of the transitional period.	
01 January 2021	UK rights cease to be earlier rights for the purpose of EUIPO proceedings.	
01 January 2021	The Delta UK Registration is formed from the Delta EUTM, creating its own, separate property right.	
09 June 2021	Decision in the EU Cancellation Action.	
09 August 2021	Appeal filed by the Appellant against the decision in the EU Cancellation Action.	
11 October 2021	Withdrawal of the appeal by the Appellant in the EU Cancellation Action.	
26 November 2021	Entry into force of TPN 1/2021.	
04 May 2022	Opposition No. 433277 filed by the Appellant against the Respondent's UK application No. 3700725 DELTA SKY CLUB.	
16 May 2022	Resumption of the Delta Cancellation Action following the conclusion of the EU Cancellation Action and the non-use action.	
25 May 2022	Opposition No. 433783 filed by the Appellant against the Respondent's UK application No. 3700711 SKY CLUB.	
18 August 2022	Evidence filed by the Respondent in support of the Delta Cancellation Action.	
20 September 2022	Evidence filed by the Respondent in support of the Delta Cancellation Action (following an extension of time request).	

¹ This Chronology adopts the definitions and terminology used in the Appellant's Skeleton Argument.

12 December 2022	The Appellant's Opposition Nos. 433277 and 433783 are consolidated.	
23 January 2023	Evidence filed by the Appellant in defence of the Delta Cancellation Action.	
10 February 2023	Ontro Cancellation Action filed (No. 505823), based on the Ontro Sign, relying on 5(4)(a) / 47(2)(b) of the Act.	
10 February 2023	Making of the Appellant's Suspension Request.	
27 March 2023	Preliminary decision in the Delta Cancellation Action, refusing the Appellant's Suspension Request.	
25 April 2023	Evidence in reply filed by the Respondent in support of the Delta Cancellation Action.	
26 April 2023	Defence and Counterstatement filed by the Respondent in the Ontro Cancellation Action.	
05 May 2023	CMC for the Delta Cancellation Action, at which the Appellant was heard in respect the Appellant's Suspension Request.	
08 June 2023	The Decision.	
15 June 2023	Request for leave to appeal the Decision made by the Appellant.	
28 June 2023	Comments on the Decision filed by the Respondent.	
30 June 2023	Comments on the Decision filed by the Appellant.	
04 July 2023	Leave to appeal the Decision granted to the Appellant.	
14 July 2023	The Appellant's Consolidated Opposition Nos. 433277 and 433783 are suspended pending the appeal decision in the Delta Cancellation Action.	
31 July 2023	Form TM55 P and Grounds of Appeal filed.	
25 August 2023	Respondent's Notice filed.	
16 October 2023	Evidence filed by the Appellant in support of the Ontro Cancellation Action.	