**O/0908/25**

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION NOS. 910767093, 915524069, 916347502 & 905480298**

**IN THE NAME OF**

**ENNISMORE INTERNATIONAL MANAGEMENT LIMITED**

**AND**

**THE APPLICATIONS FOR DECLARATIONS OF THE INVALIDITY THEREOF UNDER NOS 506280, 506326, 506328 & 506865**

**BY**

**SION O'CONNOR**

## BACKGROUND AND PLEADINGS

1. These invalidation proceedings are among a fairly large number of actions between Mr Sion O'Connor ("the applicant") and Ennismore International Management Limited ("Ennismore") ("the registered proprietor") or another company within the same group. The earliest are oppositions by Ennismore to applications by Mr O'Connor to register trade marks containing the word "HOXTON". Hoxton forms part of the London Borough of Hackney and is the location of a planned property development by Mr O'Connor. He then applied to invalidate the earlier marks relied upon in those oppositions, and those invalidations are the subject of this decision. At its heart is the question of whether – or under what circumstances – a geographical place name may be registered as a trade mark.

2. The marks in dispute are shown below:

| |
|---|
| UKTM No. 910767093 ("the 093 mark")<br><br>**THE HOXTON**<br><br>Filing date: 28 March 2012<br>Registration date: 10 August 2012<br><br><u>*Class 43*</u><br>*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.* |
| UKTM No. 915524069 ("the 069 mark")<br><br>the hoxton<br><br>Filing date: 8 June 2016 |

| |
|---|
| Registration date: 20 April 2017<br><br>Goods and services in Classes 3, 4, 21, 35, 41, 43 and 44 (listed in Annex A). |
| UKTM No. 916347502 (“the 502 mark”)<br><br>the hoxton<br><br>Filing date: 10 February 2017<br>Registration date: 14 July 2017<br><br>Goods and services in Classes 16, 20, 25, 35 and 36 (listed in Annex A). |
| UKTM No. 905480298 (“the 298 mark”)<br><br>THE HOXTON<br><br>Filing date: 9 November 2006<br>Seniority date: 22 June 2006[1]<br>Registration date: 15 November 2007<br><br><u>*Class 43*</u><br>*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.* |

3. Because it owned EU Trade Mark (“EUTM”) Nos. 10767093, 15524069, 16347502 and 5480298 which were valid at the end of the Brexit Transition Period, the Intellectual Property Office created comparable UK trade marks under Section 7A of the European Union (Withdrawal) Act 2018, which gave effect to Article 54 of the Withdrawal

[1] Seniority is claimed from UKTM No. 2425154, now expired.

Agreement. The marks have the same legal status as if they had been applied for and registered under UK law and retain the original filing dates of the EUTMs (and any priority or seniority dates, where relevant).

4. The applications for invalidation were made by Mr O'Connor on 10 July 2023 (the 093 mark), 18 July 2023 (the 069 and 502 marks) and 27 December 2023 (the 298 mark). All four applications are brought under sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(3)(b), which are relevant in invalidation proceedings under section 47 of the Trade Marks Act 1994 ("the Act"). In addition, the applications for declarations of invalidity against the 069 and 502 marks are brought under section 3(6). They concern all the goods and services for which the marks are registered.

*The claims against the 093 mark*

5. Under section 3(1)(b), the applicant claims that the 093 mark consists of the definite article ("the") and the word "Hoxton" which denotes a geographical area and so is devoid of distinctive character. He also claims that it consists exclusively of signs or indications which may serve in trade to designate the geographical origin of the services, and so falls foul of section 3(1)(c). Under section 3(1)(d), he asserts that the trade mark consists of an indication customary in the current language for describing goods and services provided in the geographical area of Hoxton.

6. Under section 3(3)(b), the applicant claims that the registered proprietor does not trade within the geographical area of Hoxton. Consequently, the mark is deceptive to the public.

*The claims against the 069 and 502 marks*

7. Under sections 3(1)(b), 3(1)(c) and 3(1)(d), the applicant makes the same claims with respect to the words as he did in the application to cancel the 093 mark. In addition, he claims that the typeface used in these marks has no distinctive character and that the marks as wholes have not acquired distinctive character in relation to the services for which they are registered. He does not mention the goods.

8. The claims made under sections 3(3)(b) are the same as those made against the 093 mark.

9. Under section 3(6), the applicant claims that:

> "The trademark owner is misusing the trademark to oppose genuine trademark applications submitted in line with honest business practices by genuine members of the Hoxton community.
>
> Hence the 3 conditions of bad faith have been met (C-529/07 Chocoladenfabriken Lindt & Sprungli AG v Franz Hauswirth GmbH (2009) ETMR 56) and it can be concluded that the application was made in bad faith:
>
> - The fact that the trademark owner knows or must know that a third party is using … an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration was sought;
>
> - The trademark owner is preventing third parties from continuing to use such a sign;
>
> - The degree of legal protection enjoyed by the third party's sign and by the registered sign."

*The claims against the 298 mark*

10. The claims made under sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(3)(b) are the same as those made against the 069 and 502 marks.

*The registered proprietor's defences*

11. The registered proprietor is defending all four applications and denies the claims in their entirety. In particular, it argued that the section 3(1)(d) claim made no sense, and should be struck out, as the word "Hoxton" has no meaning in the dictionary and is not used in everyday language in connection with the goods and services for which the marks are registered. The registered proprietor also claimed that the earlier marks had acquired distinctive character through the use that had been made of them.

12. In respect of the claims under section 3(3)(b), the registered proprietor argued that the applicant would need to show evidence of actual deception or that there is a

sufficiently serious risk that consumers would be deceived. It put the applicant to proof on this point.

13. Finally, it claimed that the section 3(6) claim was without any basis. It further said that it would show that the applicant was acting in bad faith and abusing the trade mark process. The applicant had made "*numerous"* applications to invalidate THE HOXTON marks, and attacked other marks owned, or applied for, by the registered proprietor, in retaliation against the registered proprietor's oppositions to applications made by the applicant for trade marks including the word "Hoxton".

**THE HEARING**

14. The matter came to be heard by me via videolink on 13 May 2025. The applicant represented himself, as he has done throughout these proceedings. The registered proprietor was represented by Michael Hicks of Counsel, instructed by Wedlake Bell LLP.

**EVIDENCE**

15. The applicant's evidence in chief consists of a witness statement from Mr O'Connor dated 24 June 2024. It is accompanied by a large number of exhibits. They are not numbered sequentially. This is because Mr O'Connor appears to have a "master set" from which he selects individual exhibits to be used in each of the sets of proceedings in which he is engaged against the registered proprietor. His evidence goes to the history of the Hoxton area of London and the interactions between the parties. He also provides evidence on brand ratings for UK brands in general and hotel brands in particular. Alongside the evidence in chief, the applicant filed written submissions.

16. The registered proprietor filed its evidence in the form of a witness statement from Kevin Rockey, Deputy Brand Chief Operating Officer of Northern & Eastern Europe at Ennismore International Management Limited, dated 4 October 2024. He has held this position since 2021 and had been with the registered proprietor for six years at the date of the witness statement. It is accompanied by 8 exhibits and goes to use of the mark for goods and services in Classes 3, 4, 21, 25, 35 and 41. He also provides evidence of other hotels with names containing words that denote geographical

locations and a list of trade marks on the UK register that contain the word “HOXTON”. The registered proprietor also filed written submissions.

17. The registered proprietor had requested on 13 September 2024 that, in the interests of efficiency and management of costs, it be allowed to rely on evidence already filed in relation to revocation proceedings (lead case CA 506372). Permission was granted on 27 September 2024. This evidence consists of a witness statement from Mr Rockey dated 9 May 2024. The witness statement is accompanied by 22 exhibits. His evidence goes to the use made of the contested marks. Alongside this evidence, the registered proprietor filed written submissions.

18. The applicant filed evidence in reply in the form of a second witness statement from Mr O’Connor dated 4 December 2024. It is accompanied by 10 exhibits, and, again, these are not sequentially numbered. These exhibits include documents filed in other proceedings between the parties, extracts from the Common Practice on Distinctiveness of the European Union Intellectual Property Office (“EUIPO”) and some examples of figurative logos that have been produced by ChatGPT in response to a request to design logos for the Hoxton Hotel with a similar level of distinctiveness to the Windsurfing Chiemsee marks and compliant with EUIPO Common Practice on Distinctiveness.

19. I have read and considered all the evidence, submissions and authorities filed by both parties and taken them into account, along with the oral submissions made at the hearing, in coming to this decision. While I have not summarised these documents, I shall refer to them below to the extent I consider necessary.

**RELEVANCE OF EU LAW**

20. 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.

## PRELIMINARY ISSUES

*The enclosure argument*

21. At several points in the hearing and in his final written submissions, the applicant referred me to what he described as a warning given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. I think it is worth quoting this passage in full. It appears right at the start of the judgment (footnotes are omitted) at [284]-[285]:

> "In 1909 Sir Herbert Cozens-Hardy MR said:
>
> > 'Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure'
>
> The trade mark registration Acts up until 1994 stood firmly in the way of wealthy traders. Where they adopted marks which other traders were likely to want to use descriptively they found it either difficult or impossible to register their marks. The same applied to laudatory words and to important geographical marks, such as York. In some cases this policy may have gone too far: registration was denied even to marks which were '100% distinctive', *i.e.* those which had, through both use and recognition as trademarks, come to be taken by all concerned as denoting the proprietor's goods. The Trade Marks Act 1994, implementing an EC Directive, has swept away the old law. A mark which is 100% distinctive will almost certainly be registered now. I am not concerned with such a case. I am concerned with a much commoner sort of case: where a trader has made some use of a common laudatory word along with a distinctive mark. He can show that the word has achieved some recognition (*quaere* as really denoting trade origin on its own) but no more. Can he then avail himself of the Act to get a monopoly in the common word? If he can, then the 1994 Act enables big business to buy ordinary words of the English language as trade marks at comparatively little cost."

22. The quotation from Sir Herbert Cozens-Hardy MR, and indeed the subsequent commentary by Jacob J, are trenchant, and I can understand their attraction for a litigant in person. It is not the first time that this passage has been cited to me. However, given the number of times that the applicant has referred to it, it is important to bear in mind that the excerpt is an introduction to the judge's consideration of the facts and the law. As such, it has no precedential value. My task in this decision is to determine the facts of the matter and apply the law to them. I shall say no more about this quotation.

*The registration process undergone by the contested marks*

23. The applicant submitted on page 1 of his submissions filed on 24 June 2024 that *"None of the 4 trademarks followed the standard UK IPO registration process. There was no opportunity for the community of Hoxton, or anyone else, to oppose the registration of these 4 trade marks."* I have already noted in [paragraph 3] of this decision that the four contested trade marks are comparable marks that were created because the registered proprietor owned four EUTMs at the time the UK left the EU. As part of the EU registration process, the applications had been published for opposition purposes and it would have been possible to oppose their registration at the EUIPO. Nevertheless, the applicant is entitled to make an application to invalidate the marks, as he has done here, and present evidence that was not available to the EUIPO during the examination process. Consequently, I dismiss this argument.

**DECISION**

**Legislation**

24. The relevant parts of section 47 of the Act are as follows:

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

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

…

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

…

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

25. The relevant parts of section 3 of the Act are as follows:

"(1) The following shall not be registered-

…

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

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

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

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

…

(3) A trade mark shall not be registered if it is-

…

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

…

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

**Section 3(1)(c)**

26. I shall deal with this ground first, given its centrality to the case of the applicant. The case law relating to this section (which corresponds with Article 7(1)(c) of the EU Trade Mark Regulation, formerly the Community Trade Mark ("CTM") Regulation) was set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

"91. The principles to be applied under art. 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

'33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L40, p. 1), see, by analogy, [2004] ECR 1-1669, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr & Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. 1-12447; [2004] E.T.M.R. 9'

[2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

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

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

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/89 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97

*Windsurfing Chiemsee* [1999] E.C.R. I-2779, paragraph 35; and Case C-363/99 *Koninklijke KPN Nederland* [2004] E.C.R. I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

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

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of

which registration as a mark is sought is capable of designating a 'characteristic' of the goods of services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time or production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that this list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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

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

27. Whether the contested marks are descriptive must be assessed through the eyes of the relevant parties, as the Court of Justice of the European Union ("CJEU") held in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. In paragraph 24 of that decision, it described the relevant parties as in trade or the average consumers of the goods and services in question, *"reasonably well-informed and reasonably observant and circumspect"*. The case law quoted above in *Starbucks* makes it clear that a mark will be caught by this section if the relevant parties can easily recognise that it designates a characteristic of the goods and services, such as their geographical origin. The assessment must also be made as of the relevant date, which is the date of application of the mark, as set out below:

| | |
|---|---|
| 093 mark: | 28 March 2012 |
| 069 mark: | 8 June 2016 |
| 502 mark: | 10 February 2017 |
| 298 mark: | 9 November 2006 (seniority date: 22 June 2006) |

28. The 093 mark is a word mark, while the 069 and 502 marks are lightly stylised in a lower-case typeface. The 298 mark (shown below for convenience) has a reversed upper-case N at the end of the mark. In my view, the average consumer would still identify this mark as a stylised form of the phrase "The Hoxton".


*The case law on the registration of geographical names*

29. As there was some disagreement between the parties on the interpretation of the case law on this section, I shall go through the key cases in some detail. The first is *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber & Anor*, Joined Cases C-108/97 and C-109/97. Mr O'Connor submitted that, in paragraphs 25 to 26 of its judgment, the CJEU held that there is a public interest in keeping geographical names free for general use and that geographical names are not registrable unless acquired distinctiveness is shown.[2] This is what it said:

[2] Final written submissions, pages 5 and 7.

> “25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.
>
> 26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.”

30. However, the CJEU went on to say:

> “31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of person with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.
>
> 32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the same, and with the category of goods concerned.”

31. There is, therefore, no blanket ban on the registration of trade marks consisting of, or containing, geographical names, even where there is no evidence to show that such marks have acquired distinctiveness. Whether such a sign may perform the function

of a trade mark must be the subject of a fact-based assessment. I note here that in his written submissions dated 4 December 2024, the applicant quotes the operative part of this judgment, which can be found in paragraph 37. He argues that the German version of the judgment *"better captures the intention"* of the CJEU and provides a translation, the provenance of which is unknown. In considering and writing this decision, I have used the English language version published by the CJEU. I shall return to what this case has to say about acquired distinctiveness later in my decision, should that be necessary.

32. The second case, which the applicant submits is the most relevant case for the purposes of this ground, is *Canary Wharf Group Ltd v Comptroller-General of Patents, Designs and Trade Marks* [2015] EWHC 1588, in which Mr Iain Purvis QC sat as a Deputy Judge of the High Court. The applicant says that Mr Purvis took the view that the names of most UK towns and cities were capable, when used in the UK, of designating the geographical origin of services and would be excluded from registration in the absence of acquired distinctiveness. He refers in particular to paragraphs 22 and 23 of this decision. However, these need to be read in context:

> "20. Before me, Mr Malynicz (who did not appear below) accepted that the Hearing Officer was correct to find that Canary Wharf was, in the perception of the public, a geographical area. However, he contended that the Hearing Officer had made a number of other errors in carrying out the assessment required by *Windsurfing Chiemsee*. These errors, he said, undermined the decision to refuse registration.
>
> 21. His first objection was to a passage in paragraph 50 of the Hearing Officer's decision which states as follows:
>
> > 'The case [*Windsurfing Chiemsee*] was, and is, important because it plainly identified the "need to keep free" principle to be applied in the specific instance of geographical names or locations. But such a principle can apply, notwithstanding that a particular location may not have a current or likely UK-wide "association" with particular goods or services. Thus, if those goods or services may be considered to be ones which could be

> considered “local” in nature, such as, say, hairdressing, the provision of meeting places for worship or other activities, garage services and so forth, then the name of any small town or even village may need to be “kept free”.’

Mr Malynicz attacked this on the basis that the Hearing Officer was effectively identifying a ‘blacklist’ of goods or services (ones which could be considered ‘local’ in nature) for which any place name would always be refused registration.

22. It seems to me that the basic point being made in this passage is a perfectly valid one. A large number of services falling with the Nice Classification (possibly most services), including those listed by the Hearing Officer, are of a kind that one would expect to be available locally in any major centre of population in the UK. The names of most cities and towns would therefore be capable, when used in the UK, of designating the geographical origin of those services and therefore would be excluded from registration under s3(1)(c) in the absence of acquired distinctiveness.

23. However, the Hearing Officer may have been guilty of over-generalisation. First of all, the mere fact that services are of a kind which one would expect to be provided ‘locally’ does not mean that there is a blanket ban on the registration of all place names in respect of such services. Locally-provided services may be of a kind which one simply would not expect to be provided in all parts of the country. For example, an application for the name of a city far inland such as ‘Coventry’ might be allowed for ‘lobster pot repair services’ (unless of course the evidence was that the public would expect lobster pots to be sent away to inland industrial areas to be repaired).

24. Secondly, there may be issues connected with the obscurity of the place-name in question. The Hearing Officer’s reference to *‘the name of any small town or village*’ would cover many place names which are unknown to the majority of potential consumers of the services in question in the UK. Such names are capable of designating geographic origin to people living

in or near the town or village in question, but perhaps not to the 'average consumer'. The CJEU in *Windsurfing Chiemsee* noted in paragraph 33 that names which were *'unknown to the relevant class of persons'* were not *'in principle'* prohibited from registration. On the other hand, it could be said in the Hearing Officer's favour that the public policy underlying the restriction on registration of geographical terms is not served by allowing monopolies to be obtained over the names of small towns for the kind of services already being provided by numerous traders in those towns. This seems to me to raise a difficult question of policy.

25. In my view, however, neither of the potential difficulties I have identified with the Hearing Officer's general statement in paragraph 50 is capable of affecting the outcome of this case. So far as the first point is concerned, the services for which CANARY WHARF is sought to be registered are precisely the kind of services one would expect to be provided in, from or to the geographical area of Canary Wharf. So far as the second is concerned, it is accepted by the Applicant that Canary Wharf is famous throughout the UK."

33. In my view, the comments made in paragraphs 22 to 23 when read in context do not support the applicant's submission that *"These findings confirm that 'Hoxton', like 'Canary Wharf', is incapable of functioning as a distinctive trade mark and that its registration grants an unfair monopoly over descriptive language."*[3] Given the admission by the applicant in that case, Mr Purvis could proceed on the basis that Canary Wharf was famous throughout the United Kingdom. He did not have to consider whether, or where, to draw a line between the geographical terms that would be prohibited and those that might not.

34. I note here that the applicant also submitted that aspects of the *Cardiff Airport* and *Belfast International Airport* cases (BL O/386/13) are also relevant. He did not specify which particular aspects he meant, but I have read the decision and consider that it does not add anything to what was said in *Canary Wharf*, which is, of course, a higher authority.

[3] Final written submissions, page 6.

35. I will make some brief remarks on two other sets of proceedings referred to by the applicant. The first of these are the appeals brought before the General Court ("GC") in the dispute between Iceland Foods Ltd and the business and trade promotion bodies of the country of Iceland (Cases T-105/23 and T-106/23). Since the hearing in the present proceedings took place, the judgments in these two cases have been issued, upholding the decisions of the Grand Board of Appeal of the EUIPO invalidating Iceland Foods' EUTMs. It is important to state that these judgments do not form part of assimilated EU case law and so are not binding on me, although they may be persuasive.

36. The applicant submits that the decisions of the Grand Board of Appeal show that geographic terms *"cannot be monopolised, even after decades of use, unless robust and specific evidence of acquired distinctiveness is provided".*[4] With respect, this is not what was said by the Grand Board of Appeal or by the GC. Instead, both appellate bodies stress that the registration of geographical names as trade marks is not possible where that name is associated with the applied-for goods and/or services in the mind of the relevant class of consumers, or where it is reasonable to find that it could designate the geographical origin of the goods and/or services. This follows the judgment of the CJEU in *Windsurfing Chiemsee*. What this means is that I must make a finding on the understanding of the relevant class of consumers of the contested mark, by reference to the goods and services in the specification. As the GC said in *Peek & Cloppenburg KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-379/03,

> "37. … a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (Case T-295/01 *Nordmilch v OHIM (OLDENBURGER)* [2003] ECR II-4365, paragraphs 27 to 34).
>
> 38. In making that assessment the Office is bound to establish that the geographical name is known to the relevant class of persons as the designation of a place. What is more, the name in question must suggest a

[4] Final written submissions, page 7.

current association, in the mind of the relevant class of persons, with the category of goods or services in question, or else it must be reasonable to assume that such a name may, in the view of those persons, designate the geographical origin of that category of goods or services. In making that assessment, particular consideration should be given to the relevant class of persons' degree of familiarity with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods or services concerned (see, by analogy, *Windsurfing Chiemsee*, paragraph 37 and paragraph 1 of the operative part)."

37. Finally, I note that in his submissions of 4 December 2024, the applicant says that *"The case that is most relevant to this application is that of 'Supreme'."*[5] He does not give me any citation for this case, beyond the fact that it is a case involving EUIPO refusal to register a mark consisting of the word "supreme", applied for by an unnamed clothing company. A search on the Darts IP database produces 19 EUIPO Administrative Hearings concerning trade marks containing the word "supreme". If parties wish a Hearing Officer to consider any case law, it is important that full references are given, so that the correct case can be looked at. That said, "Supreme" is clearly a laudatory expression and so this case is not entirely on all fours with the present matter.

*The cancellation applicant's evidence concerning Hoxton*

38. The cancellation applicant has filed a large volume of evidence to support his argument that Hoxton *"is a historically rich, culturally significant and widely recognised London district."*[6] These include extracts from historical records.

39. The applicant argues that Hoxton's independent geographic identity is confirmed by *The Place Names of Middlesex*,[7] its inclusion on maps,[8] its use in transport infrastructure (such as a railway station),[9] its status as one of the wards of the London

[5] Page 5 of the submissions.
[6] Transcript, page 4.
[7] Exhibit SO-05.
[8] Exhibits SO-07 and SO-08.
[9] Exhibit SO-13.

Borough of Hackney[10] and its use as an area by the Office for National Statistics.[11] The location also appears in the names of schools, medical facilities, places of worship, other community organisations and businesses.

40. The claims to a high degree of renown among the public centre on the creative activity that took place in Hoxton in the 1990s. At the hearing, Mr O'Connor argued that *"From the 1990s onwards, Hoxton became synonymous with the rebirth of British contemporary art, style and nightlife."*[12] This is the subject of a number of articles and extracts filed as exhibits and listed below:

a) "London swings again"*, Vanity Fair*, March 1997;[13]

b) "Brit art's square dealer moves on", *The Observer*, 22 September 2002;[14]

c) "Where have all the cool people gone?", *The Guardian*, 21 November 2003;[15]

d) "Hoxton hip in satirist's sight", *The Guardian*, 9 December 2004;[16]

e) "The Mohawk becomes, well, cute", *New York Times*, 1 September 2005;[17]

f) "Hoxton Story" (Theatre review), *The Guardian*, 16 September 2005;[18]

g) "Hoxton Rocks", *New York Times*, 19 November 2006;[19]

h) "36 hours in East London", *New York Times*, 26 April 2012;[20]

i) "Acid Jazz at 25: 'Everyone said we were made to set up in Hoxton'", *The Guardian*, 1 November 2012;[21]

j) "Joshua Compston was once the wunderkind of the British Art World … and now he's been practically forgotten", *Daily Beast*, 17 January 2014;[22]

k) "High-profile Hoxton rebels given mean-tested rents", *Financial Times*, 17 August 2015;[23]

[10] Exhibit SO-12.02, SO-12.05, SO-12.06.
[11] Exhibit SO-11.02.
[12] Transcript, page 5.
[13] Exhibit SO-18.01.
[14] Exhibit SO-20.01.
[15] Exhibit SO-18.03.
[16] Exhibit SO-18.04.
[17] Exhibit SO-18.06.
[18] Exhibit SO-18.05.
[19] Exhibit SO-18.07
[20] Exhibit SO-18.08
[21] Exhibit SO-18.09.
[22] Exhibit SO-20.05.
[23] Exhibit SO-36.01.

l) “Aviva opens ‘digital garage’ in technology push”, *Financial Times*, 18 January 2016;[24]

m) “Gentrification ground zero: the rise and fall of Hoxton Square” (includes discussion of the photograph “A great day in Hoxton”), *The Guardian*, 14 March 2018;[25]

n) “Hoxton and De Beauvoir area guide”, *Time Out*, 16 March 2018;[26]

o) “Hoxton property prices at five-year low”, *Financial Times*, 4 July 2019;[27]

p) “The best restaurants in Hoxton”, *Time Out*, 15 January 2020;[28]

q) “Hoxton Press: Hackney’s exemplary housing development”, *Financial Times*, “4 years ago”;[29]

r) “Travis’ Fran Healy on inspiring David Beckham’s ‘Hoxton fin’ mohawk”, *New Musical Express*, 27 March 2024;[30]

s) “Bridgerton star Victor Alli takes us to his Hackney manor”, *Financial Times*, 4 June 2024.[31]

41. There is also an undated extract from the 21st edition of *Time Out London*, entitled “Shoreditch & Hoxton”. It refers to David Cameron as Prime Minister and to a future event happening at the start of 2013. I therefore find that this would have been published some time in 2010-2012.

42. The applicant has also exhibited an article entitled “London Reigns”, published by the magazine *Newsweek* on 3 November 1996.[32] This appears to be about London in general and I cannot find a reference to Hoxton.

43. Exhibit SO-19 contains extracts from academic papers. Meanwhile, Exhibit SO-22 contains extracts from a book entitled *The First to Know: How hipsters and mavericks shape the zeitgeist* by Lida Hujić, published in 2010.

[24] Exhibit SO-36.02.
[25] Exhibits SO-18.02 and SO-18.10.
[26] Exhibit SO-18.11
[27] Exhibit SO-36.04.
[28] Exhibit SO-18.12.
[29] Exhibit SO-36.03.
[30] Exhibit SO-196.01.
[31] Exhibit SO-36.05.
[32] Exhibit SO-18.14.

44. Exhibit SO-196 contains further undated articles referring to the Hoxton Fin hairstyle, including Wikipedia entries and extracts from the Popsugar website and two other websites (slashseconds.org and frozentears.co.uk).

45. These exhibits show that during the 1990s, artists, fashion designers and other creative people moved into the area surrounding Hoxton Square. Alexander McQueen, the fashion designer, had a studio there and Young British Artists Damien Hirst, Tracey Emin and Gary Hume were all associated with the area. In 2000, Jay Jopling opened a gallery, White Cube 2, on Hoxton Square. The gallery's website states that at this time Hoxton Square was *"the epicentre of London's artistic resurgence"*.[33] According to *The Guardian* article "Where have all the cool people gone?",

> "By the end of the 90s, Hoxton had spawned an entire lifestyle: the skinhead had been replaced by the fashionable Hoxton fin as the area's signature haircut, the derelict warehouses turned into million-pound lofts. As the groovy district du jour, Hoxton had come to represent the cliff face of the cutting edge, and everyone wanted a piece. At Tracey Emin's opening at the White Cube 2 gallery in Hoxton Square in 2001, Guardian art critic Adrian Searle recalls, 'You literally couldn't get into the square.'"[34]

46. Yet the story told by the exhibits is that the coolness of the area began to decline shortly after this point. *The Guardian* continues:

> "But now, only two years later, there are whispers that Hoxton is on the way down. Popularity, they say, has killed personality. Overexposure has destroyed the sense of Hoxton as an exclusive club for the ultra-fashionable: on a Saturday night, the Hoxton-Shoreditch thoroughfare of Curtain Road has lost any sense of an alternative identity, and the Bacardi Breezer-drinking hordes are indistinguishable from those in the West End."

47. Later articles reinforce this message. By 2018, *The Guardian* was saying in "Gentrification's ground zero: the rise and fall of Hoxton Square":

[33] Exhibit SO-20.02.
[34] Exhibit SO-18.03.

"… visit Hoxton Square today and you'll see almost no resemblance to the one in the photo ['A Great Day in Hoxton, 1998']. Instead of scruffy musicians and artists, it's full of young professionals wearing office-ID lanyards around their necks."

And

"By the time the 2012 Olympic Games began in London, Hoxton no longer seemed like an artsy, low-rent neighbourhood, but a startup technology community."[35]

*Assessment of the applicant's claim*

48. I accept that Hoxton is a real place, demonstrated by the maps, the information on the wards that make up the London Borough of Hackney, transport infrastructure and public and community organisations. However, I do not see how these exhibits assist the applicant in attempting to show that average consumers, who may live anywhere in the UK, would understand the contested marks to be descriptive of the geographical origin of the goods and services. Many places have these amenities and appear on maps, without being known beyond the local area.

49. I am also unconvinced by the early exhibits. The applicant points to the inclusion of Hoxton in Domesday Book, a record of land ownership in England commissioned by William I in 1085. The National Archives describes this document as *"the most complete record of pre-industrial society to survive anywhere in the world"*.[36] Consequently, inclusion in the record does not, in itself, mean that a place is historically or culturally significant, or that it was known to the average consumer of the goods and services for which the contested marks are registered at the time the applications for those marks were made. I could say the same about the land ownership records and wills that date from the 14th, 15th and 16th centuries. In my view, these are the sort of documents one would expect to find in any geographical place in England.[37] Neither

[35] Exhibits SO-18.02 and SO-18.10.
[36] Exhibit SO-01.
[37] I say "England" as it was not until 1707 that the kingdoms of England and Scotland were united.

am I persuaded that the existence of a music hall in the 19th and 20th centuries tells me anything about the average consumer's knowledge at the relevant date.[38]

50. It is likely that some people in the UK will be aware of the role of Hoxton in contemporary British art and design. However, it is notable that the number of articles is small, amounting to 19, and confined to a few publications. I do not consider that the academic articles are likely to have a wide readership among average consumers of the goods and services for which the contested marks are registered. I do not doubt the credentials of the author of *The First to Know,* but it is difficult to tell from the extracts presented the extent to which average consumers were aware of the trend-setters of Hoxton. Furthermore, it appears that Hoxton's period at the centre of the British contemporary art world was relatively brief.

51. It is important to be precise about the contested marks. They are not "Hoxton", but "The Hoxton", registered either as a word mark (the 093 mark) or in particular typefaces (the other three marks). The applicant submitted that the verbal element of each of these marks is composed of two non-distinctive elements: the first being the definite article and the second the geographical name Hoxton. Furthermore, he argued that the typefaces are plain and lacking in any distinctive character.[39] He submits that the marks directly refer to Hoxton.

52. Mr Hicks, for the registered proprietor, submitted that:

> "… the word 'the' makes a difference to the way average consumers will perceive the mark. It does take it a step away from just 'Hoxton' plus something else."[40]

53. I agree with Mr Hicks that the addition of the definite article takes the mark away from just a geographical reference. It is not common to speak of a town or area by adding "The", unless that is already part of its name. One does not, for example, refer to "The Wales", "The Manchester" or "The Westminster". The listener or reader would be waiting for some other word to complete the concept. Consequently, it is my view

[38] Exhibit SO-06 contains documents relating to Hoxton Hall, a music hall on Hoxton Street, Hackney. They are dated from 1867 to 1984.
[39] Final written submissions, page 9.
[40] Transcript, pages 23-24.

that the average consumer of the registered proprietor's goods and services, who would be a member of the general public, would not readily recognise the marks as indicating geographical origin, even if they were aware that "Hoxton" was a place in East London. Mr O'Connor submitted that this argument was undermined by the existence of several businesses using "The Hoxton" in their name. The one he specifically referred to at the hearing was "The Hoxton Vet".[41] However, in my view, this reinforces the unusual syntax of the marks. If the word "Hoxton" were being used geographically, one would expect "The Hoxton" to be followed by a word indicating the type of business, such as a veterinary surgery. I find that the marks do not fall foul of section 3(1)(c) of the Act.

54. Furthermore, I am not convinced on the basis of the evidence that has been filed that average consumers would have been aware of Hoxton as an area of London at any of the relevant dates. I do not consider that the position would be any different for parties in trade. Consequently, I do not consider that the word "Hoxton" was associated in the mind of the average consumers of the goods and services with those goods and services at the relevant dates, neither was it reasonable to assume that such an association may be established in the future.

55. The section 3(1)(c) ground fails.

**Section 3(1)(b)**

56. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now Article 7(1)(b) of the EUTM Regulation, and is identical to Article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, Case C-265/09 P, as follows:

> "29. … the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

[41] Transcript, page 42.

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

57. The applicant's case under this ground is that the marks consist of two words, each of which is non-distinctive, and the 069, 502 and 298 marks are presented in typefaces of no distinctive character. First, I shall say that I agree with Mr Hicks that each mark should be looked at as a whole. For the reasons outlined under section 3(1)(c), I take the view that "The Hoxton" is more than the sum of its parts, even if the average consumer were aware of the geographical location of Hoxton. Consequently, this ground also fails.

**Section 3(1)(d)**

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

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

Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

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

59. I also take note of the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Affinity Leasing Limited v Total Motion Limited*, BL O/522/20:

"26. … the case law of the CJEU and the English courts seems to be better understood as requiring the term in question to have already become customary in the trade in question, specifically to designate the goods or services in respect of which registration of the mark is sought and not merely that it has become customary in the trade more generally.

…

28. In my view where reliance is placed on section 3(1)(d) and, in particular, where the usage alleged goes back some years (as here) it is ordinarily reasonable to expect some evidence that the term in question has, in fact, been used specifically to denote the goods or services in question at the relevant date, not merely an evaluation of what an average consumer may think. …"

60. The applicant's claim under this section is that the contested marks consist of an indication customary in the current language for describing goods and services provided in the geographical area of Hoxton. To support his claim, he has adduced evidence of a number of businesses in some of the sectors covered by the proprietor's marks that include the word "Hoxton" in their name. It appears to me that this is

essentially a re-run of the arguments made under section 3(1)(c). Alleged descriptive use is not covered by this ground. The applicant has made no further arguments to support a claim that the marks consist of indications that have become customary in the current language or in the *bona fide* and established practices of the relevant trades to designate the goods or services for which the marks are registered.

61. The section 3(1)(d) claim therefore fails.

**Section 3(3)(b)**

62. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Professor Phillip Johnson, sitting as the Appointed Person, conveniently summarised the case law at paragraph 84 of his decision:

> "(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: C-87/97 *Consorzio per la tutela del formaggio Gorgonzola*, ECLI: EU:C:1999:115, paragraph 41; C-259/04 *Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; C-689/15 *W. F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;
>
> (b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer): *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 55;
>
> (c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder's Club* [2010] ETMR 12, paragraphs 25 and 26;
>
> (d) the deception must have some material effect on consumer behaviour: *CFA Institute's Application* [2007] ETMR 76, paragraph 40;
>
> (e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05, *HUP Uslugi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraphs 67 and 68; T-327/16, *Aldi v EUIPO*, ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T-29/16 *Caffè Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS – École de ski internationale v OHIM*, EU:T:2991:200, paragraph 50; *Caffè Nero*, paragraph 47.

63. The applicant submits that the registered proprietor has admitted that it has no hotels in the geographic area of Hoxton, and that consequently its use of the contested marks would mislead the public. According to the applicant, the public would be likely to assume that services offered under these marks originate from, or are meaningfully connected to, the area of Hoxton.

64. Earlier in my decision, I found that the average consumer was not likely to be aware of the area of Hoxton. I remind myself that the average consumer for the goods and services at issue is a member of the general public. In my view, knowledge of the role of Hoxton in the British art scene of the 1990s is unlikely to be held by more than a small proportion of this public. It is also important to remember that the marks are “THE HOXTON”, rather than “HOXTON” *solus*, and, as I have already found, the definite article means that it is not likely that the mark will be perceived as denoting a geographical area, even if the consumer is aware of Hoxton as an area of East London.

65. The claim under section 3(3)(b) fails.

**Section 3(6)**

66. In *Skykick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*, [2024] UKSC 36, the Supreme Court considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Sky plc & Ors v Skykick UK Limited & Anor*, Case C-371/18, *AS v Deutsches Patent- und Markenamt*, Case C-541/18, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, *Hasbro, Inc. v EUIPO,* Case T-663/19, *pelicantravel.com s.r.o. v OHIM,* Case T-136/11, and *Psytech International Ltd v OHIM,* Case T-507/08. Lord Kitchin summarised the law as follows:

> "240. The general principles are these:
>
> (i) It is an absolute ground of invalidity of an EU trade mark that the application for that registered mark was made in bad faith, and this ground may be relied upon before OHIM (or, now, the EUIPO) or by means of a counterclaim in infringement proceedings (*Lindt*, para 34).
>
> (ii) The date for assessing whether an application to register an EU trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky CJEU*, para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the establishment and functioning of

the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton*, para 45).

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

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

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

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

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be

made of it (*Sky CJEU*, para 76; *Deutsches Patent- und Markenamt*, para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/04 (*Sky CJEU*, para 77).

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

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

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

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

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

67. Further relevant points arising from the case law are the following:

a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that *"cogent evidence is required due to the seriousness of the allegation"*. This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors*, [2008] EWHC 3032 (Ch), paragraph 167.[42]

68. The relevant dates for the assessment of this ground are the dates of application of the 069 and 502 marks, that is **8 June 2016** and **10 February 2017** respectively.

69. The applicant's case as pleaded appears to be that the registered proprietor has misappropriated the name of "Hoxton" and is using it in order to block other parties from registering trade marks containing the word "HOXTON". His submissions, both on paper and at the hearing, ranged more widely than this. He essentially repeated

[42] Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

the arguments made in support of his claim that “HOXTON” was descriptive. I have already dealt with these and will say no more about them here. The applicant also argued that the ‘069 and ‘502 marks were filed without any intention to use the marks in relation to the goods and services for which registration was sought, but that it was a defensive filing, intended to block use of the word by others.

70. In his pleadings, the applicant referred to the judgment of the CJEU in *Lindt* as establishing three conditions of bad faith that have been met in this case. These can be found in the operative part of the judgment. The CJEU said:

> “53. Having regard to all the foregoing, the answer to the questions referred is that, in order to determine whether the applicant is acting in bad faith within the meaning of Article 51(1)(b) of Regulation No. 40/94, the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:
>
> - the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;
>
> - the applicant’s intention to prevent that third party from continuing to use such a sign; and
>
> - the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.”

71. The applicant has adduced no evidence to show that at the date of application for the 609 and 502 marks, the registered proprietor knew or must have known that a third party was using an identical or similar sign capable of being confused with those marks. I say, again, that I have already dealt with the argument that “Hoxton” is descriptive.

72. The evidence to support the claim that the applications were made to block competitors comes down to the oppositions filed by Ennismore against the applicant’s

own applications for trade marks and its threatened oppositions to Application Nos. 3921980 (HOXTON MIX), 3921986 (HOXTON MIX PLUG IN) and 3917577 (Hoxton Mix/Hoxtonmix). These last three were, in the end, not opposed and were registered on 10 November 2023, 13 October 2023 and 27 October 2023 respectively. The dates on which the registered proprietor opposed, or threatened to oppose, all these applications are shown in the table below:

| **Application Opposed** | **Date of Opposition** | **Date of Threatened Opposition** |
|---|---|---|
| 3737799 (Hoxton Circus) | 4 May 2022 | |
| 3737800 (Hoxton 8) | 4 May 2022 | |
| 3738199 (Hoxton Circle) | 4 May 2022 | |
| 3879534 (Hoxton Yards) | 12 June 2023 | |
| 3932611 (Hoxton Yards) | 20 October 2023 | |
| 3921980 (HOXTON MIX) | | 9 August 2023 |
| 3921986 (HOXTON MIX PLUG IN) | | 9 August 2023 |
| 3917577 (Hoxton Mix/Hoxtonmix) | | 9 August 2023 |

73. It will be seen that these dates are significantly after the relevant dates. While evidence later than the relevant date may shed light backwards on the position at that point, I consider that there is little that can be taken from this evidence. I have already referred to the principle that an allegation of bad faith is a serious one and must be supported by cogent evidence. It is not enough to file evidence that could equally show good faith. These examples of oppositions and threatened oppositions are entirely consistent with a trade mark proprietor seeking to protect its rights, as it is permitted to under the law. Mr O'Connor characterised the actions of the registered proprietor as interference in the application for the HOXTON MIX trade marks, partly because the amendments to the specification to Application No. 3912986 were made following the publication of the application and the notification of third parties, including the registered proprietor. However, this is not uncommon in trade mark proceedings, and there is no information on the content of any discussions that might have taken place between the registered proprietor and the applicant for that mark. The evidence does not come close to establishing a pattern of behaviour such as that shown in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch), and cited by the applicant.

74. I will briefly comment on the submissions made by the applicant in relation to the breadth of the specifications. The applicant's final written submissions refer to the judgment of the High Court in the *Skykick* case. As I have noted above, the Supreme Court handed down its judgment in the case in 2024. The actual date of this was 13 November 2024, around 6 months before the final written submissions were filed. I appreciate that it is not easy for a litigant in person to become aware of the latest developments in case law, although I note that Mr O'Connor correctly quotes Arnold J (as he then was) saying that broad protection may be indicative of bad faith. The key passage from the Supreme Court's summary of the law quoted above is to be found in points (ix) to (xii). In my view, the applicant has not provided evidence containing objective, relative and consistent indicia tending to show that, when the applications were filed, the registered proprietor had the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark.

75. The applicant has failed to establish a *prima facie* case of bad faith and so the section 3(6) ground is unsuccessful.

**OUTCOME**

76. The applications to invalidate UKTM Nos. 910767093, 915524069, 916347502 and 905480298 have failed and, subject to a successful appeal, the marks will remain on the register.

77. For completeness, I note here that the 298 and the 502 marks are also subject to revocation proceedings (CA 506372 and 506373). The specifications of those marks may therefore be reduced in line with the findings in that decision.

**COSTS**

78. At the hearing, I indicated that I would invite the parties to make submissions on costs once I had issued my decision on the substantive matters. As the registered proprietor has been successful, it has 14 days from the date of this decision to file submissions on costs. The applicant will have 14 days from receipt of those submissions to make its own submissions on costs. As the applicant is a litigant in

person and unlikely to be familiar with the process followed, I think it helpful to explain that those submissions should respond to the submissions of the registered proprietor and refer only to costs. They should not comment on the substantive points of this decision.

79. I will then issue a costs decision and set the appeal period.

**Dated this day of 29th September 2025**

**Clare Boucher,**
**For the Registrar,**
**Comptroller-General**

**ANNEX**

**Specification of UKTM No. 915524069**

*Class 3*

*Eye-masks filled with lavender or other herbs, flowers or plants; beauty masks; facial packs; potpourri; scented essential oils for application to potpourri; cushions and sachets filled with lavender or other herbs, flowers or plants; perfumes; toilet waters; eau de cologne; perfume oils; aromatherapy oils and products; essential oils; incense; incense cones; incense sachets; incense spray; massage oils; non-medicated massage preparations; extracts of flowers; breath freshening preparations; perfuming preparations for the atmosphere; soaps; body washes; non-medicated toilet preparations; non-medicated toilet preparations produced from essential oils; preparations for the care of the hair, skin, scalp, face and nails; lip balms; toners; moisturisers; shampoos; conditioners; creams and lotions for removing make-up; sun-tanning preparations; sun-screening preparations; deodorants and antiperspirants; body sprays; bath and shower products; foam bath, bath salts, bath oil; shower gel; depilatory preparations; shaving preparations; aftershave preparations; cosmetics; tissues and wipes impregnated with non-medicated toilet preparations; cotton wool and cotton wool buds; cleaning preparations for household use; reed diffusers; none of the aforementioned goods relating to air treatment, air conditioning or air purifying.*

*Class 4*

*Candles; scented candles; none of the aforementioned goods relating to air treatment, air conditioning or air purifying.*

*Class 21*

*Household or kitchen utensils and containers; combs and sponges; brushes; glassware, porcelain and earthenware; crockery; mugs; none of the aforementioned goods relating to air treatment, air conditioning or air purifying.*

*Class 35*

*Retail services, shop retail services and retail services provided over the Internet all relating to eye-masks filled with lavender or other herbs, flowers of plants, beauty masks, facial packs, potpourri, scented essential oils for application to potpourri, cushions and sachets filled with lavender or other herbs, flowers or plants, perfumes,*

*toilet waters, eau de cologne, perfume oils, aromatherapy oils and products, essential oils, incense, incense cones, incense sachets, incense spray; retail services, shop retail services and retail services provided over the Internet all relating to massage oils, non-medicated massage preparations, extracts of flowers, breath freshening preparations, perfuming preparations for the atmosphere; retail services, shop retail services and retail services provided over the Internet all relating to soaps, body washes, non-medicated toilet preparations, non-medicated toilet preparations produced from essential oils, preparations for the care of the hair, skin, scalp, face and nails, lip balms, toners, moisturisers, shampoos, conditioners, creams and lotions for removing make-up; retail services, shop retail services and retail services provided over the Internet all relating to sun-tanning preparations, sun-screening preparations, deodorants and antiperspirants, body sprays, bath and shower products, foam bath, bath salts, bath oil, shower gel, depilatory preparations, shaving preparations, aftershave preparations, cosmetics, tissues and wipes impregnated with non-medicated toilet preparations, cotton wool and cotton wool buds; retail services, shop retail services and retail services provided over the Internet all relating to cleaning preparations for household use, reed diffusers, retail services, shop retail services and retail services provided over the Internet all relating to candles, scented candles; retail services, shop retail services and retail services provided over the Internet all relating to household or kitchen utensils and containers, combs and sponges, brushes, glassware, porcelain and earthenware, crockery, mugs; none of the aforementioned services relating to air treatment, air conditioning or air purifying.*

*Class 41*

*Event planning services; organising, producing and conducting events; art exhibitions; live music services; entertainment services; entertainment club services; nightclub services; arranging, hosting, producing and conducting of talks, presentations, conferences, concerts, discos, fitness classes, yoga classes, exhibitions and shows; provision of sporting facilities; gymnasium and health club services; personal trainer services; entertainment information services; providing casino facilities; cinema services; information services and/or the listing of information relating to events, entertainment, recreation, leisure, sport, the arts, conferences, exhibitions, competitions, contests, carnivals, displays, shows, programmes and performances;*

*publication of online guide books, travel maps, city directories and listings for use by travellers.*

*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 holdings talks, presentations, conferences, concerts, discos, fitness classes, yoga classes, exhibitions, functions, conventions, exhibitions, seminars and meetings; provision of food and drink.*

*Class 44*

*Cosmetic and beauty treatment; beauty salon services; hair salon services; nail salon services; spa services.*

**Specification of UKTM No. 916347502**

*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.*