O-0787-25

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3961995
BY ETT HEM LTD
TO REGISTER

ETT HEM

AS A TRADE MARK
IN CLASSES 21 & 26
AND OPPOSITION THERETO (UNDER NO. 445311)
BY
ETT HEM SVERIGE AB

Background and pleadings

1. Ett Hem Ltd ("the applicant") applied to register the trade mark **Ett Hem** on 28 September 2023. The mark was published in the Trade Marks Journal on 13 October 2023 in classes 21 and 26. The published goods are set out in Annex 1 of this decision.

2. Ett Hem Sverige AB ("the opponent") opposed the application in full on 15 January 2024 under sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"). Under section 5(4)(a), the opponent alleges that use of the contested mark and its goods amount to passing off and it relies on the unregistered sign **Ett Hem** for which it claims use in the UK since 2013 for the following goods and services, namely:

Scented products such as candles, perfumes and cold candles; keyrings; pyjamas and cashmere socks; bed linen; alarm clocks; sheep skins; ceramics; stationery; notebooks and postcards.

Hotel; Hotels, hostels and boarding houses, holiday and tourist accommodation; Hotel restaurant services; Hotel services; Information relating to hotels; Restaurants; Restaurant services; Serving of food and drink in restaurants; Provision of food and drink; Information, advice and reservation services for the provision of food and drink; Providing temporary housing accommodations; Providing accommodation for meetings; Providing accommodation for functions; Food and drink catering; Catering for the provision of food and beverages; Providing facilities for fairs and exhibitions; Providing facilities for conventions and conferences; Rental of meeting, conference and reception rooms; bar services; Temporary accommodation reservations; Catering for the provision of food and beverages; Hospitality services (accommodation, food and drink).

Hotel concierge services; Concierge services.

3. Under section 3(6) the opponent alleges that the applicant acted "below the standard of acceptable commercial behaviour judged by the ordinary standards of honest people"[1] and therefore the contested application was made in bad faith.

4. The applicant filed a counterstatement in which it denied all grounds of opposition and put the opponent to proof of its claims.

5. During the proceedings both sides filed evidence and both sides filed submission in lieu of an oral hearing.

6. The applicant has been represented throughout by J A Kemp LLP and the opponent by Pinsent Masons LLP.

7. I make this decision based on a reading of all the material before me.

8. 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 that predate the UK's withdrawal from the EU.

EVIDENCE

Opponent's Evidence in Chief

9. The opponent filed a witness statement dated 28 May 2024 in the name of Jeanette Mix, who is its owner and founder. Ms Mix appends 38 exhibits.

10. Ms Mix states that mark **Ett Hem**, which is Swedish for "at home", is the name of a boutique hotel in Stockholm, Sweden which the opponent opened in 2013. Ms Mix gives the following turnover in pounds sterling generated under the **Ett Hem** brand in the UK:

[1] Opponent's Statement of Grounds, paragraph 15.

Year	Turnover
2015	£234,500
2016	£265,100
2017	£276,000
2018	£269,800
2019	£255,800
2020	£103,000
2021	£82,500
2022	£273,000
2023	£430,500

11. Ms Mix points out that the lower 2020 and 2021 figures are attributable to the pandemic travel restrictions.

12. Ms Mix states that the opponent spends approximately £22,000 p.a. promoting its brand internationally. Ms Mix exhibits screenshots dated 28 May 2024 from the opponent's website, www.etthem.se.[2] The screenshots show images of the hotel and facilities as well as a "book a room" and "book a table" functions and the facility to allow a UK customer to select pound sterling (GBP) to view prices. Stays at the hotel can be booked with hotel directly and via a number of UK based booking agents.[3] Ms Mix sets out the following volumes of unique UK visitors to the opponent's website, and the number of UK guests staying at the opponent's hotel, namely:

Year	Total UK visitors to website	Total UK guests staying at hotel
2015	8783	420 (out of 3075)
2016	9725	474 (out of 3487)
2017	10798	455 (out of 3642)
2018	9600	402 (out of 3707)
2019	8313	410 (out of 3747)
2020	6312	179 (out of 3574)

[2] Exhibits 11 & 12.
[3] Exhibits 9 & 10.

2021	5582	88 (out of 4187)
2022	8852	362 (out of 6233)
2023	12675	582 (out of 8114)

13. Ms Mix states that advertising in the UK is conducted via the opponent's website, its social media channels, its UK booking agents and via external means such as vehicles wraps and billboards.

14. Ms Mix exhibits a number of articles dated between 2015- 2023 from UK mainstream media online publications featuring the opponent's hotel, namely Daily Mail, Financial Times, Evening Standard, The Independent, House & Garden, Silverspoon London and Tatler.[4] The articles comprise a collection of hotel reviews, as well as highlights of its food and drink provision and its interior design.

15. Ms Mix states that the Ett Hem hotel has won the following awards and accolades:[5]

- 2013-2019 Conde Nast Traveler's Gold list
- 2013 House & Garden award – garden pineapple winner
- 2013 Andrew Harper Grand Award
- 2015 Mr & Mrs Smith award – best dressed hotel winner
- 2018 Tatler awards – best hotel in the world
- 2019 The Telegraph – The 50 greatest hotels in the world
- 2022 Small Luxury Hotels – mystery inspector excellence award

16. Ms Mix states that the hotel has an inhouse florist and uses the services of a third party to decorate the hotel with floral arrangements. She also states that floral arrangements are an integral part of the ambience of the hotel.

Applicant's evidence

17. The applicant filed a witness statement dated 19 July 2024 in the name of Elena King, who is its director and co-founder. Ms King states that **Ett Hem** was one of a

[4] Exhibits 19-28.
[5] Exhibits 29-33.

number of brand names the applicant considered for the provision of what are now the contested goods. Ms King states she has an interior design business and that her husband and business partner is Swedish, so the contested mark was chosen as a reflection of their business and a connection to his roots. Ms King states that neither she nor her husband were aware of the opponent's sign until September 2022 when the applicant was at the point of filing its first UK trade mark (UK TM No.3834479). The applicant engaged a third party PR consultancy firm, namely Le Grey, for the purpose of increasing its web traffic and were made aware of the existence of the opponent's mark at that time by Le Grey, who also act on behalf of the opponent. Ms King states that having undertaken further due diligence she found that the opponent had a trade mark registered in Sweden for hotel and restaurant services so did not believe registration of the contested mark and goods in the UK would cause any issue.

Opponent's evidence in reply

18. The opponent filed a witness statement dated 19 September 2024 in the name of Matthew Harris, a Chartered Trade Mark Attorney for the opponent's legal representatives, Pinsent Masons LLP. Mr Harris appends 5 exhibits.

19. Mr Harris seeks to re-emphasise the points made in Ms Mix's witness statement about the connection between hotel services and floristics. Mr Harris exhibits a number of online articles dated between 2013-2018 from Occa Design, TimeOut, Swedish Chamber of Commerce for the UK, Luxsphere and DeZeen which specifically mention flowers in the hotel or the garden space as part of their overall review of the hotel.[6]

20. That concludes my summary of the evidence.

DECISION

Section 5(4)(a)

21. Section 5(4)(a) states:

[6] Exhibits 39-43

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]

(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

22. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

23. Section 5A of the Act is as follows:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

24. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,[7] Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

"First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by

[7] [1990] RPC 341, HL, page 406.

association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

25. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon;
(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
(c) the similarity of the mark, name etc used by the defendant to that of the claimant;
(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

Relevant date

26. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited,*[8] Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:[9]

> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

[8] BL O-410-11
[9] BL O-212-06

27. The filing date of the application is 28 September 2023, which is the relevant date. However, in the present case there are other factors to consider, arising from evidence of actions by the applicant before the application date of the contested trade mark, which may constitute *"the start of the behaviour complained about".* I must consider the first external act by the applicant about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future.

28. In the opponent's evidence, Ms Mix identifies 4 February 2022 as the incorporation date for the applicant's company and 14 August 2022 as the date of the first post on the applicant's Instagram page using the handle ETT HEM LONDON and the name ett_hem. The applicant's post contains a video of a flower arranging tutorial and the rubric mentions "the Ett Hem forever flowers product".[10] I have also noted that Ms King states in her witness statement that the applicant filed its first **Ett Hem** trade mark (UK TM No. 3834479) on 29 September 2022. In the present case, I will therefore assess the questions of the opponent's goodwill, misrepresentation and passing off not only at the filing date, but also at 14 August 2022, which appears to be the first evidenced use of the applicant's **Ett Hem** mark.

Goodwill

29. The first hurdle for the opponents is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*[11] viz*,*

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

[10] Exhibit 4
[11] [1901] AC 217 (HOL)

30. In *Smart Planet Technologies, Inc,* the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> *".. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."*

31. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the services. The relevant market for assessing goodwill is the UK. My summary of the opponent's evidence is contained above in paragraphs 9-16. Although the opponent's business consists of a single boutique hotel in Stockholm, it has demonstrated that, pre pandemic, UK customers accounted for around 1/6th of its annual guests. Post pandemic, the UK guest number remained of similar scale although the overall number of guests increased. The opponent's hotel is by nature an exclusive offering, and the bare numbers evidenced (fewer than 3400 UK guests over 9 years by the relevant date, and fewer than 2800 by the 2022 relevant date) suggests that it is not widely known by a majority of UK consumers. However, I find there is sufficient use to show it has generated a small but protectable goodwill for its hotel services. Whether or not the evidence warrants a finding of goodwill associated with precisely the services claimed, I am satisfied that the goodwill extends to the claimed "Hotel services" including hotel restaurant services.

32. However I cannot find any goodwill for the goods claimed by the opponent namely *Scented products such as candles, perfumes and cold candles; keyrings; pyjamas and cashmere socks; bed linen; alarm clocks; sheep skins; ceramics; stationery; notebooks and postcards.* In Ms Mix's witness statement at paragraph 40, she states

> "Ett Hem also advertises various products for sale, including scented products such as candles, perfumes and cold candles; personal items such as keyrings, pyjamas and cashmere socks; home products such as bed linen, alarm clocks, sheep skins and ceramics; stationery such as notebooks and postcards. Customers, including UK visitors, purchasing such products from Ett Hem can replicate the personality, design and embodiment of the Ett Hem lifestyle in their own home."[12]

And at paragraph 49 she states:

> "Ett Hem offers various household goods for sale at the Ett Hem premises and is renowned for its unique and homely interior design, in which the use of fresh flowers has a significant part to play."

33. If the opponent retails goods at its hotel premises only, rather than online via its website, then it is not possible to know whether the customer is a UK-based guest. It is also unclear to me from these statements if these are **Ett Hem**-branded goods or whether it is the case that the opponent advertises and retails third-party branded goods, which happen to be in use at the hotel as part of the general décor or provided for guests' comfort. Ms Mix has not shown evidence or images of any **Ett Hem**-branded goods for sale, which should have been relatively straightforward to include in evidence if such items exist. Nor did Ms Mix make clear if the turnover generated by the applicant included the sale of goods as well as the hotel related services. If the turnover figures were for sales of goods at large then sales to UK customers have not been identified or separated out.[13] Therefore I find that the opponent has not been able to demonstrate goodwill in respect of the goods it claims.

[12] Jeanette Mix witness statement, paragraph 40.
[13] The requirement to have UK customer was set out in In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31.

Misrepresentation

34. As the opponent has cleared the first hurdle of goodwill for its hotel-related services, I will go on to consider the second hurdle of misrepresentation.

35. The test for misrepresentation was set out in *Neutrogena Corporation and Another v Golden Limited and Another*,[14] where Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."
>
> And later in the same judgment:
>
> "…. for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

[14] [1996] RPC 473

36. In *Lumos Skincare Limited v Sweet Squared Limited and others*[15], Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

37. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived – which assessment is to be made taking account of all surrounding circumstances, as outlined in the case law I cited above.

38. So far, I have found the opponent has goodwill for the sign **Ett Hem** in respect of hotel-related services. The contested mark is **Ett Hem**, so clearly the marks are identical. The contested goods broadly cover ceramic items in class 21 and artificial flower arrangements in class 26. On the face of it, there does not appear to be a common field of activity between the parties. In its evidence, the opponent sought to make a connection between hotel services and both artistic objects and floristry. Ms Mix states that the opponent's hotel has an in-house florist and it uses flowers from a third party to decorate the hotel. However, in my view, this does not equate to provision of floral arrangements either as goods for sale or as a floristry service for others. I understand that it is in a hotel's interest to make its interior dressing and ambiance as attractive and welcoming as possible, but generally guests will stay in a

[15] [2013] EWCA Civ 590

specific hotel for a number of reasons, e.g. location, accessibility, provision of food and drink but, in my view, it is much less likely to stay at a hotel solely for the artistic objects or the floral arrangements.

39. In *Harrods Limited v Harrodian School Limited,*[16] Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego* case *Falconer J*. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.
>
> The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

[16] [1996] RPC 697 (CA).

> '…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.*[17] Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

[17] [1984] R.P.C. 501.

40. In the same case Stephenson L.J. said at page 547:

> '…in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

41. In my view, the opponent is not a household name as per *Lego,* nor do I find there is sufficiently compelling evidence as per *Stringfellow* to associate artistic objects and flower arrangements with hotel services in the minds of consumers. The goods may be used in a hotel setting but that could be said about all manner of fixtures and fittings, as was pointed out by the applicants in its written submissions.[18] The opponent has not been able to show that its **Ett Hem** brand is associated with artistic objects or floral arrangements for sale *per se,* only that some objects and floral arrangements are used as part of a hotel interior dressing and for the improvement of the hotel's ambience. As such, I find that the case for misrepresentation has not been made out. Moreover, even if previous UK guests of the opponent, recalled and associated the name of the hotel in Sweden with the applicant, I am also not satisfied that there is any clear damage likely to arise to the (limited) business goodwill if the applicant were permitted to use the contested trade mark in respect of the specified goods.

[18] Applicant's written submissions, paragraph 2.28.

Conclusion

42. The opponent's claim brought under section 5(4)(a) falls for lack of misrepresentation and damage.

Section 3(6)

43. Section 3(6) of the Act states:

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

44. The opponent claims that the applicant has sought a connection between themselves and the opponent for their own commercial advantage and the application to register the now contested mark supports this pattern of behaviour. In particular the opponent states:

> "…the Applicant was aware of the former use and goodwill in the name ETT HEM at the relevant date, and the Application was filed to take advantage of that reputation, damage it, or otherwise disrupt the legitimate interests of Ett Hem, in a manner below the standards accepted in industrial or commercial matters. Further, the Applicant notes on its website that its business and use of "Ett Hem" is "inspired by its Swedish roots" and its links to Sweden. Ett Hem is headquartered in Sweden. Ett Hem's use of ETT HEM has acquired substantive goodwill in the UK through substantial investments in advertising, marketing, sales, press articles, awards and personnel."[19]

45. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*,[20] Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]

[19] Opponent's written submissions, paragraphs 22 and 23.
[20] [2024] UKSC 36

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

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

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

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

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro*

Inc v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

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

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

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

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

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

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant

had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

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

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

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

46. Moreover in *Skykick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and

for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

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

47. According to *Alexander Trade Mark*,[21] the key questions for determination in a claim of bad faith are:

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

[21] BL O/036/18.

48. It is also necessary to ascertain what the applicant knew at the relevant date.[22] Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date.[23]

49. I must consider whether the application to register the contested mark is an act of bad faith. My consideration depends on whether the applicant's motivation amounts to a dishonest intention or other sinister motive which must be judged by assessing whether it involves conduct which departs from accepted standard of ethical behaviour or honest commercial and business practice.

50. In her witness statement for the applicant, Ms King states that she chose the Swedish phrase Ett Hem (At Home) as a reflection of her interior design interests and because her husband was Swedish. Furthermore, she makes the following admission:

> "8. Before filing a logo version of the trade mark shown here,  , under UK Trade Mark Registration No. 3834479 ("our first trade mark filing") on 29 September 2022 we were looking to optimise traffic to our website and generate awareness around our goods and services. We approached a public relations consultancy to assist called Le Grey. As part of our discussions with them they asked whether we were related to the Opponent and their boutique Swedish hotel. Their knowledge of the Opponent was coincidental as they also represented the Opponent. Naturally, we informed them that we were not connected and undertook some diligence ourselves which pointed to the Opponent only having registered rights in Sweden for the word mark Ett Hem in respect of "hotels; restaurants" in Class 43 and where their website showed use in relation to a boutique hotel. Given our intended line of business, the fact that the Opponent's rights appeared to be limited to Sweden and where there was no obvious collision in activities which might have created an issue

[22] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).
[23] *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

for our search engine optimisation we marched on with our first trade mark filing which we undertook ourselves."

And later in the same document,

"11. We, being the Applicant, and contrary to what the Opponent asserts, did not consider that the Applicant had any rights in UK and certainly none which would trespass into our field of activity which is quite unique, when filing either our first filing or the Application. We were not aware of any trading activity by the Opponent in United Kingdom and nor did we consider that in filing each application did this seek to take advantage of the Opponent's usage of the trade mark Ett Hem in Sweden where this only related to a boutique hotel. Our intention was only ever to protect a trade mark which had a clever and creative nod to our business activity and future activities and which resonated due to its Swedish connection and my relationship with Robin. We possessed a good faith intent when filing each Application and certainly did not do so in order to harm or block the legitimate business activities of the Opponent in connection with their boutique hotel in Sweden."[24]

51. The applicant's witness statement confirms that it had not known of the opponent's sign or the hotel until it was pointed out by Le Grey. The applicant confirms that it undertook research into the opponent's brand and established that it was a single hotel in Stockholm and that the opponent held a registered trade mark right in Sweden for "hotels; restaurants" in class 43. Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith.[25] Moreover the applicant believed that there was sufficient distance, or "no obvious collision" in her words, between the opponent's hotel services in Sweden and the provision of floral arrangements (and latterly ceramics and floral arrangements) in the UK. I made the same finding previously in this decision under section 5(4)(a) regarding the lack of a common field of activity. The opponent

[24] Applicant's witness statement, paragraphs 8 &11.
[25] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12.

has not been able to show that it provides **Ett Hem** branded ceramic/artistic objects or floral arrangements for sale. At best it has only been able to prove that it has goods of that nature, which may be third-party brands, as part of its hotel décor. Taking the evidence into consideration, the applicant made a reasonable determination, in my view, that the opponent operated in Sweden under **Ett Hem** for hotels and restaurants and did not operate in the UK for ceramics and floral arrangements. Therefore, I find the applicant's behaviour, in making the contested application, did not amount to a dishonest intention nor has it departed from accepted standards of ethical behaviour or honest commercial and business practices.

52. The claim brought under section 3(6) of the Act fails.

OVERALL CONCLUSION

53. The opponent has been unsuccessful in its opposition claims. Subject to any appeal against this decision, the contested application can proceed to registration.

Costs

54. The applicant has been successful in these proceedings and as such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the guidance given in TPN 1/2023, I award costs as follows:

£350 Considering the Notice of Opposition and preparing a counterstatement.
£800 Considering other side's evidence and preparing own evidence.
£450 Preparing written submission in lieu.
£1600 Total

55. I order Ett Hem Sverige AB to pay Ett Hem Ltd the sum of £1800. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of August 2025

June Ralph
For the Registrar
The Comptroller-General

Annex 1

Applicant's published goods:

21: Vases; Urns being vases; Flower vases; Glass vases; Earthenware floor vases; Bud vases; Floor vases; Ritual flower vases; Glass floor vases; Clay floor vases; Flower vases of precious metal; Porcelain flower pots; Pots for flowers; Figurines [statuettes] of porcelain, ceramic, earthenware or glass; Bowls for floral decorations; Stone floor vases; Glass flowerpots; Figurines of porcelain, ceramic, earthenware, terra-cotta or glass for cakes; Saucers for flower pots; Figurines of earthenware; Goblets; Vases of precious metal; Commemorative statuary cups of porcelain, ceramic, earthenware, terra-cotta or glass; Urns; Earthenware jars; Glass pots; Figurines of glass; Figurines of porcelain, ceramic, earthenware, terra-cotta or glass; Candlesticks of glass; Glass candlesticks; Statuettes of earthenware; Statuettes of porcelain, ceramic, earthenware, terra-cotta or glass; Statuettes of porcelain, ceramic, earthenware or glass; Statues of porcelain, ceramic, earthenware, terra-cotta or glass; Statues of earthenware; Statues of porcelain, ceramic, earthenware or glass; Planters of pottery; Sculptures of earthenware; Containers for flowers; Busts of porcelain, ceramic, earthenware, terra-cotta or glass; Busts of china, terra-cotta or glass; Figurines made of decorative glass; Flower bowls; Glass ornaments; Ornamental figurines made of glass; Flower pots; Pots (Flower -); Prize cups of porcelain, ceramic, earthenware, terra-cotta or glass; Boxes of earthenware; Statuettes of glass; Planters of earthenware; Decorative objects [ornaments] made of glass; Decorative boxes of glass; Ornaments [statues] made of porcelain; Glass jars; Flowerpots; Figurines of porcelain; Ceramic ornaments; Figurines of terracotta; Wall decorations of porcelain; Glass bowls; Bowls (Glass -); Ornamental figurines made of porcelain; Statues of glass; Glass decanters; Ornaments [statues] made of china; Candelabra [candlesticks]; Earthenware mugs; Statuettes of porcelain; Glass tableware; Teacups (yunomi); Teacups [yunomi]; Sculptures of glass; Works of art of porcelain, ceramic, earthenware, terra-cotta or glass; Enamelled jars; Pomanders [containers]; Candelabras; Ornamental figurines made of china; Holders for flowers and plants [flower arranging]; Ceramic figurines; Planters of glass; Decorative porcelain ware; Busts of earthenware; Figurines made of earthenware; Planters of porcelain; China ornaments; Wall decorations of terra-cotta; Candlesticks; Sculptures of porcelain;

Decorative chinaware; Stained glass figurines; Ornamental sculptures made of glass; Ornaments made of earthenware; Statuettes of terracotta; Teapots; Bowls for plants; Statuettes of china; Flower baskets; Painted glassware; Glassware (Painted -); Statuettes made of earthenware; Figurines of china; China figurines; Decorative sand bottles; Statues of porcelain; Plaques of pottery; Vases not of precious metal; Ornamental sculptures made of porcelain; Sculptures of china; Porcelain cake decorations; Works of art of porcelain, ceramic, earthenware or glass; Ornamental sculptures made of china; Glass carafes; Plaques of earthenware; Statues made of earthenware; Glass flasks [containers]; Statues, figurines, plaques and works of art, made of materials such as porcelain, terra-cotta or glass, included in the class; Figurines made of glass; Decanters; Glass holders for candles; Sculptures of terracotta; Glass goldfish bowls; Pots; Pottery; Boxes of porcelain; Jars (Glass -) [carboys]; Glass jars [carboys]; Boxes of ceramics; Glass mugs.

26: Bouquets of artificial flowers; Wreaths of artificial flowers; Artificial flowers; Flowers (Artificial -); Silk flowers; Artificial flower wreaths; Artificial flowers of paper; Artificial flowers of textile; Artificial flowers of plastics; Artificial fruit, flowers and vegetables; Artificial garlands and wreaths; Artificial flower arrangements; Garlands (Artificial -); Artificial garlands; Artificial wreaths; Artificial corsages; Artificial topiaries; Artificial Christmas garlands; Artificial Christmas wreaths; Decorative ribbons; Artificial foliage; Pre-lit artificial Christmas garlands; Paper ribbons [hair decorations]; Ornamental bows of textile for decoration; Pre-lit artificial Christmas wreaths; Artificial plants, other than Christmas trees; Artificial Christmas garlands incorporating lights; Artificial Christmas wreaths incorporating lights.