

O-127-16

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO 2201115
IN THE NAME OF TITANIC TRADEMARK LIMITED**

AND

**AN APPLICATION UNDER NO 500742
FOR CANCELLATION THEREOF
BY PROPERTY RENAISSANCE LIMITED**

Background

1. The trade mark TITANIC QUARTER is registered under no 2201115 and stands in the name of Titanic Trademark Limited (“the registered proprietor”). It was filed on 24 June 1999 and was entered in the register on 25 July 2003. It is registered for the following specification of services:

Class 36

Leasing of real estate; real estate management; real estate development services; management of business parks; insurance and financial services in connection with real estate affairs

Class 41

Theme parks; business parks; amusements; educational services; information services; provision of recreation activities and facilities; provision of cultural activities and facilities; provision of exhibitions; production of shows; but not including any such services relating to the motion picture film Titanic

Class 42

Scientific and industrial research; information technology services including computer software design

Class 43

Provision of accommodation; hotel services; provision of food and drink; restaurant services; cafes; snack bars; fast food bars

2. Property Renaissance Limited (“the applicant”) applied to revoke the registration in its entirety on grounds under section 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”) claiming the trade mark had not been used within the relevant periods in relation to any of the services for which it is registered. Under section 46(1)(a) the relevant period is 26 July 2003 to 25 July 2008 with revocation sought from 26 July 2008. Under section 46(1)(b) there are three periods of non-use claimed: 22 January 2010 to 21 January 2015, 10 November 2009 to 9 November 2014 and 31 August 2009 to 30 August 2014. Revocation is requested from 22 January 2015, 10 November 2014 or 31 August 2014.

3. The registered proprietor filed a counterstatement in which it denied each of the claims made. Only the registered proprietor filed evidence which I will refer to later in this decision. The applicant filed written submissions in lieu of evidence. The matter came before me for a hearing on 18 January 2016 when the registered proprietor was represented by Mr Stuart Baran of Counsel instructed by Charles Russell Speechlys LLP (“CRS”). The applicant was represented by Mr Ben Longstaff of Counsel instructed by Harrison IP.

Preliminary issues

4. At the hearing, I dealt with a number of preliminary issues. I set out both these and the background to them, below but in brief, they were a request to transfer proceedings to the Intellectual Property Court (“IPEC”) and a request to file two further witness statements.

5. Following the filing of the counterstatement, the registered proprietor was allowed a period expiring on 9 June 2015, to file its evidence in chief. On that date, through its former representatives, it filed a witness statement of John Nicholl dated 8 June 2015 and, at the same time, requested an extension of the period so as to allow it to file other evidence. By way of a letter dated 11 June, the parties were advised that the reasons given in support of the extension request were considered insufficient to justify it. A period expiring on 18 June, a date corrected by a further letter, issued the same day, to 25 June was allowed for the parties to request to be heard in the matter if they disagreed with that decision. The parties were advised that in the absence of a request to be heard, the refusal of the request would stand and matters would proceed to the next stage. Neither party requested to be heard. That being so, the refusal stood and the parties were subsequently advised that the applicant was allowed until 22 September to file its own evidence and/or submissions.

6. On 22 September, the applicant filed a request seeking an extension of the period for it to file its evidence and/or submissions. The reasons given were considered sufficient to justify the request. By way of a letter dated 24 September, the parties were advised that in the absence of a request to be heard in the matter by 8 October, the grant of the extension would stand and matters would proceed to the next stage with the applicant having until 3 November to file its evidence and/or submissions. Neither party requested to be heard so the grant of the extension stood.

7. The applicant filed written submissions on 3 November. By way of a letter dated 10 November, the parties were advised that in the absence of evidence of fact from the applicant, the evidence rounds were considered complete. The parties were also advised of the option to have a decision made either from the papers then on file or following a hearing and were given until 8 December within which to file any further written submissions. The registered proprietor requested to be heard and a hearing was subsequently set down to take place on 18 January 2016 with the parties notified accordingly.

8. On 1 December 2015, CRS, having been appointed as the registered proprietor's representatives, requested reconsideration of the decision to conclude the evidence rounds so as to allow it to file evidence in reply to the submissions made in lieu of filing evidence by the applicant. The letter stated that CRS had only recently been appointed as representatives for the registered proprietor. It acknowledged that re-opening the periods for filing evidence would impact on the date of the hearing already set but stated that it did not consider that such a delay would adversely affect the parties. This was because the "trade mark in question is being relied on in proceedings before [IPEC], but the trial of those proceedings is scheduled to take place on 13 and 14 September 2016". It noted that the applicant's submissions had made some criticisms of various parts of the registered proprietor's evidence. Whilst it also noted that the applicant had not filed evidence formally to refute any of Mr Nicholl's evidence it nevertheless requested until 18 January 2016 to file evidence to respond to or disprove the matters alleged. It indicated that it wished to file a second witness statement by Mr Nicholl as evidence in reply.

9. In a further letter dated 23 December 2015, CRS made the request to transfer proceedings to IPEC or in the alternative, requested permission to file further

evidence in the form of a witness statement of Mr Conal Vincent Harvey (and exhibits), evidence which had already been filed in the ongoing IPEC proceedings. The letter also indicated that:

“It may be that a further application to admit any Reply evidence served in the Infringement Proceedings may also need to be made under Rule 38(8) at the hearing on 18 January 2016”.

No mention was made of what this latter evidence might be.

10. The applicant's views were sought on the request, however, on 13 January 2016, a further letter was received from CRS. Referring back to its letter of 23 December, it requested admittance of a second witness statement of John Nicholl, dated 13 January 2016 along with exhibits JN7 to JN25.

11. Skeleton arguments in relation to the substantive hearing were due to be filed by both parties by 2 p.m. on 14 January. Both parties filed them as required with the registered proprietor including a supplementary skeleton argument on its late requests. The applicant also filed a supplementary skeleton argument dealing with the late requests. Whilst this was not received until 15 January, given the lateness of the registered proprietor's requests, I take no issue with this.

The request to transfer proceedings to IPEC

12. The ongoing IPEC proceedings have been brought by the company which is the applicant in these proceedings. It makes a claim against Stanley Dock Hotel Ltd and Stanley Dock Properties Ltd (“Stanley”). In its letter, CRS state that Stanley are companies “associated” with the registered proprietor in these proceedings and are said to be licensees of the trade mark the subject of these proceedings. The claim at IPEC is based on trade mark infringement and passing off against Stanley. The claim is said to be based, in part, on the claimant's (here, applicant's) registered trade mark TITANIC SPA and Stanley's use of the name TITANIC HOTEL. Stanley have counterclaimed that the TITANIC SPA mark is invalid in light of the TITANIC QUARTER mark (which mark is the subject of these proceedings).

13. The applicant objected to the request to transfer proceedings to IPEC. Mr Longstaff submitted that the “naked purpose” of the request was to delay the reaching of a decision, deprive it of an answer and to give the registered proprietor a “second and third bite of the cherry in terms of evidence”. He noted that the registered proprietor was not a party to the IPEC proceedings, that a case management conference had already taken place in those proceedings with no mention of any transfer being made and that “it would no doubt come as a considerable surprise to any IPEC judge to find that a party had successfully invited the Office to make such an order... without any reference whatsoever to the Court.”

14. After some lengthy submissions at the hearing, Mr Baran eventually clarified that he was not requesting that I order these proceedings be joined with the ongoing IPEC proceedings (which he acknowledged was not an order I could make in any event). Rather, he requested that they be transferred as new and standalone proceedings on the basis that IPEC could determine the validity of the registration

and would then have full knowledge of all matters and could decide how to proceed in view of the other ongoing proceedings before it. He submitted that if proceedings remained with the registrar, an appeal against the substantive decision could be filed which would mean there would be further uncertainty as to the validity of the registration which could then adversely affect the IPEC proceedings.

15. Whilst Stanley is said to be a licensee of the trade mark the subject of these proceedings, the nature of the association between them and the current applicant is not further explained. And whilst the trade mark is being relied on in the IPEC proceedings, its validity has not been challenged as part of those proceedings. Transferring these proceedings to the court would, obviously, delay matters as the proceedings would, effectively, begin again. Whilst I acknowledge that CRS were appointed as representatives only in November 2015, the registered proprietor has had the benefit of professional representation throughout. These proceedings have been ongoing for a considerable period of time and have reached the stage where, subject to my decision on the late-filed requests, matters are ready for determination. The registrar is well versed in determining revocation actions where the issue is alleged non-use of the mark and no reasons have been given to suggest that such a determination cannot be made in the current case, a determination that will be reached much sooner than would be the case were proceedings transferred at this late stage. The possibility of an appeal being filed at some point in the future does not change my view. In all the circumstances, I declined to transfer these proceedings to IPEC.

The request to file further evidence

The evidence of Mr Harvey

16. As indicated above, in its letter dated 23 December 2015, CRS requested that, should the request to transfer proceedings to IPEC be refused, the witness statement of Mr Harvey should be admitted because it “sets out in greater detail the history and extent of use of the...mark and is clearly material” to the registered proprietor’s case. The witness statement, dated 12 November 2015, was attached to the letter though, for technical reasons, I had not been able to view all of the exhibits before the hearing. Mr Baran submitted that Mr Harvey’s evidence had been in the applicant’s possession since mid-November.

17. Whilst noting that the registered proprietor had sought to file it at a very late stage in these proceedings, Mr Longstaff confirmed the evidence had been in the applicant’s possession as claimed and submitted that the applicant did not object to its admittance nor did it seek to file any evidence in response to it. In the circumstances, I admitted this evidence.

The further evidence of Mr Nicholl

18. As to the second witness statement of Mr Nicholl, the applicant objected to its admittance. As set out above, the applicant did not file evidence in support of its application but instead, made written submissions on Mr Nicholl’s first witness statement filed as evidence in chief by the registered proprietor. It is not unusual for applicants to choose not to file evidence in non-use proceedings given that the

burden is on the registered proprietor to prove what use has been made of the mark. The following extract from Tribunal Practice Notice (“TPN”) 2/2010 sets out the procedural sequence as follows:

“Rule 38 Application for revocation (on the grounds of non-use)”

The registered proprietor

8. Having been served with the applicant’s form TM26(N), the registered proprietor will be allowed two months to file form TM8(N) ‘Notice of defence and counterstatement’ together with the evidence of use (or proper reasons for non-use) it intends to rely upon in order to defend the registration. If a counterstatement is filed without evidence (as the rules permit), the registrar will specify a further period, normally of two months, within which any evidence in support of the trade mark registration may be filed.

The applicant for revocation

9. Following the serving of the counterstatement, the applicant will normally be permitted two months to file any evidence or written submissions in response to the registered proprietor’s counterstatement and evidence of use of the trade mark (or proper reasons for non-use).

The registered proprietor

10. If the applicant files evidence of fact, the registered proprietor will be given one month from receipt of the applicant’s evidence, in which to notify the Registry of their intention to file evidence of fact in reply. The period for filing evidence in reply will then be set; normally to one month (i.e. one further month will be allowed).

11. The evidence rounds will be regarded as complete when:

- a) The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or
- b) The applicant has filed evidence of fact and the period has passed for the registered proprietor to file evidence in reply.”

19. Given that the applicant had not filed any evidence of fact, the parties were advised that the evidence rounds were complete in the line with TPN above. Mr Longstaff submitted that the registrar was correct in bringing the evidence rounds to a close. He submitted that there can be no reply evidence to mere submissions.

20. In its letter of 1 December, CRS stated:

“We write to ask that you reconsider the decision to conclude the evidence rounds. Whilst the [applicant’s] letter...dated 3 November 2015...largely comprises submissions in relation to the proprietor’s evidence set out in the Witness Statement of Mr John Nicholl (and the accompanying exhibits) it also

contains assertions as to fact to which the proprietor will not be able to adequately respond without the opportunity to file evidence in reply.”

21. The registered proprietor referred to three separate issues raised in the applicant’s submissions in support of its request to file evidence in reply to them. I summarise these as follows:

1. The applicant had noted that in his initial evidence Mr Nicholl had stated that he is the financial director of Titanic Quarter Ltd which, along with Titanic Trademark Ltd are wholly-owned subsidiaries of Ivy Wood Properties Ltd. Its submissions acknowledge the connection between the various companies but points out that Mr Nicholl does not state he holds any particular position with Ivy Wood nor does he explain how he might be aware of or access information about the registered proprietor.
2. The applicant’s submissions briefly sets out what it considers to be the nature of the TITANIC QUARTER development. It makes reference to other developments in the UK by way of comparison though gives no details of them other than their name and/or location. The registered proprietor submits that it order “to be able to properly assess the relevance of the comparison” it should be allowed to file evidence regarding the nature of these other sites.
3. The registered proprietor states the applicant’s submissions “invites the [IPO] to disbelieve certain of the statements made by Mr John Nicholl in his witness statement...” It goes on to say that “We note that the applicant has not served any evidence to refute Mr Nicholl’s statements [but n]onetheless... Mr Nicholl should have the opportunity to respond by filing evidence in reply.”

22. As regards the first of these, in his initial witness statement Mr Nicholl gives evidence as to the relationship between the company of which he is the financial director, the registered proprietor and their parent company. Mr Nicholl has stated that his company uses the trade mark with the consent of the registered proprietor which is supported by the fact that the registered proprietor has filed Mr Nicholl’s evidence in support of its claim that the trade mark has been put to genuine use, as claimed, within the relevant period. Nothing has been put forward to explain how the issue of whether or not Mr Nicholl has any formal position in the parent company or whether and how he might be aware of the registered proprietor’s own business is of any relevance to the consideration of whether, as claimed, his company has used the trade mark within the relevant period with the consent of the registered proprietor.

23. As to the second, Mr Nicholl’s initial witness statement makes no mention of other third party developments elsewhere in the UK. Whilst the applicant’s submissions do make a very brief reference to some other developments elsewhere (in as much as naming them and saying they are either a regeneration area or a retail/cultural/ leisure site), it has not filed evidence relating to these other developments. Its submissions in this regard cannot affect the outcome where the issue to be determined from the evidence is whether genuine use has been made of the trade mark for the services for which it is registered and thus evidence from the registered proprietor about these other developments would not assist.

24. As regards the third basis for making the request, Mr Longstaff submitted that the registered proprietor was under a misapprehension as to the nature of the “challenge” the applicant had made to Mr Nicholl’s first witness statement. He stated that the submissions filed by the applicant did not seek to say that he (Mr Nicholl) should be disbelieved. Rather, they were nothing more than observations on the weight and significance which should be attached to that evidence. Those are commonly made submissions that do not require evidence to be filed to counter them.

25. Referring to the evidence the registered proprietor now sought to file, Mr Longstaff submitted that a little over 12 hours before skeleton arguments were due, the registered proprietor had written to the applicant enclosing:

“an entirely new witness statement from Mr Nicholl, along with no fewer than 19 exhibits- altogether amounting to 320 pages (not including cover sheets) [...which] vastly exceeds the size of [its] first-round evidence from June 2015 and is comfortably in excess of the limit of 300 pages for first round evidence (let alone reply evidence -150 pages) beyond which the Office is likely to question its relevance.”

He submitted that seeking to file this evidence is:

“an intolerable abuse of process...[and] appears to be a belated and cynical effort to disrupt the hearing, with no regard to due process of the Office or to [the applicant’s] right to a fair hearing in a reasonable timescale...”.

26. Mr Longstaff also submitted that the registered proprietor had given no indication of why the material now sought to be filed had not been filed earlier, could not be compensated for in costs and paid no regard to the original timetable set. He submitted that admitting the evidence would necessarily delay matters as it would lead to postponement of the hearing. The application was, he submitted, “unheralded”, late filed, without adequate explanation and unfair. He submitted that the registered proprietor had been professionally represented throughout and had:

“ample resources at its disposal with which to collate and present its evidence. Such evidence ought to be easy to prepare, and there is no excuse for [the registered proprietor’s] dilatory approach.”

27. In making its request to file a second witness statement of Mr Nicholl, the registered proprietor submitted that it wanted to respond to the submissions made by the applicant which referred to his first witness statement. For the reasons given above, I do not find that it is necessary or material to the issues to be determined that such a response be made by the filing of evidence. It could have responded to them by filing its own written submissions. It did not do so. What it has done, is seek to file a very large volume of evidence which goes way beyond what is considered a reasonable volume of evidence even in cases where that evidence is in reply to what might have been filed as evidence in chief by the other party rather than submissions. As I indicated above, I do not consider that the evidence the registered proprietor now seeks to file evidence can be regarded as “evidence in reply” as the applicant filed no evidence to which a reply could be made. Rather, it seems to me,

the applicant is seeking to file further evidence. That would appear to be supported by Mr Nicholl himself given that in his second witness statement he states:

“3. I make this statement to supplement the information provided in my initial statement and answer the points made.”

And,

“In this statement I expand on the use which the Proprietor and those with its consent have made of the TITANIC QUARTER mark in the periods in issue in these proceedings.”

28. When considering a request to file further evidence, the Tribunal will consider, primarily, the following:

- The materiality of the evidence to the question needed to be determined;
- The justice and fairness of subjecting the opposite party to the burden of evidence in question at that stage of the registry proceedings, including the reasons why the evidence was not filed earlier;
- Whether the admission of the additional evidence would prejudice the other party in ways that cannot be compensated for in costs (e.g. excessive delay).

29. In filing submissions, the party filing them will often comment on the weight or otherwise which should be accorded to the evidence filed by the other party or comment on what it sees as flaws or gaps in the claims made or evidence filed by that other party. In cancellation proceedings such as these, it is, however, a matter for a registered proprietor to put forward its best evidence when given the opportunity to do so as its evidence in chief. It is not appropriate for it to wait for an applicant to criticise that evidence and perhaps expose the flaws in it which the registered proprietor then seeks to address by filing further evidence which would have been available to it at the earlier date (see the comments of Jacob J in *Laboratoire De La Mer Trade Marks* [2002] FSR 51).

30. The registered proprietor filed evidence in chief. It sought an extension of time to file more evidence but the request was refused as the reasons given for that extension did not justify it. The registered proprietor did not challenge that refusal. In seeking to file the second witness statement of Mr Nicholl, it appears to me that the registered proprietor could be said to be attempting to circumvent the earlier refusal of its requested extension of time and file material that would have been available to it and could have been filed earlier in proceedings. I do not consider that the change of professional representation is a material factor. Neither in its written submissions nor in oral submissions at the hearing did the registered proprietor give any indication of why the material now sought to be admitted could not have been filed within the period originally allowed to it. The content of the vast majority of it would indicate it was in existence well before that time even though the witness statement itself was only completed on 13 January 2016. Mr Baran accepted that the material could have been filed earlier in proceedings.

31. There can be little doubt that admitting the evidence would place a significant burden on the applicant both in reviewing that evidence and responding to it. It would also delay significantly the final decision in these proceedings as the evidence periods, effectively, would restart. That said, the burden and delay has to be weighed against other factors such as the materiality of the proposed evidence which is sought to be filed. In this case, I note that Mr Baran submitted at the hearing that the registered proprietor was satisfied that its other evidence i.e. the first witness statement of Mr Nicholl along with the now admitted witness statement of Mr Harvey, is sufficient to show that genuine use had been made of the mark within the relevant period. Taking all matters into account, I refused to admit the further witness statement of Mr Nicholls.

Decision

32. Section 46(1) of the Act states:

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

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

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

(c)...

(d)...

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

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

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

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

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

33. Section 100 is also relevant and reads:

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

34. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

35. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

36. The registered proprietor's evidence consists of the following:

- A witness statement dated 8 June 2015 by John Nicholl, Financial Director of Titanic Quarter Limited with exhibits JN1 to JN6;
- A witness statement dated 12 November 2015 by Conal Vincent Harvey Limited with exhibits CVH1 to CVH18. Mr Harvey holds appointments with a number of companies. That includes Harcourt Developments, a Dublin based property construction, investment and management company, Vice-Chair of Titanic Belfast Ltd, Director of the registered proprietor and Executive Vice Chair of Titanic Quarter Limited.

37. Mr Nicholl states that his company uses the mark with the knowledge and consent of the registered proprietor. He states the two companies are sister companies being wholly-owned subsidiaries of Ivy Wood Properties Limited.

38. Mr Nicholl states that Titanic Quarter is the name of a development in Belfast, “named with reference to the area of the city where the RMS Titanic was built”. At JN2, pages 2 and 3, he exhibits a copy of a Wikipedia extract downloaded on 14 May 2015 which states that the development is a:

“...large-scale waterfront regeneration project, comprising historic maritime landmarks, film studios, education facilities, apartments, a riverside entertainment district, and the world’s largest Titanic-themed attraction centred on land in Belfast Harbour...The 185-acre (75 ha) site, previously occupied by part of the Harland and Wolff shipyard, is named after the company’s (and city’s) most famous product RMS Titanic.”

39. The Wikipedia extract also states that since 2005, the area has been home to a science park and, since 2009, the Belfast Harbour Marina. In November 2010, the first hotel, a Premier Inn with onsite restaurant opened in Titanic Quarter. At the same time Belfast Audi, operated by the Agnew Group, opened its new headquarters and car showroom there. A month later, the first residential and retail development was completed and in September 2011, part of what is now Belfast Metropolitan College relocated there.

40. In addition Mr Nicholl states that the development is:

“a large-scale leisure and hospitality space in which a variety of services – including hotel, food and drink and entertainment and leisure services - are offered, and with which [his] company has been involved for many years. It has some 15,000 people living, studying and working in it, and attracts around a million visitors each year. It further comprises the Titanic Studios which have played host to the creators of the famous HBO TV series Game of Thrones.”

41. Also at JN2, is what Mr Nicholl says are press cuttings. Page 4 appears to be a montage of newspaper or magazine articles. Whilst I can see that most of them are not in English, the individual articles are presented in such a way that it is impossible to read where or when they may have been published or what they say. Page 5 is an article taken from the BBC News website dated 11 March 2005 which refers to the unveiling of plans “for the biggest property development scheme ever undertaken in Northern Ireland” being the “development of the 185-acre former shipyard area in Belfast , known as Titanic Quarter”. The article goes on to say that “The area is controlled by a property company from the Irish Republic, Harcourt Developments, in conjunction with the Harbour Commissioners”. No mention is made of the registered proprietor or Titanic Quarter Ltd.

42. Mr Nicholl states “the annual turnover associated with the TITANIC QUARTER brand was £7.6m in 2014, £8.8m in 2013 and £10.1m in 2012”. He does not explain the meaning of “associated with” nor does he further breakdown these turnover figures or give any indication as to which company(ies) or services they refer.

43. At JN1 he exhibits the “About us” page from the titanic-quarter.com website which was downloaded on 13 May 2015. It includes the following:

“Reflecting the achievements of history with the latest design approaches, Titanic Quarter’s futuristic mix of residential, commercial, tourism, education and retail space has provided Belfast with a new urban quarter. With 145,000 sq m already completed, 90 companies on site and around 5,000 people already living and working in the area, the ambitious scheme will ultimately provide homes and employment for 50,000.”

44. At JN3 Mr Nicholl exhibits a number of documents which, he states, were intended for retailers interested in taking space and individuals or companies wishing to live in the development. Pages 1 and 2 are headed “living”. The very limited text includes the following:

“The ARC is Titanic Quarter’s first residential development. With its final block completed in 2012, the 474-unit scheme quickly became one of Belfast’s most sought after locations...”

45. Pages 3 and 4 are headed “Retail And Leisure”. Again, the text is very limited but it includes the following:

“With almost 4,000,000 million visitors annually and 50,000 people ultimately expected to live and work in Titanic Quarter, retail and leisure opportunities form an important element of the scheme.

Units totalling 30,000 sq ft at the ARC residential development, located between the Odyssey and Titanic Belfast, are currently available to let.

MACE opened it’s (sic) first convenience store in Titanic Quarter at the ARC in April 2013.”

Whilst these pages indicate that residential and commercial property has been or is available for let, no further evidence is given which shows any details of those lets or the mark(s) under which such services may have been offered.

46. Pages 5 and 6 appear to be a copy of a leaflet. It welcomes readers to “Titanic Quarter, the new city centre quarter of Belfast” and advertises opportunities for retailers in “A prime location, set to become the beating heart of new Belfast.” The contact is given as CBRE [CBRichard Ellis]. The remaining pages, pages 7 to 35, form a copy of *TQ Living*. This is described in the forward, written by the CEO of Titanic Quarter Ltd, as “The first edition of Belfast’s new lifestyle magazine”. The magazine contains a number of general interest articles but also includes ones entitled “The Titanic Arc” written by one of the architects who designed the Arc residential building. Another is “Titanic’s Dock [which is] based at the Northern Ireland Science Park’s site in Titanic Quarter” and which refers to the Belfast Harbour Commissioners as co-promoters of the area. It states: “The aim of Titanic Quarter and the Science Park is to recapture that innovative spirit and help Belfast

become a hub in the Knowledge Revolution while also supporting a 21st Century urban village...”.

47. Whilst undated, Mr Nicholl states that the materials forming exhibit JN3 are “current”. There is no indication given of where, when or to whom any of the materials may have been circulated or in what numbers.

48. Mr Nicholl states:

“Each year around 1 million visitors come to the TITANIC QUARTER development for its entertainment facilities which include:

- Titanic Belfast, opened March 2012, which includes museum galleries
- Titanic Heritage –which includes the shop SS Nomadic open to the public since 2013 and the historic buildings including the Drawing Offices, the restored slipways where Titanic was built and launched, and the dock and pumphouse
- T13 –an urban sports park offering BMX biking, skateboarding, urban art, DJ sessions, free running, breakdancing, music events and art
- Odyssey Arena, opened 2000, which hosts musical and theatre events, exhibitions and sports events
- Belfast Harbour Marina

49. At JN4, Mr Nicholl exhibits print-outs from the titanic-quarter.com website. The twelve pages show they were downloaded on 2 June 2015. Pages 1 and 2 refer to “TQ Play” and includes the following:

“Every year 4,000,000 visitors enjoy Titanic Quarter and its surrounding area.

From unique Titanic heritage to world-class concerts and the largest urban sports centre on the island, Titanic Quarter is Northern Ireland’s most exciting urban community”.

Pages 3 and 4 are entitled “Titanic Belfast”. It refers to it being a:

“stunning £100m interactive attraction” which is “At the centrepiece of Belfast’s Titanic story - and Titanic Quarter itself”

The article gives the address of the Titanic Belfast attraction as “1 Olympic Way, Queen’s Road, Titanic Quarter, Belfast...”

Pages 5 and 6 are entitled “Titanic Heritage”. It states that “Titanic Quarter is the authentic home of RMS Titanic’s legend and this is where her memory lives on in the fabric of Belfast’s maritime heritage”. The pages refer to visitor attractions including “Titanic Drawing Offices” located at “1 Olympic Way, Titanic Quarter, Belfast” and “SS Nomadic” located at “Queen’s Road, Titanic Quarter, Belfast”.

Pages 7 and 8 are entitled “T13” which is described as “Belfast’s very own Urban Sports Park. Set in a former shipbuilding warehouse...”

Pages 9 and 10 are entitled “Odyssey” which is described as “the 10,000 seat arena [which is] one of Ireland’s top venues.

Pages 11 and 12 are entitled “Belfast Harbour Marina”. The text begins: “Titanic Quarter is home to Northern Ireland’s largest city-centre marina. It’s (sic) initial phase is providing up to 40 berths for yachts and leisure craft beside the Odyssey and Titanic Belfast” operated by Belfast Harbour... “.

50. Mr Nicholl states that his company has “leased some of the retail units in the Titanic Quarter development to restaurants and hotels” but gives no details of those leases, when they may have been leased or under which mark such services may have been made.

51. At JN5 he exhibits a further three pages taken from the titanic-quarter.com website on 2 June 2015 which gives details of some of these establishments. The pages are headed “Eating” and begin:

“Titanic Quarter is home to an eclectic mix of eateries and cafés...”

The list of eating places include: Bistro 401 & The Galley (Address: Titanic Quarter, Queen’s Island Belfast), The Dock (Address: Dock Café, ARC Retail, 2a Queen’s Road, Titanic Quarter, Belfast), Thyme Restaurant, at Premier Inn and Pizza Hut, Rockies Sports Bar and Red Panda at the Odyssey Pavilion. Mr Nicholl states that these restaurants and hotels “are promoted through [his] company’s website as amenities of the Titanic Quarter development”. Mr Nicholl gives no information of any leases involving these companies.

52. As to Mr Harvey’s evidence, I bear in mind that it was not originally made for these proceedings and so not all of it is relevant to these proceedings. He gives brief details of a number of companies involved in the development of Titanic Quarter, two of which are the registered proprietor and Titanic Quarter Ltd. He states that Titanic Quarter is a “branded destination development at which a wide range of hotel, food, drink and entertainment and leisure services are available”. He states that the “ill-fated ship RMS Titanic was built at the Harland and Wolff shipyard in Belfast on land known as Queen’s Island”. He states that redevelopment of part of Queen’s Island was proposed in the 1990s with that redevelopment originally referred to as Titanic Park but in early 1999 it was renamed Titanic Quarter. He states that “Titanic Quarter is the name of the development situated on the site where RMS Titanic was designed and built”.

53. Mr Harvey states:

“In 2006, major infrastructure works commenced with the provision of roadways, quay walls, public spaces etc. to facilitate the commencement of Phase 1 development works, which included the construction of the ARC apartments and retail complex, Gateway Hotel, Gateway Offices, Public Record Office for Northern Ireland and Belfast Metropolitan College”.

He gives details of various works carried out and planning applications made in relation to the redevelopment. In 2009 planning applications were filed by Titanic Quarter Ltd and Belfast Harbour Commissioners for:

- Restoration and change of use for the listed former drawing office into function rooms with the erection of a pavilion for ancillary uses including a bar;
- Refurbishment and part restoration and change of use of the former Harland & Wolff headquarters building for use as a hotel with spa, swimming pool gymnasium and other ancillary uses;
- Development of 152 apartments, 2 hotels, business, retail, restaurants, bars and cafes, health spa, financial, professional and other services, car parking and landscaping;
- Hotel, ancillary restaurant and conference facilities, hotel offices, landscaped public realm and car parking.

54. Mr Harvey gives details of a further application made by Titanic Foundation Ltd and Titanic Quarter Limited in November 2014 in relation to the former Harland & Wolff headquarters building which was granted in May 2015 with work due to have commenced in November 2015.

55. Mr Harvey states:

“The first residential development, The ARC, was immensely successful with three quarters being sold “off plan” in 2007. The ARC was completed at Titanic Quarter in stages, with practical completion achieved and the first occupiers moving in during 2009. It comprises 474 apartments, retail outlets and the Belfast Titanic Quarter Hotel (Premier Inn).”

56. At CVH8, Mr Harvey exhibits a copy of a “Hotel Prospectus”. He states that 100 copies of this document were distributed in June 2009 to potential hotel operators and agents. The 26 page document indicates on its cover page:

Titanic Quarter- A captivating destination for the twenty-first century”

The introduction, set out at page 2, begins:

“Promoted by Harcourt Developments and Titanic Quarter Ltd. as the largest waterfront development in Europe...”

Page 7 of the prospectus is headed “Hotels at Titanic Quarter”. It includes the following text:

“Titanic Quarter Ltd. are now making available three complementary hotels in the second phase of the development of Titanic Quarter. At this stage, the hotels have only been specified in general terms, with the detailed design and specification to be determined by the operators.”

At page 24, the prospectus concludes:

“In conclusion, the planned hotels represent a unique opportunity for leading hotel operators seeking high growth, high yield locations.”

57. Mr Harvey refers to Premier Inn and states that it “has consent to use the name Titanic Quarter as a lessee of the Gateway hotel”. He gives no details of this lease. At CVH9, pages 1 and 2, Mr Harvey exhibits a printout from the Premier Inn website downloaded on 22 September 2015. It is headed “Belfast Titanic Quarter Hotel”. To the left of the first page is a heading:

“Premier Inn Belfast
Titanic Quarter”

The text begins:

“Stay at Premier Inn Hotel Belfast Titanic Quarter and your next port of call could be...”

At page 2 there is a reference to the hotel’s Thyme restaurant and directions are given to the “Odyssey Arena” nearby.

58. Also within this exhibit is a copy of an undated brochure entitled “The Arc, Abercorn Basin Apartment Homes”, described as a “landmark development of one, two and three bedroom apartment homes and penthouses in the heart of Belfast”. At the bottom of the front cover is the tagline “Make your home in Titanic Quarter”. Not all of the text shown in the brochure is legible but there are a number of references to Titanic Quarter within it. On page 5 is included “Titanic Quarter is an exciting example of the waterfront-living renaissance that is sweeping the world”. Page 6 refers to Titanic Quarter as “A dynamic setting, a place to work, play, learn and relax...”, Page 8 refers to “Titanic Quarter, the new focal point of Belfast, will be a destination in its own right...” and refers to the Arc as “one of the first projects within Titanic Quarter...”. Page 9 states “Titanic Quarter itself will provide dedicated cycle and bus lanes to bring you speedily into the city centre...”, page 15 includes “That’s life at the Arc in Titanic Quarter, the new heart of Belfast” and page 17 includes “From East facing apartment homes, one can gaze over Titanic Quarter with its gardens, public art and the famous Samson and Goliath cranes...” On the final page of the brochure, the developers are shown to be Titanic Quarter and Harcourt Developments and details are given of the residential estate agents to contact for further information (BTWCairns).

59. Mr Harvey states that Titanic Belfast is a worldwide acclaimed visitor attraction and “Titanic Quarter’s signature project”. Operated by Titanic Belfast Ltd it “contains nine galleries of exhibitions” and allows visitors to “take a walking tour focusing on the building and the history of the shipyard or attend the Ocean Exploration Centre which offers opportunities to watch expeditions to deep sea landscapes and learn about such environments”. Mr Harvey states the Titanic Belfast holds and entertainment and liquor licence for the operation of cafes, bistros, a banqueting suite and merchandising outlet. At CVH10 he exhibits a brochure about its conference and banqueting facilities said to be available from the company’s

website. The brochure is not dated and there is no indication of when it was downloaded. The only reference to Titanic Quarter is on the last page which gives the address of the venue as "...Queen's Road, Titanic Quarter, Belfast...".

60. At CVH11 is exhibited a copy of a report prepared by Deloitte which is a three year evaluation of Titanic Belfast which "opened to the public on the 31 March 2012 ...The building is owned by Titanic Foundation Limited and commercially operated by Titanic Belfast Limited". The report highlights the need for the "further development of linkages within Titanic Quarter, between Titanic Quarter and the wider city, and between Titanic Belfast and other visitor attractions within NI." The report states that "Titanic Belfast is only three years old. It is part of a wider Titanic Signature Project and Titanic Quarter development which are around ten years old." The report concludes that more needs to be done to agree a vision and strategy and set priorities in the context of, inter alia, "wider city and region developments-what is the Titanic Quarter's role and what is its relationship with the city and region?"

61. Mr Harvey states that the Titanic Quarter trade mark is:

"...used on all Titanic Quarter Ltd marketing, promotional, sponsorship and event promotion material." He states that it is the trade mark "used on the Titanic Quarter website and social media channels...It is used as a branding for Titanic Quarter as a destination and used for directional/road signage."

62. At CVH14 he exhibits examples of the use he refers to. The exhibit consists of pages from his company's website as well as from the Facebook, Twitter and LinkedIn websites. None of these pages are dated though the website pages were downloaded on 6 November 2015, the Facebook pages show posts made in August, October and November 2015 and, from its content, the LinkedIn pages appears to date from November 2015 as it refers to something happening "next month from December 2015 to December 2020". I note that these pages refer to Titanic Quarter as "a futuristic district in the centre of Belfast".

63. At CVH15 is a copy of an information document which Mr Harvey states his company published for potential investors. It is undated but entitled "Titanic Quarter 2015". It states (page 2):

"Today some 15,000 people live, work and study in Titanic Quarter and it attracts some 1m visitors every year from across the island of Ireland and more than 100 countries across the world, It is home to major TV and film productions, leading-edge R&D, the world's largest Titanic visitor attraction and one of Belfast's most desirable residential developments.

Over 100 national and international organisations including Citi, Microsoft, IBM, SAP, HBO, Belfast Metropolitan College, University of Ulster and Queen's University Belfast are already established in Titanic Quarter."

No details are given of how many of these documents were published nor of its circulation.

64. Mr Harvey states that the Titanic Quarter development has received awards including “top prize in the Mixed-use Development category for the 2012 Regeneration and Renewal Awards, and in 2013 the development was “Highly Commended” by Property Week in the Regeneration category”.

65. At CVH3, CVH13 and CVH16 Mr Harvey exhibits what he says are articles of press coverage. CVH3 consists of two pages. The first, taken from the highbeam.com website, is entitled “Cannes launch for Titanic Quarter” and states that “Details of the first phase of the new Titanic Quarter masterplan will be unveiled, with redevelopment plans for Abercorn Basin-Marina outlined at the 16th annual MIPIM exhibition in Cannes”. It makes no mention of who might be behind the development. The article states it appeared in “*The News Letter (Belfast, Northern Ireland)* on 8 March 2005. The second page is an article taken from the BBC News website. Also referring to the planned development, it is dated 11 March 2005 and refers to the developers as Harcourt Developments in conjunction with the Harbour Commissioners.

66. Exhibit CVH13 consists of four pages taken from the Belfast Telegraph website. The article is entitled “Luxury hotel has designs on derelict Titanic offices in Belfast”. The only reference to Titanic Quarter is as part of a company name mentioned in the sentence which notes that: “Titanic Foundation in partnership with Titanic Quarter Ltd has been working on this project over the last two years”. The article bears a publication date of 18 February 2015.

67. Exhibit CVH16 consists of 13 pages. Page 1 is an article from *Property Week* published on 4 April 2005. Again, it refers to the MIPIM exhibition in Cannes and the proposed development by Harcourt Developments. Quotes are given in the article by a number of people including one by the Chief Executive of Titanic Quarter Ltd though no mention is made of any involvement in the project by this company. Pages 2 to 5 is an article taken from *Irish America* dated December/January 2007. It refers to the development of “Titanic Quarter [as] the most important employment, investment and regeneration opportunity to arise in Northern Ireland for a generation.” Pages 6 to 10 is an article from *Caterer and Hotelier* dated 1-7 March 2007 entitled “A bright future for Belfast”. It includes references to “the new Titanic (sic) quarter” (page 6) and, at page 9, gives brief details of the overall plans and expected sources of funding. At page 11 is an article from *The Irish News* dated 12 June 2013. Entitled “Titanic Quarter ‘could be template for regeneration’” it refers to a report issued by the CBI which, in turn, refers to the Titanic Quarter project as possibly being a model for the future growth of other cities in the UK. Pages 12 and 13 contain an article published in *The Belfast Telegraph* on 19 October 2015 entitled “How 10 years turned the Titanic Quarter from a wasteland to a wonder” and reports how phase 1 of the regeneration project is complete with plans for phase 2 having been revealed. It states that the “area has hundreds of residents who live in the trendy Arc apartments overlooking the marina, and is also home to the Northern Ireland Science Park, the Public Records Office and a Premier Inn hotel”.

68. At CVH18, Mr Harvey exhibits two short videos which he states were made available on the YouTube and Titanic Quarter websites. The first, said to have been published on 7 December 2012, is entitled *Titanic Quarter Something New*. It shows the Titanic Quarter development. At what I take to be an entrance to the

development, there is a decorative metal sign with the word *Titanic* cut into it. The video shows various buildings some of which have signs on the outside indicating the occupier of those buildings e.g. Premier Inn, Citi, PRONI (Public Records Office of Northern Ireland). The commentary describes Titanic Quarter as a “community” and a “living and working and playful environment”. The second video, said to have been published on 21 February 2013, is entitled *Tour of Titanic Quarter*. The commentary describes it as being “based on a series of urban villages linked by open green spaces and stunning public areas and amenities” and having a “clear sense of place”.

69. Mr Harvey states:

“The annual turnover “associated with the Titanic Quarter brand was £7.6m in 2014 and the annual advertising spend on promotion of the development is currently around £150,000 per annum. The annual marketing expenditure for Titanic Belfast is significantly larger –around £600,000 per annum. These sums go toward the promotion of the combined Titanic brand in the UK and worldwide.”

Again, he does not specify what “associated with” means nor does he give any breakdown of the turnover or promotional spend under the mark.

70. For the registered proprietor, Mr Baran submits that “the uses made of the Mark, evidence by the material adduced, demonstrate part of a vast enterprise with international recognition. The different parts of the specification relate to aspects of a huge, popular and diverse business. These uses are plainly directed to creating and/or maintaining a market share in the respective services; they cannot sensibly be described as token or sham.” He went on to refer me to the case of *Castellblanch v OHIM C-131/06 P*, as establishing the fact that “a trade mark which has been used alongside other signs or trade marks does not stop it from being genuine use”.

71. The applicant submits that much of the evidence dates from after the relevant periods. This is true however that does not necessarily mean that it is of no probative value as evidence may cast light backwards. There are many references throughout the evidence to Titanic Quarter as the name of a development in Belfast, a long-term development which began well before the relevant periods and continues. That development is a mixed one, consisting of e.g. residential, business, educational, retail and hotel accommodation, along with visitor attractions, entertainment venues and places for eating and drinking all located within the confines of that development.

72. In its written submissions, the applicant accepts that Titanic Quarter is the name of a development area “where numerous businesses conduct their own activities” but submits that they do so “under their own names, franchise or brand names and that their use of their own names cannot reflect on the use of TITANIC QUARTER just because the address of these businesses is in Titanic Quarter, Belfast”.

73. The trade mark in issue is registered for a wide range of services as set out at paragraph 1 above. The registered proprietor’s evidence provides turnover figures “associated with the brand” for the years 2012 to 2014 (inclusive) but those figures

have not been broken down in any way and certainly not in relation to any specific services supplied under the trade mark in issue by the registered proprietor or by Titanic Quarter Ltd. The evidence does go some way to show that the Titanic Quarter development is occupied by a number of businesses and organisations which themselves operate in a wide range of services.

74. Mr Baran submitted that the witness statements of Mr Nicholl states that leases have been entered into by his company whilst Mr Harvey states that the trade mark is used on all of his company's marketing material. He refers me to the comments of Mr Arnold Q.C's comments in *Extreme O-161-07*, and highlights the following statement:

"31...A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might have been destroyed in a fire. In such circumstances I do not see anything in either Directive, the 1994 Act or the 2000 Rules which would require the proprietor to adduce evidence from an external witness (which is not to say that it might not be advisable for the proprietor to do so)."

75. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

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

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

76. As indicated above, the registered proprietor’s evidence has come from Mr Harvey, Director of the registered proprietor and Executive Vice Chairman of the company said to use the mark with the consent of the registered proprietor and from Mr Nicholl, the latter company’s Financial Director. Both are in positions where they can be expected to have knowledge of the facts. No evidence has been filed and no submissions have been made, which indicate that it was not possible for either gentleman or their companies to produce any particular documentary evidence.

77. There can be no doubt from the evidence that Titanic Quarter Ltd has played a role in the development of the area known as Titanic Quarter as have a number of other companies or organisations. What evidence has been filed, however, makes generalised claims of use of the trade mark by Titanic Quarter Ltd or through third parties in relation to the services for which the trade mark is registered but is largely silent as to when, how or the extent to which any such use may have been made at any time and certainly within any of the relevant periods. There is no evidence from any of the third party businesses within the development that they have used the mark in relation to the services they provide whether with the consent of the registered proprietor or otherwise and there is nothing in the evidence which persuades me they have done so, particularly within the relevant periods. Whilst turnover figures have been provided, they have not been broken down in any way that allows me to assess the source of that turnover. In contrast, there is evidence that Titanic Quarter is used as the name of the development within a particular area of Belfast and that some third parties are located there. Those third parties provide a wide range of services but there is no evidence they use the mark in the provision of those services. Rather, they refer to TITANIC QUARTER as part of their addresses to help identify the location of their premises within the city of Belfast. Such use is not consistent with the essential function of a trade mark nor does any such use maintain or create an outlet for the services or a share in the particular market concerned.

78. In all the circumstances and taking the evidence as a whole, I find that the registered proprietor has not shown that it has made genuine use of the mark or that such use has been made by others with its consent in relation to any of the services for which the mark is registered within any of the relevant periods. That being the case, the application for cancellation of the registration on the grounds of its non-use under section 46(1) of the Act succeeds in full.

Summary

79. The application for cancellation of registration No 2201115 succeeds in full and, subject to any successful appeal, it will be revoked from 26 July 2008 under the provisions of section 46(1)(a) of the Act.

Costs

80. The applicant has been successful and is entitled to an award of costs in its favour. At the hearing, Mr Longstaff requested costs off the scale to reflect the extra effort and expense caused by the registered proprietor's late applications to file evidence and transfer proceedings to IPEC. He submitted that the lateness of the requests meant that it had not had sufficient time to prepare a schedule of costs and asked for time to do so.

81. I allow a period of two weeks for the filing of a schedule of costs. Once received, I will issue a supplementary decision on costs. The period for appeal against this decision will run from the date I issue that supplementary decision.

Dated this 8th day of March 2016

**Ann Corbett
For the Registrar
The Comptroller-General**