

BL O/0443/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK REGISTRATION

NO. UK00917155003

FOR THE TRADE MARK:



AND

IN THE MATTER OF TRADE MARK REGISTRATION

NO. UK00916422354

FOR THE TRADE MARK:

PODIUM INVESTMENT

IN THE NAME OF PODIUM INVESTMENT

AND

APPLICATIONS CA000506528 AND CA000506527, RESPECTIVELY

BY LENDLEASE DIGITAL AUSTRALIA PTY LIMITED

TO REVOKE THE AFORESAID REGISTRATIONS FOR NON-USE

Background and pleadings

1. UK00917155003 and UK00916422354 (“the contested marks”)¹ stand registered in the name of PODIUM INVESTMENT (“the proprietor”).

2. The contested marks are as follows:

UK00917155003 (“the figurative mark”)



Filing date: 30 August 2017

Date of entry in register: 17 April 2018

Class 35: Advertising in the field of real estate and building; Auctioneering of property; Organisation and management of investment undertakings for construction and/or preparation of residential and non-residential buildings for sale, rental and leasing; Assistance in the management of real estate undertakings for development, sale, leasing and lending purposes; Organisation of trade fairs, exhibitions and promotions in the field of real estate affairs; Organisation of tenders on markets for trading in land, real estate, usable floor space and residential premises, rental of advertising space.

Class 36: Brokerage relating to purchasing, sale and rental of real estate; Real estate management; Organisation and management of funding for investment undertakings consisting in the construction and/or preparation of residential and non-residential buildings for sale; Rental,

¹ The contested marks were initially registered at the European Union Intellectual Property Office (EUIPO). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the contested marks being registered as EUTMs, at the end of the Implementation Period, they were automatically converted to comparable UK trade marks. The comparable UK marks are now recorded on the UK trade mark register and have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain.

lending, real estate management, brokerage relating to the purchase, sale and leasing of buildings, premises and usable floor space, real estate appraisal, rental and/or leasing of real estate, residential premises and usable floor space; Administration of real estate, premises and usable floor space, consultancy relating to the management and administration of residential buildings and housing estates; Real estate agencies, real estate insurance, leasing of real estate, real estate investment; Information in the field of real estate; Advice on real estate management.

Class 37: Building construction; Repair, upkeep and maintenance of buildings; Plumbing and gas and water installation; Maintenance of plumbing; Maintenance and repair of utilities in buildings; Assembling [installation] of building framework; Electrical installation services; Maintenance and repair of gas and electricity installations; Installation of building automation equipment; Installation of door openers; Installation of security and safety equipment; Installation of apparatus for ventilating; Installation of security systems; Installation of lighting systems; Installation of sanitary apparatus; Installation of apparatus for air-conditioning; Installation of washroom apparatus; Retrofitting of ventilating installations in buildings; Retrofitting of air conditioning installations in buildings; Retrofitting of heating installations in buildings; Fire alarm installation and repair; Maintenance of fire alarm installations; Maintenance and repair services relating to automatic door equipment; Installation of fixtures and fittings for buildings; Wiring of buildings for telecommunication transmission; Installation of building scaffolds, working and building platforms; Beneath ground construction work relating to plumbing; Advisory services relating to the installation of building automation equipment; Advisory services relating to the installation of security and safety equipment; Installation of insulating materials in buildings, roofs and structures; Installation of computer, telecommunications and ICT systems, apparatus and equipment for use in building construction and architecture; Construction and maintenance of roadways; Laying of paving; Laying of asphalt; Ground levelling and

soil compaction; Excavation; Demolition of buildings, Completion of building works, Rental of construction and building equipment, Construction supervision services, Building of fair stalls and shops; Construction information; Building consultancy; Building construction information; Plant maintenance.

Class 42: Design in the field of building construction, city planning and technology; Architectural consultation services, Architecture and interior design, Architectural consultation; inspection of buildings; Technical supervision and inspection; Construction supervision of industrial installations; Drawing up energy performance certificates and energy auditing in the field of building construction; Design and development of information technology for buildings; Monitoring of events which influence the environment within buildings; Monitoring of activities which influence the environment within buildings; Design of controlled environmental buildings; Measuring the environment within buildings; Recording data relating to energy consumption in buildings; Professional consultancy relating to energy efficiency in buildings; Scientific and technical research; Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture; Installation of computer software for use in building construction and architecture.

UK00916422354 (“the word-only mark”)

PODIUM INVESTMENT

Filing date: 02 March 2017

Date of entry in register: 08 January 2018

Class 35: Advertising in the field of real estate and building; Auctioneering of property; Organisation and management of investment undertakings for construction and/or preparation of residential and non-residential buildings for sale, rental and leasing; Assistance in the management of real estate undertakings for development, sale, leasing and lending

purposes; Organisation of trade fairs, exhibitions and promotions in the field of real estate affairs; Organisation of tenders on markets for trading in land, real estate, usable floor space and residential premises, rental of advertising space.

Class 36: Brokerage relating to purchasing, sale and rental of real estate; Real estate management; Organisation and management of funding for investment undertakings consisting in the construction and/or preparation of residential and non-residential buildings for sale; Rental, lending, real estate management, brokerage relating to the purchase, sale and leasing of buildings, premises and usable floor space, real estate appraisal, rental and/or leasing of real estate, residential premises and usable floor space; Administration of real estate, premises and usable floor space, consultancy relating to the management and administration of residential buildings and housing estates; Real estate agencies, real estate insurance, leasing of real estate, real estate investment; Information in the field of real estate; Advice on real estate management.

Class 37: Construction services; Repair, upkeep and maintenance of buildings; Plumbing and gas and water installation; Maintenance of plumbing; Maintenance and repair of utilities in buildings; Assembling [installation] of building framework; Electrical installation services; Maintenance and repair of gas and electricity installations; Installation of building automation equipment; Installation of door openers; Installation of security and safety equipment; Installation of apparatus for ventilating; Installation of security systems; Installation of lighting systems; Installation of sanitary apparatus; Installation of apparatus for air-conditioning; Installation of washroom apparatus; Retrofitting of ventilating installations in buildings; Retrofitting of air conditioning installations in buildings; Retrofitting of heating installations in buildings; Fire alarm installation and repair; Maintenance of fire alarm installations; Maintenance and repair services relating to automatic door equipment; Installation of fixtures and fittings for buildings; Wiring of buildings for

telecommunication transmission; Installation of building scaffolds, working and building platforms; Beneath ground construction work relating to plumbing; Advisory services relating to the installation of building automation equipment; Advisory services relating to the installation of security and safety equipment; Installation of insulating materials in buildings, roofs and structures; Installation of computer, telecommunications and ICT systems, apparatus and equipment for use in building construction and architecture; Construction and maintenance of roadways; Laying of paving; Laying of asphalt; Ground levelling and soil compaction; Excavation services; Demolition of buildings, Completion of building works, Rental of construction and building equipment, Construction supervision services, Building of fair stalls and shops; Construction information; Building consultancy; Building construction information; Plant maintenance.

Class 42: Design in the field of building construction, city planning and technology; Building construction advisory services, architecture and interior design, architectural consultation; inspection of buildings; Technical supervision and inspection; Construction supervision of industrial installations; Drawing up energy performance certificates and energy auditing in the field of building construction; Design and development of information technology for buildings; Monitoring of events which influence the environment within buildings; Monitoring of activities which influence the environment within buildings; Design of controlled environmental buildings; Measuring the environment within buildings; Recording data relating to energy consumption in buildings; Professional consultancy relating to energy efficiency in buildings; Scientific and technical research; Design and development of computer, telecommunications and ICT hardware, apparatus, systems and software for use in building construction and architecture; Installation of computer software for use in building construction and architecture.

3. On 18 September 2023, Lendlease Digital Australia Pty Limited (“the cancellation applicant”) applied to revoke the contested marks in accordance with sections

46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”).² Revocation is sought in respect of the specifications in their entirety. The cancellation applicant alleges that the registered proprietor has not used the contested marks in the United Kingdom within the following five-year periods:

The figurative mark

- (i) Following the date of completion of the registration process, i.e. 18 April 2018 to 17 April 2023 (‘the first relevant period for the figurative mark’). The earliest possible date from which the contested mark may be revoked is **18 April 2023**.
- (ii) 18 September 2018 to 17 September 2023 (‘the second relevant period for the figurative mark’). The earliest possible date from which the contested mark may be revoked is **18 September 2023**.

The word-only mark

- (i) Following the date of completion of the registration process, i.e. 09 January 2018 to 08 January 2023 (‘the first relevant period for the word-only mark’). The earliest possible date from which the contested mark may be revoked is **09 January 2023**.
 - (ii) 18 September 2018 to 17 September 2023 (‘the second relevant period for the word-only mark’). The earliest possible date from which the contested mark may be revoked is **18 September 2023**.
4. The registered proprietor filed defences and counterstatements in which it denies the claims against it in their entirety. The pleading is the same for each action; the

² The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

registered proprietor states that it has made genuine use of the contested marks, for all of the services covered by the registrations, within all of the relevant periods.

5. The cancellation applicant is represented by Lewis Silkin LLP and the registered proprietor is represented by Haseltine Lake Kempner LLP.
6. The registered proprietor filed evidence. This will be summarised to the extent that it is considered appropriate. No hearing was requested, however the registered proprietor filed submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers filed.

Evidence

7. The proprietor's evidence is in the form of the following two witness statements:
 - Wojciech Dobrzański, the President of the Management Board of Podium Investment,³ dated 25 April 2024, together with exhibits WD01-25.
 - Anna Kurpiewska-Welenc, of JWP Patent & Trademark Attorneys of Poland, dated 28 May 2024, together with exhibits AK-W01-02.
8. Mr Dobrzański's evidence seeks to demonstrate that the contested marks have been put to genuine use throughout the relevant 5-year periods.
9. Ms Kurpiewska-Welenc's evidence provides a certified translation of Mr Dobrzański's witness statement.
10. I have given due consideration to all of the documents and will refer to the evidence to the extent it is necessary in my decision.

DECISION

³ Mr Dobrzański has held this position since 27 April 2018

11. Section 46 of the Act states:

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

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

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

(c) [...]

(d) [...]

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

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

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations

for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

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

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

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

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.” 20.

12. Section 100 of the Act states:

“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.”

13. Given that the contested marks are comparable marks, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, the proprietor may rely upon use of those marks in the EU (including the UK) for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

14. A finding of genuine use during the latter relevant periods will be sufficient to avoid revocation of the marks under section 46(1)(b), and, by virtue of section 46(3), section 46(1)(a). Provided that such use is deemed to be genuine use, this will be the case even if the evidence in relation to the earliest periods is deemed insufficient.

Relevant case law

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

16. In *Awareness Limited v Plymouth City Council*,⁴ Mr Daniel Alexander, QC (as he then was) sitting as the Appointed Person said:

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

...

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the

⁴ Case BL O/236/13

tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

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

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*,⁵ Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

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

⁵ Case BL O/404/13,

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

Form of the marks

19. Section 46(2) of the Act states that:

“... use of a trade mark includes use in a form (“the variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it is registered...”

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

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

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

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17

M & K v EUIPO, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

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

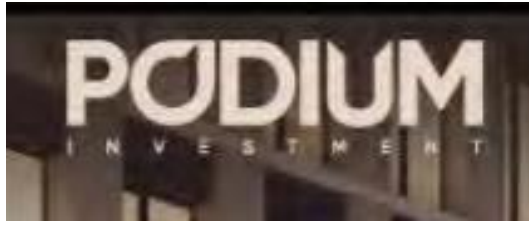
21. The contested marks are registered for the word-only mark **PODIUM**

INVESTMENT and the figurative mark



. I note that the evidence shows use of the word-only mark and the figurative mark but, also, in the following forms shown below:

i)



ii)



22. First addressing the proprietor's word-only mark, this mark is protected for use in any standard typeface or in either upper case, lower case or any customary combination of the two. In my view, this covers use of the words "PODIUM INVESTMENT" as presented in the above examples. As for the device element at the beginning of example ii, I do not consider that its addition takes away from the fact that it is the words 'PODIUM INVESTMENT' that remain the primary indicator of origin for the mark. On this point, I refer to the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 wherein the CJEU set out that use of a mark generally encompasses both its independent use and its use as part of another mark, so long as it continues to be perceived as indicative of the origin of the goods/services at issue. This is the case here and, therefore, I find that the above use in examples i and ii is use of the opponent's mark as registered.

23. As for the figurative mark, I find that the word element "PODIUM INVESTMENT" is the main distinctive element in the mark. The examples above also contain the distinctive elements "PODIUM INVESTMENT", and I find that the figurative variants shown above have minimal impact on the mark's distinctive character. I, therefore, find the examples above to be acceptable variants of the proprietor's figurative mark.

Evidence of use

24. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

25. The evidence provided relates jointly to the figurative mark and the word mark and I will, therefore, consider the marks in tandem.

26. I note the following from the proprietor's evidence by way of Mr Dobrzański's witness statement and exhibits WD01-WD25:

- The proprietor claims that they specialise in the construction of modern A-class office buildings with the use of innovative architectural and technical solutions. They go on to state that they have been involved in numerous large scale building projects and have received critical acclaim for its design and construction of these projects.
- The examples of building projects undertaken by the proprietor include the building of the Opel car showroom in Krakow, the Euromarket Office Centre in Krakow, the BMW car showroom in Krakow and Podium Park in Krakow. Exhibit WD01 includes extracts from the proprietor's website displaying a timeline of these building projects. I note that the Podium Park project is the only project that falls within the relevant dates. The proprietor explains that Podium Park is a modern complex consisting of three interconnected 11 story office buildings. Design of Podium Park began in 2015, and construction began in 2016.
- Turnover figures have been provided by the proprietor and are shown below:

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Financial Year	Total revenue: PLN	Conversion to GBP (approx.)⁷
Jan-Oct 2023	7, 883, 295	1, 568, 184
2022	7, 965, 287	1, 584, 494
2021	9, 360, 495	1, 862, 036
2020	134, 681 936	26, 791, 604
2019	4, 091, 362	813, 874
2018	976, 413	194, 232

- The proprietor does not provide any breakdown as to EU use prior to IP Completion Day or any reference to UK use from after that date. However, the proprietor claims that they predominantly operate in Poland.
- The figures provided above do not give a breakdown of sales in relation to the different type of services provided under the marks for which use is claimed, however exhibit WD03 includes a selection of invoices all bearing the word mark “Podium Investment”. I have set out the pertinent details from the invoices in the following table:

Invoice date of sale	Customer name and location	Amount due (EUR)	Services
31/01/2020	Podium Investment Sp. z.o.o. Krakow	97,369	Construction works- Building C, Podium Park under the agreement for construction works of 18 December 2019 for January 2020

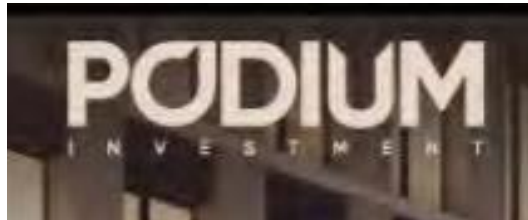
⁷ As per my own conversions conducted on www.xe.com on 14 May 2025

31/01/2020	Podium Investment Sp. z.o.o. Krakow	63,839	Soft costs for Building C Podium Park under the agreement for construction works of 18 December 2019 for January 2020
29/02/2020	Podium Park sp. z.o.o. Warsaw	63,331	Soft costs for Building C Podium Park under the agreement for construction works of 18 December 2019 for February 2020
29/02/2020	Podium Park sp. z.o.o. Warsaw	238,951	Construction works- Building C Podium Park under the agreement for construction works of 18 December 2019 for February 2020
31/03/2020	Podium Park sp. z.o.o. Warsaw	546,468	Construction works- Building C Podium Park under the

			agreement for construction works of 18 December 2019 for March 2020
30/04/2020	Podium Park sp. z.o.o. Warsaw	177,296	Construction works- Building C, Podium Park under the agreement for construction works of 18 December 2019 for April 2020

- Several international companies have leased office space within Podium Park, including Ailleron S.A, Heineken Global Shared Services and British company Revolut. Articles have been included in exhibit WD13 regarding Heineken's tenancy at Podium Park, and a press release in relation to Revolut moving its service centre to Podium Park. Although the article about Heineken is dated after IP Completion Day, and is in relation to use outside of the UK, the press release in relation to Revolut is dated 20 March 2019. I note that the article states that Podium Park is implemented by Podium Investment.
- It is further explained that, in December 2019, the entire complex of properties on which the Podium Park project was carried out was acquired by Globalworth for €134 million. The proprietor states that, on the basis of this agreement, they were responsible for the design, construction, finishing and leasing of investment projects. An article from Dentons, dated 3 January 2020, is exhibited at WD14 and states that "Dentons and Marcin Imiolek Law Firm jointly advised Podium Investment Polska, a development company located in Krakow, on the €134 million sale of Podium Park."

- Exhibit WD10 displays printouts from the proprietor's website ('podiuminvestment.pl') from the Wayback Machine Archive. The printouts are dated 29 December 2019, 19 December 2021 and 19 October 2019. The mark shown on the website is reproduced below:



- The website claims, "We are a pioneer real estate" and describes itself as "A developer with a vision". I note that no data or information have been provided to show the website's user traffic over any of the relevant periods, so I am unable to derive any clear information as to how many users were exposed to the mark in the relevant territory during the relevant periods.
- In 2018, Podium Park received a BREEAM award. The proprietor describes BREEAM as the world's leading and longest running established method of assessing, rating and certifying the sustainability of buildings. An extract of the 2018 BREEAM awards guide is shown as exhibit WD16. The awards guide names Podium Investment as the developer of Podium Park, and I further note that Podium Investment is shown as one of the sponsors of the awards with the following information displayed:

Podium Investment is a Polish developer, focusing on creating buildings that are distinguished by their architecture, with above-standard ecological solutions and using innovative technologies. In Podium's portfolio you will find a modern, A-class office buildings and a BMW showroom. At present time, Podium are realising a complex of offices, Podium Park in Krakow, which is going to introduce a new value to the office buildings market in Europe. The ambition is to create the most welcoming work environment for employees.
www.podiuminvestment.pl



- In relation to advertising and promotional activities, the proprietor claims that its construction of development projects serves as its main source of advertising

and marketing. They assert that, given the huge projects that have been developed by the proprietor, the general public in Poland, and other European countries, are aware of the proprietor and the services provided under the marks. However, the proprietor does not further elaborate on this point or produce any advertising expenditure figures.

- The proprietor uses branding agencies to design and update their logos and websites. They have commissioned a brand book to ensure that use of the marks is consistent. A copy of the brand book has been included in exhibit WD04 and a sample is reproduced below. Although not stated, I note that the brand book is dated 2018:



- Appended at exhibit WD05 are invoices from the branding agencies for work undertaken in respect of the brand book and website design. The invoices are all dated 2018.

- The proprietor states that they have sponsored numerous events in Europe. The events highlighted are: Expo Real 2016, held in Germany; Aspire Industry Summit 2018, held in Poland, on 15 May 2018; and Practical Sports Psychology National Conference, May 2023, held in Poland. Evidence of the proprietor's attendance at these events is evidenced at exhibits WD17 to WD23. The first event mentioned fell before any of the relevant dates. The third event falls after IP Completion Day, and does not pertain to use in the UK. In respect of the Aspire Industry Summit, this falls within the relevant periods, and the proprietor has provided printouts of a brochure for the event, which includes the proprietor's figurative mark. Also provided, are invoices relating to their sponsorship of this event at exhibit WD23.
- An additional sponsorship that the proprietor highlights is the proprietor's son, who is a Formula 4 racing driver for the Spanish team "Technicar". It is claimed that sponsorship commenced in February 2022, and images of the proprietor's son and his racing car displaying the figurative mark are provided at exhibits WD08 and WD24. The proprietor states that there are UK competitions being planned which will further expose the proprietor and its marks to a UK audience. However, this evidence does not relate to use or promotion during the relevant period; and, whilst sponsorship commenced in 2022, it is unclear what territory this relates to.
- The proprietor has provided a selection of news articles, featuring Podium Investment, at exhibit WD25. However, these are dated 2017 and 2024, which fall outside of all the relevant periods.

Sufficient use

27. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the services at issue in the relevant territory during the relevant five-year periods. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the services for which use has been shown;
- the nature of those services and the market(s) for them; and
- the geographical extent of the use shown.

28. I have carefully considered the evidence provided by the opponent and whether this meets the requirements for genuine use as per *easyGroup*, set out earlier in this decision. I am also mindful of the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails to “show”, and what might reasonably have been conclusively shown. As I shall come to explain, I find there are several shortcomings in the evidence.

29. Whilst I note the proprietor’s claims that it has used its mark in relation to all its services as registered, I remind myself that, where broad statements purporting to verify use over a wide range of services are supported by a much narrower range of use in evidence, this should be considered more critically. In that respect, I note that the proprietor claims that they were responsible for the design, construction, finishing and leasing of investment projects in 2019, following the acquisition of Podium Park by Globalworth. However, there is no evidence provided to support this claim, such as lease agreements or architectural designs. The article provided at exhibit WD14 provides very little detail about the acquisition itself and the services that have been provided by the proprietor under its contested marks. Further, as the turnover figures have not been broken down per category of services, I am unable to ascertain to which services the turnover figures relate.

30. The proprietor did not clarify the position it occupies in the relevant market. Whilst I am not particularly familiar with the market for construction/real estate services, I believe this is likely to be worth millions, or even billions of pounds. I find that the sales figures, albeit significant, are not exceptionally large. Nonetheless, to determine whether there has been genuine use, I remind myself that the test is not whether the use has been quantitatively significant, but whether there has been real commercial exploitation of the mark, intended to create and preserve an outlet for the services which are sold under or in relation to that mark. I also remind myself

that the assessment of genuine use is not simply about sales figures, and I must consider them alongside other evidence of use.⁸

31. I appreciate that some parts of the evidence are undated, imprecise or irrelevant. However, the proprietor has provided several examples of use of the contested marks, particularly in relation to its Podium Park project. This is exemplified by the invoices provided, the articles dated within the relevant periods and the BREEAM award that the proprietor received for the project. I further note that the proprietor's sponsorship of the Aspire Industry Summit in 2018 would have led to some exposure of the contested marks during the relevant period, although, without any further clarification from the proprietor, the extent of the exposure to the relevant public during the relevant period is unclear.

32. Taking all of the above into account and bearing in mind that it is important to consider the evidential picture as a whole, not just whether each individual piece of evidence shows use on its own, I consider the evidence provided, in spite of its shortcomings, is sufficient to show genuine use of the contested marks to maintain or create a share in the market for some of the services as specified below.

Fair Specification

33. In respect of the framing of a fair specification, I remind myself of the case of *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, ("*Titanic Spa*") wherein Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

⁸ Case T-467/20 *Industria de Diseño Textil, SA (Inditex) v EUIPO*, EU:T:2021:842.

34. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, the Court of Appeal set out the proper approach to partial revocation, as follows:

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

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

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

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

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

of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

35. I keep in mind that it is not for the proprietor to show use of each individual term relied upon, whilst I am also mindful not to allow too wide a protection. Having carefully considered the proprietor’s evidence, and having due regard to the relevant case law, including how the average consumer would perceive the services for which use has been shown, I find it appropriate for the proprietor to retain: *Building construction* in class 37, for its figurative mark; and *construction services* in class 37, for its word-only mark. I say this keeping in mind that the invoices provided are all for construction services, and that the overall narrative of the evidence points towards the proprietor specialising in construction.

36. I do not consider the evidence sufficient to support the retention of any of the remaining services in 35, 36, 37 and 42, for either contested mark, because of the reasons I have outlined in paragraph 24 of this decision, and the fact that there are no examples of the proprietor using its marks in relation to these services.

CONCLUSION

37. The application for revocation on grounds of non-use against the proprietor’s figurative mark succeeds under sections 46(1)(a) and 46(1)(b) for: all of its services in classes 35, 36 and 42; and some of its services in class 37. The figurative mark is revoked with effect from the earliest date requested, being **18 April 2023**.

38. The figurative mark shall remain registered in respect of ***building construction*** in class 37.

39. The application for revocation on grounds of non-use against the proprietor’s word-only mark succeeds under sections 46(1)(a) and 46(1)(b) for: all of its services in classes 35, 36 and 42; and some of its services in class 37. The figurative mark is revoked with effect from the earliest date requested, being **09 January 2023**.

40. The figurative mark shall remain registered in respect of **construction services** in class 37.

COSTS

41. In these consolidated proceedings, both parties have enjoyed a share of success, but the applicant for revocation significantly more-so than the proprietor. Further, whilst the proprietor filed evidence and submissions, the cancellation applicant did not. On that basis, I award an amount for “considering the proprietor’s evidence” below the scale as set out in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant for revocation the sum of **£1170** as a contribution towards the cost of the proceedings, including a 10% reduction on costs to account for the proprietor’s partial success:

Official fee (x2 @ £200):	£400
Preparing a statement and considering the other side’s statement (x2 @ £250):	£500
Considering the proprietor’s evidence:	£400
Sub-total:	£1,300
Less 10%	-£130
Total:	£1,170

42. I therefore order PODIUM INVESTMENT to pay Lendlease Digital Australia Pty Limited the sum of £1170. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2025

Catrin Williams
For the Registrar