

## TRADE MARKS ACT, 1996

### Decision in Hearing

In the matter of an application for the revocation of the registration of Trade Mark No. 214878 and in the matter of the registered Proprietor's opposition thereto.

PROPERTY RENAISSANCE LIMITED

Applicant for Revocation

TITANIC TRADEMARK LIMITED

Proprietor

#### **The registered trade mark**

1. Titanic Trademark Limited (hereinafter "the Proprietor") of Queens Island, Belfast BT3 9DU, United Kingdom, is the registered Proprietor of the trade mark TITANIC QUARTER. The mark is registered under No. 214878 in respect of "*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*" in Class 36; "*theme parks; amusements; educational services; provision of recreation activities and facilities; provision of cultural activities and facilities; publication of text; provision of exhibitions; production of shows*" in Class 41 and "*provision of accommodation; hotel services; provision of food and drink; restaurant services; cafes; snack bars; fast food bars; scientific and industrial research; computer software design services for the creation, storage and dissemination of information*" in Class 42.
2. The application for registration of the mark was filed under the Trade Marks Act, 1996 (the "Act") with an application date of 24 June 1999, which is deemed to be the date of registration. Publication of the registration of the mark appeared in Journal No. 1955 on 13 November 2002.

#### **The application for revocation**

3. On 19 January, 2015 Property Renaissance Limited of Low Westwood Lane, Huddersfield HD7 5UN, United Kingdom, (whereinafter "the Applicant") made an application for the revocation of the registration pursuant to the provisions of Section 51 of Act. The application was grounded on Sections 51(1)(a) and 51(1)(b) of the Act which

provide that the registration of a trade mark can be revoked if, within the period of five years following the date of publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the Proprietor, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use; or on the grounds that any use made of the mark has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.

### **Notice of Opposition**

4. On 11 August, 2015 the Proprietor filed a Notice of Opposition to the application together with evidence supporting its claims of use of the mark; such evidence consisting of a Statutory Declaration, dated 7 August 2015, of John Nicholl, Financial Director of Titanic Quarter Limited, of Titanic House, Queens Road, Belfast, BT3 9DT, United Kingdom, and six accompanying exhibits marked “JN1” to “JN6”.
  
5. In his Statutory Declaration Mr. Nicholl states that his company and Titanic Trademark Limited are wholly-owned subsidiaries of the company Ivy Wood Properties Limited. He says his company uses the trade mark TITANTIC QUARTER with the knowledge and consent of Titanic Trademark Limited. He says his company is behind the well-known Titanic Quarter development in Belfast, named with reference to the area of Belfast in which the famous RMS Titanic was built. He includes in his Statutory Declaration the Wikipedia entry (as viewed on 14 May 2015) which records that Titanic Quarter is:  
  

*“a large-scale waterfront regeneration, 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 the city's, most famous product RMS Titanic”*
  
6. Mr. Nicholl states the Titanic Quarter 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 it 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. He says the Titanic Quarter is promoted by the Regeneration Investment Organisation (RIO), part of UK Trade and Investment.

7. Mr. Nicholl attaches at Exhibit JN1 the “About Us” page of Titanic Quarter Limited website and extracts from the Media Village Masterplan. At Exhibit JN2 he attaches further information, including the relevant Wikipedia entry and press cuttings relating to the Titanic Quarter development.
8. Mr. Nicholl attaches at Exhibit JN3 a copy of a brochure relating to the Titanic Quarter development intended for retailers interested in taking space and individuals wishing to live in the development. He states that it is clear from the aforementioned evidence that the TITANIC QUARTER trade mark has been put to genuine use in relation to “*leasing of real estate; real estate management; real estate development services; insurance and financial services in connection with real estate affairs*”. He says that, although the Exhibits are current, these services have been provided by his company throughout the period from January 2010 to January 2015.
9. Mr. Nicholl states that each year around 1 million visitors come to the Titanic Quarter development for its entertainment facilities which include:
  - Titanic Belfast (opened in March 2012, which includes museum galleries).
  - Titanic Heritage, which includes the ship 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, the dock and the pumphouse.
  - T13 – an urban sports park offering BMX biking, skateboarding, urban art, DJ sessions, free running, breakdancing, music events and art exhibitions.
  - The Odyssey Arena, opened in 2000, which hosts musical and theatre performances, exhibitions and sports events.
  - Belfast Harbour Marina.
10. He attaches at Exhibit JN4 print-outs from the Titanic Quarter website giving information about these attractions. He states these clearly demonstrate the trade mark TITANIC QUARTER has been put to use in relation to “*entertainment services; theme parks; business parks; amusements; educational services; information services; film and video production; production of sound recordings; provision of recreation activities and facilities; provision of cultural activities and facilities; provision of exhibitions; production of shows.*”

11. Mr. Nicholl states his company has leased some of the retail outlets in the Titanic Quarter development to restaurants and hotels. He provides details of these lettings at Exhibit JN5, which consists of an extract from the Titanic Quarter website showing the “Eating” and “Staying” venues located within the Titanic Quarter. He says these restaurants and hotels are promoted through his company’s website as amenities of the Titanic Quarter development and states that from this it can be seen that the trade mark TITANIC QUARTER has been used in relation to “*provision of accommodation; hotel services; provision of food and drink; restaurant services; cafes; snack bars; fast food bars.*”
12. Mr. Nicholl states the TITANTIC QUARTER brand and development was first publicised in around 1998. He says the annual turnover associated with the TITANIC QUARTER brand was £7.6 million in 2014, £8.8 million in 2013 and £10.1 million in 2012. The annual expenditure on advertising and promotion of the Titanic Quarter development is around £150,000 per annum.
13. He provides at Exhibit JN6 a print-out from the Google Analytics report for the website [www.titanic-quarter.com](http://www.titanic-quarter.com) for the period 1 January 2014 to 31 December 2014. This shows that during the period nearly 77,000 audience sessions were opened. Of these more than 31,000 – or just over 40% - were from computers with the language set to ‘EN-GB’, that is, United Kingdom English as opposed to US English. He says this suggests to him that around 40% of potential customers establishing sessions with his company’s website were based in the United Kingdom and Ireland.
14. Mr. Nicholl states the Proprietor is also linked to Titanic Belfast, a visitor attraction within the Titanic Quarter. It is the most popular visitor attraction in Northern Ireland and has welcomed over 2.5 million people from over 165 countries since opening in 2012. Turnover for Titanic Belfast for the 12 months ending 31 March 2015 was £11.8 million, for the year ending 31 March 2014 it was £11.1 million and for the year ending 31 March 2013 it was £13.6 million. Advertising spend was circa. £650,000 per annum. Titanic Belfast attracted around 850,000 visitors in the year 2012 – 2013. It won the European Group Travel Award for “Best Group Visitor Attraction in Europe” in 2015 and was praised by UK Prime Minister David Cameron as “*an absolutely brilliant visitor attraction...and not only for people across our United Kingdom, but for people from across Europe and around the world.*”

15. He says the Proprietor's fellow group company Titanic Belfast Limited is the registered Proprietor of Community Trade Mark number 9121741 TITANIC BELFAST for goods and services in Classes 16, 18, 21, 25, 36, 37, 41 and 43. He states the Proprietor had and continues to have a longstanding association with a brand having TITANIC as its major component, resonant with the associations between the Belfast location and the RMS Titanic that was built there. That longstanding association of the Proprietors with TITANIC-based branding has been brought to the attention of millions of members of the EU public over the course of several years. He completes his declaration by stating the TITANIC QUARTER brand is well-known in relation to the facilities and services provided in Belfast not only to those who live in Northern Ireland but throughout the island of Ireland.

#### **Further Evidence**

16. The Controller set a date for the Hearing of October 2015, but following requests from the parties the Hearing was postponed. In one of these requests the Proprietor mentioned parallel proceedings and counter-proceedings between the parties that were ongoing before the UK Intellectual Property Office (UKIPO) and the then Office for Harmonisation in the Internal Market (OHIM). There then followed a request by the Proprietor to file additional evidence, which the Controller granted.

17. The additional evidence furnished by the Proprietor consists of a second Statutory Declaration, dated 22 April 2016, of John Nicholl and forty-nine accompanying exhibits marked "JN7" to "JN55". Mr. Nicholl's speaks at length about the use of the mark in his declaration and provides material depicting the mark in the numerous exhibits attached thereto. I would summarise this evidence as consisting of details of promotional activities, brochures (undated), prospectuses (undated), advertising materials, media coverage, newsletters, invoices for room hire, details of sporting and cultural activities hosted in Titanic Quarter, details of leases of property and a general commentary on the activities that are or have been connected with Titanic Quarter. The vast bulk of the material concerns business activities and use of the TITANIC QUARTER mark within the United Kingdom, and accordingly, I had some difficulty identifying the material that is relevant and specific to the proceedings at hand which concern the use of the mark in Ireland.

18. On 2 June, 2016 the Trade Mark Agents representing the Applicant filed notice of its intention to refer at the Hearing to an enclosed decision, of the Hearing Officer in the UK,

in corresponding cancellation proceedings of UK Registration No. 22011145 TITANIC QUARTER, in which the Hearing Officer decided the application for cancellation of the registration succeeded in full.

### **The Hearing**

19. At the Hearing the Applicant was represented by Mr. Seamus Doherty, Trade Mark Attorney of Tomkins & Co., and the Proprietor by Mr. Paul Coughlan BL, instructed by Paul Kelly, Trade Mark Attorney of FRKelly.

20. Mr. Doherty argued that the mark referred to in all the Proprietor's evidence is not the trade mark as registered in Ireland, namely TITANIC QUARTER (two words only) but relates to the trade mark depicted below, which contains a distinctive figurative element that puts some distance between it and the TITANIC QUARTER word mark. This, he argued, constitutes use in a form differing in elements that have the effect of altering the distinctive character of the registered mark.



As such, use of this mark does not demonstrate use of the mark as registered as this mark does not fall within the boundaries set by Section 51(2) of the Act to starve off an attack based on non-use and which would allow the mark to remain on the Register. I mention this line of attack for completeness sake, as it turned out to be moot as I found the mark was not used in Ireland, in any form, during the relevant period.

21. Mr. Doherty argued the evidence submitted by the Proprietor under Exhibits “JN1” to “JN6” only shows or provides information on the geographical location Titanic Quarter, which is the postal address of the businesses in the area. In both his declarations Mr. Nicholl provides lots of information about the Titanic Quarter development being a large-scale leisure and hospitality space in which a variety of services are offered, but none of it shows any genuine use of the trade mark for the goods and services for which the mark is registered.

22. He went through the other exhibits (“JN7” to “JN55”) in turn and argued that each and every piece of evidence either relates to information about the geographical area Titanic

Quarter or the Titanic Quarter development or was merely an extract from a website; or does not show genuine use of the mark; or that if use was shown it strictly relates to use in Northern Ireland; or that the material relates to events outside the relevant period for these proceedings. He argued none of it constitutes genuine use of the mark in the State.

23. Mr. Doherty argued that proof of genuine use must be established for Ireland. The evidence submitted by the Proprietor primarily relates to Northern Ireland which is a different jurisdiction. Practically the identical evidence was filed by the Proprietor to support use in relation to corresponding revocation action against their UK trade mark. In those parallel proceedings he noted that, despite the activities of the Proprietor of the UK TITANIC QUARTER trade mark being based in the United Kingdom, nonetheless the UKIPO revoked the registration in its entirety on the basis of non-use. In that case the UKIPO Hearing Officer found at paragraphs 77-78<sup>1</sup> as follows:

*“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.”*

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<sup>1</sup> Property Rebaissance Limited v. Titanic Trademark Limited, Decision O-127-16 of 8<sup>th</sup> March, 2016

24. For his part Mr. Coughlan argued the Applicant's case was based on the UKIPO finding that "It's not a trade mark it's an address". He maintained the Proprietor is a commercial venture that created the commercial product TITANTIC QUARTER. The TITANIC QUARTER product and TITANIC QUARTER trade mark is centred on building, working, trading and visiting businesses that use the TITANIC QUARTER brand.
25. Mr. Coughlan argued the mark is not like Stillorgan (a suburb of Dublin) which does not constitute a brand that attracts consumers. It is more like the Point Village (the Dublin Docklands regeneration project consisting of office, retail, leisure and living space) which possesses a definite and particular power of attraction. He argued there are often layers of branding surrounding goods and services and maintained TITANIC QUARTER was the umbrella trade mark under which all other activities exist. He directed me to the DANONE<sup>2</sup> appeal of a High Court decision to the Supreme Court. The High Court had found that use of the trade mark ESSENSIS had been unequivocally confined to referring to an identified ingredient of the yogurt as distinct from the yogurt itself and this did not amount to a genuine use of the trade mark within the meaning of the Act. The Supreme Court overturned the High Court decision to revoke the trade mark ESSENSIS, finding the High Court had applied an unduly narrow application of the principles relating to trade mark use. Mr. Coughlan suggested the factors identified in the Supreme Court decision, wherein the Supreme Court was satisfied that the use of the trade mark actually made in the Danone case is sufficient to meet the general criteria set out by the Court of Justice of the European Union (CJEU) in *Ansul*<sup>3</sup>, and are applicable in the instant case. In *Ansul* the CJEU stated:

*"37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the*

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<sup>2</sup> Campagnie Gervais Danone v. Glanbia Foods Society Limited IESC 36, [S.C. No. 141 of 2007] 19 May 2010

<sup>3</sup> *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439



*trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.*

...

*42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.*

*43. In the light of the foregoing considerations the reply to the first question must be that Article 12(1) of the Directive must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”*

26. Mr. Coughlan also argued there cannot be any serious suggestion that the Proprietor applied for the mark as a sham or to maintain it on the Register for improper reasons. He argued that use of the mark was not just internal use by the Proprietor, who is trading, selling and carrying on commercial activities under the mark. He maintained that during the relevant period the mark was constantly being advertised and used in respect of the services for which it is registered by, or with the consent of, the Proprietor.

27. I mentioned above that I had difficulty identifying what material in the 55 exhibits attached to Mr. Nicholl’s evidence relates to use of the TITANIC QUARTER mark in Ireland, so I asked Mr. Coughlan to assist me. He pointed to Exhibit “JN6” which contains a printout from Google Analytics showing that 40% of visits to the [www.titanicquarter.com](http://www.titanicquarter.com) website were from computers with the language set to United Kingdom English, suggesting that 40 % of potential customers establishing sessions with the website were based in the United Kingdom or Ireland.

28. He also directed me to paragraph 19 of the second Statutory Declaration of John Nicholl wherein he states the TITANIC QUARTER mark was used on his company's "*website, stationery, e-mail sign off, advertising and promotional material not only in Northern Ireland but throughout the Republic of Ireland*". He pointed to paragraph 30 of the same declaration wherein Mr. Nicholl says the guest list for the launch of the Titanic Quarter in 2007 at the MIPIM exhibition in Cannes, France included people from the Republic of Ireland. Also at paragraph 35 Mr. Nicholl speaks of visitors from the Republic of Ireland passing through the business lounges of Belfast City Airport who would have been exposed to advertisements in respect of the TITANIC QUARTER mark. He noted that at paragraph 37.8 there is a reference to a TITANIC QUARTER launch event in Dublin in January 2007.
29. Mr. Coughlan also pointed to paragraph 46 wherein Mr. Nicholl states that Google Analytics shows that between 2013 and 2014 there were 4,222 sessions to his company's website from computers in the Republic of Ireland. He directed me to paragraph 48 in which Mr. Nicholl states that a promotional brochure bearing the TITANIC QUARTER mark was handed out to potential customers in the UK, Ireland and Europe at conferences, events and meetings. Mr. Coughlan also identified paragraphs 54 and 55 wherein Mr. Nicholl speaks of TITANIC QUARTER advertisements in the Finance Dublin yearbook from 2009 to 2014 and on the Finance Dublin website, and provides publication circulation figures showing 2,000 copies of the yearbook were distributed in Ireland and that thousands of visitors to the website were from Ireland.
30. Lastly, Mr. Coughlan directed me to paragraphs 84 and 85 relating to the construction of a hotel as part of the TITANIC QUARTER development. The hotel was leased by Premier Inn in 2010 and a further three hotels were planned. The Prospectus for these additional hotels was circulated to a number of potential hotel operators in Ireland and elsewhere.
31. As well as the items identified by Mr. Coughlan I have found nothing else in the evidence to suggest the Proprietor may have made use of the trade mark TITANIC QUARTER in Ireland except a single invoice made out to a Dublin-based company.
32. In reply Mr. Doherty argued the evidence relied upon by the Proprietor, and the elements of it identified by Mr. Coughlan in response to my request for assistance in identifying

material specifically pointing to use of the mark in Ireland, does not actually show use of the mark. Mr. Doherty maintained the circumstances of this case were similar to the CANARY WHARF trade mark application before the UKIPO, which that office refused to register.

### **The law**

33. The relevant section of the Act is Section 51, which is written in the following terms:

*“(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 publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, 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;*

### **Decision**

34. The Proprietor’s TITANIC QUARTER trade mark is registered in respect of *“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”* in Class 36; *“theme parks; amusements; educational services; provision of recreation activities and facilities; provision of cultural activities and facilities; publication of text; provision of exhibitions; production of shows”* in Class 41 and *“provision of accommodation; hotel services; provision of food and drink; restaurant services; cafes; snack bars; fast food bars; scientific and industrial research; computer software design services for the creation, storage and dissemination of information”* in Class 42.

35. One of the primary grounds upon which the issue is contested is whether the TITANIC QUARTER is a trade mark or merely an address. While the Proprietor is keen to emphasise the TITANIC QUARTER brand, in its own evidence the Proprietor has provided ample examples of the term being used strictly in relation to a development or as a geographical location. There is nothing in the law that, in all circumstances, prohibits a location name from also being a trade mark in respect of particular goods or services. There are ample examples of this, including Waterford (for crystal) and Middleton (for whiskey). Therefore, there is no doubt in my mind that the TITANTIC QUARTER is

both an address and a brand that possesses the power of attraction, which is the fundamental *raison d'être* of trade marks.

36. Nonetheless, there are many questions to be considered in determining whether or not the TITANIC QUARTER trade mark should remain on the Register. I have already stated the brand has the power to attract; but does its power of attraction relate solely to the location name? Does the trade mark uniquely identify the Proprietor, or third parties authorised to use the mark by the Proprietor, as the trade source of services delivered under the mark? Have the services for which the mark is registered been delivered, within the relevant period, under the trade mark in Ireland by the Proprietor or with its consent? If use was made of the mark in Ireland during the relevant period, was it genuine use?

37. There is ample material emanating from the Court of Justice of the European Union (CJEU) to assist me in answering these questions. The CJEU has set out what is required in order to establish genuine use of a trade mark insofar as revocation proceedings are concerned. These include *Ansul*<sup>4</sup>, *La Mer*<sup>5</sup>, *Silberquelle*<sup>6</sup> and *Sunrider*<sup>7</sup> in which the following factors were identified as the criteria to be assessed by competent authorities:

- i. Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark. *Ansul* §35
- ii. 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
- iii. 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
- iv. 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

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<sup>4</sup> *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439

<sup>5</sup> *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

<sup>6</sup> *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759

<sup>7</sup> *Sunrider v Office for Harmonisation in the Internal Market* (C-416/04 P) [2006] E.C.R. I-4237

- v. 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* §18, §24-25; *Sunrider* §72
- vi. 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* §38-39; *La Mer* §22-23; *Sunrider* §70-71

38. Looking firstly at what the TITANIC QUARTER trade mark relates to. In my opinion it primarily refers to the location in Belfast that comprises lands once forming part of the Belfast docklands and ship-building area. The area was developed to house a mix of business, retail, residential and leisure units all within the location to be known as the Titanic Quarter. There can be no doubt that the Titanic Quarter location has earned a reputation as a desirable location in which to live, work and play. In his evidence at Exhibit “JN2” Mr. Nicholl relies on the following description (which he takes from Wikipedia) of Titanic Quarter as “*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, known until 1995 as Queen’s Island*”, clearly identifying the Titanic Quarter as a location, not a trade mark under which services are traded.

39. Nonetheless, I am satisfied there is also a secondary meaning which relates to use of the term TITANIC QUARTER as a brand associated with the Proprietor. In my opinion the Proprietor has used the TITANIC QUARTER trade mark in respect of “*leasing of real estate; real estate management; real estate development services; management of business parks;*” in Class 36. I am not concerned with the extent of such use of the mark

in the United Kingdom or whether that use can be considered genuine use. I am, however, concerned with the use of the mark in Ireland. No evidence was provided to show the Proprietor developed, owned or managed real estate in the State during the relevant period or had a single Irish customer who availed of these services during the relevant period. Therefore, I find there is no evidence to demonstrate the mark was used in Ireland for these services.

40. The mark is also registered in respect of “*insurance and financial services in connection with real estate affairs*” in Class 36. However, there is nothing to show the Proprietor has a single customer to which it supplied insurance and financial services in connection with real estate, in Ireland or anywhere else.

41. There is no evidence to point to any Irish businesses or individual having become customers of the Proprietor for any of the real estate, insurance or financial services offered under the TITANIC QUARTER mark save for a single invoice, dated 20 January 2015, to a Dublin-based company in respect of room hire and snacks. This single invoice does not demonstrate genuine use of the disputed mark in the State in respect of accommodation rental services. In any event the invoice is dated outside the relevant period and cannot be taken into account in these proceedings. I am satisfied the Proprietor has failed to prove any real commercial exploitation of the mark on the Irish market for real estate related services within the relevant period.

42. Turning to the other services for which the mark is registered. I can find no evidence of trade by the Proprietor or with its consent for these services under the trade mark TITANIC QUARTER in Northern Ireland, let alone the State. There are many businesses located in the Titanic Quarter area of Belfast that provide the likes of “*theme parks; amusements; educational services; provision of recreation activities and facilities; provision of cultural activities and facilities; publication of text; provision of exhibitions; production of shows*” services in Class 41 and “*accommodation; hotel services; provision of food and drink; restaurant services; cafes; snack bars; fast food bars; scientific and industrial research; computer software design services for the creation, storage and dissemination of information*” services in Class 42. However, there is no evidence the Proprietor is providing these services. Taking one example of which the Proprietor speaks; the hotel in the Titanic Quarter that is managed by the Premier Inn chain. The Proprietor does not provide the hotel or accommodation services delivered by the Premier

Inn, nor are they delivered under the TITANIC QUARTER trade mark. While the hotel may be referred to as the Premier Inn Belfast Titanic Quarter its use of the term Titanic Quarter relates solely to the location, not to the Proprietor's trade mark. Irrespective of the hotel's use of the term I am satisfied it is the Premier Inn brand that attracts consumers to the hotel not the trade mark TITANIC QUARTER.

43. In his evidence Mr. Nicholl attempts to identify the Titanic Quarter as a trade mark alone and maintains that the location of his company and the businesses trading under the TITANIC QUARTER trade mark is Queen's Island, Belfast not the Titanic Quarter, Belfast. This is an unsustainable argument as Mr. Nicholl also submitted evidence stating that until 1995 the location was known as Queen's Island, which strongly suggests the area became known under another name from 1995. The official postal address may still be Queen's Island, but I am in no doubt that the area in which the businesses are located is now known by all concerned as the Titanic Quarter. Furthermore, I am satisfied that if I addressed a letter to, say, the Premier Inn, Titanic Quarter, Belfast, the good people at the Royal Mail would deliver my correspondence to the addressee without any difficulty.
44. The Proprietor points to the launch in 2007 of the Titanic Quarter development in both Dublin and Cannes, to which guests from Ireland were invited, as evidence of use of the mark. However, I am satisfied that these launches were merely to seek backing from investors to assist with the regeneration and development of the lands to be known as the Titanic Quarter. Even if this was considered use of the mark these events took place way outside of the relevant period.
45. The Proprietor also advertised in the Finance Dublin yearbook for a number of years, but I view this as no more than advertising the Titanic Quarter location as an ideal area in which to invest and do business.
46. The Proprietor also argued that Irish citizens who passed through the business lounges of Belfast Airport would have been exposed to advertisements for the Titanic Quarter. But this does not constitute use of the mark in Ireland any more than Irish citizens encountering an advertisement for a particular trade mark in the business lounge of a London or any other UK airport would constitute use of the UK advertised mark in Ireland.

47. Another argument advanced by the Proprietor to demonstrate use of the mark concerns the handing out of brochures at “events”. But no specific and relevant details of these events, such as the nature, venue or date, was provided and, therefore, these events cannot be deemed use of the mark in Ireland during the period in question.
48. The Proprietor also claimed that the businesses located in the Titanic Quarter use the TITANIC QUARTER trade mark with its consent and deliver their services under that brand. I do not agree. There is no evidence to confirm or even suggest that businesses in the Titanic Quarter area of Belfast have sought or have been granted, or even need the permission of the Proprietor of the TITANIC QUARTER trade mark to use the term Titanic Quarter in respect of their businesses. The businesses operating in the Titanic Quarter area, other than the Proprietor itself, have their own standalone brands under which they trade and deliver their services. There is no evidence to suggest they use the term Titanic Quarter as anything other than a geographical indication. Their use of the term Titanic Quarter 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 relevant market for these services in the State.
49. Most tellingly there is zero evidence from any of the third party businesses within the Titanic Quarter that they use or have used the mark within the relevant period in relation to the services they provide in Northern Ireland let alone the State, whether with the Proprietor’s consent or otherwise.
50. The Proprietor points to financial evidence in support of its case in the form of turnover figures for the years 2012 through 2014. However, the figures represent the total turnover for the group of companies of which the Proprietor is a member, not the Proprietor’s turnover alone. There is no breakdown of the figures in terms of turnover generated under different revenue streams in terms of the diverse services provided by the group of companies as a whole. Also, there is no indication of the turnover resulting from trade under the TITANIC QUARTER trade mark in the State. Accordingly, the financial evidence that was submitted by the Proprietor does not assist its case. It only highlights the lack of any evidence that specifically relates to sales or commercial activity under the mark in Ireland. Therefore, I must conclude that these turnover figures do not indicate use of the mark in Ireland for any of the services for which the trade mark is registered.



51. In his evidence Mr. Nicholl states the Proprietor has connections or links with many attractions in the Titanic Quarter including such venues as Titanic Belfast (the renowned Titanic experience) and the Odyssey arena (a major concert and exhibition centre, which according to the Proprietor's own evidence opened in the year 2000, long before the first sod was turned on the Titanic Quarter development in 2006), though he fails to provide any explanation of what these connections or links are. He claims the services provided by these entities in the Titanic Quarter constitute delivery of the services under the TITANIC QUARTER trade mark. This theme continues throughout Mr. Nicholl's evidence. In summary he claims that any services delivered by any business located in the Titanic Quarter is being delivered under the TITANIC QUARTER trade mark with his company's authority.

52. Mr. Nicholl provides details about the Titanic Belfast attraction and highlights the success and popularity of it, including visitor numbers. There is no doubt that there have been many thousands of Irish visitors to this attraction and I am sure that many Irish citizens have also attended events in the Odyssey Arena, but there is no evidence to show the Proprietor is involved with, or has any stake in either operation. Both these two entities appear to be owned and operated by separate organisations. The Titanic Belfast and Odyssey Arena are completely different trade marks to TITANIC QUARTER and any suggestion that these two entities are providing their services under the TITANIC QUARTER trade mark is fanciful.

53. The onus of proving use lies with the Proprietor and no supposition is entitled to be made in that regard. This is clear from case law where, in *Vitakraft*<sup>8</sup>, the Court had this to say at paragraph 28:

*“... genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”*

54. Under Section 99 of the Trade Marks Act, 1996 the onus of proving use lies with the proprietor. In this regard Jacob J. had this to say in *La Mer*<sup>9</sup> at paragraph 9:

*“In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye - to ensure that use is*

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<sup>8</sup> Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM, Case T-356/02

<sup>9</sup> La Mer Technology Inc v Laboratoires Goemar SA (C-259/02) [2004] E.C.R. I-1159

*actually proved - and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted."*

55. In these proceedings there is a clear absence of evidence of use. At the Hearing Mr. Coughlan argued the Proprietor cannot physically export services delivered under the TITANIC QUARTER mark to Ireland. Nor can it post or hand over the services to consumers in Ireland. The lack of evidence of use of the mark in the State is a result of the cross-border nature of the business, and he maintained Irish consumers are aware of the TITANIC QUARTER mark and he pointed to the huge numbers of Irish citizens who go to Northern Ireland on an annual basis to avail of services delivered under the trade mark.

56. I understand where Mr. Coughlan is coming from but I do not agree. This matter is not about whether Irish citizens know of the Titanic Quarter in Belfast or have used any of the services provided by businesses located in that location. The question at issue is use by the Proprietor of the trade mark TITANIC QUARTER in Ireland in respect of the services for which the mark is registered. In this case I find the Proprietor has clearly failed to meet the requirement to prove use of its mark in the State. The Proprietor has failed to use the mark in accordance with its essential function and, therefore, I must revoke the registration in respect of all services.

57. By virtue of Section 51(6) of the Act, the revocation of the registration of a trade mark has the effect that the rights of the Proprietor shall be deemed to have ceased from (a) the date of the application for revocation, or (b) if the Controller is satisfied that the grounds for revocation existed at an earlier date, that date. In the present case the Applicant sought revocation for non-use within the five-year period ending on the date of application for revocation and I am happy to revoke the registration as of that date, namely 19 January, 2015.

Dermot Doyle

Acting for the Controller

26 October, 2016