

O/134/15

TRADE MARKS ACT 1994

CONSOLIDATED APPLICATIONS 500259 - 266

BY AROSA LIMITED

**TO REVOKE TRADE MARKS 2002442, 2349382, 2349384, 2002436, 2449104,
2449105, 2467732 & 1229540**


IN THE NAME OF RAFFLES INTERNATIONAL LIMITED



FOR NON-USE

Background and pleadings

1. This case is about whether a party which operates hotels abroad, but with customers in the UK, can legitimately register marks in the UK in relation to services provided abroad.

2. Raffles International Limited (“RIL”) is the registered proprietor of the trade marks shown below. On 14 January 2014, Arosa Limited (“Arosa”) applied under s.46(1)(a) and (b) of the Act for these trade mark registrations to be revoked in their entirety for non-use.



Trade mark number	Mark	Revocation action	Periods of non-use relied upon for the purposes of s.46(1)(a) and (b) of the Act.
2002442 Date of entry in register 31 January 1997	RAFFLES	500260	(a) 1/2/97-31/1/02 (b) 14/01/09-13/01/14
2349382 Date of entry in register 04 March 2005	RAFFLES	500261	(a) 5/3/05-4/3/10 (b) 14/01/09-13/01/14
2002436 (series of 2) Date of entry in register 14 February 1997		500259	(a) 15/2/97-14/2/02 (b) 14/01/09-13/01/14
2449104 Date of entry in register 08 February 2008	RAFFLES RESIDENCES	500263	(a) 9/2/08-8/2/13 (b) 14/01/09-13/01/14


2449105	RAFFLES ESTATES	500264	(a) 9/2/08-8/2/2013 (b) 14/01/09-13/01/14
Date of entry in register			
08 February 2008			
2467732	RAFFLES RESIDENCE CLUB	500265	(a) 12/4/08-11/4/13 (b) 14/01/09-13/01/14
Date of entry in register			
11 April 2008			
2349384		500262	(a) 5/3/2005-4/3/2010 (b) 14/01/09-13/01/14
Date of entry in register			
04 March 2005			
1229540		500266	(a) 3/11/84-2/11/89 (b) 14/01/09-13/01/14
Date of entry in register			
02 November 1984			

2. RIL filed counterstatements which initially defended the trade marks for all the goods/services for which they are registered. However, shortly before the hearing described below, RIL conceded that there had been no genuine use of trade mark 1229540.

3. Following the hearing, the goods/services for which RIL still defended the other marks was reduced to the following.

Number	Mark	Specification
2002442	RAFFLES	Class 43
		Hotel management, hotel reservations, hotels housekeeping services, catering, cafeteria and restaurants; but none relating to alcoholic beverages.

2349382	RAFFLES	Class 35
		Business management of hotels; the bringing together, for the benefit of others, of a variety of beauty products, toiletries, jewellery, clothing, foodstuffs, and drink products, goods, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet; all included in Class 35.
		Class 43
		Hotel services, hotel accommodation services, reservation services for hotel accommodation, room hire, provision of conference facilities, banqueting services, bar, café, restaurant services, cocktail lounge and coffee shop services, food cooking services; providing of facilities for conventions and exhibitions.
2002436 (series of 2)		Class 43
		Hotel management, hotel reservations, hotels, housekeeping services, catering, cafeteria and restaurant services; but none relating to alcoholic beverages.
2449104	RAFFLES RESIDENCES	Class 35
		Business management of hotels, service apartments, food outlets, beverage outlets; the bringing together, for the benefit of others, of a variety of beauty products, toiletries-jewellery, clothing, foodstuffs, and drink products, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet, display services for merchandise; all included in Class 35.
		Class 36
		Provision of accommodation apartments; apartment house management; accommodation management services; renting and leasing of residential accommodation; renting and leasing of apartments, flats, buildings, houses, condominium and other residential accommodation; real estate affairs; real estate management services; provision of housing accommodation; leasing of accommodation on behalf of others; rental of apartments; rental of flats; rental of service apartments.
2449105	RAFFLES ESTATES	Class 35
		Business management of hotels, service apartments, food outlets, beverage outlets; the bringing together,

		<p>for the benefit of others, of a variety of beauty products, toiletries, jewellery, clothing, foodstuffs, and drink products, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet, display services for merchandise; all included in Class 35.</p> <p>Class 36</p> <p>Provision of accommodation apartments; apartment house management; accommodation management services; renting and leasing of residential accommodation; renting and leasing of apartments, flats, buildings, houses, condominium and other residential accommodation; real estate affairs; real estate management services; provision of housing accommodation; leasing of accommodation on behalf of others; rental of apartments; rental of flats; rental of service apartments.</p>
2467732	RAFFLES RESIDENCE CLUB	<p>Class 35</p> <p>Business management of hotels, service apartments, food outlets, beverage outlets; the bringing together, for the benefit of others, of a variety of foodstuffs, wines, spirits and other alcohol products, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet; all included in Class 35.</p> <p>Class 36</p> <p>Management of apartments, flats, condominiums, and other types of residential accommodation; rental and leasing of apartments, flats, condominiums and other types of residential accommodation; operation of serviced offices and residential accommodation; real estate management services; provision of housing accommodation; leasing of accommodation on behalf of others; advisory and consultancy services relating to the above.</p>
2349384		<p>Class 35</p> <p>Business management of hotels; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet, display services for merchandise; all included in Class 35.</p> <p>Class 43</p> <p>Hotel services, hotel accommodation services, reservation services for hotel accommodation, room hire, provision of conference facilities, banqueting services, bar, café, restaurant services, cocktail lounge and coffee shop services, food cooking services; providing of facilities for conventions and exhibitions; information.</p>

4. In my view, this was a realistic and sensible concession on RIL's part.

5. The hearing took place on 13 February 2015. RIL was represented by Mr Thomas St Quintin of counsel, instructed by Wildbore & Gibbons, and Arosa was represented by Ms Ashton Chantrielle of counsel, instructed by Olswang LLP.

The evidence

6. RIL's evidence takes the form of a single witness statement by Diana Banks, who is RIL's Vice-President for Brand Strategy. Ms Banks statement includes 10 lengthy exhibits, enough to occupy 2 ring binders. Arosa did not file evidence, but I heard extensive submissions on Ms Banks' evidence.

7. Ms Banks says that the original Raffles hotel was opened in 1887 as a 10 room establishment in Singapore. There is an historical link to the UK due to the colonial history of Singapore. The current hotel has 103 suites, fine wining and dining, a spa, gymnasium and swimming pool, theatre playhouse, museum, shopping arcade, a ballroom, and meeting and function rooms. In addition to the hotel in Singapore, there are Raffles hotels in Cambodia, China, United Arab Emirates, France, Saudi Arabia and the Seychelles. Apart from the original hotel in Singapore, the hotels are operated by FRS Hotel Group Sarl under licence from RIL. The licensed hotels opened between 1997 and 2013.

8. The Singapore hotel has had many famous British visitors over the years, including Joseph Conrad, Rudyard Kipling, Noel Coward, and Somerset Maugham. The hotel has also received visitors from the British Royal Family. In 2006, the Queen and Prince Philip stayed at the hotel during a State visit to Singapore. In 2012, the Duke and Duchess of Cambridge also stayed there.

9. The hotel is also known for other things. The Singapore Sling cocktail was first created in the bar of the hotel. In 2005, the hotel hosted the International Olympics Committee and the announcement that the UK would be the location for the 2012 games was made from the hotel. In 2006, the hotel hosted a one day meeting of G7 Finance Ministers.

10. The Singapore hotel has 14 bars and restaurants, including the Raffles Grill. Since 1995 the hotel has held an annual Raffles Hotel Wine and Food Experience, which is visited by internationally acclaimed chefs, vintners, and special guests from around the world. Gordon Ramsay took part in 1998. Some promotional material for this event from around 2000 to 2003 is in evidence¹. It shows use of the RAFFLES mark and also the composite mark registered under 2002436. The material was posted on the website rhwfae.com, but it is not clear whether this website received any significant number of visits from people in the UK.

¹ See exhibit DB3 pages 4 and 5.

11. The hotel also operates the Raffles Culinary Academy.

12. Since 1991, the Singapore hotel has included the Raffles Hotel Arcade, which is a series of shops. In 2001, the THOS S.B. Raffles shop was opened in the arcade, which Ms Banks says sells fine foods, wines and spirits.

13. According to Ms Banks, RIL has not historically needed to rely heavily on advertising in the UK in order to attract customers for Raffles hotels. The estimated advertising spend in the period 2002 – 2012 was around £450k. However, advertising spend increased significantly in 2012 – 2013. In these years the professional media monitoring agency IPCB valued Raffles promotion as equivalent to around £5m in advertising expenditure. Some of this expenditure was on trade promotions intended to provoke media coverage of Raffles hotels. A report by RIL's UK PR agency Mango for 2013 indicates that the promotions prompted pieces in 16 national newspapers, 51 pieces in consumer magazines, 30 pieces in regional newspapers, 50 in trade publications, 75 online and 1 in a broadcast². Some examples of these pieces are in evidence³. Ms Banks provides figures from YouGov indicating that the level of 'aided' awareness of Raffles in the UK is 72%.

14. There are examples in evidence⁴ of Raffles hotels being advertised by UK publications such as the Financial Times (in 2010 and 2011 referring readers to the Raffles website for enquiries), The Daily Mail (in 2011, referring readers to the Raffles website and quoting prices in pounds sterling), and the Evening Standard (in 2011, also referring readers to the Raffles website and quoting prices in pounds sterling).

15. Raffles hotels have also been promoted in the UK by a travel company called Black Tomato. Ms Banks exhibits a copy of a proposal from Black Tomato for the promotion of Raffles hotels using, inter alia, Black Tomato's website, e-newsletters and social media. The proposal notes that 60% of Black Tomato's customers are based in the UK⁵. It was proposed that customers would be able to book rooms via the Black Tomato website. The campaign was to cover the period April to June 2013. Black Tomato's proposal to RIL for the marketing campaign shows use of the word RAFFLES below the fan device shown in registration 2349384⁶. Ms Banks exhibits a report of the campaign. It shows use of the RAFFLES mark on the Black Tomato website, that over 1000 enquiries were received during the 3 months promotion, and that nearly 500 bookings were made at Raffles hotels during the same period via Black Tomato. Ms Banks also provides evidence of a similar collaboration with

² See exhibit DB6, page 58

³ See exhibit DB6, pages 6-73

⁴ See exhibit DB8, pages 114, 127, 200 & 201.

⁵ See exhibit DB6, pages 1-13

⁶ See exhibit DB6 page 1. The same composite sign also featured on the back page of an undated travel guide to RAFFLES resorts produced by Black Tomato. See DB6, page 50. There is no evidence as to how or where (or even if) this was distributed to the public.

another UK based travel agent called Cox & Kings during the same period in 2013. This included an advertorial for Raffles hotels appearing in the summer edition of that agent's magazine. 55k copies of the magazine were mailed to Cox & Kings' customers in 2013. Raffles hotels also appeared on the agent's website.

16. In 2012, RIL promoted the 125th anniversary of the Raffles hotel in Singapore. RIL engaged a UK based travel consultant called Elegant Resorts to help promote the event to UK customers. According to the report from Elegant Resorts⁷ e-shots were sent to 45k of its clients and Raffles hotels could be booked via its website. A celebratory event for the UK press was held at the Ivy restaurant in June 2012. A copy of the invitation for that event and the guest list (showing that 38 people in the media and travel business were invited) are in evidence⁸. The invitation includes the composite mark mentioned in the previous paragraph with the fan device shown in registration 2349384 appearing above the word RAFFLES⁹.

17. Ms Banks says that numerous other travel companies offer packages to Raffles hotels out of the UK, including Kuoni, P & O cruises, Abercrombie and Kent, Trailfinders, Lonely Planet, and Hayes and Jarvis. Some examples of packages offered by these companies in 2011 – 2013 are in evidence¹⁰. Several of these agents offered special deals for booking Raffles hotel, such as complimentary meals. I note that one of the Singapore tours offered by P & O cruises in 2011 included a visit to Raffles hotel “*to admire its colonial style architecture, shopping arcade and the Raffles Hotel museum.*”¹¹.

18. Raffles hotel also features in UK travel guides for Singapore. The Dorling Kindersley DK Eyewitness Travel Top Ten published in 2009 featured the Raffles Hotel on its front cover and lists the hotel amongst its top 10 places to visit in Singapore.

19. RIL operates a website at www.raffles.com. A page from the website as it looked on 26 May 2014 is in evidence¹². It shows use of the RAFFLES mark, and the logo shown below, in relation to hotel, restaurant and bar services, and also that the hotels offered meeting and function rooms. The page relating to the Raffles hotel in Paris indicates that it is able to host parties of up to 100 people. I note that the website is in English, but that no prices are shown. The telephone number provided is an international one.

⁷ See exhibit DB6, pages 55/56

⁸ See exhibit DB6, pages 84-88

⁹ The same mark is at pages 84/85 of DB5, which appears to be a press release by a UK PR agency for the RAFFLES Seychelles hotel, but this is not mentioned by Ms Banks in her statement and there are no details of where or to whom it was sent.

¹⁰ See exhibit DB4

¹¹ See page 9 of exhibit DB4

¹² See exhibit DB1, page 7. The page carries a copyright of 2014 indicating that the web pages used in the period 14 January 2009 to 13 January 2014 may have looked different.

20. Ms Banks provides a breakdown of UK visitors to the Raffles website showing that:

- In the period between 2009 and 2012, the site was visited by around 140k to 175k UK visitors per annum.
- Around 70% of these were first time visitors to the website.
- Between 2010 and 2012, 1279 bookings were made by UK visitors directly through this website.

21. Ms Banks also provides details of the total rooms booked by UK guests in the period 2009 to 2013. These show that:

- UK guests booked between around 3.5k and 18k nights of accommodation at the Raffles Singapore hotel in each of the years between 2009 and 2013.
- This accounted for between 8% and 17% of total bookings at the Singapore hotel.
- Guests from the UK made up the second largest national group of users of the Singapore hotel.
- UK guests accounted for between 15k and 22k nights of accommodation at all Raffles hotels in the years between 2009 and 2013.
- UK guests accounted for between 5.8% and 8.9% of all guests at Raffles hotels during this period.

22. In 2006, RIL introduced a vehicle for chauffeuring VIPs and guests at the Singapore hotel. I note that the pages in evidence from the Raffles.com website in May 2014¹³ state that the hotel offers a car service to transfer guests around the city and to and from the airport.

23. Ms Banks exhibits copies of what appears to be a promotional magazine called RafflesWorld¹⁴. I note that the magazine for the 1st quarter of 2009 (i.e. in the relevant period for the purposes of s.46(1)(b), although actually dated 2008) includes¹⁵ an article about 'Raffles Residences', which at that time were being built in Makati, Philippines. Completion was expected in 2011. I also note that a later copy of the same magazine included an article about 'Raffles Estates' luxury homes, which

¹³ See exhibit DB1, page 18

¹⁴ See the second half of exhibit DB5

¹⁵ See page 21 of DB5

were being built in 2010 in the Seychelles. Oddly, Ms Banks says nothing at all about this material in her statement. It is not therefore clear whether this material was distributed in the UK or at all.

The law on genuine use

24. Section 46(1) of the Act states that:

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

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

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

(c).....
.....

(d).....

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

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

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

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

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

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

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

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

25. Section 100 is also relevant, which reads:

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

26. In *Stichting BDO v BDO Unibank, Inc.*¹⁶, Arnold J. stated as follows:

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

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

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

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

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

¹⁶ [2013] F.S.R. 35 (HC)

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

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

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

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

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

Genuine use of RAFFLES in the UK?

28. Ms Chantrielle submitted that the use shown by RIL did not count as genuine use because it did not show use of any of the marks in the UK. RIL does not operate hotels in the UK. In this connection, Ms Chantrielle argued that s.46(1) could be read as meaning:

“...[the mark] 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 [in the United Kingdom] for which it is registered....”.

29. In support of this point, Ms Chantrielle drew my attention to the comments of Jacob J. (as he then was) in paragraph 19 of his judgment in the *Crate & Barrel*

case¹⁷. The learned judge pointed out that the use required was use of the mark in the UK, not merely use of the mark abroad which could be seen over the internet in the UK. A similar point was made by Birss J. in *Thomas Pink Ltd v Victoria's Secret UK Ltd*¹⁸. Furthermore, Ms Chantrielle submitted that it is not sufficient to show that RIL has a reputation or customers in the UK. Absent use of the mark in the UK, such factors are irrelevant.

30. For his part, Mr St Quintin pointed out that in *Thomson Holidays Ltd v Norwegian Cruise Line*¹⁹ it appears to have been taken for granted that a UK travel agent providing overseas package holidays to UK consumers provided those services in the UK. Further, it is well established that a hotel operating overseas can acquire a protectable goodwill in the UK. The judgment of the Court of Appeal in *Ciprian*²⁰ illustrates the difficulties that may arise in assessing whether a party providing services abroad is entitled to legal protection of its trade mark(s) in the UK. Lloyd L.J. noted that the test adopted for the purposes of establishing goodwill under the law of passing off may need revision. He said:

“...in the circumstances of the present day, with many establishments worldwide featuring on their own or shared websites, through which their services or facilities can be booked directly.....from anywhere in the world, the test of direct bookings²¹ may be increasingly outmoded.”

31. However, as Ms Chantrielle submitted, the test for goodwill in unregistered marks under the common law of passing off is not necessarily the same as the requirement for genuine use of a registered mark under the Act²². The 1994 Act is based on EU Directive 104/89. The 1994 Act therefore severed the common roots between previous Trade Mark Acts and the English common law of passing off. The key difference is that in order to establish a local goodwill for the purposes of the law of passing off it is generally sufficient to show that you have customers in the UK, whereas under the Act it is necessary to show that a registered mark has been used in the UK by the proprietor or with his consent. However, although it is theoretically possible to have customers in the UK without the mark having been used here, the presence of UK customers will usually be the result of use of the mark in the UK. In that connection, I note from the *Ansul* case that use of the mark in the UK includes use of the mark in advertisements aimed at maintaining or creating a share of the UK market for the services.

¹⁷ *Euromarket Designs Inc. v Peters and Anr* [2000] ETMR 1025

¹⁸ [2014] EWHC 2631 (CH) at paragraph 133 of the judgment

¹⁹ [2003] RPC 32, Court of Appeal

²⁰ [2010] EWCA Civ 110

²¹ From *Alain Bernardin & Cie v Pavilion Properties Ltd* [1967] RPC 581

²² See, for example, the judgment of Floyd J. (as he then was) in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), at paragraph 12.

32. Ms Chantrielle reminded me that the burden is on RIL to demonstrate “*solid and objective*” evidence of genuine use of the marks in the UK. Section 100 places the burden on RIL to show use of its marks which qualifies as use in the UK. As regards the requirement for the evidence of use to be ‘solid and objective’, if this means that must be sufficiently solid and objective to satisfy the normal civil standard of evidence, which is the balance of probability, then I accept this submission. When I asked her about it, Ms Chantrielle did not suggest that the requirement for ‘solid and objective’ evidence required anything different. Whilst keeping the burden of proof in mind, I must also remember that I should not decide whether there has been genuine use of RIL’s marks purely on the basis that it has not discharged that burden unless I cannot reasonably make a finding in relation to that issue despite having striven to do so²³.

33. RIL relies on a number of uses, but for the purposes of establishing whether there has been genuine use of the RAFFLES mark, it is sufficient to focus on just two of those categories: the use of the mark on the raffles.com website and the use by Black Tomato, Cox & Kings and Elegant Resorts in 2012 and 2013. It is clear from s.46(3) that use in the 5 year period preceding the filing of the application for revocation is sufficient to defeat an attack under s.46(1)(a) or (b). I will therefore focus my assessment on the period 14 January 2009 to 13 January 2014 (“the relevant period”).

34. As regards the website use, in joined Cases *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller*²⁴ the CJEU was asked for an interpretation of Article 15(1)(c) of Council Regulation 44/2001/EC of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (“the Brussels I Regulation”), and in particular the requirement that “*the contract has been concluded with a person who pursues commercial or professional activities in the member state of the consumer's domicile or, by any means, directs such activities to that member state*”. The CJEU interpreted the national court as asking, in essence, “*on the basis of what criteria a trader whose activity is presented on its website or on that of an intermediary can be considered to be ‘directing’ its activity to the Member State of the consumer's domicile ..., and second, whether the fact that those sites can be consulted on the internet is sufficient for that activity to be regarded as such*”.

35. The court held that it was not sufficient for this purpose that a website was accessible from the consumer’s Member State. Rather, “*the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer's domicile*”. In making this assessment national courts had to evaluate “*all clear expressions of the intention*

²³ *Stevens v Cannon* [2005] EWCA 222 at [46]

²⁴ C-585/08 and C-144/09

to solicit the custom of that state's customers". Such a clear expression could include actual mention of the fact that it is offering its services or goods *"in one or more Member States designated by name"* or payments to *"the operator of a search engine in order to facilitate access to the trader's site by consumers domiciled in various member states"*.

36. Finally, the court concluded:

"The following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader's activity is directed to the Member State of the consumer's domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists."

37. The CJEU adopted a broadly similar approach in *L'Oreal v eBay*²⁵ when asked whether goods bearing a trade mark and offered for sale on an online marketplace were being offered for sale in a particular territory.

38. I note that the raffles.com website is not a specifically UK domain. The '.com' domain level is international in nature. The website in question is in English. It plainly used the name RAFFLES and it was obviously possible to book hotel services via that site because the evidence shows that between 2010 and 2012 over 1000 UK customers did so. They must have thought that the website was intended for them. Taken together with the other evidence of RIL's efforts to promote RAFFLES in the UK during the relevant period and the international nature of the services offered by RIL to its customers, I have no doubt that, judged objectively, RIL's use of RAFFLES on its website was aimed, at least in part, at the UK market. It therefore counts as use of the RAFFLES mark in the UK for advertising purposes during the relevant period.

39. I find that the uses of RAFFLES described above by Black Tomato, Cox & Kings and Elegant Resorts, on their websites, magazines, e-newsletters, e-shots and social media, which is stated to have been as a result of collaborations between these parties and RIL, is further use of RAFFLES in the UK with the consent of RIL

²⁵ Case C-324/09, at paragraphs 63 to 66 of the judgment.

during the relevant period. The relatively high proportion of UK guests visiting the Singapore hotel and the fact that 500 of those people booked RAFFLES hotels via the Black Tomato website (and that 60% of its customers are based in the UK), confirms the correctness of this conclusion.

39. In the light of these findings it is not necessary to examine whether the use of RAFFLES by other UK travel agents, such as Kuoni and Trailfinders, in order to offer holiday packages to their UK customers, also counts as use of RAFFLES in the UK with RIL's consent.

Use of RAFFLES in the UK in relation to which services?

40. The RAFFLES mark has plainly been used in relation to hotel services. Ms Chantrielle accepted that hotel management, hotel reservations, cafeteria and restaurants services stood or fell with hotel services. There is ample evidence that RAFFLES eating and drinking facilities are promoted as part of its hotel services. These services are part and parcel of high end hotel services. I am satisfied that the provision of eating and drinking services would be a significant factor in the decision of many of the UK consumers to book accommodation at RAFFLES. I therefore find that there was genuine use of RAFFLES in the UK during the relevant period in relation to all the services listed earlier in this paragraph.

41. Ms Chantrielle did not accept that certain other quite similar services stood or fell with hotel services. In particular, she did not accept that catering services or housekeeping services were necessarily part and parcel of hotel services. I accept this submission, but it appears to me that the difficulty with the generality of these descriptions could be overcome by qualifying these descriptions very simply through the addition of the words "... provided in hotels"²⁶. Expressed like this, I find that these descriptions are part and parcel of hotel services. I find that the same applies to banqueting services, food cooking services, bar, cocktail lounge and coffee shop services. Customers would expect most quality hotels to provide these services, including room keeping and in-room catering services. The expected presence of all of these facilities would have a bearing on the decision of UK consumers to book accommodation at RAFFLES.

42. On the other hand, there is no evidence that the provision of facilities for conventions and exhibitions, room hire or provision of conference facilities, were promoted to UK consumers during the relevant period. This is because:

- The evidence from the RAFFLES website showing the promotion of such facilities is dated after the end of the relevant period;

²⁶ By analogy with the inclusion of a "save for" limitation as per paragraph 3.2.2(b) of Tribunal Practice Notice 1/2012

- Ms Banks provides no evidence of UK consumers having booked conventions, exhibitions, or any other corporate events at RAFFLES hotels;
- Although it is true that many hotels provide such facilities, it is not safe to infer that UK consumers would regard the use of RAFFLES in relation to a hotel in Singapore, or any of the other RAFFLES hotel locations, as use of the mark to create or maintain a market for such services amongst UK consumers.

43. Mr St Quintin drew my attention to the record of an article in the 'special' section of the Financial Times dated 11 December 2010, which records that the RAFFLES hotel in Singapore has amongst its various attributes, a first rate business centre²⁷. However, it is not the existence of corporate facilities which is in issue. The issue is the extent, if any, to which relevant services were advertised in the UK under the RAFFLES mark with RIL's consent. The article in the Financial Times was not an advertisement for any services. And there is nothing to indicate that it was (or needed to be) published with RIL's consent.

44. RAFFLES is also registered under 2349382 in class 35 in relation to:

Business management of hotels; the bringing together, for the benefit of others, of a variety of beauty products, toiletries, jewellery, clothing, foodstuffs, and drink products, goods, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet; all included in Class 35.

45. Ms Chantrielle did not accept that 'business management of hotels' is part and parcel of a hotel service, and neither do I. This is a business service offered to those running hotels. There is no evidence that RAFFLES has been used in relation to such services.

46. Mr St Quintin relied on the use of RAFFLES in relation to the shopping arcade mentioned in the evidence, and as part of the name of the shop operated by, or on behalf of, RIL at the Singapore establishment, which is called THOS S.B. Raffles. These facts are relied on for the purpose of supporting the registration of RAFFLES in relation to:

'the bringing together, for the benefit of others, of a variety of beauty products, toiletries, jewellery, clothing, foodstuffs, and drink products, goods, enabling customers to conveniently view and purchase those goods in a hotel, food and beverage outlet; all included in Class 35.'

47. Ms Chantrielle appeared at one point in the hearing to accept that these services also stood or fell with hotel services, but later she seemed to resile from that position. I have taken her later submissions as reflecting Arosa's position on this matter.

²⁷ See page 118 of exhibit DB8

48. I do not accept that the evidence shows genuine use of RAFFLES in relation to these retail services for the following reasons:

- The use of RAFFLES in relation to the shopping arcade is not use in relation to the registered services.
- With the possible exception of the goods offered in the THOS S.B. Raffles shop, RIL does not bring together any goods. It brings together the (other) retail outlets in the arcade which in turn bring together and offer goods on their own account²⁸.
- The evidence that P & O cruises offered a tour to Raffles Singapore hotel to UK consumers on a cruise in that region, which mentioned the Raffles arcade is not evidence of genuine use of that mark in the UK because a) there is no evidence that the use was made with RIL's consent, and b) offering to take UK consumers to, inter alia, a shopping arcade at a hotel in Singapore whilst on a tour from a cruise ship cannot be regarded as use of the name of the shopping arcade in order to create a market for services in the UK.
- I accept that the use of THOS S.B. Raffles could constitute use of RAFFLES in relation to the registered services on the basis of the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*²⁹, but, at most, Ms Banks' evidence only supports use of that mark in relation to food, wine and spirits.
- In any event, there is no evidence of use of THOS S.B. Raffles in the UK.
- It is, in my view, close to fanciful to suggest that there is a UK market for services to permit UK consumers to 'conveniently view and purchase' goods brought together in Singapore.

49. For the reasons given above I find that registrations 2002442 and 2349382 should be revoked for non-use except in relation to:

Number	Mark	Specification
2002442	RAFFLES	Class 43
		Hotel management, hotel reservations, hotel services: cafeteria and restaurant services: housekeeping services, catering services, all provided in hotels: but none relating to alcoholic

²⁸ See, by comparison, the list of services in *Land Securities v Registrar of Trade Marks* [2008] EWHC 1744, which concerned the services of the operator of a shopping centre.

²⁹ Case C-12/12

		beverages.
2349382	RAFFLES	Class 43
		Hotel services, hotel accommodation services, reservation services for hotel accommodation; café and restaurant services; banqueting services, bar, cocktail lounge, coffee shop services and food cooking services, all provided in hotels.

The use of RAFFLES RESIDENCES, RAFFLES ESTATES and RAFFLES RESIDENCE CLUB (registrations 2449104, 2449105 & 2467732)

50. In his skeleton argument, Mr St Quintin referred me to the uses shown of RAFFLES ESTATES and RAFFLES RESIDENCES in the Rafflesworld publication³⁰. However, he had to accept that there is no evidence that this publication was ever circulated in the UK. Consequently, there is no evidence of use of these marks, or RAFFLES RESIDENCE CLUB, in the UK.

51. Mr St Quintin relied instead on s.46(2) of the Act, which states that use of a registered mark in a form which does not alter its distinctive character (compared to the form in which it is registered) is to be treated as use of the registered mark. Mr St Quintin submitted that use of RAFFLES should also count as use of the marks shown above because:

- RAFFLES is highly distinctive for the services at issue;
- The words ESTATES, RESIDENCES and RESIDENCE CLUB are wholly descriptive additions to this highly distinctive word.

52. Ms Chantrielle submitted that the composite word marks had a different distinctive character compared to the word RAFFLES alone.

53. If it had mattered, I would have accepted that RESIDENCES is wholly descriptive of the services for which this mark is registered and that RAFFLES RESIDENCES therefore has the same distinctive character as RAFFLES alone. I am less sure about the other two marks, particularly RAFFLES RESIDENCE CLUB.

54. However, there is no need for me to reach a concluded view about this because there is another obvious reason why the use of RAFFLES alone cannot assist RIL so far as any of these marks are concerned. This is because there is no evidence of any use of RAFFLES in the UK (in advertising or otherwise) in relation to any of the services in classes 35 and 36 for which these marks are registered. Evidence of use of RAFFLES in relation to services in class 43 cannot assist RIL. I therefore find that these marks must be revoked for non-use.

³⁰ See exhibit DB5, pages 21 and 65.

The use of RAFFLES International & fan device registered under 2349384

55. The registered mark looks like this:



56. There is no evidence of use of that mark or any other RAFFLES mark in the UK in relation to the services for which it is registered in class 35. There is no evidence of use of the mark as registered in relation to any services in class 43 either. Instead RIL relies on a couple of uses of the word RAFFLES with the fan device (i.e. without the word INTERNATIONAL) shown in the evidence. These uses are said to count as use of the registered mark in accordance with s.46(2) of the Act because the word 'International' is a) subordinate to RAFFLES in the registered mark, and b) non-distinctive.

57. The used mark looks like this:



58. The only reliable evidence of public facing use of this mark in the UK during the relevant period is on the invitation for the celebratory event for the UK press was held at the Ivy restaurant in June 2012³¹. I accept this was external use of the mark intended to maintain a market in the UK for the services provides at the Raffles hotel in Singapore.

59. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade

³¹ See paragraph 16 above

mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

60. The distinctive character of the registered mark is based on the distinctive word RAFFLES and, to a lesser extent, the fan device positioned at the top right hand corner of the mark. I accept Mr St Quintin's submission that the word 'International' is a) subordinate to RAFFLES in the registered mark, and b) non-distinctive.

61. The distinctive character of the used mark depends on the same two elements. The increase in the relative size of the fan device and its re-positioning above the word RAFFLES has minimal visual impact. The absence of the word 'International' and its replacement with the wholly descriptive words 'Hotels and Resorts' is likely to be noticed by an average consumer, but does not alter the distinctive character of the mark.

62. Mr St Quintin drew my attention to paragraph 21 of the judgment of the CJEU in *Bernhard Rintisch v Klaus Eder*³² in which the court explained the purpose of the corresponding provision in the Trade Marks Directive like this:

"As to the purpose of Article 10(2)(a) of Directive 89/104, that provision, which avoids imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, is intended to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned."

63. In my judgment, the mark shown at paragraph 55 above is the kind of acceptable variation of the registered mark covered by s.46(2) of the Act. It follows that the application for revocation for non-use of this mark fails for the services in class 43 for which I have found that RIL sought to maintain a market in the UK, namely:

Hotel services, hotel accommodation services, reservation services for hotel accommodation; café and restaurant services; banqueting services, bar, cocktail lounge, coffee shop services and food cooking services, all provided in hotels.

64. The registration of the mark in class 35, and for the other services for which the mark is registered in class 43, must be revoked for non-use.

³² Case C-553/11

The use of the composite marks registered under 2002436

65. The series of two marks in question look like this:



66. There is some evidence that these marks were used in relation to the annual Raffles Hotel Wine and Food Experience. However, the promotional material for this event which is in evidence dates from around 2000 to 2003³³ (i.e. before the start of the relevant period). Further, the use in question was on the website rhwfae.com, and it is not clear whether this website received any significant number of visits from people in the UK. In the circumstances, I find that there is no evidence of use of these marks which qualifies as use in the UK.

67. The difference between these marks and the word RAFFLES alone is plainly too great to say that the distinctive character of the composite marks is not altered by the omission of the device elements. Consequently, these marks must be revoked for non-use.

Outcome

68. Subject to appeal, trade mark registrations 1229540, 2002436, 2449104, 2449105 & 2467732 will be revoked in their entirety for non-use.

69. Registrations 2002442 and 2349382 will also be revoked for non-use except in relation to the services in class 43 specified at paragraph above.

70. Registration 2349384 will also be revoked for non-use except in relation to the services in class 43 specified at paragraph above.

Effective dates of revocation

71. I see nothing in the evidence which shows use of any of the revoked or partly revoked marks in the UK after the various dates of entry of the marks in the UK register, but prior to the relevant period for the purpose of s.46(1)(b). The conditions

³³ See exhibit DB3 pages 4 and 5.

for revocation therefore appear to have existed as soon as the marks had been on the register for 5 years. The marks should therefore be revoked (or, in the case of 2002442, 2349382 & 2349384, partially revoked) from the following dates.

2002442 - 1 February 2002
2349382 - 5 March 2010
2349384 - 5 March 2010
2002436 - 15 February 2002
2449104 - 9 February 2013
2449105 - 9 February 2013
2467732 - 12 April 2013
1229540 - 3 November 1989

Costs

72. Five of the eight marks in these proceedings will be revoked for non-use. The applications to revoke the other three have partly succeeded. Therefore Arosa has been more successful than RIL and is entitled to a contribution towards its costs.

73. Mr Chantrielle asked me to award costs off the usual scale because RIL's documentary evidence was voluminous, poorly indexed, poorly explained, and partly irrelevant. This caused Arosa to spend considerable time and money going through it.

74. Mr St Quintin submitted that costs should be assessed on the usual scale.

75. The registrar's authority to award costs is based on s.68 of the Act and Rule 67 of the Trade Mark Rules 2008.

"Costs of proceedings; section 68

67. The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and by what parties they are to be paid."

76. The Registrar normally awards costs on a contribution basis within the limits set out in the published scale. The latest version of the scale is included in Tribunal Practice Notice 4/2007. However, as this Notice indicates, the Registrar has the power to award reasonable costs on a different basis where the circumstances justify it. The courts have long recognised this: see *Rizla Ltd's Application*³⁴. The Practice Notice recognises that unreasonable behaviour may justify costs on a compensatory basis. The Appointed Person follows a similar approach and sometimes awards costs on a compensatory basis: see, for example, *Ian Adams Trade Mark*³⁵.

77. I have some sympathy with Arosa's complaint about the poor presentation of RIL's evidence, particularly the fact that the significance of much of it was either poorly explained, or not explained at all. This must have added to the cost to Arosa

³⁴ [1993] RPC 365

³⁵ BL O-147-11

of assessing this evidence. I accept that presenting voluminous evidence without adequate explanation as to its relevance, which puts the other side to the additional cost of properly assessing the relevancy and worth of the evidence, may amount to unreasonable behaviour. However, in my view, RIL's evidence in this case was not (quite) sufficiently poorly presented and explained so as to constitute unreasonable behaviour and thereby justify costs on a compensation basis. In assessing costs on-scale, I will, however, go towards the top of the scale.

78. I order Raffles International Limited to pay Arosa Ltd the sum of £3000. This is made up of:

£1000 for the official fees in filing 5 forms TM26(I)

£500 towards the cost of preparing the above and considering the counterstatements

£1500 towards the cost of considering RIL's evidence

79. In deciding on these amounts I have taken into account that a) the evidence covered 8 consolidated proceedings covering 7 different marks, and b) RIL was successful on the central issue of whether it had used RAFFLES in the UK in relation to its hotel services abroad. This is why I have made no award of costs for the hearing.

80. The above sum should be paid within 7 days of the end of the period allowed for an appeal or, if an appeal is filed, but is unsuccessful or withdrawn, within 7 days of this decision becoming final.

Dated this 26th Day of March 2015

**Allan James
For the Registrar**