

O-378-09

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO. 83256
BY MASCHA & REGNER CONSULTING KEG
TO REVOKE REGISTRATION NO. 2202123
IN THE NAME OF THE CARLYLE, LLC

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Background

1. Registration No. 2202123 is for the trade mark THE CARLYLE. The registration procedure was completed on 10 December 1999. The registration stands in the name of The Carlyle, LLC (“the registered proprietor”) and is registered in respect of *Hotel, restaurant, cabaret, cocktail lounge, banquet facilities and health spa services in Class 42*.

2. By an application received 18 June 2008, Mascha & Regner Consulting KEG (“the applicant”) applied for the registration to be revoked under the provisions of sections 46(1)(a) and (b) of the Act on the grounds of non-use. Revocation is sought with effect from 11 December 2004 in relation to the claim made under section 46(1)(a) and from 18 June 2008 in respect of the claim made under section 46(1)(b).

3. The registered proprietor filed a counter-statement essentially denying the registration should be revoked under either section 46(1)(a) or (b).

4. Only the registered proprietor filed evidence in these proceedings. The matter came before me for hearing on 18 November 2009 when the registered proprietor was represented by Simon Malynicz of Counsel instructed by RGC Jenkins & Co. The applicant did not attend nor was it represented but written submissions in lieu of attendance were filed which I have taken into account in reaching my decision.

The Evidence

5. This consists of witness statements from Jeffrey J Barone, Vice President and Secretary of The Carlyle, LLC since 1 March 2006 and Stephen Richard James, the registered proprietor’s trade mark attorney. I do not intend to summarise the evidence fully (though I have, of course, reviewed it and will refer to it as necessary) but from it, the following can be taken.

6. There is no dispute that The Carlyle is a Hotel situated on Madison Avenue, New York. The hotel is owned by the registered proprietor in these proceedings and said to be under the ultimate control of Rosewood Hotels & Resorts LLC (“Rosewood”). The hotel opened in 1931 and has been in the current ownership since 2000.

7. The Carlyle has around 180 rooms and suites (exhibits JJB1 and JJB4). It prides itself on being a luxurious establishment in the art deco style with its former guests including royalty and US presidents as well as well-known people from the music, stage and screen industries (exhibit JJB1, JJB6 and SRJ7). The hotel was included in the UK-based Condé Nast Traveller’s Gold List in 2006 and 2007 as being best

hotel for ambience/design (exhibit JJB4 showing it to be listed 17th out of 18 and 13th out of 18 hotels in the respective years).

8. The Carlyle has a range of facilities including a number of restaurants and a cocktail lounge/bar (see exhibit JJB6). One of its restaurants, Café Carlyle, plays host to regular cabaret and jazz performances (JJB1). The hotel also has spa facilities however, whilst the actual date of opening of the spa is not specified, it appears from exhibit JJB6 that the spa did not open until the summer of 2008 (see extract from Hotel Designs magazine dated 14 February 2008).

9. Mr Barone gives the following details of the number of UK residents who have stayed at the hotel:

Year	UK resident visitors	Revenue from UK resident visitors
2004	102	£277,834
2005	652	£1,731,527
2006	724	£2,296,347
Total	1478	£4,305,708

10. Rosewood has a London sales office which Mr Barone says has the facility to book rooms as well as the other facilities provided by The Carlyle. As of the date of Mr Barone's witness statement (10 January 2008) 4 people were employed there. He says the office has the facilities to take prepayment for bookings at the hotel in £ sterling and that it deals directly with potential and actual UK based customers as well as UK based travel agents, tour operators, corporations and conference and meeting agents. Mr Barone says that UK residents can also book rooms at The Carlyle through well known UK travel agents and, in support of this at JJB6, exhibits printouts from the British Airways and Yahoo Travel websites.

11. The evidence at JJB1 shows screen prints taken on 9 September 2008 (and therefore after the relevant periods) from the Wikipedia (1 page), thecarlyle.com (2 pages) and rosewoodhotels.com 11 pages) websites. The extracts from Wikipedia and thecarlyle.com give general information about the hotel, its café and bar with the latter pages providing also a New York telephone number as a contact point. The extracts from the rosewoodhotels.com website give details of Rosewood and the various hotels and resorts this company owns/runs. These pages also include details of the company's sales offices, one of which is in London, and provide a "toll-free" phone number for Great Britain for room reservations for all of the company's hotels and resorts. The "toll-free" number given for Great Britain is the same number as that given for a number of other countries namely Denmark, France, Germany, Northern Ireland, Portugal, Sweden and Switzerland.

12. Whilst no evidence is given as to when thecarlyle.com or rosewoodhotels.com websites were first available, various extracts from the Internet archive Waybackmachine are exhibited at JJB2 which relate to the rosewoodhotels.com website. The extracts are shown to date from 23 January 2005, 13 January 2006 and 12 November 2007. They show a list of hotels owned by Rosewood including The Carlyle. Each of the three extracts gives contact details for The Carlyle in New York (including the address and phone/fax numbers, all, of course, in New York.)

The extracts also show details of Rosewood's sales office in London. Whilst nothing turns on this, I note that the details in the latest of these differ from those presented in the earlier two.

13. No details are given for any expenditure made in relation to advertising or promotion of the hotel within the UK. That said, both Mr Barone and Mr James refer in their witness statements to the activities of Rosewood's sales office in London and say that it operates via sales calls, trade shows and mailings as well as entertainment and marketing events. At SRJ5 is exhibited a copy of an invitation to attend a book launch which Mr James says he received from Ms Vicki Taylor, the Regional Director of Sales of Rosewood. I do not know whether he received the invitation as an invitee or as part of his preparation for filing evidence. The book being launched was a commemorative illustrated history of the Carlyle hotel. The event was to take place on 25 June 2008 at Claridge's Hotel in London. No further details of any marketing activities are provided.

14. At JJB5 are exhibited several extracts from major UK newspapers and magazines, some online and some paper versions, which make reference to or review the hotel, its café or bar. These include extracts from the travel sections of The Sunday Times, The Independent, The Telegraph, The Mirror, The Guardian, The Mail on Sunday and House & Garden. These extracts date from as early as 30 November 2002 through to 30 May 2008. In some cases the mention of The Carlyle hotel is somewhat peripheral ("Another great hotel is The Carlyle in New York" see-My life in travel, The Independent 7 June 2008) in others the articles report a little more fully on the author's stay at or visit to the hotel or one of its facilities (see-Room Service: Carlyle Hotel, New York City, The Independent 30 November 2002). Some of these extracts include contact details for the hotel in the form of a New York telephone number or by reference to thecarlyle or rosewoodhotels websites.

15. At SRJ8 is exhibited an extract from a consumer website which offered a stay at The Carlyle as part of a competition prize. The closing date of the competition was 23 September 2007. Further extracts, from the Thomas Cook Travel Magazine and lifestyle-boutique city guide also make reference to the hotel and provide contact details including a New York telephone number.

16. Mr James also makes reference to previous proceedings between the parties involving revocation of a Community Trade Mark and exhibits the evidence of use filed in that case. The exhibit consists not of original material but of photocopies, the quality of which is so poor that I am unable to see with any degree of accuracy exactly what the material shows, although I am able to discern that some of it is in language(s) other than English. In any event, I do not know the extent of the claims and defences made in that case and will make my decision on the basis of the claims and material before me.

17. That concludes my summary of the evidence as far as I consider it necessary.

The Law

18. The application for revocation is founded on section 46 of the Act. This states:

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

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

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

(c)

(d)

(2) For the purposes 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)

(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 exist at an earlier date, that date.”

19. The onus of showing that the trade mark in question has been used within the relevant periods, or that proper reasons exist for its non-use, rest with the proprietor. This is set out in section 100 of the Act which states:

“100. –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.”

20. The application for revocation is based on section 46(1)(a) and (b) of the Act. The registration procedure for the mark in suit was completed on 10 December 1999. The applicant seeks revocation of the registration under section 46(1)(a) from 11 December 2004. The relevant period under this section is therefore 11 December 1999 to 10 December 2004. Under section 46(1)(b) it seeks revocation from 18 June 2008, making the relevant period 18 June 2003 to 17 June 2008.

21. Whilst the Act refers to “genuine use” having been made of the trade mark, it does not set out what constitutes such use. The requirements for “genuine use” have been set out by the European Court of Justice in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2004] FSR 38. From these two leading authorities, the following main points can be derived:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be “on the market” and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- the use must be with a view to creating or preserving an outlet for the goods or services *Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

22. Before I go on to consider the evidence filed by the registered proprietor there is a preliminary matter I should address. At the hearing, Mr Malynicz criticised the applicant's written submissions, describing the challenges made therein as a "diatribe against our evidence of use". He said that if the applicant had wanted to challenge the registered proprietor's evidence it should have done so "in a proper way" by filing its own evidence or by seeking cross examination.

23. Mr Richard Arnold Q.C. sitting as the Appointed Person in *Pan World Brands Ltd v Tripp Ltd*, the *Extreme* trade mark case, [2008] R.P.C 2 said:

"36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that ... it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

Whilst I agree the applicant's submissions criticise the registered proprietor's evidence, I do not consider them to say that the evidence is e.g. untrue or incredible. In my view, the applicant's submissions do no more than that which any advocate would do at a hearing i.e. highlight what, in the advocate's opinion, the evidence actually shows and, perhaps more importantly, what it doesn't show. I will make my own evaluation of the evidence based on the principles set out above.

24. The applicant's submissions include a comment that the registered proprietor has not provided any evidence of use of the mark in respect of any of the services specified in the registration. It states that "the services are of a nature that require the immediate presence of the purchaser for delivery, and were only ever provided in

the United States of America, a foreign country". It points to the absence of invoices or other documentary evidence of use of the trade mark in connection with actual sales. This was a matter also considered by Mr Richard Arnold Q.C. in the *Extreme* trade mark case. He said:

"(4) The standard of proof was the ordinary civil standard of proof upon the balance of probabilities. When applying this standard, the less probable the event alleged, the more cogent the evidence had to be to demonstrate that it did indeed occur. ([30]) *H (Minors)(Re)* [1996] A.C. 563, HL applied. *NODOZ Trade Mark* [1962] R.P.C. 1, Ch.D. considered.

(5) Whilst a bare assertion of use would not suffice as evidence of use, a statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark had been used would not constitute bare assertion. It might be impossible for a witness to produce documentary evidence and there was nothing in the Trade Marks Directive, the Act or the Rules which required the proprietor to adduce evidence from an external witness, although it might be advisable to do so. ([31])"

Mr Arnold held that in the absence of positive evidence of non-use it was not correct to impose a standard of proof requiring the appellant to provide "certainty" and "conclusive evidence". The correct approach is to step back and consider the evidence as a whole to see what facts it has established. The standard of proof is the ordinary civil standard of proof on the balance of probabilities.

25. Clearly, as the hotel is located in New York and provides its facilities there, it cannot be said to provide these services in the UK. Mr Malynicz accepted this but submitted that despite this there had been genuine use of the mark in the UK. This submission was based on the claim that advertising and marketing of the hotel and its services had taken place in the UK and this was sufficient, in his view, to constitute genuine use of the mark in the UK. He was unable to take me to any reported cases on the point but did refer me to the opinion of the late Advocate General Colomer in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07 amongst others as support for his claim and said that "what distinguishes material use from non-material use is whether the use is competitive for market share and custom on the market".

26. There is nothing in the evidence to show that the registered proprietor has ever placed any advertising in the UK for any of its services. Whilst there are several newspaper and magazine extracts (JJB5) mentioning the hotel and some of its facilities, all of these are written by third parties and are, at best, simply reviews of visits the authors have paid to (parts of) the establishment.

27. There is evidence that the registered proprietor has its own website (JJB1) however I do not know when this website was established and the extract bears no date other than the date it was downloaded (9 September 2008) which is after the relevant periods. There are extracts from the Rosewoodhotels website which refer to the hotel (JJB1 and JJB2). Again the extracts at JJB1 bear no dates other than the date the print was taken. The extracts at JJB2 are said to date from within the

relevant periods however the information in these extracts refer to Rosewood and simply list The Carlyle as one of the company's many hotels. And, in any event, as was stated in *800 Flowers Trade Mark* [2000] FSR 697,

“the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world. It all depends on the circumstances, particularly the intention of the website owner and what the reader will understand if he accessed the site”

28. In his evidence Mr James refers to a book launch and exhibits an invitation to the event (SRJ5). The exhibit shows the event was due to take place very shortly after the expiry of the latter of the relevant periods. Clearly these events take some time to organise and it is likely that this organisation would have to have been carried out during the relevant period. The invitation shows the event to be a “cocktail reception celebrating the commemorative release of the book”. I am far from convinced that this proves the event was intended to promote the services of the hotel but in any event, there is no evidence of how many invitations were sent out, to whom they were sent nor how many people (if any) attended the event.

29. The Internet competition details exhibited at SRJ8 refer to part of the prize being a short stay at the Carlyle hotel. The competition refers to The Carlyle as a Rosewood Hotel and is said to be “to celebrate the opening of New York Fashion Now at the V&A”. It shows the competition to be open to UK residents and to have a closing date of 23 September 2007. There is no evidence as to who organised this competition (and certainly none that the registered proprietor did) and there is no evidence to show how many people (if any) may have accessed this webpage.

30. There is (unchallenged) evidence that UK residents stayed at the hotel in the years 2004-2006. What is singularly absent is any detail as to how they may have arranged those stays. Both Mr Barone and Mr James state that bookings can be made by a number of means. They refer to independent travel agents and also to the London booking office. Whilst there is no dispute that there has been a sales office in London for several years and no reason to doubt the claims made that the office had the facility to book stays at the hotel in New York, there is no evidence that any bookings for this particular hotel were actually made through it. In view of the fact that the contact details for the hotel set out in the various parts of the evidence give readers an Internet address or New York telephone number as a contact point it would appear that any location with Internet or phone access would have provided a similar “facility”. Whilst it is clear that Rosewood operates a number of hotels and resorts, there is no evidence the office has ever been promoted by or used the trade mark in dispute. In any event all of the evidence referring to it shows that sales office to be a Rosewood sales office for much of Europe marketing services which are delivered in the US.

31. There is evidence that there is a “toll free” number available to people the UK allowing them to call a Rosewood office to make a reservation in the company's hotels and resorts. The number given appears to be an international freephone number and the same number is given for people from many other European countries to call. I do not have any information to show where any calls to that

number would be taken however again, all references to the number appear in the Rosewood material and not under the trade mark in dispute. And again, there is no evidence of anyone (and if so who and where they are based) having used this number.

32. In short, I find there is no evidence within the relevant periods of any marketing or advertising of the hotel and its facilities in the UK by the registered proprietor under the mark. That being the case, I do not need to decide whether advertising and marketing alone is sufficient to constitute genuine use of the mark in the UK for services provided elsewhere. In my view the registered proprietor has not shown genuine use of the mark in the UK in respect of any of the services as listed in the specification.

33. That is not an end to the matter however as Mr Malynicz submitted an alternative claim that the registration should be retained in relation to *hotel reservation services, hotel booking services and hotel information services* to reflect the work carried out by the London sales office and claimed that these were services which would be included within the general term *hotel services* as set out in the specification of the registration as per the decision in *Thompson Holidays Ltd v Norwegian Cruise Ltd* [2003] RPC 32. This alternative claim was raised for the first time in the registered proprietor's written submissions and did not therefore form part of its initial case. Certainly, the applicant did not, as far as I am aware, have any prior notice of it. I therefore decline to deal with it. Had I done so, I would have rejected the claim not least, in view of my findings set out above, because the evidence does not show any use of the mark by the sales office within the relevant periods.

34. As I have found there has not been any use of the trade mark in respect of any of the services for which it is registered within the period of five years following its registration, I direct that registration number 2202123 be revoked in full with effect from 11 December 2004.

35. The application for revocation has succeeded and the applicant is entitled to an award of costs in its favour. I note that the applicant did not file any evidence nor did it attend the hearing though it did file written submissions in lieu of attendance. I therefore award costs on the following basis:

Filing notice of opposition and reviewing counterstatement:	£200 & £200 fee
Reviewing evidence:	£500
Filing written submissions:	£300
Total:	£1200

36. I order The Carlyle, LLC to pay Mascha & Regner Consulting KEG the sum of £1200. This sum is to be paid with seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of December 2009

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