

O-160-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 84238
BY MERLIN ATTRACTIONS OPERATIONS LIMITED FOR REVOCATION OF
REGISTRATION NO. 1559240 IN THE NAME OF
ATLANTIS SUBMARINES INTERNATIONAL, INC**

BACKGROUND

1. Registration No. 1559240 for the trade mark shown below stands registered in the name of Atlantis Submarines International, Inc (“ASI”).



The trade mark was applied for on 17 January 1994 and the registration procedure was completed on 23 June 1995. The trade mark stands registered for the following services:

Organising and arrangement of tours and excursions; organising and arrangement of submarine tours and excursions; travel agency services; travel advisory and information services; booking services relating to travel, holidays, trips and conducted tours; all included in Class 39.

The registration is subject to the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the word “Submarines” and a device of a submarine.”

2. On 23 November 2011, Merlin Attractions Operations Limited (“Merlin”) applied for revocation of this registration under the provisions of sections 46(1)(a) & (b) of the Trade Marks Act 1994 (“the Act”). Merlin seeks revocation in respect of all the services for which the trade mark is registered.

3. Merlin asks for the registration to be revoked with effect from 24 June 2000 under section 46(1)(a) and, under section 46(1)(b), 23 November 2011.

4. On 17 February 2012, ASI filed a form TM8 and counterstatement. In its counterstatement ASI said:

“3. [ASI’s] primary business is that of providing submarine tours in destinations such as Hawaii, Cayman Islands, Aruba, Barbados, Curacao, Guam and the Virgin Islands.

4. These tours may be booked by UK customers directly with [ASI] or through affiliate web sites. UK customers can also book through UK travel agents or as shore trips from cruise ships. [ASI] will provide evidence of this and will show that a significant percentage of the 12 million customers who have taken their tours since they

commenced in 1987 are UK citizens who will have utilised services provided in the UK or available to the UK to arrange the tours.”

5. Only ASI filed evidence. While neither party asked to be heard, both parties filed written submissions in lieu of attendance at a hearing. I will refer to these submissions below.

ASI's evidence

6. This consists of a witness statement, dated 11 May 2012, from Doug King, Chief Operating Officer of Atlantis Submarines (International Holdings) Inc (“ASIH”); Mr King has been employed by ASIH for 25 years. Mr King begins by explaining ASIH’s corporate structure, namely:

- ASIH is the parent company incorporated in Canada;
- ASI (also based in Canada) is a wholly owned subsidiary of ASIH;
- Atlantis Submarines (Barbados) Inc (“ASB”) which operates ATLANTIS submarine tours in Barbados, is incorporated in Barbados and is a wholly owned subsidiary of ASIH. Mr King explains that while a licence fee is paid, “no written TM licence agreement exists, due to the relationship between these companies.”
- Atlantis Adventures (Cayman) Ltd (“AAC”) which operates the ATLANTIS submarine tours in Grand Cayman under licence from ASI is incorporated in Grand Cayman, and in which, states Mr King, “[ASIH] has a 40% equity interest.”

7. Mr King explains that ASIH was founded in 1985 and “originated the tourist submarine industry”. It remains, he says, the world leader in the industry and operates tourist submarines at Grand Cayman, Barbados, Aruba and Cozumel in the Caribbean, on three islands in Hawaii and in Guam. ASIH employs approximately 400 people worldwide.

8. Exhibit DK01 consists of what Mr King describes as “an extract from the current Cayman Islands tourist information site for the UK market...”. The page provided was downloaded on 8 May 2012 from www.caymanislands.co.uk and, under the heading Atlantis Adventures Cayman Ltd, contains, inter alia, the following text:

“Atlantis Submarine Cayman is celebrating its 25th Anniversary in 2010...”

To the right of the page there are representations of four flags, one of which is that of the European Union. At the bottom of the page is a box to “BOOK NOW”. While the trade mark the subject of the registration does not appear on the page, it does contain the above quotation as well as references to: “Atlantis Submarines International”, “Atlantis”, “Atlantis 1 Submarine”, “Atlantis X1 Submarine” and “Atlantis 1”.

9. Mr King states: “the primary destinations for our British customers in the Caribbean are Barbados and Grand Cayman and over the years we have carried a total of approximately 3

million passengers at these two locations.” Exhibit DK02 consists of 16 pages taken from ASIH’s websites www.atlantissubmarines.com and www.atlantisadventures.com. Page 2 refers to both Hawaii and the Caribbean; pages 2-4 appear to date from 2012; pages 3 and 4 relate to the Cayman Islands; the trade mark the subject of the registration can be seen on pages 2 and 3 with page 4 containing a reference to “Atlantis Submarines”. Page 3 contains references to “Make a Reservation”, “Click here to check availability” and “Book on-line & Save”. Pages 5-7 relate to Hawaii. At the top right of page 5 there appears a trade mark similar to that registered but with the submarine device to the right of the words; the words “Atlantis Submarines” also appears on this page as does a reference to “Book Now”.

Page 6 contains references to “Atlantis Adventures”, “Atlantis Submarines” “Atlantis”, “Atlantis Navatek Cruises”, “Atlantis Submarine Adventure” and “Atlantis Combo”, together with a reference to “Search for your experience”. Page 7 contains, inter alia, a reference to a “Gold Certification – 2011-2013” received by “Atlantis Adventures” from the Hawaii Ecotourism Association and a copyright date of “2000-2011”. Pages 8-9 refer to Barbados, they also appear to date from 2012. The trade mark the subject of the registration can be seen on the top left of page 8 and the page also contains references to “GREEN ATLANTIS”, “Atlantis Submarines”, “Book Now” and “Check availability.”

Pages 8 and 9 contain, inter alia, representations of four flags, one of which is the Union Jack (the relevance of these flags is not explained); page 9 also contains references to “Atlantis Submarines”. Pages 3, 5, 6, 7 and 8 contain references to what appears to be US toll free telephone numbers and/or prices in US\$.

10. Page 10 consists of a page downloaded from www.atlantisadventures.com using the Internet archive waybackmachine which is dated 28 January 2011. It may contain the trade mark the subject of the registration, but the top of the page where the trade mark appears is partially obscured by the data obtained from the Internet archive. The page contains the words “Atlantis Submarines” in a slightly stylised font, “Atlantis Submarine Tour” and under the heading “Book on-line or call us toll free” has telephone numbers in Hawaii, the Caribbean and Guam; there is also a reference to “Reserve your activities”. Page 11 appears to date from 2011 and contains a reference to, inter alia, “Atlantis Submarine Tour”. Page 12 is also from www.atlantisadventures.com and was obtained using the waybackmachine; it dates from 25 August 2006 and at the top right of the page there is a trade mark similar to that registered but in which the word “SUBMARINES” is replaced by the word “ADVENTURES”. The page relates to the “Atlantis Travel Agent Program”. Of this page Mr King says it is:

“...designed to provide an enhanced service to travel agents booking via the website or through Atlantis’ dedicated travel agent representatives. Atlantis adventures offered under the mark include powered snorkel expeditions, as well as tours and excursions provided jointly with third party operators to include catamaran sailings, beach barbeques, whale watching, themed evening entertainment and helicopter tours.”

The page directs travel agents to “Travel Agent Representatives” based in: Honolulu, Fort Lauderdale, Guam and Vancouver and contains references to “Become a member” and “Make a reservation.”

11. Pages 13-17 (also from www.atlantisadventures.com) and obtained using the waybackmachine all date from 15 October 2006. Page 13 bears the Atlantis ADVENTURES and device trade mark mentioned above at the top right of the page and also the device and word Atlantis together (but without the word "SUBMARINE") on other parts of the page. There are also references to "Atlantis Adventures", "Atlantis Submarine Expedition", and "Atlantis Submarine". The remaining pages contain similar references and relate to a range of the activities referred to by Mr King above and offer the opportunity to "Reserve this tour".

12. Mr King states that Atlantis Submarine operating sites have a marketing relationship with cruise lines such as P&O, who sell tickets for submarine rides to their passengers. Exhibit DK03 consists of 4 pages downloaded from www.pocruises.com on 8 May 2012 in relation to a 30 night Caribbean cruise on the ship Aurora commencing on 16 October 2010. Under the heading "Shore excursions by port" it says:

"Please note: The excursion(s) listed are typical for this port. During the 12 weeks before departure, confirmed excursions can be viewed and pre-reserved via the Cruise Personaliser."

Page 4 of the exhibit contains a reference to:

"The Atlantis Submarine Experience – SOMETHING DIFFERENT – Enjoy the magic of the underwater world of Grand Cayman on board the incredible Atlantis Submarine."

Under the heading "Plan ahead" it says:

"By reserving your shore excursions prior to your cruise, you can relax having secured a place on the tours you want. No need for last minute destination research or arrangements."

13. Mr King explains that ASIH gives the cruise line a net rate for a submarine ride and the cruise line markets and sells the ride to its passengers at a higher price; the cruise line collects the full ticket price from the customer and remits the net amount to ASIH. The difference in the two prices is shown as a commission in exhibit DK4 which consists of an:

"Atlantis Adventures (Cayman) Ltd – Agent Commission Report – Summarised"

for the period 1 October 2006 to 31 December 2011."

14. The report appears to refer to a range of P&O vessels (the Arcadia, Armetis, Aurora, Ocean Village, Oceana and Oriana) and lists, inter alia, the number of passengers and the net revenue for the ATLANTIS EXPEDITION. The exhibit appears to indicate that in the period mentioned, 965 people took the Atlantis Expedition with a net Revenue of, what I assume to be, approximately US\$46,000. Mr King states that ASIH has a similar pricing relationship with Virgin Holidays, no further evidence in this regard is provided.

15. Mr King explains that ASIH sells submarine tours “by means of the following marketing channels”: cruise lines e.g. Carnival, Princess, Royal Caribbean P&O; travel agents e.g. Virgin Holidays, Thomson, Expedia; island hotel desks; via its website and the websites of agents with whom it has marketing relationships and direct sales to on island customers. He states that originally brand awareness was generated through advertising in print media, attendance at trade shows and the efforts of sales agents. He adds that in the early years of its operation, ASIH employed a full time sales agent in the UK. Mr King goes on to say that brand awareness and sales are now generated through its own websites and the websites of others such as cruise lines, Expedia, Virgin and Trip Advisor. He says that increasingly customers find ASIH’s services via the web prior to their departure and make a buying decision prior to their arrival on the islands on which ASIH operates. ASIH’s website is, Mr King explains, also linked to government web sites such as Barbados.org. Other than exhibits DK03 (relating to P&O) and DK05 (relating to tripadvisor.co.uk), no supporting evidence is provided by Mr King.

16. Mr King refers to the website www.tripadvisor.co.uk explaining that a search of that site reveals 86 reviews of ASIH’s services, of which 26 were written by UK citizens. He adds “please keep in mind that a relatively small percentage of our customers take the time to write a review on Trip Advisor”. While copies of all of these reviews are not provided, Mr King does provide the following details:

<u>Date - review posted</u>	<u>Location of Reviewer</u>
14 April, 2012	Wakefield, West Yorks
30 March, 2012	London, U.K.
13 Feb., 2012	London, U.K.
18 Jan. 2012	Birmingham, U.K.
13 Dec., 2012	London, U.K.
26 OCT., 2011	Essex, U.K.
19 July, 2011	England
4 July, 2011	Glasgow, U.K.
17 May, 2011	Broadstairs, U.K.
26 March, 2011	London
19 Feb., 2011	United Kingdom
8 Feb., 2011	Amersham, U.K.
30 Dec., 2010	Cambridge, U.K.
21 Dec., 2010	London, U.K.
8 Nov. 2010	Peterborough, U.K.
29 September, 2010	Derby, U.K.
7 September, 2010	Newbury, Berkshire
2 September, 2010	South Yorkshire
10 August, 2010	Portsmouth, U.K.
8 July, 2010	Portsmouth, U.K.
21 Dec., 2010	Cheshire, U.K.
20 May, 2010	Kent, U.K.
21 Dec. 2009	Norwich, England
09-Mar-08	Northampton. U.K.
7 June, 2006	Hants, U.K.
3 Feb. 2006	Manchester, U.K.

together with an example of a review written on 26 March 2011 by “a resident of London” which reads as follows:

“We booked this trip after reading the reviews on Tripadvisor. We bought the early bird tickets a couple of weeks in advance on the website because we knew we were going to be in Barbados on that day. They were \$88 each which seemed a bit pricey but what the hell, we were on holiday and this was to be a brand new experience. When we arrived everything went smoothly, they handed us our tickets after we showed them our online booking number and proceeded to wait 10 minutes before boarding the small ferry to take us to the Submarine out in the middle of the sea...”

17. Exhibit DK5 consists of 3 pages downloaded from tripadvisor.co.uk on 8 May 2012. The reviews provided are in relation to “Atlantis Submarines Barbados”; 2 reviews from the UK from February 2011 are highlighted.

18. Exhibit DK06 consists of pages downloaded on 8 May 2012 from www.infoweb.newsbank.com. The exhibit contains holiday/travel related articles from *The Times* (dated 10 January 2009) entitled “Fizzing with new pursuits for all the family, from ziplines above the forest to coral beds under the sea”, *The Express* (dated 29 November 2009) entitled “Learning my island ABC”, *The Daily Mail* (dated 2 October 2010) entitled “Islands of Adventure” and *The Daily Telegraph* (dated 16 July 2011) entitled “The perfect island for summer family fun”; all of these mention “Atlantis Submarine”.

19. In relation to ASIH’s relationship with P&O, Mr King explains that P&O is based in the UK and that “P&O cruises generally homeport out of Southampton, England.” Passengers from the UK form, he says, the majority of passengers on P&O cruises. He states that P&O advertise ASIH’s submarine services on its website so that clients can reserve their tours on line or through their travel agent prior to departure. He goes on to say that ASB has had a long relationship with Virgin Holidays who are based in the UK and who market ASIH’s submarines to UK residents and advertise Atlantis Submarines on its website. ASB has, he states, carried the following number of Virgin Holiday passengers: 2007 – 3,669, 2008 – 3,513, 2009 – 2,758, 2010 – 1,830 and 2011 – 1,268 (13,038 in total).

20. Exhibit DK07 consists of a page produced using Google Analytics. Mr King says that this page shows visitors to the ASB website between September 2011 and April 2012. He notes that of the 31,240 visits in that period, 5,497 were from the UK.

21. Mr King concludes his statement in the following terms:

“34. In order to protect the trade mark in the Cayman Islands it is necessary to have a UK registration. In [ASI’s] case that base registration is...the subject of these proceedings. In so far as the registrar has any discretion in revocation proceedings we ask that it is exercised in favour of [ASI] and that the trade mark in suit is allowed to remain on the register and continue to be protected for the designated services.”

22. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The Law

23. Section 46 of the Act reads as follows:

“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 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).....

(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.”

24. Section 100 of the Act is also relevant and reads:

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

The relevant five year periods

25. The application for revocation is based upon sections 46(1)(a) & (b) of the Act. Merlin asks for the registration to be revoked with effect from 24 June 2000 under section 46(1)(a) and, under section 46(1)(b), 23 November 2011. The relevant periods are, therefore, under section 46(1)(a) – 24 June 1995 -23 June 2000 and under section 46(1)(b) – 23 November 2006 -22 November 2011.

ASI’s first written submissions

26. In its submissions dated 29 October 2012, ASI said, inter alia:

“4. In the subject case it is clear from the evidence that [ASI] has used its mark genuinely and extensively in the course of trade as a means of distinguishing its services from those of other traders. Whilst the tours and excursions themselves are provided overseas, the services involved in booking and arranging the tours and excursions are provided directly to UK consumers and indirectly as set out in Mr King’s evidence.

5...we submit that the specification of services of [ASI] is not unduly wide and sufficiently identifies the category of services for which the mark has been used without ambiguity. We therefore request that the wording is retained in its entirety.”

Preliminary point arising from Merlin’s submissions

27. Merlin’s submissions of the same date consist of, inter alia, a detailed critique of Mr King’s witness statement and exhibits. In a letter dated 30 October 2012, ASI responded to these submissions. It said, inter alia:

“The content of the submissions on behalf of [Merlin] is totally inappropriate for this stage of the proceedings. In particular [Merlin] seeks to object to the format and admissibility of

Mr King's evidence of use. Any such objections should have been raised at the earliest opportunity and certainly within the 2 month term set by the registrar.

As TPN 5/2007 makes clear, it is unacceptable for one party to invite the registrar to disbelieve the evidence of the other without giving the second party the opportunity to respond."

28. ASI asks for certain paragraphs of Merlin's submissions to be either struck out or for the opportunity for it to file a response. In a letter dated 31 October 2012, Merlin responded to ASI's letter and asked for its submissions not to be struck out. It said, *inter alia*:

"...However, given that the proceedings at issue is a non-use revocation and the only papers filed to date are the witness statement of Mr King (together with exhibits) that purported to relate to [ASI's] use of its mark, it is difficult to see what other aspect of the case [Merlin's] submissions could conceivably relate to.

29. In relation to ASI's point on TPN 5/2007 Merlin said:

"...We would point out that at no point in its submissions did [Merlin] invite the registry to disbelieve the evidence of Mr King. [Merlin's] submissions were most certainly very critical of the evidence provided, but inviting the registry to disbelieve sworn evidence and criticising said evidence are two entirely different things. We also point out that at no stage did [Merlin] object to the format and/or the admissibility of Mr King's evidence. Whilst it was pointed out that Mr King's witness statement was not notarised or legalised, this was with a view to questioning the statement's probative value as a whole rather than its admissibility."

30. Tribunal Practice Notice (TPN 5/2007) referred to by the parties is entitled "Procedure for parties to challenge evidence filed in *inter partes* trade mark disputes". The relevant parts read as follows:

"1. The purpose of this Tribunal Practice Notice is to set out procedures for parties to challenge factual evidence filed by the other side in *inter partes* disputes. It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or by answering the challenge that his or her evidence is untrue in cross-examination. The tactic of raising such challenges without notice at oral hearings has drawn the following comment from Richard Arnold Q.C. as the Appointed Person in EXTREME Trade Mark BL O/161/07).

"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 the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

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. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). 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)."

31. The TPN goes on to explain the circumstances and manner in which evidence should be challenged. I note the following in Merlin's submissions dated 29 October 2012:

"19. Mr King's witness statement and exhibits have been simply signed and is not notarised or legalised.

20. While [Merlin] is not inviting the registry to calling into question the veracity of the contents of Mr King's witness statement, it considers that the probative value of Mr King's statement, as and of itself, must be considered to be at the lower end of the spectrum bearing in mind Mr King is part of the corporate structure to which [ASI] belongs and his vested interest in seeing the trade mark maintained.

21. It is submitted that in light of the reduced probative value of Mr King's statement *per se*, the actual evidence adduced by Mr King...will be material in determining whether genuine use [of the registered trade mark] has taken place in the relevant market and will be more significant in terms of the assessment than the assertions made by Mr King in his statement."

32. Mr King has filed his evidence in the form of a witness statement which he has signed and which bears a statement of truth; it therefore complies with the requirement of Section 69 of the Act and rule 64 of the Trade Marks Rules 2008. In approaching the paragraphs identified in Merlin's submissions which ASI consider are open to objection, I must keep in mind that in revocation proceedings the onus is upon ASI to prove that it has used its trade mark. I must also consider Mr King's position in the company and bear in mind what information was likely to have been available to him to support the evidence he provides. As Merlin have confirmed that it is not challenging the veracity of Mr King's statement, I intend to approach its submissions (which go to the heart of rather than the background to the dispute, the latter of which is not, in my view, relevant) on the basis that what Merlin is asking me to do is not to disbelieve Mr King's evidence, but, to use the words of the Appointed Person in *Extreme*, not to consider it uncritically. If I consider Merlin's submissions go beyond this (bearing in mind it had the

opportunity to file evidence or challenge ASI's evidence during the evidential rounds), I propose to give its submissions no weight.

The authorities on genuine use

33. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

"In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

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

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

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

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

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

(3) 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].

(4) 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]”.

General observations

34. As none of the evidence provided by ASI appears to relate to the period in play under section 46(1)(a) of the Act i.e. June 1995 to June 2000, I have only the position under section 46(1)(b) of the Act i.e. November 2006 to November 2011 to consider. In these proceedings ASI is relying upon use on the Internet on both its own websites and those of partner organisations and use in the press. When considering ASI’s evidence, I remind myself of the comments of the General Court (GC) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07* in which it stated:

“105. Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).”

I will also keep in mind the comments of Jacob J in *Laboratories Goemar SA’s Trade Mark* [2002] ETMR 34 when he said:

“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 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. In the present cases there was a difference between the total sales figures and relevant sales. Mr Mellor, for the applicants for revocation, told me that sorting out the wheat from the chaff involved a lot of work. In the end, however, he accepts that some very small potentially relevant sales under the marks were proved.”

35. Although ASI’s evidence shows a number of examples of the trade mark in use in the form in which it is registered, the evidence also contains examples of the word “Atlantis” being used in a range of different formats. As ASI have at no point indicated that it is relying upon the provisions of section 46(2) of the Act i.e. “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”, I proceed on the basis that it considers the examples of the use in the form in which the trade mark is registered

to be sufficient. When approaching ASI's evidence, I must keep in mind that it is not enough that consumers based in the UK have availed themselves of ASI's services whilst overseas. In order to constitute genuine use in the UK, I must consider whether ASI's evidence demonstrates that it is maintaining or creating a market for its services in the UK.

36. In relation to use on the Internet, Merlin refers to comments in *Dearlove (t/a Diddy) v Combs (t/a Sean Puffy Combs, Puffy and P. Diddy)* [2007] EWHC 375 in which Kitchen J (having referred to the decisions in *800-Flowers Trade Mark* [2002] FSR 12 and *Euromarket Designs Inc v Peters* [2001] FSR 20) said:

“25 I believe it is clear from these authorities that placing a mark on the internet from a location outside the United Kingdom can constitute use of that mark in the United Kingdom. The internet is now a powerful means of advertising and promoting goods and services within the United Kingdom even though the provider himself is based abroad. **The fundamental question is whether or not the average consumer of the goods or services in issue within the United Kingdom would regard the advertisement and site as being aimed and directed at him.** All material circumstances must be considered and these will include the nature of the goods or services, the appearance of the website, whether it is possible to buy goods or services from the website, whether or not the advertiser has in fact sold goods or services in the United Kingdom through the website or otherwise, and any other evidence of the advertiser's intention.” (my emphasis).

37. In relation to exhibit DK01, in its submissions Merlin says, inter alia:

“25... Mr King's contention is that [the website referred to] is “a tourist information site for the UK market” but nothing in the evidence provided support this. The extract adduced simply provides information about the Atlantis Submarines excursion in the Cayman Islands...Clearly the implication is that because the website uses the Internet top level domain indicator “.co.uk”, then this site is necessarily aimed at and used by UK customers; however, this is not a conclusion that can in any way be drawn from the evidence provided.

30. Nothing [provided in exhibit DK01] relates to the UK specifically in any way...There is no mention of the United Kingdom in the text and no indication that the UK consumer was the intended target of the website...”

38. I have described the contents of exhibit DK01 above; while the page provided was downloaded after the period specified under section 46(1)(b) of the Act had expired, I note that Mr King describes it as “the current Cayman Islands tourist information site for the UK Market”, suggesting that it is simply the most recent incarnation of the site. While it does not bear a representation of the trade mark the subject of the registration, it does contain references to “Atlantis” in a range of formats (see para. 8 above). Although the UK is not specifically mentioned in the text, the page contains the domain indicator “.co.uk” and the flag of the European Union; the relevance of the latter is not explained. I think that the use of the domain name “.co.uk.” is likely to lead the average consumer in the UK to think that the page provided

was directed at him. While this exhibit suggests that ASI may have been targeting customers in the UK, Mr King has provided no evidence of the number of bookings ASI has received via this website from customers based in the UK.

39. In relation to exhibit DK02, Merlin says, inter alia:

“33. In relation [to the websites] identical criticism can be levelled at these in terms of their evidential value with regard to showing use of the trade mark in the United Kingdom. Nothing on the extracts provided is aimed specifically at the UK consumer and all on-line booking prices are provided in US Dollars.”

40. Although the trade mark the subject of the registration does appear on various pages of the exhibit i.e. pages 2, 3, 8 and, I think, page 10, with the exception of the device of the Union Jack which appears on pages 8 and 9 (the relevance of which is not explained and which appears to date from 2012), as none of the other pages appear to be directed at the average consumer in the UK, this exhibit does not, in my view, assist ASI.

41. Turning now to the evidence of use in conjunction with partner organisations, I note that in relation to exhibit DK03 Merlin says, inter alia:

“39...Contrary to Mr King’s assertions, it cannot be assumed, simply because P&O is a company with its base in the UK, that all of P&O’s customers are a) from the United Kingdom; and b) purchased any tickets for the Atlantis Submarine experience attraction before setting out on a cruise....”

42. As I indicated above, exhibit DK03 was obtained from www.pocruises.com. While it refers to a P&O cruise which began on 16 October 2010 i.e. within the material period, it does not indicate from where the cruise departed nor does the trade mark the subject of the registration appear in the exhibit. In addition, while it is clear from text included in the exhibit that shore excursions can be booked in advance, ASI provides no evidence/explanation of how many customers based in the UK who travelled on the Aurora booked an “Atlantis Submarine Experience” through P&O whilst in the UK.

43. In relation to exhibit DK04, Merlin notes in its submissions that, inter alia: (i) the trade mark the subject of the registration does not appear in the exhibit, (ii) the spreadsheet refers to “Atlantis Expeditions”, (iii) the currency at issue is not identified, and (iv) bearing in mind evidence in Mr King’s statement relating to other activities ASI provides, it is unclear what services were actually provided. While the exhibit does show activity within the relevant period, it is true that that it does not feature the trade mark the subject of the registration, the specific services provided, the currency concerned (but which I have assumed to be US\$) or the numbers of those from the UK who booked the excursion prior to leaving the UK. As to ASI’s relationship with Virgin Holidays, as Merlin points out, no supporting evidence whatsoever has been provided in this regard.

44. In relation to Mr King’s comments on marketing, exhibit DK05 and the table listing 26 reviews from tripadvisor.co.uk dated between 3 February 2006 and 14 April 2012, Merlin notes

in its submissions that, inter alia: (i) no evidence attesting to any sales made by the marketing channels identified or that these sales were made under the trade mark the subject of the registration have been provided, (ii) no copies of the various websites referred to by Mr King have been provided, (iii) sales to UK based customers via island hotel desks or to on island customers originating from the UK would not count in any case, (iv) all the trip advisor evidence shows is that 26 people who live in the UK have travelled to Barbados and have taken an Atlantis submarine excursion while they were there. As to the tripadvisor review that is provided, this indicates that the trip was paid for in dollars, suggesting, in Merlin's view, that the trip was not paid for until the consumer had left the UK. In his statement Mr King refers to a range of cruise lines, travel agents and websites. However, other than the exhibit and table mentioned above, no evidence in this regard has been provided by ASI in support; evidence which ought to have been readily available to it. In the absence of such evidence, I am simply not in a position to judge, for example, to whom the marketing materials were directed or what trade mark was identified in those materials.

45. In relation to exhibit DK06 Merlin says:

"61. It is submitted that references to Atlantis Submarines in these articles is for all intents and purposes, incidental. These are not "adverts" or pieces commissioned by Mr King's company (or if these pieces were in fact commissioned no evidence attesting to this has been adduced). The simple occurrence of the term "Atlantis Submarine" in a UK publication does not equate to any "trade mark" use in the United Kingdom and the evidence adduced does certainly not amount to "promotion through traditional print media" as no actual promotion has taken place. All of the exhibits referred to are articles most likely printed in the "holiday" or "travel" sections of UK newspapers which coincidentally make reference to Atlantis Submarines. There is no active "promotion" by Mr King's company at all."

46. Although all of the articles are dated within the material period for the purposes of section 46(1)(b) of the Act, they all appear in a journalistic rather than promotional context e.g. "...to a voyage in an Atlantis Submarine, the ultimate undersea adventure", "A trip on the Atlantis Submarine beckoned...", "to depths of 65ft to 100ft in the Atlantis Submarine to view exotic fish..." and "Or book a seat on one of the two Atlantis submarines...". Given the nature of that use, I agree with Merlin that these references do not amount to promotion on the part of ASI but to incidental references to ASI's services which appeared in the travel/holiday related sections of national newspapers.

47. In relation to the sales between ASB and Virgin Holidays, once again it is likely that the majority of these sales took place in the material period for section 46(1)(b) of the Act. However, I note that in his statement Mr King says:

"18...If the sales to Virgin customers occur in Barbados, the Virgin agents in Barbados are paid a commission on the sale."

The above indicates that Virgin customers can book an excursion whilst in Barbados. As no supporting evidence has been provided (and in particular no explanation of the number of UK

based passengers who booked whilst in the UK), the position is uncertain and does not assist ASI.

48. Finally, in relation to exhibit DK07 (the Google analytics report), Merlin says:

“65...It is noted at the outset that the majority of the period 24 November 2011 to April 2012 relates to a period post dating [Merlin’s] request for revocation.

66...simple figures relating to website traffic do not in any way, as and of themselves, constitute use of a trade mark.

67. As has also been discussed above, the “Atlantis Barbados” website is not aimed at UK customers and therefore even if visitor numbers from the UK totalled more than 50,000 during the same period, this would still not equate to “use” of [ASI’s] trade mark in the United Kingdom.”

49. As Merlin points out, a significant portion of the period to which the report relates is after the material date under section 46(1)(b) of the Act (although Mr King says the report dates from September 2011 and not November 2011 as Merlin suggests). While I noted above that the website pages which refer to ASI’s services in Barbados (exhibit DK02 pages 8 and 9) bear a representation of the trade mark as registered and contains images of the Union Jack, as I mentioned earlier, the relevance of the Union Jack is not explained; other indications such as prices in US\$ dollars suggest, as Merlin argues, that the site is not directed at the average consumer in the UK.

50. Having considered the totality of ASI’s evidence in the light of (i) Merlin’s criticisms of it, (ii) the burden placed upon it by section 100 of the Act, (iii) the comments in *Anheuser-Busch Inc* and *Laboratories Goemar* reproduced above and (iv) what evidence ought to have been available to it, it is, I think, reasonable for me to conclude that:

- ASI’s primary business is the operation of tourist submarines in a number of locations overseas;
- ASI and its services are mentioned on the “co.uk” version of the Cayman Island’s website which is likely to be directed at consumers in the UK;
- ASI’s websites show the trade mark in use in, inter alia, the form in which it stands registered;
- the word Atlantis accompanied by a range of other indications most notably Atlantis Submarine(s) appears throughout the evidence;
- the vast majority of ASI’s website use is directed otherwise than at the UK. The use of the flag of the European Union and the Union Jack are not explained;

- ASI has a business relationship with UK based P&O cruises. ASI's services appear in P&O's on-line brochure and it is possible for customers to book an "Atlantis Submarine Expedition" prior to departing on a cruise;
- that between January 2006 and December 2011, 965 P&O passengers availed themselves of an "Atlantis Expedition" in the Cayman Islands resulting in what appears to be a net revenue of US\$46,000. No indication of, inter alia, what percentage of those taking the tour originated from the UK or booked the tour whilst in the UK is provided;
- ASI appears to have a similar arrangement with UK based Virgin Holidays. In the period 2007-2011, 13,038 Virgin Holiday customers are said to have taken a submarine tour whilst in Barbados. No evidence from Virgin Holidays is provided nor is there any indication of what percentage of those taking the tour originated from the UK or booked whilst in the UK;
- that insofar as marketing of ASI's services is concerned, no evidence is provided of its business relationship with Carnival, Princess, Royal Caribbean, Thomson, Expedia, Virgin Holidays or Barbados.org nor of how its trade mark appears on the websites of these undertakings;
- that between February 2006 and April 2012, 26 reviews of ASI's services written by UK consumers have been posted on www.tripadvisor.co.uk. No indication is provided of how these consumers booked these tours;
- ASI and its services have been mentioned (in passing) in the travel sections of a number of national newspapers. This usage does not amount to promotion of its services by ASI;
- that in the period September 2011 to April 2012, 5,497 visits were made to the Atlantis Barbados website by visitors from the UK.

51. As I mentioned earlier, the fact that a UK consumer can book one of ASI's submarine tours whilst on location overseas or on a cruise which has departed the UK does not, in my view, assist ASI in these proceedings. Numerous holiday services will be used by holiday makers whilst abroad; that some of those may be citizens of the UK does not give rise to the maintenance or creation of a market for the services in the UK. While the evidence shows that UK consumers have availed themselves of ASI's submarine tours, even if I were to approach ASI's evidence on the basis that it shows use of the trade mark as registered in the period under consideration under section 46(1)(b) of the Act in relation to (at least) the operation of tourist submarines, as I have not been provided with examples of the websites of any of ASI's partner organisations other than the Cayman Islands & P&O (upon which I have commented above), I am not in a position to judge to what extent these other organisations and by extension ASI are targeting customers in the UK. In addition, no evidence/explanation has been provided as to how many UK customers placed orders via ASI's websites or how many of the 965 P&O customers or the 13,038 Virgin Holiday customer originated from the UK or, even if all of them did, how many of them booked ASI's services whilst in the UK. In view of the above, and returning once again to the onus placed on ASI by section 100 of the Act, I am unable to

conclude on the basis of the evidence provided that ASI has made genuine use of its trade mark in the material periods in relation to the services for which it stands registered. Notwithstanding ASI's plea, there is no discretion; Merlin's application succeeds.

Conclusion

52. ASI's registration will be revoked in full with effect from 24 June 2000.

Costs

53. As Merlin has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Merlin on the following basis:

Preparing a statement and considering ASI's statement:	£200
Considering ASI's evidence:	£500
Written submissions:	£400
Application fee:	£200
Total:	£1300

54. I order Atlantis Submarines International Inc to pay to Merlin Attractions Operations Limited the sum of **£1300**. This sum is to be paid within 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 18th day of April 2013

C J BOWEN
For the Registrar
the Comptroller-General