

O-139-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2588977
BY RAJESH TALWAR
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 3, 9, 14, 16, 18,
20, 21, 24, 25, 26, & 35:**



AND

**OPPOSITION THERETO (NO 102892) BY RENAISSANCE HOTEL
HOLDINGS, INC**

The background and the pleadings

1) Application 2588977 was filed by Fashion Finder (Le Monde) Ltd (“Le Monde”) on 25 July 2011 and was published in the Trade Marks Journal on 14 October 2011. Registration is sought in respect of a range of goods and services, but these opposition proceedings are brought only against the services sought to be registered in classes 35 & 43. Le Monde subsequently withdrew its class 43 services, so leaving the dispute as to whether the mark should be registered in class 35. The mark and the class 35 services are as follows:

R

Retail services connected with the sale of perfumes, toilet water, perfumed water, colognes, essential oils, bath and shower preparations, toilet soaps, body deodorants, creams and gels for the face, creams and gels for the body, non-medicated toilet preparations, cosmetics, skin care preparations, sun care preparations, hair care preparations, shampoos, hair gels, hair sprays, hair mousses and hair balms, dentifrices, anti-perspirants, shaving preparations, pre-shave and after-shave preparations, essential oils, shoe cleaning preparations, spectacle frames, sunglasses frames, sunglasses, lenses for spectacles and sunglasses, clips for spectacles and sunglasses, cases and containers for spectacles and sunglasses, radios, calculators, holders and covers for mobile phones, accessories for mobile phones, holders for laptops, covers for laptops, skins for laptops, jewellery and imitation jewellery, articles made of precious metals or coated therewith, clocks and watches, watch straps and watch bracelets, lapel pins, cufflinks, tie clips, tie pins, tie slides, tie bars, collar and shirt studs, scarf rings, stationery, posters, cards, postcards, greetings cards, invitations, diaries, calendars, photograph albums, prints, gift bags, gift boxes, gift tags, gift wrap, notepads, writing instruments, stickers, transfers, personal organizers, address books, pen and pencil holders, desk mats, folders, bookmarks, bookends, picture holders, articles made from leather or imitation leather, bags, luggage, travel bags, leisure bags, sports bags, holdalls, cases, rucksacks, handbags, toiletry and cosmetic bags, tie cases, briefcases, belts, wallets, card holders, cheque book holders, purses, walking sticks, umbrellas and parasols, furniture, household furniture, hand-held mirrors, wall mirrors, picture frames, ornaments made of plastic, ornaments made of wood, ornaments made of plaster, non-metal key chains, sleeping bags, cushions, drinking glasses, jugs, coasters, serving trays, candlesticks and candle holders, soap boxes, toothbrushes, combs and brushes, lunchboxes, glassware, crockery, mugs, plates, tableware, ceramics, porcelain, earthenware and enamelware, decorative articles, cookware, household utensils and containers, soap dishes, soap dispensers, tissue

holders, brushes, combs, bowls, vases, plant pots, candlesticks, candleholders, soap boxes, hair brushes, brushes for footwear, nail brushes, shaving brushes, shaving brush stands, toothbrushes, clothes brushes, toilet cases, shoe horns, shoe trees, household and kitchen utensils, household containers, bed linen, hand towels, bath towels, dish towels, duvet covers, pillowcases, table linen, table napkins, textile wall hangings, friezes and borders of textiles for wall hanging, cushion covers, handkerchiefs, clothing, footwear, headgear, hair ornaments, hairbands, hairclips, hairpins, hat pins, badges, lapel pins, collar and shirt studs, parts and accessories for all the aforesaid goods.

2) The opponent is Renaissance Hotel Holdings, Inc (“Renaissance”). Its opposition is based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The earlier marks/signs relied upon are:

Community Trade Mark (“CTM”) registration 9582081 which was filed on 8 December 2010 and which completed its registration procedure on 2 March 2012. The mark and the services for which it is registered are:

R

Class 41: Health and fitness club services, namely providing instruction and consultation in the field of physical exercise; rental of exercise equipment; providing fitness and exercise facilities; golf club, golf course and golf instruction services; education; providing training, entertainment, sporting and cultural activities; education and entertainment, namely arranging conferences, organization of exhibitions for cultural or educational purposes; providing facilities for recreation activities; providing facilities and services for swimming pools and water sports; providing tennis facilities, rental of tennis courts and tennis instruction; providing hotel guests with educational and entertainment information about local attractions and points of interest, and distribution of materials in connection therewith; night clubs; casino services; event planning and management services.

Class 43: Hotel services, restaurant, catering, bar and cocktail lounge services; resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others.

This mark is relied upon under section 5(2)(b) of the Act.

CTM registration 8799504 which was filed on 8 January 2010 (and also claims a priority date of 14 July 2009) and which completed its registration procedure on 2 September 2010. The mark and the services for which it is registered are:



Class 36: Real estate services, namely listing, leasing, management, operation, rental and brokerage of apartments and condominiums; real estate financing.

Class 41: Health and fitness club services, namely providing instruction and consultation in the field of physical exercise; rental of exercise equipment; providing fitness and exercise facilities; golf club, golf course and golf instruction services; education; providing of training , entertainment, sporting and cultural activities; education and entertainment; arranging conferences; organization of exhibitions for cultural or educational purposes; providing facilities for recreation activities; providing facilities and services for swimming pools and water sports; providing tennis facilities; rental of tennis courts; tennis instruction; providing hotel guests with educational and entertainment information about local attractions and points of interest, and distribution of materials in connection therewith; night clubs; casino services; event planning and management services.

Class 43: Hotel services, restaurant, catering, bar and cocktail lounge services, resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others.

This mark is relied upon under section 5(2)(b) of the Act.

CTM registration 772863 which was filed on 13 March 1998 and which completed its registration procedure on 7 March 2000. The mark and the services for which it is registered are:



Class 35: Operation of businesses for others, namely, operation of hotels, resorts, restaurants, night clubs; secretarial and word processing services; photocopying services.

Class 39: Transportation and storage services; arranging of tours and of cruises; arranging of transportation for travelers; arranging of travel; arranging travel tours, travel guide services, travel booking services, travel agencies, and travel information services; ground transportation services, namely, bicycle rental, motorcycle rental, car rental, and ground transportation of passengers by car, limousine, van or bus.

Class 41: Hotel and restaurant training school services; management of casinos; educational services, organization of lectures, publication of books, magazines, newsletters and of text, all relating to travel and to touring; booking agency services for theatre and cinema tickets; club entertainment services; cabaret services; organising of competitions; concert services; arranging and conducting of conventions relating to entertainment; organising of dancing display; entertainer services; fashion show services; orchestra services; social club entertainment services; staging of tournaments; arranging conferences, providing casino facilities, providing golf club services, providing facilities for recreation activities; health club services; rental of skin diving equipment; casino services.

Class 42: Hotel, resort, restaurant, bar, cocktail lounge, nightclub, cafe, snack bar, catering and banqueting services; management of bars, of conference rooms; barber shop and beauty salon services; reservation services for hotel accommodations; management services for hotels and restaurants; providing facilities for exhibitions and conferences; health resorts; health spas; banquet and social function facilities for special occasions; hotel concierge services; hotel services for preferred customers; rental of rooms; providing facilities for business meetings; providing convention facilities; franchising, namely offering technical assistance in the establishment and/or operation of hotels, resorts, restaurants, night clubs.

This mark is relied upon under section 5(2)(b) of the Act. The mark is claimed to have been used in respect of all of the services for which it is registered.

UK registration 2535098 which was filed on 23 December 2009 (and also claims a priority date of 14 July 2009) and which completed its registration procedure on 2 March 2012. The mark and the services for which it is registered are:

R

Class 43: Hotel services, restaurant, catering, bar and cocktail lounge services; resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others.

The above mark is relied upon under both sections 5(2)(b) & 5(3) of the Act. The mark is claimed to have a reputation for all of the services for which it is registered.

Under section 5(4)(a), Renaissance makes a claim on the basis of the following signs: “[t]he letter “R” and as applied for in UK Trade Mark Application 2535098” which are claimed to have been used (in relation to the services of 2535098) since as early as 2009; Renaissance considers that the use of the applied for mark would be contrary to the law of passing-off given the goodwill it has created.

3) Given their filing dates, all of Renaissance's marks constitute earlier marks as defined by section 6 of the Act. Given the dates on which they completed their respective registration procedures, only CTM 772863 is subject to the proof of use provisions set out in section 6A of the Act.

4) Le Monde filed a counterstatement denying the grounds of opposition. It put Renaissance to proof of use in respect of its earlier marks, but, given my comments in the preceding paragraph, such a request can only relate to CTM 772863. Le Monde denied that the respective marks and services are similar and, consequently, denied that there was a likelihood of confusion. Le Monde denied that Renaissance has a reputation for the purposes of section 5(3) and denied that a link would be made between the respective trade marks; it put Renaissance to proof of its reputation. Le Monde denied that Renaissance has goodwill in respect of the signs referred to in its pleadings and denied that misrepresentation/damage will arise; it put Renaissance to proof of any goodwill/reputation.

5) Only Renaissance filed evidence (along with written submissions). Neither party requested a hearing. Le Monde filed written submissions in lieu of a hearing. It should be noted that since the filing of its submissions, Le Monde has assigned the applied for trade mark to Mr Rajesh Talwar. Mr Talwar has confirmed that he stands by the applicant's case and that he accepts a liability for costs, should they arise. I will, though, refer for the most part to Le Monde, as it was it which provided the counterstatement and submissions.

Renaissance's evidence

6) This comes from Mr Kevin M Kimball, Renaissance's Vice President. It is clear from his evidence that the various R marks relied upon are used in relation to, essentially, hotel services. In the vast majority of cases whatever R mark is being used, it is used in conjunction with the word RENAISSANCE (as exemplified by CTM 8799504) and, furthermore, it is often made clear that RENAISSANCE hotels are part of the MARRIOTT group. Over the years different R marks have been used. Mr Kimball refers to the "Original R logo" which was first used in the UK as early as 1983 in relation to the Ramada Renaissance Hotel in London. The Original R logo is depicted below:



The two images above are contained in Exhibit 4 which is described as a hotel directory from 1983. It appears to be a US catalogue given the nature of included telephone numbers and the use of the words SUMMER/FALL. There is a reference to a UK hotel with the Original R logo (as per the above right image)

used in connection with it, together with the designation LONDON RENAISSANCE CLUB which relates to the rooms and suites on the top floor of the hotel.

7) Reference is then made to the “Script R logo” which is depicted below (albeit with the word RENAISSANCE below it):



The above image is taken from Exhibit 5 which is a further hotel directory from 1999. It, again, appears to be a US (or at least Americas) document but it also includes worldwide hotels. Hotels in London, Manchester and Reading are listed in the directory. It is added that the logo has been used continuously in the UK “during the time relevant to the opposition”. The Script R logo is said to have been first used in the EC since at least as early as 1994. A further directory showing use of the logo is provided from 1994 featuring Renaissance Hotels in Vienna, Brussels, Prague, Berlin, Cologne, Dortmund, Dusseldorf, Hamburg, Heidelberg, Karlsruhe and Amsterdam. It is added that the logo has been used continuously in the EC “during the time relevant to the opposition”.

8) Reference is then made to the “New R Logo” which is depicted below (albeit with the words RENAISSANCE HOTELS below it):



Mr Kimball states that the New R Logo was first used in the UK since at least as early as 11 October 2009. Archive web prints are provided from this date showing it in association with the Renaissance London Heathrow Hotel; it is added that the logo has been continuously used since then in the UK. Mr Kimball states that the New R Logo was first used in the EC since at least as early as 17 September 2009 in connection with the then newly opened Renaissance Hotel in Paris (Arc de Triomphe) and that Renaissance’s website used the new logo from this date. To further exemplify the use, a further web archive print is provided from marriott.com relating to the Renaissance Bracello Airport Hotel with a similar logo to that above. The print appears to date from 19 January 2008 (which is actually before the claimed date of first use in the EC).

9) Exhibit 1 of Mr Kimball’s evidence runs to over 300 pages. There are prints from Renaissance’s websites relating to the Renaissance London Heathrow Hotel (dating from 2007-2010), St Pancras Renaissance London Hotel (dating

from 2012) and from the Renaissance Manchester City Centre Hotel (dating from 2010). The hotel group is identified as MARRIOTT. The signs used are either: a) the Script R logo with the word RENAISSANCE below, or b) the New R Logo with the word RENAISSANCE below. Some of the prints (albeit only a small number) do not feature any of the marks relied upon. The Script R logo is used most often. Exhibit 2 (which runs to over 370 pages) is of a similar nature. The prints relate to Renaissance London Chancery Hotel (dating from 2007), Renaissance London Gatwick Hotel (dating from 2007-2008), Renaissance Reading Hotel (dating from 2007 to 2008) and Renaissance Solihull Hotel (dating from 2007). The same logos are used, the vast majority, again, being the script R logo. Exhibit 3 (which runs to over 270 pages) contains similar information albeit the prints relate to 15 hotels in the EU (but outside the UK). The same two signs are used, but, again, the script R logo is used on the majority of prints.

10) Mr Kimball states that in 2005 Renaissance revised its business model in the UK to focus on managing and operating hotels rather than franchising them. Various press releases and news articles are provided in Exhibit 9 to support this. It seems that RBS (Royal Bank of Scotland) became the owners of the hotels with Renaissance (or more specifically its parent company Marriott) said to be the long term manager of them. Further information about Marriott and its group of companies is provided in Exhibit 10; I do not need to summarise this.

11) Mr Kimball states that the RENAISSANCE mark and the R logo(s) are used in relation to hotels, restaurant, catering, bar, cocktail lounge, fitness club and spa services; management and operation for others of hotels, resorts, restaurants, night clubs, bars, casinos, spas and facilities for meetings, events, conferences, exhibitions and weddings; providing “full business service center’s in our managed hotels”; transport services; hotel reservation services and marketing and consultancy services relating to all of this. He states that the hotel web site prints he has exhibited make reference to print, fax, copy, messenger, delivery, postal, secretarial and translation services etc. It is stated that the services include business management (etc) to others including services to hotel owners. Exhibit 11 contains documents (the dates are not clear) about Marriott & Renaissance (including the script R logo) of a corporate nature which, effectively, explains what types of hotels will be created and managed for its franchises and owners. The documents do not focus specifically on the UK or the EC, but references are made to its global hotels.

12) Revenue figures and total number of room nights sold is provided for the years 2006-2011 as booked by UK travel agents (although not specifically for UK hotels). The total number of room nights ranges from 95k to 105k and the turnover from 14US\$ million at its lowest (in 2009) to 26US\$ million at its highest (in 2007). In 2008 the website marriott.com received over 223 million visits and in 2011 over 380 million. It is stated that millions of room nights are booked each year at RENAISSANCE and R logo mark hotels including hundreds of thousands

in the UK. Further worldwide figures are provided of room nights booked in total and by UK residents – the figures are substantial.

13) It is stated that Marriott operates a loyalty scheme. UK membership numbers for the years 1997-2011 are provided. The figures have ranged from 118k in 1997 to 1.7 million in 2011. Worldwide figures are also provided which I need not detail. The scheme has won a number of rewards over the years. It is stated that members receive regular emails and mailings which include information about the hotels it [Marriott] operates including the RENAISSANCE and R logo(s) hotels. Exhibit 12 contains examples of this, most of which feature the script R logo. There is information about hotels in Prague, Moscow and other European destinations. In terms of the UK, I note a reference to a hotel in London Gatwick and in Manchester. A large number of the prints are not in English and, so, are not aimed at the UK consumer; the documents have not been translated.

14) Mr Kimball states that Renaissance's hospitality and travel related goods and services have been widely advertised including on the Internet. There are at least 75 domain names based on the Renaissance brand. It is stated that the marriott.com website received 985k visits (in 2008) specifically targeting the RENAISSANCE and R logo brands from computers in the UK which resulted in over US\$20 million in revenue. Similar figures are provided for 2009 (729k visits, \$12.4 million revenue), 2010 (1.2 million visits, \$18 million revenue) and 2011 (1.7 million visits, \$21.3 million revenue). Similar figures are provided for 9 other EU countries of similar substantial levels.

15) In 2009 marriott.com was ranked the world's 7th largest online consumer retail website. In 2011 it was ranked no.3 by the Internet Retailer Mobile Commerce Top 300. Articles relevant to this are provided in Exhibit 13. Annual gross global revenue is provided between 1997 and 2011; the figures are in the \$billions. Reference to MARRIOTT (and its sub-brands including RENAISSANCE) is included in a book (an extract is in Exhibit 14) by Scott M David entitled *Brand Asset Management – Driving Profitable Growth Through Your Brands*. Various other references to awards and publicity are provided; it is not necessary to detail this here but it is borne in mind. Revenue for Renaissance in the UK has ranged between £209 million and £186 million between 2006 and 2011.

16) In June and July 2006 two thousand subscribers of Business Traveler were asked to participate in a survey, 33% of whom participated. MARRIOTT was selected best hotel chain. RENAISSANCE hotels were listed as a familiar brand. Relevant evidence is contained in Exhibit 18. Reference to a North American hotel satisfaction index is made (Exhibit 19) but I see no need to summarise this, nor have I summarised a further reference to another "survey" which appears to be US orientated. Mr Kimball states that in 2004 Renaissance ("my company") was ranked as one of the 100 best companies to work for. The award was won by Marriott not Renaissance. Various annual reports for Marriott (not

Renaissance as indicated by the witness) are provided for the years 2006-2011; it is not necessary to summarise them. Details of trade mark registrations are included in Exhibits 22 & 23 from around the world – these are noted but their detail is not necessary to record.

17) Mr Kimball states that a great deal of money and effort is spent on promoting the RENAISSANCE and R brands. Worldwide figures are given which I do not need to summarise. Reference is made to UK and EU promotion and that this is also significant. Figures provided for the UK range between £1.2 million in 2005 and £1.63 million in 2011 (the highest amount was £2.09 million in 2006). Examples of promotional materials are provided in Exhibit 24. The advertisements feature, most often, co-branding under the Marriott brand. There is some use of advertising of RENAISSANCE and R logo on its own, but this is the exception rather than the rule. The R logo featured is the script logo. In the 141 page exhibit there is only one example of the new R logo being used. There are some, but not many, that feature only MARRIOTT. Not all are dated, but a good many can be placed before the relevant date. It is stated that advertisements have been placed in the *Independent* and the *Financial Times* newspapers, no examples are provided nor is information given as to how many times advertisements have been placed in such publications. Exhibit 25 contains some press coverage. The prints are all from before the relevant date and contain references to RENAISSANCE hotels, often identified as a sub brand of MARRIOTT. These are pure typed press articles so there is no use of any of the R logos.

18) It is stated that many RENAISSANCE hotels around the world have retail shops in them offering a range of consumer products branded with the RENAISSANCE and R logo mark such as shorts, bathrobes, slippers and sweets. To exemplify, it is stated that as early as 2006 a shop was located at the Renaissance Chancery Court Hotel in London offering Renaissance and R logo merchandise. Exhibit 26 contains a witness statement from Katy David, a student member of ITMA, who is employed by AA Thornton & Co. She states that she went into this shop in June 2006 and purchased a t-shirt bearing the script R logo and the Renaissance London Chancery Court hotel name. She provides a picture of the t-shirt and a receipt. The retailer is “The Shop, Renaissance Chancery Court, London”. The t-shirt cost £15.99. Also provided are some photographs with a date of 2007 on them showing a shirt and a bathrobe that were offered for sale through the Renaissance Mumbai Hotel and Convention Centre. All are marked with the script R logo. The bathrobe carries only the script R logo and not the name of the hotel. It is stated that similar apparel has continued to be offered.

19) Mr Kimball refers to an online retailing service called “Collect Renaissance” through which customers around the world can purchase a wide range of goods of others, including bedding, linens, glassware, decorative items such as sculptures, ceramics, light fixtures, wine racks and other household items, electronic goods and fragrances. It is stated that many are branded with the mark

RENAISSANCE and the R logo. Exhibit 28 contains extracts from the website www.collectrenaissance.com. It is stated that the new R logo is on the home page, but it is not present in the print exhibited. The pages are headed COLLECT RENAISSANCE. The goods are various, not all are RENAISSANCE branded. One is so marked, but it is difficult to see what it is. Sales on the website are said to have been made since at least 2009. However, no sales figures are given, let alone where the customers making such sales have been based.

20) Mr Kimball states that the new R logo has been used on a blog-based website entitled RLife which can be found at the web address www.renaissancelife.com (the domain name was registered in October 2009). Exhibit 29 contains extracts which feature the new R logo in conjunction with the word LIFE (to create RLife). The extracts relate to a number of events including an opening (after restoration) party for St Pancras Renaissance London – the blog article is dated 9 May 2011. Various celebrities attended and Jamie Cullum performed. Various other extracts are provided from dates in 2010 and 2011 – they are mostly music themed (some are other types of entertainment) referring to concerts and other events – most appear to be US orientated. There is a reference to Bruno Mars staying at the London Chancery Court, another relating to the hotel more generally. Mr Kimball states that R Life events have received press attention – Exhibit 30 contains what appears to be a press release about the “entertainment platform” – no specific mention is made of UK events. There is also a list of some further press headlines which appear on some websites and some further pages from www.renaissancelife.com.

21) Mr Kimball refers to various successes Renaissance has had in enforcing its trade mark rights. He states that because the R logo is displayed in close proximity to RENAISSANCE, then the fame and repute of RENAISSANCE attaches to it.

Section 5(2)(b)

22) Section 5(2)(b) of the Act reads:

“5.-(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

23) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Renaissance's best prospect of success

24) On the face of it, the closest (in terms of mark similarity) earlier marks are those which represent the new R logo, the widest registration for which (in terms of services) is CTM 958208, a mark which is not subject to the proof of use provisions. I will focus my assessment on this earlier mark. If Renaissance does not succeed with this earlier mark then I will consider later whether any of the other earlier marks improve its position.

The average consumer

25) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods/services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

26) The services of the application are retail services. The average consumer is a member of the general public looking to purchase the goods specified in the specification (which themselves are general consumer items). No more than an average level of care and consideration will be deployed in selecting an appropriate service provider.

27) The services of the earlier mark are more varied, in class 41 they include services for health and fitness recreation and services for entertainment, the average consumer of which is likely to be a member of the general public. No more than an average level of care and consideration will be deployed in selecting an appropriate service provider. The other services in class 41 are educational in nature, the average consumer of which could be a member of the general public, or businesses seeking appropriate training. It is possible here that

slightly more care and consideration will be deployed in seeking an appropriate service provider, but not the highest level. In class 43 the services include hotel services (the average consumer of which is generally a member of the general public) and arranging of rooms for functions and conferences etc (the average consumer of the former could be a member of the general public or a business but the latter a business user only). I consider that slightly more care and consideration will be deployed as such services are not selected frequently, they can be reasonably expensive and can be an important choice; nevertheless, the care and attention used will not be of the highest level. Restaurant (and other food/drink) services are also covered and the degree of care and attention is no more than average.

28) In relation to all of the above services, they will often be selected after perusal of brochures or via Internet searching etc., although, in some cases, the service provider may be chosen on a walk-in basis from the street (such as retailing or food services).

Comparison of the marks

29) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



30) There is only one element in each of the marks and, so, the dominant and distinctive elements of each mark are the letters R of which they consist.

31) From a visual perspective, both marks clearly consist of a single letter R which is presented in a similar, but unremarkable font. There is, though, a difference in that the R in the applied for mark is only partially presented, with the left hand aspect partially absent. Nevertheless, there is still a reasonable amount of visual similarity.

32) From an aural perspective, both marks will be pronounced in the normal way that the letter R is articulated. The marks are aurally identical.

33) In terms of concept, both marks will be seen as the letter R and such a letter will form the conceptual hook. The marks are conceptually identical.

The distinctiveness of the earlier mark

34) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

35) In terms of inherent characteristics, letters are not highly distinctive signs. That being said, the letter R has no real significance in relation to hotel services or anything else covered by the earlier mark. It has a moderate level of inherent distinctive character. In terms of the use made, the new R logo has been used since October 2009, around 21 months before the relevant date. As I have already mentioned, the use of the mark is often in conjunction with the word RENAISSANCE. Mr Kimball has provided extensive evidence, however, it is not particularly well marshaled. At times he conflates Renaissance with Marriott. I have no clear picture of how many RENAISSANCE hotels were in the UK in the 21 month period of relevant use. I have focused on the UK because confusion must be measured from the perspective of the UK average consumer. Nevertheless, the headline revenue figures are impressive. I come to the view that in relation to hotel services there has been some enhancement of distinctive character so as to at least uplift the degree of distinctiveness to a reasonable level.

Comparison of the services

36) When making the comparison, all relevant factors relating to the services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

37) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

38) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

39) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

40) Renaissance has put little forward by way of argument. In its written submissions filed with its evidence it states:

“The opponent submits that the remaining opposed retail services in Class 35 covered by the contested mark are all similar and complementary to those covered by the Opponent’s earlier marks and that in relation to a highly similar mark, there is a likelihood of confusion on the part of the relevant public.”

Whilst Renaissance goes on to give further submissions in relation to the similarity of marks, the interdependency principle etc, it provides no real detail as to why it considers the services to be similar.

41) Le Monde considers the lack of explanation from Renaissance to be telling. Le Monde submits that the purpose and nature of the respective services are very different and that there is no aspect of complementarity. I have to say that I find it difficult to discuss a closest service as there is nothing that is obviously similar. A hotel service is used by a person who wishes to avail himself of overnight (or longer) accommodation. A hotel may provide other services (food, health club facilities) for which one may specifically go to a hotel, but one does not go to a hotel for the provision of a retail service. The nature of a hotel and a retail service is different. The purpose of a hotel and retail services are different. These services do not compete – one would not make a competitive choice between going to a hotel or going to a retailer. Renaissance claim that the services are complementary, however there is no evidence or argument as to why the use of one service is important or indispensable for the other. According to Mr Kimball, one of its hotels in London has had a shop in it. However, there is nothing to suggest that this is the norm for a hotel. In any event, shops can be found in many places, in airports, hospitals, etc but this does not mean that the services are similar. The relevant consumers for both sets of services may be drawn from the general public, but this is a very superficial factor. **Hotel services are not similar to the retail services of the earlier mark.** I have fully considered the other services of the earlier mark. I can see no reason to regard them as similar to the services of the applied for mark so there is little point in rehearsing similar (and obvious) arguments to those I have already made.

Likelihood of confusion

42) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors

from the viewpoint of the average consumer and determining whether they are likely to be confused.

43) I have found no similarity between the services. Accordingly, there can be no likelihood of confusion³. However, in case I am wrong on my assessment of services similarity and that there is some (albeit low degree) of similarity then I still do not consider that there is a likelihood of confusion. Although the marks are reasonably distinctive, the link between the services would not, in my view, give rise to confusion – the average consumer would put the use of the respective marks down to a co-incidental use not to there being some form of economic connection.

The other earlier marks

44) I have fully considered the other earlier marks. Although some of the earlier marks have further services to bear in mind, none cover services which are obviously similar to retail services. Furthermore, there are further differences between the marks which render them less similar. The grounds of opposition under section 5(2)(b) are dismissed.

Section 5(4)(a) of the Act

45) Section 5(4)(a) of the Act prevents the registration of a mark the use of which is liable to be prevented:

“(a) by virtue of any rule of law (in particular, the law of passing-off) protecting an unregistered trade mark or other sign used in the course of trade..”

46) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as

³ See, for example, the CJEU's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-398/07.

distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

47) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom."

48) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁴. However, being a small player does not necessarily prevent the law of passing-off from being relied upon⁵.

49) In terms of the material date, I note the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07 where it was stated:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000."

50) Use of the applied for mark before its date of application may be relevant. It could establish that Le Monde were the senior users, or that there had been

⁴ *Hart v Relentless Records* [2002] EWHC 1984

⁵ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the mark could not have been prevented under the law of passing-off at the material date⁶. However, Le Monde has filed no evidence in these proceedings so there is no impact on the material date which remains as 25 July 2011.

51) I have no doubt that Renaissance had goodwill in the UK at the material date in relation to hotel services. Renaissance claims goodwill wider than that. It says its goodwill extends to retailing. The retailing evidence relates to Mr Kimball's evidence that many RENAISSANCE hotels around the world have retail shops. He explained that as early as 2006 a shop was located at the Renaissance Chancery Court Hotel in London. Evidence is given by Ms Katy David that she purchased a t-shirt from the shop in 2006. However, despite the voluminous evidence filed by Renaissance, it has not put forward evidence as to the number/volume of sales made in this shop, there are no pictures of the shop from which I can ascertain its significance or nature (or the signs used therein). All I have is evidence of a single sale. This is not sufficient to establish goodwill. The only further evidence relating to retailing is fundamentally flawed. There is evidence of some clothing purchased in a hotel in Mumbai. This is not relevant in terms of establishing goodwill in the UK. There is also evidence regarding the Collect Renaissance website, however, as I observed earlier, no evidence is given as to the number of UK consumers who have accessed the website let alone UK consumers who have purchased from it. There are further difficulties with the passing-off claim. Whilst the R logos form part of the fabric of its goodwill, the public familiar with Renaissance's business will know of its use alongside the RENAISSANCE name. Therefore, the use of the letter R as applied for would not, in my view, and bearing in mind the primary nature of its goodwill as a hotelier, lead to a substantial number of people believing that the retail services are being offered by Renaissance. There would be no misrepresentation. **In view of these factors the claim under section 5(4)(a) is dismissed.**

Section 5(3) of the Act

52) Section 5(3)⁷ of the Act reads:

"5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in

⁶ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

⁷ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* ("Addidas-Salomon") (C-408/01)).

the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

53) In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA* (Chevy) [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

54) In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

55) In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

– the existence of the likelihood of confusion on the part of the public”.

56) In terms of the three heads of damage relevant to this ground of opposition, they were summarised in Case C-487/07 *L'Oreal SA and others v Bellure NV* (“*Bellure*”) and others (“*Bellure*”) as follows:

“39 As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40 As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41 As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”

57) I consider the claim under section 5(3) to be weak. Only the new R logo is relied upon under section 5(3) (as embodied by UK registration 2535098). Even if one were to accept that the mark meets the required level of knowledge for a reputation to exist, I do not, due to the criticisms I made earlier of the evidence, consider that the mark has the strongest of reputations. This is exasperated because the mark is most often used in conjunction with the sign RENAISSANCE. Furthermore, the mark is not inherently highly distinctive. I consider the net effect of all this, bearing in mind that the reputation (if it exists) is in relation to hotel services whereas the applied for services are retailing, is that the relevant public will not bring the earlier mark to mind. As a link has not been established then the ground of opposition must fail.

58) There would have been, in any event, further problems with the claim under section 5(3). In relation to the claim for unfair advantage, if a link were to be made, I do not consider that the image transfer (or the subsequent “leg up”) as outlined by the jurisprudence would obviously be in operation. This is even before coming to the “unfair” aspect of unfair advantage and the “added factor” outlined by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753. One such added factor would have been an intention to take advantage of the reputation, but there is no evidence that this was the case and there is no basis to make an inference that it was. No other factor has been identified. In relation to dilution, the claimed harm or detriment that could be done to the distinctive character of the earlier mark, I do not consider that the ability of the earlier mark to identify its services would be weakened by the use of the applied for mark. Finally, in relation to tarnishing, the argument put forward is based on the potential for the applied for mark to be used in relation to inferior services – but there is nothing inherently inferior in the service of retailing so the claim is nothing more than unsubstantiated hypothesis.

59) The ground of opposition under section 5(3) of the Act is dismissed.

Costs

60) Le Monde (now Rajesh Talwar) has been successful and is entitled to a contribution towards costs. I hereby order Renaissance Hotel Holdings, Inc to pay Rajesh Talwar the sum of £1700. This sum is calculated as follows:

Preparing a statement and considering the other side’s statement
£300

Considering Renaissance’s evidence (which was substantial)
£800

Filing written submissions
£600

61) The above sum should 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 27th day of March 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**