

O-327-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2225326
IN THE NAME OF BRISTAN LIMITED
FOR REGISTRATION OF RENAISSANCE
AS A SERIES OF TWO TRADE MARKS IN CLASSES 11, 20 AND 21**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 93963
IN THE NAME OF RENAISSANCE HOTEL HOLDINGS INC**

Trade Marks Act 1994

**IN THE MATTER OF application No. 2225326
in the name of Bristan Limited
for registration of RENAISSANCE
as a series of two trade marks in Classes 11, 20 and 21**

And

**IN THE MATTER OF opposition thereto under No. 93963
in the name of Renaissance Hotel Holdings Inc**

BACKGROUND

1. On 10 March 2000, Bristan Limited made an application to register RENAISSANCE in the following format as a series of two trade marks:

RENAISSANCE



2. Registration is sought in Classes 11, 20 and 21 in respect of the following goods:

Class 11 Showers; shower heads; taps; basin mixer and pop-up wastes; slider rails; riser rail kits; waste outlets; plugs for baths; plugs for sinks; plugs for showers; shroud covers; bath shroud covers; standpipes; upstands; water filter kits; filter cartridges; water filter replacement cartridges; water filters; wastes; waste display units; pop-up wastes; non-return valves; basin pop-up wastes; bidet pop-up wastes; thermostatic showers; concealed thermostatic showers; exposed thermostatic showers; thermostatic concealed shower valves; exposed shower valves; concealed showers with adjustable riser; wall brackets; wall mounted elbows; parts and fittings for the aforesaid goods.

Class 20 Extending shaving mirrors; shower displays; water pipe valves; parts and fittings for the aforesaid goods.

Class 21 Toilet utensils; shower tidies; soap and sponge baskets; free standing toothbrush holders; free standing toothbrush and tumbler holders; towel rails; double towel rails; tumbler holders; free standing toilet roll holders; single towel rails; double towel rails; toilet brushes and holders; waste bins; grab bars; pedal waste bins; tissue boxes; toilet roll holders; towel rings; soap dishes; soap baskets; toothbrush holders; bath racks; clothes lines; disc packs; radiator rails; parts and fittings for the aforesaid goods.

3. On 2 December 2005, Renaissance Hotel Holdings Inc filed notice of opposition to the application, the grounds of opposition being in summary:

1. Under Section 5(3) because use by the applicant of the identical mark in relation to the goods of the subject application, will, without due cause, take unfair advantage of, or be detrimental to the opponents' earlier mark.

The opponents rely on one earlier trade mark, No. 1294338, for the mark RENAISSANCE which is registered in Class 42 in respect of "Hotel, bar, banqueting and hotel reservation services". Use is claimed in respect of all of these services.

2. Under Section 5(4)(a) by virtue of the law of passing off.

4. The applicants filed a counterstatement in which they put the opponents to proof of the use that they have made of their mark in relation to services that are the same or similar to those covered by the application, and deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Only the opponents filed evidence in these proceedings, which insofar as it is relevant I have summarised below. The matter came to be heard on 25 June 2008, when the applicants were represented by Mr Nigel Parker of N E Parker & Co. The opponents were represented by Mr Jeremy Pennant of D Young & Co, their trade mark attorneys.

Opponents' evidence

7. This consists of four Witness Statements. The first is dated 12 April 2007, and comes from Bob Cotton, Chief Executive of the British Hospitality Association, an organisation that represents various sectors of the hospitality industry, including the hotel, restaurant and catering industries, in contacts with government and policy makers.

8. Mr Cotton says that through his involvement with his organization he has noticed that in the last few years there has been a trend for hotels to maximize their revenue through sales of branded products, including home furnishings and products for the bath and shower. He says that these are often described as being “hotel style” to cash in on the attributes and cache of products found in certain well-established up-scale hotels and resorts, such as the RENNAISANCE hotels, and the resorts of RENNAISANCE Hotel Holdings Inc. (RHHI), being members of the Marriott Hotel group. Extracts from the RHHI website are shown as Exhibit BC1, which includes a page from an “Online Store” listing product categories such as bedding, a bath and spa collection, home furnishings, fitness equipment, a “hotel collection”, although with the exception of a range of bedding sold under the name “Revive Collection” there are no specific goods mentioned. The page shows a US telephone number for customer services.

9. Mr Cotton says that he has personal knowledge of the Marriott group of companies offering hotel-style home furnishings and other products through various websites and online stores, mentioning a curved shower rod and shower curtain rings under a “bath collection” on shopmarriott.com, details of which can be seen at Exhibit BC2. This exhibit shows the page relating to the Online Store referred to in Exhibit BC1, depicting the shower rod and rings along with a shower curtain, and aromatherapy goods. The prices quoted are in dollars, and again shows a US telephone number for customer services. Mr Cotton says that he is personally aware that sales of products and services associated with hotels and resorts is occurring through retail stores, and increasingly via the Internet, mentioning, in particular, www.hotelstoyou.com, where “hotel-style” shower heads, shower rods, shower hooks, toothbrush holders, tissue box covers, bathroom tumblers and soap dishes may be purchased, details of which can be found as Exhibits BC3 and BC4. The exhibits depict a range of goods, inter alia those mentioned by Mr Cotton, but there is no indication that this relates to the UK. The prices being in dollars and the mention of an enquiry line being available Monday to Friday 8am to 5pm “EST” (which I take to mean Eastern Standard Time) suggests that this is a US site.

10. Mr Cotton goes on to refer to extracts from westin-hotelsathome.com (Exhibit BC5), www.bedbathandbeyond.com (Exhibit BC6), www.hiltonhome.com (Exhibit BC7) and www1.maceys.com (Exhibit BC8) where “hotel-style shower heads, shower rods, shower hooks, tissue boxes, soap dishes, soap pumps, waste bins, toothbrush holders, and small storage jars are being offered for sale. As with the other websites, the telephone numbers and product prices being in \$ support the view that these are US sites with no indication that they have a UK portal or have ever attracted customers from the UK. Mr Cotton concludes his Statement saying that it is his opinion that the use of a well established up-scale hotel brand such as RENAISSANCE for these goods and the like, would lead the customers into believing that they are being offered, or authorized by the owner of the hotel brand.

11. The next Witness Statement is dated 23 August 2007, and comes from Kevin M Kimball, Vice President of Renaissance Hotel Holdings Inc., Mr Kimball says that he has been associated with his company since 1997 and with its parent company since 1976.

12. Mr Kimball says that the trade mark RENAISSANCE was adopted by his company's predecessor in title, Ramada Inns Inc., in March 1981, and has been used continuously and extensively in connection with the provision of hotel, restaurant, resort and lodging services, and related travel services such as reservation services for hotel accommodations, and a range of merchandise. He says that his company acquired Ramada Inns Inc., along with the RENAISSANCE trade mark in 1997. He goes on to recount the expansion of the RENAISSANCE and Marriott businesses, the only reference to the UK being a "toll free number at 0800-221-222" for reservations.

13. Mr Kimball states that the trade mark RENAISSANCE has been in use in the UK "at least as early as 1988", the same year in which it was registered here. Exhibit 1 consists of a brief history of the Marriott group, including its acquisition of RENAISSANCE. Mr Kimball goes on to set out the extent of his company's worldwide business, stating that in 2004 there were in excess of 95 million hits on the Marriott website. He goes on to give figures for the number of room-nights reserved by UK residents in RENAISSANCE hotels worldwide in the years 2001 to 2006, and the revenue generated, which is as follows:

Year	Room nights	Revenue
2001	372,081	US\$48 million
2002	468,344	US\$ 61 million
2003	493,554	US\$ 65 million
2004	527,771	US\$79 million
2005	515,395	US\$ 82 million
2006	526,331	US\$90 million

14. Mr Kimball goes on to refer to Exhibit 2, which consists of publications entitled "An investment in Proven leadership" issued in 2005, which, he says provides additional information relating to the Marriott Group of companies and hotel chains, and "Thrive with Marriott International When You Grow with Renaissance" issued in 2004 and 2005 that provides further information on the RENAISSANCE brand. Exhibit 3 consists of a listing of the various brands within the Marriott Group, showing RENAISSANCE with an R logo and the words "HOTELS & RESORTS", the accompanying text showing the ® symbol after RENAISSANCE. Mr Kimball refers to the Marriott "rewards scheme" that members of the public can join and earn bonus points for staying at various hotels in the Marriott Group including RENAISSANCE hotels. The total number of UK members from 1997 to 2006 is given as follows:

YEAR	UK MEMBERS
1997	118,818
1998	156,616
1999	226,419
2000	325,107
2001	419,952
2002	518,784
2003	610,735
2004	730,851
2005	891,163

2006

1,044,003

15. Mr Kimball says that members of the Marriott Rewards scheme receive regular emails and updates relating to hotels including those operated by his company under the RENAISSANCE brand in the United Kingdom and elsewhere. Exhibit 4 consists of a series of newsletters dating from August 1997, the earliest occurrence of RENAISSANCE appears in 2004. Mr Kimball states that his company, including its wholly owned subsidiaries, affiliates and parent company is one of the largest providers of hotel related services in the world, doing business in 83 countries.

16. Mr Kimball says that for many years the Marriott Group of companies have offered a variety of goods for sale under the hotel and related brand names, including RENAISSANCE. Goods such as shower rods and shower rings for use in home bathrooms are offered through hotels, in-room catalogues and/or the Marriott website, with others being offered through Ritz-Carlton hotels and catalogues. Examples of these goods are shown in Exhibit 5.

17. Mr Kimball goes on to give details of the sales generated by hotel stays and hospitality services offered under the RENAISSANCE trade marks around the world. These are as follows:

Year	US\$ in excess of:
1997(April - December)	950 million
1998	1.6 billion
1999	1.7 billion
2000	1.9 billion
2001	1.8 billion
2002	1.9 billion
2003	1.9 billion
2004	2.3 billion
2005	2.6 billion
2006	2.8 billion

Figures for the UK have not been provided.

18. Mr Kimball refers to the reputation and recognition of the RENAISSANCE trade mark by professionals within the hospitality industry, citing the book "Brand Asset Management - Driving Profitable Growth Through Your Brands" in which it says:

"MARRIOTT is another impressive corporate brand, incorporating MARRIOTT CONFERENCE CENTRES, MARRIOTT VACATION CLUBS, MARRIOTT MARQUIS, MARRIOTT'S RESIDENCE INN, COURTYARD BY MARRIOTT, Fairfield Inn by MARRIOTT, Springhill Suites by MARRIOTT, RENAISSANCE by MARRIOTT and TOWN PLACE SUITES BY MARRIOTT."

A copy of the relevant pages from this publication are shown as Exhibit 6.

19. Exhibit 7 is an extract from the book "The Business of Hotels" by S. Medlik and H. Ingram (published in 2000) which lists MARRIOTT INTERNATIONAL as the third leading hotel group worldwide based on a survey by the magazine "Hotels" in July 1999. There is no mention of RENAISSANCE.

20. Exhibit 8 consists of articles describing the Marriott Group business, inter alia, the RENAISSANCE group. The earliest comes from the 20 January 2002 edition of The Business magazine, which refers to the acquisition of the RENAISSANCE Group. Later editions of the Financial Times, The Guardian, The Times and the Daily Mail give details of wireless Internet being installed in RENAISSANCE hotels, or the sale/opening of RENAISSANCE hotels

21. Mr Kimball refers to a survey conducted in June and July 2006, involving two thousand subscribers to Business Traveller magazine. a copy of the subsequent article that appeared in the magazine is shown as Exhibit 9, but is difficult to read because of the poor copy quality. The survey results relate to the MARRIOTT Group, referring to RENAISSANCE hotels as being among the groups "familiar brands".

22. Mr Kimball goes on to refer to a guest satisfaction index study of North American hotels undertaken by J.D. Power & Associates in 2003 shown as Exhibit 10. Whilst RENAISSANCE Hotels and Resorts is mentioned, there is nothing to indicate whether the survey involved any UK consumers. Mr Kimball goes on to refer to a 2001 Consumer Reports Magazine article that rated the RENAISSANCE brand as "one of the nation's best hotel brands." and the Business Travel News ranking of RENAISSANCE branded hotel services as Number 1 in the category "upscale -ease in arranging individual travel.". Exhibit 11 consists of an extract from the Marriott Group website dating from 2 January 2004, reporting that Marriott International Inc. had been ranked by Fortune magazine as one of the 100 best companies to work for. There is nothing that shows these are based on the UK market or reflect the views of the UK consumer.

23. Mr Kimball refers to his company's annual reports for the years 2000 to 2006 shown as Exhibit 12, which, he says show the extent of use and growth of the use of RENAISSANCE and provides an overview of the business. He does not give any useful details such as how many were distributed and to whom.

24. Mr Kimball goes next to Exhibit 13 which consists of a list of his company's portfolio of trade mark registrations and pending applications consisting of or containing the element RENAISSANCE around the world. Exhibit 14 consists of "selected" copies of registration certificates for the RENAISSANCE mark, including six UK trade mark registrations and one Community trade mark registration.

25. Mr Kimball returns to his company's use of the RENAISSANCE mark in the UK, giving the date of first use as being "at least as early as 1998 as evidenced by the attached web archive pages obtained from Way Back Machine... and shown as Exhibit 15". The first page of the exhibit shows entries relating to the website address <http://renaissancehotels.com/> the earliest dating from 5 December 1998. From the website details at the foot, the next page of

the exhibit can be seen to be from this date. It is headed with the R logo with RENAISSANCE in large letters beneath, with the words "HOTELS AND RESORTS" in smaller lettering beneath. The next two pages are from the same date and contain a list of the locations of RENAISSANCE hotels, Heathrow, London being among them. A later page from 1999 shows 3 RENAISSANCE hotels in the London area, and one in Manchester. Mr Kimball says that the RENAISSANCE mark has been used continuously in the United Kingdom since the date of first use.

26. Exhibit 16 contains a list of locations in the United Kingdom where RENAISSANCE hotels can be found, namely in Derby, Heathrow, London Gatwick, Manchester, Reading and Solihull, with Exhibits 17 through 23 giving details relating to each of these hotels. Mr Kimball gives the dates that these hotels opened under the RENAISSANCE brand as being "at least as early" as the years quoted:

Heathrow 1998
London Gatwick 1999
Manchester 1999
Reading 1999
Derby 2001
Solihull 2001

The dates for the first four of these are consistent with the web pages shown in Exhibit 15.

27. Mr Kimball reiterates that along with the MARRIOTT group, his company offer various hotel branded products including shirts, chocolates, candies, mints and linens, examples of which are shown as Exhibit 24. The exhibit consists of various photographs of confectionary, towels, a shirt, aromatherapy bath lotions, soaps and bedding, some bearing the RENAISSANCE name with the R logo above and the name of the hotel beneath, others just showing the Marriott name. Some are clearly complementary bath preparations traditionally provided by good hotels, others such as the shirt may well be for sale but this is not clear. Whatever is the case, they are either undated or bear a date after the relevant date. Even so, it seems to me reasonable to assume that the bathroom items and bedding were probably being provided from the date that the hotel opened; that is in my experience a common and known feature of the hotel trade.

28. Mr Kimball goes on to refer to his company's advertising of its RENAISSANCE hotel services in magazines, newspapers, television, radio, outdoor signs, airports, point of sale displays in hotels and elsewhere, and gives the approximate spend on these activities broken down into inside and outside the US. Whilst the figures quoted are significant, it is not possible to apportion them to the UK. He goes on to address his company's advertising and marketing of the RENAISSANCE brand, Exhibit 25 providing a selection of advertisements and marketing materials showing use of the RENAISSANCE trade mark in the United Kingdom. Most show RENAISSANCE primarily as part of the Marriott group advertising, but none can be seen to originate from before the relevant date. None mention any goods being available from either Marriott or RENAISSANCE.

29. Mr Kimball goes on to refer to the press coverage given to RENAISSANCE in relation to the hotel services provided, examples of which are shown as Exhibit 26. This shows an article dated 22 March 1998 from the Independent that, inter alia, refers to the RENAISSANCE hotel in High Holborn. Another article from the 20 March 2000 edition of the Financial Times reports the opening of the hotel. The remaining articles date from 2003 onwards and either mention a RENAISSANCE hotel for possible visits, or report various happenings or events in a RENAISSANCE hotel.

30. Mr Kimball goes on to refer to actions where his company has successfully enforced its rights in the RENAISSANCE name and mark in jurisdictions around the world, but does not give any details by which to judge their relevance. He does not say whether his company has been unsuccessful in any of its actions.

31. Mr Kimball turns his attention to hotel branded merchandise, stating that for several years, hotel groups, such as his company have offered merchandise to consumers bearing hotel brands, and those owned by hotel companies such as the REVIVE brand of Marriott. He refers to The Ritz-Carlton Hotel Company, LLC, a sister company within the MARRIOTT Group, which has for many years offered hotel branded products for sale, examples of which are shown in Exhibit 27. The exhibit consists of copies of catalogues, the first dating from 2001. This shows decorative plates, book stand, photo frame, dish, boxes, clock, hour glass, casual shirts, shorts and a jacket, baseball cap, leather bags, bathrobes, polo dress, mugs, glasses, tea, CD, sun lotion, beach robe, bathroom preparations, duvet and pillows. Apart from originating from after the relevant date, the prices are in \$ and the UK does not feature in the list of "Participating Ritz Carlton Gift Shops" listed at the rear. A second brochure from 2003 suffers from the same defects. A third brochure lists products from various designers with some Ritz Carlton items being branded from the "signature range". The copy is poor and difficult to read. The only clue as to its origins is that again the prices are in \$. It is not possible to date it.

32. Mr Kimball says that many hotel companies offer members of the public goods of hotel quality for use at home, including many items that are intended for use in the bath. Exhibit 28 is said to consist of examples of bath-oriented merchandise offered for sale to members of the public by hotel companies under their hotel brands. The exhibit consists of extracts taken from the websites of Marriott, Hilton, and Westin hotels. These show a shower rod, shower curtain, shower curtain rings and towels being sold by Marriott. The Hilton also lists a shower rod, shower curtain and shower curtain rings, but also a bathrobe, towels, soap dish, bath trays, waste baskets, soap pump and a tissue box. The WESTIN hotel shows a shower head, shower rod, shower curtain, shower hooks, bathrobes and bath towels. As with the earlier extracts from the internet, these show the prices in \$ and appear to be from the US, at least there is nothing that shows them to have been available and accessed by UK consumers, or anything to say that they reflect the position at the relevant date.

33. Mr Kimball next exhibits material from non-hotel businesses that advertise and promote hotel-style merchandise, stating that this demonstrates the desirability of such products to members of the consuming public. The material is shown as Exhibit 29, and consists of the results of a "Next Tag" search done in June 2007 for "hotel style" goods, in particular, a towel

rack". This retrieved 51 matches, some of which Mr Kimball has printed. These quote the prices of the merchandise in dollars which is not surprising given that they are US traders. There does not appear to be any from the UK amongst the results, or anything that indicates UK consumers have accessed these sites or transacted any business with them.

34. Mr Kimball returns to the proceedings initiated in other jurisdictions to prevent registration of marks consisting of or containing the word RENAISSANCE for hotel style products, Exhibit 30 showing a decision from the Taiwanese trade mark office. In this case a trader had applied to register RENAISSANCE in respect of bedding, quilts, bedspreads, bedcovers, wool quilts, pillow cases and blankets in Class 24. Mr Kimball draws attention to his company's trade marks as having been held to have become well known as famous marks, and "highly distinctive and famous". The Taiwanese office determined that the later mark indicated "an affiliated business relationship, licensing relationship, franchising or other relationships and finally ... be led into confusion and mis-identification".

35. Mr Kimball concludes his statement stating that given the trend of hotels to offer a range of own branded products, it is his view that use of the RENAISSANCE trade mark in relation to hotel style goods such as those covered by the trade mark application filed by Bristan Group Limited, is likely to lead to conflict and confusion on the part of the public.

36. Next is a Witness Statement dated 24 August 2007 from Gemma Williams, a Trade Mark Assistant with D Young & Co who represent the opponent's in these proceedings.

37. Ms Williams recounts having conducted a search of www.wikipedia.org to establish the reputation of the RENAISSANCE mark owned by the opponent in the UK, including the extent that a hotel's reputation extends beyond the usual goods and services offered by the hotel industry. Exhibit GW1 consists of a print-out from the website taken on 8 August 2007 which contains information relating to the RENAISSANCE brand of hotels. She notes that it is listed as being a "worldwide" brand catering for an up-market segment of the public and having established itself as a boutique-like hotel.

38. Ms Williams refers to the books mentioned by Mr Kimball in his Statement, going on to mention extracts which she provides as Exhibits GW2 and GW3. One describes Marriott International as a "leading world-wide hospitality company", the other shows the company as being at the top of a list of the leading hotel management companies. Neither exhibit mentions RENAISSANCE, and whilst this part of the Marriott group may well have contributed to the overall success, there is nothing by which to gauge the part it played.

39. Ms Williams next refers to a search of www.lexnisnexis.com to determine whether there had been any media coverage of the RENAISSANCE brand in the UK, the results of which are shown as Exhibit GW4. The features refer to RENAISSANCE in relation to the establishment and expansion of the chain, the installation of wireless network facilities, a recruitment fair being held in a RENAISSANCE hotel, the availability of rates, etc, but say nothing that helps in establishing any reputation or in the determination of this case.

40. Ms Williams next refers to her investigations on the www.shopmarriott.com website, which she says appears to be an on-line retail shopping site for all Marriott group companies, the results of which are shown as Exhibit GW5. Ms Williams refers to a number of shower products being on sale, commenting that these are the same as those referred to by Mr Kimball. She says that further investigations of the site revealed references to a “Hotel Collection” product range including t-shirts, candles and cookery books, a “Home Furnishings” product range including table lamps, chairs and framed pictures, a “Bedding Collection” offering linens and throws, and a “Down Collection” of pillows, mattress protectors and duvets. Details from the website relating to these products are shown as Exhibit GW6. The exhibit consists of a number of screenshots from the website, depicting some (but not all) of the goods stated. Although there is a sub-heading “International Shop Sites” there are no further details. The prices are also quoted in \$. So whilst it is possible that this may have included the UK, it is not certain.

41. Ms Williams refers to Exhibit GW7, which consists of a DVD containing an episode of the television series “Hotel Babylon”. This is provided to illustrate that articles, including those for which the applicants seek to register their mark, are taken (stolen) from hotels, inter alia, by guests.

42. The final Witness Statement is dated 9 January 2008, and is a second Statement by Kevin Kimball.

43. Mr Kimball sets out the amounts in US\$ spent in advertising the RENAISSANCE brand in the UK in the years 2005 to 2007, which are \$1.9 million, \$3.28 million and \$2.56 million, respectively. He gives the gross sales and turnover for his company’s hotels in the UK for 2006 as being £86 million, stating that this was the first full year that all RENAISSANCE hotels in the UK had been operated by his company. He states that prior to this most had been operated by another company under a master franchise agreement, and consequently, sales figures are not available. Mr Kimball provides some “UK specific” advertising as Exhibit 31. Whilst these show the RENAISSANCE name, either separately or as part of the Marriott Group, they either cannot be dated or clearly date from after the relevant date, and cast no light backwards.

44. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

45. I turn first to look at the ground under Section 5(3) of the act. As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004 Section 5(3) now 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 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) 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.”

46. The standard test for the sort of reputation that is needed to underpin a Section 5(3) action is set out in *General Motors Corp v Yplon SA* [2000] R.P.C. 572. In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

47. The raft of recent case law relating to objections under Article 8(5) of Regulation 40/94, equivalent to Section 5(3) of the Trade Marks Act was considered by the CFI in some detail in *Sigla SA v. Office for Harmonisation in the Internal Market* Case T-215/03, namely, Case C-292/00 *Zino Davidoff & Cie SA v Gofkid Ltd* [2003] E.C.R. I-389 at [24]-[26], and Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2003] E.C.R. I-12537 at [19]-[22], Case T-67/04 *Monopole SpA v OHIM--Spa-Finders Travel Arrangements* [2005] E.C.R. II-1825 at [30], the Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas Benelux AS* at [36]-[39], Case T-104/01 *Oberhauser v OHIM-- Petit Liberto* [2002] E.C.R. II-4359 at [25], Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] E.C.R. I-5507 at [29], Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819 at [17], Case C-251/95 *Sabel BV v Puma AG* [1997] E.C.R. I-6191 at [20] and Case C-375/97 *General Motors Corp v Yplon SA* [1999] E.C.R. I-5421 at [30]. Some of these cases I will refer to in more detail.

48. The CFI concluded that the mark at issue must be either identical or similar to an earlier mark relied upon. The earlier mark must also have a reputation. There must be a risk that the use of the mark applied for, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. In *Sigla* the CFI went on to say that that along with the “similarity” requirement for the marks, these conditions are cumulative and a failure to satisfy one of them is sufficient for a case to fail.

49. There can be no doubt that the marks applied for are the word RENAISSANCE. The applicants do not dispute that the opponents have used RENAISSANCE and acquired a reputation in respect of hotel and lodging services. What they do challenge is that this reputation is such that it will extend to the goods covered by the application, and that use by the applicants in respect of such goods will lead the consumer to associate the mark applied for with the opponents.

50. In his submissions, Mr Hey gave an explanation of how the applicants came to adopt RENAISSANCE as a trade mark, referring to the fact that RENAISSANCE is an ordinary and "attractive" English word and not an invention. He cited the *Perfection* case [1941] RPC. 162 in which Lord Cozens-Hardy stated: ‘Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure.’ Mr Hey argued that although decided some time ago (and under the 1938 Act) the principles still hold good. Recent judgments of the ECJ and the CFI, in particular, in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (in relation to Section 10(3)), have stated that the purpose of the Regulation is not to

prevent registration of any mark which is identical or similar to a mark with a reputation.

51. Accepting that the opponents have a reputation for RENAISSANCE in respect of hotel and lodging services, the question is whether this reputation is such that use of the same mark in respect of the goods of the application would take unfair advantage of, or be detrimental to, its distinctive character or the repute.

52. In *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge stated):

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

53. In *Daimler Chrysler AG v Alavi* (the *Merc* case) [2001] RPC 42 at para 88, Pumfrey J stated:

“88. In my view, the best approach is just to follow the section, remembering Jacobs A.G.’s warning that it is concerned with actual effects, not risks or likelihoods...”.

54. In relation to detriment to the repute of the earlier mark, the CFI considered that this would occur where the goods or services of the mark applied for “have a characteristic or a quality which may have a negative influence on the image of an earlier mark”. The potential for detriment in this case is not clear. There is no evidence that the applicant’s goods are of such a quality that if the consumer were to make an association this would tarnish the shine of the opponent’s reputation.

55. The opponents are not in the same area of trade as the applicants, and have sought to show that they have an established connection with at least some of the goods of the application. They have done this in a number of ways; through the "expert evidence" of Bob Cotton, by providing evidence from Mr Kimball relating to their own business and the activities of the hotel trade, and by showing there to be a trade in "hotel style" goods, the latter bolstered by research conducted by the evidence of Ms Williams.

56. There is a certain amount of repetition in the evidence of Mr Cotton, Mr Kimball and Ms Williams, which, given that they all either seek to establish the reputations of RENAISSANCE and/or establish a connection between hotels and a trade in the goods covered by the application is perhaps not surprising. Mr Cotton draws on his own personal awareness of the hotel trade, from which he says that “over the last few years, there has been a trend for hotels to maximise their revenue through sales of a wide range of branded goods”. Mr Cotton says that these products "often go beyond the traditional services offered ...into the realms of home furnishings including products for the bath and shower". Given that he made his Statement some 7 years after the application date, which to any reasonable person is more than a few years, it does nothing to set the scene at the relevant time.

57. Mr Cotton's awareness extends to companies beyond the hotel trade that he says offer "home furnishings and other items described as "hotel style" or the like that are intended to convey to consumers the attributes and cache of products found in certain well-established up-scale hotels and resorts, including RENAISSANCE. The exhibits filed by Mr Cotton consist of prints taken from the websites of the opponent's parent company Marriott and other hotels such as the Hilton and Westin, which show that they have a shop selling a small range of goods, the Macy's department store, and a business trading under the name "Hotels To You.com" that sells what it describes as "Fine hotel products for your home." Setting aside the fact that this evidence originates from 2007, it singularly fails to establish that the trading circumstances claimed exist in the UK. The evidence supporting Mr Cotton's statement shows the existence of a trade in "hotel style" goods in the US, and it is possible that visitors from the UK will have become aware of the products on sale and even made some purchases, but there is no evidence of this. Likewise, whilst there is an indication that the products may be available internationally via the internet, and it is certainly possible that the sites can be accessed and purchases made from the UK, as Jacob J said in the *800-FLOWERS* case, [2000] FSR 697:

“...the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.”

58. I am conscious that at no point does Mr Cotton say that that the trade that he describes reflects the position in the UK. The mere fact that he and his organisation exist and operate in the UK is not sufficient to draw that conclusion.

59. Notwithstanding the applicant's concession in relation to the opponent's reputation in respect of "hotel and lodging services", Mr Kimball's evidence still goes to establishing this as fact. Mr Kimball also goes down a similar route of trying to show that hotels and hotel groups, including his own, trade in the sort of goods covered by the application, and that there is a trade by non-hotel businesses in such goods under the classification of "hotel style". Mr Kimball relies upon a considerable amount of evidence which I have no problem in accepting as showing his company, and the mark RENAISSANCE are likely to have a strong reputation, in the UK, in respect of hotel and related services. There does appear to be a trade in goods being carried out by certain hotels, including those forming part of the Marriott Group, and that this encompasses some of the goods for which the applicants seek registration. However, Mr Kimball's evidence relating to the trade in goods by hotels, and hotel style goods by other businesses suffers from the same defects as those I have identified in Mr Cotton's evidence, namely, that whilst the evidence shows such a trade, it does not do so for the UK, let alone at the relevant date.

60. There is evidence that the opponents may have sold confectionary, towels, a shirt, aromatherapy bath lotions, soaps and bedding, some bearing the word RENAISSANCE with the name of the hotel beneath, others just showing the Marriott name. I say "may" because it is apparent that some of the items shown, such as bath preparations are complementary products traditionally provided by good hotels. Others such as the shirt may well be on sale, but this is not clear. The problem is that the exhibit either cannot be dated or bears a date after the relevant date. It is reasonable to infer that the bathroom items and bedding were

probably around from the date that the hotel opened, but it is not reasonable to infer that they were on sale to the public, let alone to the public in the UK.

61. Mr Kimball's evidence relating to his company's advertising of its RENAISSANCE hotel services suggest that may have created an awareness of the brand amongst consumers in the UK. Again I say "may" because if taken without the concession of their reputation by the applicants this evidence does not assist in establishing the existence and extent of any reputation. The figures for the "approximate" spend on advertising and promotion are significant, but it is not possible to apportion it to the UK. Additionally, the examples of advertisements and marketing materials provided originate from after the relevant date. It is significant that not one mention is made of any goods being available from either Marriott or RENAISSANCE.

62. The examples of press coverage received for RENAISSANCE is in relation to the hotel services it provides, and in some instances actually originates from prior to the relevant date. There is no mention of any trade in goods.

63. The evidence provided by Mr Kimball to establish that hotel groups, such as his, have offered merchandise to consumers bearing hotel brands suffers from some of the same flaws as his other evidence. Apart from originating from after the relevant date, the prices are again in \$ with no indication that the products were available or accessible by UK consumers. In fact, some of the evidence lists where products are available, in particular, the Ritz Carlton Gift Shops brochure, which at the rear contains a list of participating shops by country/continent; the UK is not mentioned. The evidence provided by Mr Kimball to show that there are non-hotel businesses that advertise and promote "hotel-style" merchandise to members of the consuming public suffers from similar defects. The prices of the merchandise are in \$ which is not surprising given that these all appear to be US traders. There does not appear to be any traders from the UK amongst the results, or any evidence that indicates UK consumers have accessed these sites or transacted any business with them

64. Ms Williams sets out to establish the reputation of the RENASSANCE mark owned by the opponent in the UK, and the extent that an hotel's reputation extends beyond the usual goods and services offered by the hotel industry. Exhibit GW1 consists of a print-out from www.wikipedia.org taken on 8 August 2007 which describes RENAISSANCE as a "worldwide" brand that has established itself as a boutique-like hotel. Ms Williams refers to the books mentioned by Mr Kimball in his Statement, providing extracts as Exhibits GW2 and GW3. One describes Marriott International as a "leading world-wide hospitality company", the other shows the company as being at the top of a list of the leading hotel management companies although neither exhibit mentions RENAISSANCE. Exhibit GW4 consists of prints from www.lexnisnexis.com, and shows the media coverage of the RENAISSANCE brand in the UK. These mostly refer to various developments and events involving RENAISSANCE and say nothing that helps in establishing any reputation or whether there is a connected trade in goods. All that these exhibits achieve is to establish what is not in dispute; that Marriott and RENAISSANCE have a presence and reputation in the UK as a hotel group.

65. Ms Williams' investigations on the www.shopmarriott.com website, the on-line retail shopping site for Marriott group companies show a number of shower products on sale. In essence these are the same as those referred to by Mr Kimball which is not surprising given that they provide information from the same source. Ms Williams' investigations also revealed references to a "Hotel Collection" product range, details from the website relating to these products being shown as Exhibit GW6. The exhibit consists of a number of screenshots from the website depicting a collection of goods for sale. Although shown as "International Shop Sites," and which, conceivably, could include the UK, but that the prices are given in \$ only adds to the uncertainty as to whether the products shown were available to the UK market or consumer. The exhibit suffers from the same defects as those I have identified in the internet evidence provided by Mr Kimball. The DVD (GW7) containing an episode of the television series "Hotel Babylon" provided to illustrate that articles, including those for which the applicants seek to register their mark, are taken from hotels, inter alia, by guests is entertaining but of no evidential value.

66. The only conclusion that I can come to based on this evidence is that in some parts of the world there is a trade by hotels in certain types of goods, and even some of the type listed in the application, but there is no evidence that this is the case in the UK, or was at the relevant date. It is also relevant that RENAISSANCE is not a word of the opponent's invention. It is an ordinary English word that denotes a cultural period in history. As such it has an attraction to those wishing to convey a particular image, style or idea of product, including those of the type covered by the application, including the bathroom fixtures and fittings on which the opponent's focus. This is relevant to the extent that the consumer is less likely to link all use to one source.

67. Whilst the Internet is global, for evidence from this source to be of any assistance it would, at the very least require details of use of the site by persons within the United Kingdom, and in this case, details of sales effected by this means, but even with such evidence (and there is none) considerable care would have to be exercised in the interpretation of the bare facts. It may well be the site came up in the results of an unrelated search, and the person did not take much, if any notice of its contents. There is no evidence that orders were placed from within the United Kingdom via the website.

68. Accepting that there is evidence of hotels outside of the UK, including RENAISSANCE hotels, selling goods of the type covered by the application, it could, and has been argued that visitors from the UK will have encountered this trade. Although bald "room night" and income figures attributed to visits by UK consumers to RENASSAINCE hotels worldwide is not evidence of actual stays, they have not been challenged and must be accepted at face value. Even so, it must be reasonable to infer that UK consumers have stayed in RENAISSANCE hotels, and had been doing so from before the relevant date; it is a matter of common sense. That said, the mere fact that consumers have stayed at these hotels is not evidence that in doing so they must have become aware of any trade in goods, or that their consciousness has been alerted to expect this as being the case in respect of the UK market.

69. Then there is the matter of the newsletter circulated to the rewards membership scheme. Whilst I have no doubt that this will have given details of the benefits of membership, and offered deals on stays in Marriott Group hotels, including RENAISSANCE, did they also

bring attention to the availability of products for sale? I do not know and there is no evidence. I do not consider this to be something that I can infer. I do not see how I can say that this, or the internet and visits from UK consumers have established a reputation for a trade in goods by hotels, or in "hotel style goods", within the United Kingdom.

70. The fact that something may be used or provided to guests of an hotel in the course of their stay does not give cause to assume or infer that the consumer will necessarily think of the hotel should another trader sell those or similar goods under the same name. It may well be that in respect of certain types of services, such as restaurants and fitness clubs, or services connected to travel and the provision of accommodation, the consumer will be aware that the hotel offers such facilities and may have extended this use beyond the guests staying at the hotel, but the same cannot be the case for goods that are essentially fixtures and fittings that are part of the fabric of the hotel. Accordingly, I see no reason why the consumer familiar with the RENAISSANCE brand, even with its undoubted reputation in respect of the hotel and lodging services, would make any association with goods of the type covered by the application if sold under the RENAISSANCE name.

71. Consequently, I do not consider there to be an advantage that could be unfairly taken, or detriment that could be suffered, in respect of the distinctive character or the repute of the opponent's mark. The ground under Section 5(3) is dismissed.

72. I will next go on to consider the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom 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, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

73. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

74. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark*[1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

75. The applicants do not dispute the opponents have a reputation for RENAISSANCE in respect of hotel and lodging services. As can be seen from my decision in respect of Section 5(3), I share the applicant's view, and I do not see any reason to believe that the position is any different in respect of goodwill. Given that the marks in dispute are identical words, the question is whether the applicant's use in respect of goods that are clearly different to the services for which the opponent has a reputation and goodwill, would constitute a misrepresentation, and one that is likely to cause damage.

76. It is not necessary that a common field of activity exists for there to be a finding of passing off, as is illustrated by the following passage from *Harrods Ltd v Harrodian School* [1996] RPC 697:

“What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration ‘... whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant: *Annabel's (Berkeley Square) Ltd v G Schock per Russell LJ.*”

77. I am aware that some larger hotels have shops that sell souvenirs, confectionery, toiletries, beverages and the like; I doubt whether the applicants would dispute that this is the situation. However, whilst there is evidence that hotels sell some of the goods covered by the application, for the reasons that I give in my decision in respect of Section 5(3), I am not aware (and there is no evidence) that this is the position in the UK.

78. Earlier I mentioned the fact that RENAISSANCE is an ordinary English word that denotes a cultural period in history, and an associated image or idea of style. To my mind this further loosens the potential for a link being made between two traders in different fields using the same mark in respect of their activities. For this, and all of the reasons I have mentioned, I do not see that use of the mark applied for could constitute a misrepresentation.

79. The third element of the action is damage. In *Mecklermedia Corporation DC Congress GmbH* [1997] ETMR 265, Mr Justice Jacob, as he then was, said:

“Now in some cases one does indeed need separate proof of damage. This is particularly so, for example, if the fields of activity of the parties are wildly different (*e.g. Stringfellow v McCain Foods (GB) Limited*, nightclub and chips). But in other cases the court is entitled to infer damage, including particularly damage by way of dilution of the plaintiff’s goodwill.”

80. I believe it must follow that as there will be no misrepresentation, there is no likelihood of any damage being caused to the goodwill or reputation attached to the opponent’s RENAISSANCE mark. It will be just as distinctive and the reputation and goodwill as intact as ever. The ground under Section 5(4)(a) is also dismissed.

81. The opposition having failed the applicants are entitled to a contribution towards their costs. I therefore order that the opponent pay the applicants the sum of £3,250 towards their costs. This sum 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 12th day of December 2008

**Mike Foley
for the Registrar
the Comptroller-General**