

O-356-10

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 995701
IN THE NAME OF
STAYWELL HOSPITALITY PTY LIMITED
IN RESPECT OF THE TRADE MARK**



PARK REGIS

IN CLASSES 35 and 43

AND

**THE OPPOSITION THERETO
UNDER NO 72008
BY
SHERATON INTERNATIONAL, INC**

Trade Marks Act 1994

In the matter of
international registration no. 995701
in the name of Staywell Hospitality Pty Limited
in respect of the trade mark:



in classes 35 and 43
and the opposition thereto
under no. 72008
by Sheraton International, Inc

Introduction

1. Staywell Hospitality Pty Limited (“Staywell”) is the holder of the above international registration (the ‘IR’). Protection in the United Kingdom was requested on 24 February 2009. The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 24 April 2009. Protection is sought in respect of the following goods and services¹:

Class 35: *Business management*

Class 43: *Temporary accommodation*

2. On 20 July 2009, Sheraton International, Inc, which I will refer to as “Inc”, filed notice of opposition on Form TM7 to the protection of the international registration only in respect of class 43. The Form TM7 had been preceded by a Form TM7A, also filed by Inc². Following withdrawal of the other grounds of opposition initially

¹ Classified according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

² Rule 17 (1), (2) and (3) of the Trade Marks Rules 2008² states:

“17.—(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.”

raised, the remaining grounds of opposition are under section 5(2)(a) and (b) of the Trade Marks Act 1994, based on a single international registration:

901786 ST. REGIS

Class 36: *Real estate development services; real estate and land acquisition, real estate equity sharing, namely, managing and arranging for ownership of real estate, condominiums, apartments; real estate investment, real estate management, real estate time sharing and leasing of real estate and real property, including condominiums and apartments.*

Protection was requested in the United Kingdom on 16 August 2006, claiming a USA priority date of 16 February 2006³. Section 6(1)(a) of the Act defines an earlier mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”.

This international registration is therefore an earlier mark. Its holder is The Sheraton Corporation.

3. Staywell filed a counterstatement, denying a likelihood of confusion. The counterstatement also contained a counterclaim in paragraph 3; namely, that the proprietor (holder) of 901786 is not the opponent. Staywell denies that Inc may rely upon 901786 to found its opposition.

4. Neither party filed any evidence. The parties were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and from any written submissions. Neither side requested a hearing and only Staywell filed written submissions, in which it repeated its contention regarding the identity of the opponent, relative to the holder of the earlier mark relied upon.

Decision

5. The relevant part of section 5 of the Act states:

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

³ The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with article 3 of the Trade Marks (International Registration) Order 1996 (as amended) (the Order) and particulars of the international registration were published in accordance with article 10 in the Trade Marks Journal of 9 February 2007. No opposition was received to the granting of protection of the international registration, consequently, as per article 12(1A) of the Order, the international registration was protected with effect from 10 May 2007, the day after the expiry of the opposition period.

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

(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.”

Article 2 of the Trade Marks (Relative Grounds) Order 2007⁴ states:

“Refusing to register a mark on a ground mentioned in section 5 of the Trade Marks Act 1994

2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.”

The transitional provisions state that article 2 shall not apply to an application for registration of a trade mark which was published before the coming into force of the Order. The Order came into force on 1 October 2007; the IR for which protection is sought was published after this date (24 April 2009), which means that the Order applies to these proceedings.

6. At the date of publication of the opposed IR, the Trade Marks (International Registration) Order 2008⁵ had come into force. Article 3(2) and (3)(a) and (b) states:

“2) Subject to paragraph (3) a protected international trade mark (UK) shall be treated as if it were a trade mark registered under the Act and the holder shall have the same rights and remedies but shall be subject to the same conditions as the proprietor of a registered trade mark.

(3) The provisions of the Act (except those listed in Schedule 1, Part 1), the Relative Grounds Order and the Trade Marks Rules (except those listed in Schedule 1, Part 2) shall apply to international trade marks (UK) and requests for extension with the following modifications;

(a) references to a registered trade mark shall include references to a protected international trade mark (UK);

(b) references to a proprietor of a registered trade mark shall include references to the holder of a protected international trade mark (UK);”

It is clear from the above that the holder of an IR is treated in the same way and is subject to the same conditions as the proprietor of a UK national trade mark.

⁴ SI 2007 No. 1976

⁵ SI 2008 No. 2206

Therefore the Trade Marks (Relative Grounds) Order 2007 applies to these proceedings in the same way as it would if the mark relied upon was an earlier UK national trade mark.

7. Article 2 of the Trade Marks (Relative Grounds) Order 2007 is explicit in its wording (emphasis added):

“The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings **by the proprietor** of the earlier trade mark or other earlier right.”

Inc is not the proprietor of the earlier trade mark relied upon: the proprietor recorded on the register is The Sheraton Corporation.

Conclusion

8. Although neither the Act nor the Rules define ‘proprietor’ as the person registered as the proprietor of the trade mark, the person that is so recorded as proprietor (or in this case the holder of the earlier IR) should be taken, *prima facie*, as the proprietor. The issue was raised in the counterstatement which means that the onus is on Inc to demonstrate that it is the proprietor in law despite what is on the register, or to demonstrate that Inc and The Sheraton Corporation are one and the same legal entity. This has not been done and, therefore, on the face of it I must regard Inc and The Sheraton Corporation as different legal entities with the consequence that the opposition has been brought by someone other than the proprietor of the earlier mark. In accordance with the Trade Marks (Relative Grounds) Order 2007, this earlier mark cannot be relied upon to support the opposition filed by the party entered as opponent on the Forms TM7A and TM7. The opposition has no legitimate basis and is therefore dismissed.

Costs

9. Staywell Hospitality Pty Limited has been successful and is entitled to a contribution towards its costs, which I award on the following basis:

Considering the other side’s statement and preparing a counterstatement:	£300
Written submissions	£200
Total	£500

10. I order Sheraton International, Inc to pay to Staywell Hospitality Group Pty Limited the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of October 2010

**Judi Pike
For the Registrar,
the Comptroller-General**