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IN THE MATTER OF the Trade Marks Act 1994

And

IN THE MATTER OF UK Registration No. 2536999



**In classes 36 and 43 in the name of MARRIOTT WORLDWIDE
CORPORATION**

And

IN THE MATTER OF REVOCATION APPLICATION No. 500977

By

DR SASCHA SALOMONOWITZ

DECISION OF THE APPOINTED PERSON

1. This is an Appeal by the Appellant Dr Salamonowitz against part of the Decision of Mr Allan James made on 10 August 2016.
2. The Appellant had applied to revoke the following mark ('the Mark') owned by the Respondent, the hotel chain Marriott Worldwide Corporation:



3. The Mark was registered as of 30 April 2010 for the following services:

Class 36: real estate services; services relating to the listing, leasing, management, operation, rental and brokerage of apartments, condominiums, time-share properties and real estate of all kinds; real estate financing

Class 43: services for providing food and drink; temporary accommodations; hotel services; restaurant, catering, bar and lounge services; resort and 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.

4. On 2 September 2015, the Appellant applied to revoke the whole registration under s46(1)(a) of the Trade Marks Act 1994 on the basis that it had not been used for a period of 5 years from the date of application, and/or under s46(1)(b) on the basis that it had not been used for a period of 5 years prior to the date of the application to revoke (nothing turns on the precise dates).
5. The Respondent filed evidence of use through a witness statement of the General Manager of Grosvenor House, the JW Marriott hotel in Park Lane, London, Mr Stuart Bowery. It also filed a statement from the Chief Executive of the British Hospitality Association, Mr Ufi Ibrahim.

6. The evidence was summarised by Mr James between paragraphs 6 and 15 of his Decision. No issue was taken by either side with his summary.
7. The Respondent relied on two particular forms in which it said the mark had been used. The following form (‘the Composite Sign’) had been used on its website between July 2014 and July 2015:



8. The Respondent also relied on a similar representation of the mark (the ‘Reversed Sign’) which was essentially the same except that the Griffin and the wording had been ‘reversed’ so they appeared as white against a black background, and the words ‘Grosvenor House London’ did not appear.
9. There were two issues before Mr James:
 - (i) Whether the use of the Composite Sign and/or the Reversed Sign could be considered to be use of the Mark for the purposes of s46(1).

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- (ii) If so, whether the Respondent had established use of the Mark for any of the services for which it was registered other than ‘hotel services’.

10. On the first issue, Mr James held that the use of both the Composite Sign and the Reversed Sign counted as use of the Mark. On the second issue, he held that genuine use had been shown in relation to the following services only:

Hotel services; restaurant, bar and lounge services; provision of general purpose facilities for meetings, conferences; provision of banquet and social function facilities for special occasions.

11. He therefore revoked the Mark in respect of the class 36 services and certain of the class 43 services but permitted it to remain on the Register in respect of the services set out above.

12. The Appellant was represented by Mr Michael Hicks at the hearing before me. He challenges Mr James’s findings on both issues. The Respondent was represented by Mr Christopher Hall.

Use of the Composite Mark

13. Mr Hicks contends that Mr James erred in law in his approach to the question of whether a mark comprising multiple elements amounted to use of one of the individual elements as a trade mark, and therefore reached the wrong conclusion on the facts of the case.

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14. In his Decision, Mr James set out the relevant law by reference to propositions given in a series of authorities, none of which were disputed before me.

15. In Colloseum Holdings AG v Levi Strauss & Co. (Case C-12/12), considering the question of whether the Levi's 'red tab' registration had been used by a tab which appeared the word 'Levi's' printed on top, the Court of Justice said as follows:

'32. As is apparent from paragraphs 27-30 of the judgment in Nestle, the 'use' of a mark in its literal sense generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark...

35. ...a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product in issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1).'

16. In Mary Quant Cosmetic Japan Ltd. v Able C&C Co. Ltd (BL O/246/08), considering whether a registration of a flower device had been used in a case where it was integrated into the proprietor's word mark 'missha', Mr Geoffrey Hobbs said as follows in relation to composite marks consisting of both device and word elements:

'there is nothing in point of law to prevent a finding that there are two marks (one verbal, the other non-verbal) in the same field of view where that accords with the reality of the case'

and the relevant question was

‘whether the [registered] trade mark...performs an independent distinctive role [in the composite mark]’.

17. In Bimbo SA v OHIM (Case C-591/12), in a different context, the CJEU said this:

’24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign...

25 Nonetheless, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately.’

18. On the facts of the present case he concluded as follows at paragraph 36:

‘As I have already noted, there is no physical or conceptual connection between the letters/word JW MARRIOTT and the griffin device. The only connection between these signs is that they are used in conjunction with one another to identify the services of the proprietor. Such use is apt to result in the griffin device mark identifying the services of the proprietor, even when it is used without the letters/word JW MARRIOTT. I therefore find that the griffin device would continue to be perceived as identifying the services of the proprietor, if it were used alone. Consequently, use of

the composite mark counts as use of the registered mark for the purposes of s46(1) of the Act.'

19. Before me, Mr Hicks contended that Mr James should have taken a stricter approach to the question of whether the griffin device, when seen in the Composite Sign, would be perceived by the public as having an independent distinctive character or as performing an independent distinctive role. He made two particular points:

- (i) There was no actual evidence showing how members of the public actually perceived the composite sign. Mr Hicks contrasted the position in Specsavers [2014] EWCA Civ 1294, where such evidence was provided (see paragraph 33 of the judgment of Kitchin LJ in that case). He also suggested (by reference to the questions put to the CJEU) that the same must have been the case in Colloseum Holdings.
- (ii) There was nothing inherent in the sign itself (for example a 'TM' marking) which identified the griffin as having independent distinctive character.

20. When considering the question of whether a particular element of a 'composite' sign performs an independent distinctive role in that sign, a tribunal is seeking to determine how the composite sign would be seen (in its context) through the eyes of the average consumer. That is a matter for overall assessment, taking into account any relevant matters, but in principle it can be dealt with simply by considering the composite sign and applying common sense.

21. Where (as here) the element in question is

- (i) presented separately and apart from the rest of the sign
- (ii) a device or picture (especially when the rest of sign comprises words or letters)
- (iii) is unrelated conceptually to the rest of the sign
- (iv) is inherently distinctive in its own right

I believe that it is a particularly easy question to answer. The griffin device self-evidently has an independent distinctive role within the Composite Sign. Essentially, as Mr Hobbs put it in Mary Quant, this is a case where there are *‘two marks (one verbal, the other non-verbal) in the same field of view’*.

22. In such circumstances, I cannot see how Mr James’ conclusion or reasoning can be faulted.

23. Taking Mr Hicks’ principal points in turn:

- (i) The fact that evidence was called and relied on to show the independent distinctive character of the Mark within a composite sign in Specsavers (and, possibly, Colloseum) does not mean that it is necessary to do so in all other cases. It is worth pointing out that the proposition being argued for in both Specsavers and Colloseum was much more difficult than the one in the present case. In both cases, the registered mark comprised a plain colour ‘background’ on which a verbal sign was superimposed. It was not self-evident that the public would have seen the mark as anything more than

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background, as opposed to something which had its own independent distinctive role.

- (ii) The presence of a ‘TM’ marking next to one of the elements within a composite sign would no doubt assist the proprietor in cases of doubt as to whether the element had been ‘used’ as a trade mark. It would help to identify that element in the mind of the average consumer as having a separate distinctive character and purpose within the overall composite sign. However, once again, it is not necessary for a trade mark proprietor to have done so where the position is clear.

24. Having upheld Mr James’ decision on the Composite Sign, it is common ground between the parties that it is not necessary for me to consider his decision on the Reversed Sign.

Use in relation to particular services

25. The Appellant challenges the Hearing Officer’s finding that there had been use of the mark (in the form of the Composite Sign) in respect of the following services:

restaurant, bar and lounge services; provision of general purpose facilities for meetings, conferences; provision of banquet and social function facilities for special occasions.

26. The Composite Sign was used at the top of the web-pages on the Respondent’s web-site for the Grosvenor House Hotel. The services set

out above are advertised on those pages as being available at the hotel. Mr James therefore held at paragraph 56 as follows:

'In my judgment, average consumers looking at the proprietor's webpages would regard the services mentioned as having been advertised under the marks shown at the top of the pages...I do not consider that this finding is undermined by the fact that the restaurants and bars in the Grosvenor House hotel have individual names. There is nothing unusual in the same goods or services being promoted under a 'house' mark as well as under a separate product or service mark. I find that this is what has happened here. It follows that there is evidence of genuine use of the contested mark in relation to advertisements for the services mentioned in this paragraph.'

27. The Appellant's point here concerns the extent to which a sign used to indicate an 'umbrella' organisation such as a hotel in which a variety of services are provided can be taken to amount to use of a sign in respect of each of the services individually.

28. I was pointed to no useful authority considering this issue. In Land Securities v Registrar of Trade Marks [2009] RPC 5 Floyd J had to consider the proper scope of a trade mark applied for by a provider of shopping centres. However, this mark was not applied for in relation to any of the actual services (such as restaurants, bowling alleys, shops) provided in the shopping centres, but rather the '*bringing together for the benefit of others*' of such services. Not surprisingly Floyd J had little difficulty in concluding that this '*bringing together*' service was provided and could be the subject of a registered trade mark owned by the shopping centre provider. The CJEU later came to the same decision in

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Netto-Marken (C-420/13), in relation to a hypermarket which (in relation to another ‘*bringing together*’ – type application) was not required to distinguish between services provided by itself and services provided by third parties (see paragraph 39 of the Judgment).

29. There is no dispute that the services in question were provided in the Respondent’s hotel. Essentially the dispute is whether the use which has been shown would only have supported a ‘*bringing together*’ type specification of the Land Securities/Netto-Marken type, and is insufficient to support a specification for the actual provision of the services themselves.
30. The point is somewhat akin to the question of whether, and if so when, a retailer of goods can be considered to be using the mark ‘*in relation to*’ the goods themselves. In Euromarket v Peters [2001] FSR 20, Jacob J said this in a case where a mark was registered for goods but the only use was in a web-site of a retailer selling third party goods:

56 That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being “in relation” to the goods. I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

57Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel US shops to the UK in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.

31. The question here is whether the web-site would be perceived by the average consumer as indicating a connection in the course of trade between the services in question and the Marriott hotel (and therefore with its associated branding including the griffin device), as opposed simply to identifying services which were provided in the hotel (without indicating any responsibility for them). Once again, this is ultimately a matter of impression on the basis of the evidence presented, which may simply be the way the mark is used in its context. It is not necessary to call actual evidence from the public as to their understanding of the message conveyed by the sign.
32. Mr Hicks' best point was in relation to the restaurant and bar services. He pointed out that hotels may sometimes act as simply a venue from which independent restaurants and bars trade, rather than operating the restaurants and bars themselves. He then pointed to the web-site which lists a number of restaurants and bars as available in the hotel. Each of these has its own name: JW Steakhouse, the Park Room, Corrigan's

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Mayfair, Park Lane Market, Red Bar, the Bourbon Bar and the Library. He said that the public would not assume the hotel was responsible for these services.

33. I have set out Mr James' decision on this point above at paragraph 26. I agree with him. I consider that the public would assume in the absence of any indication to the contrary that restaurants and bars operating in a hotel were controlled by the hotel. It is not like a shopping centre, which is understood as generally simply acting as a venue for third party services. The fact that the bars and restaurants have actual names is neither here nor there. A hotel operating more than one bar or restaurant has to give them names to enable its customers to distinguish between them. The names certainly do not positively suggest that they are operated by a third party (eg by using a third party trade mark like Costa Coffee). On the contrary, as Mr Hall pointed out, the name 'JW Steakhouse' plainly suggests that it is a JW Marriott undertaking.

34. I therefore consider that there has been use of the mark in relation to restaurant and bar services. Mr Hicks did not make any specific or separate submissions in relation to the other services, and I do not believe that they are the kind of services which would ever be likely to be provided by third parties as opposed to by the hotel itself. I therefore come to the same conclusion in relation to all the remaining services upheld by Mr James.

35. The only other issue is one which I floated at the hearing, namely whether, since the specific services had only ever been provided by JW Marriott as part of their hotel offering, the specifications of those services should be limited by wording such as '*provided within a hotel*'. The

relevant test where there has been a limited form of use within a more general specification is that set out by Kitchin LJ in Roger Meier v ASOS [2015] EWCA Civ 220:

‘The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise, the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.’

36. Having considered the matter carefully I do not think there is any basis for cutting the specification back any further. Whilst one can refer to a ‘hotel bar’ or a ‘hotel restaurant’, I do not think that they can usefully be treated as a separate trading category from bars and restaurants generally. In particular I bear in mind that hotel bars and restaurants are generally open to the public whether or not they are staying in the hotel and therefore compete with non-hotel bars and restaurants. The same reasoning applies to the other categories of service in relation to which Mr James allowed the registration to continue.

37. I therefore uphold the decision of the Hearing Officer and will dismiss the Appeal.

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38. The hearing lasted about ½ a day with skeleton arguments on both sides and some short supplementary submissions. I shall award the Respondent £800 by way of costs.

IAIN PURVIS QC
THE APPOINTED PERSON

30 October 2017