O-383-16

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2536999

IN THE NAME OF MARRIOTT WORLDWIDE CORPORATION

AND

APPLICATION No. 500977 BY DR SASCHA SALOMONOWITZ

TO REVOKE THE TRADE MARK FOR NON-USE

Background and pleadings

1. Marriott Worldwide Corporation ("the proprietor") is the registered proprietor of trade mark registration No. 2536999. The mark is shown below.

2. The mark was entered in the register on 30th April 2010.

3. The mark is registered for:

> 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, Dr Sasha Salomonowitz ("the applicant") applied for the registration to be revoked for non-use. The applicant claims that the mark was not put to genuine use in the UK in the five years following the completion of the registration process and there are no proper reasons for non-use. Consequently, he requests that the registration be revoked under s.46(1)(a) of the Trade Marks Act 1994 ("the Act") with effect from 1 May 2015. In the alternative, the applicant claims that there was no genuine use of the mark in the 5 year period between 2nd September 2010 and 1st September 2015. Consequently, he requests that the

registration be revoked under s.46(1)(b) of the Act with effect from 2nd September 2015.

5. The proprietor filed a counterstatement denying the claims. According to the proprietor, the mark has been put to genuine use throughout the periods identified by the applicant in relation to all the services for which it is registered.

The evidence

6. The proprietor filed evidence in the form of a witness statement by Stuart Bowery, who is the General Manager of Grosvenor House, a JW Marriott hotel on Park Lane in London. Mr Bowery's evidence is supported by a witness statement from Ufi Ibrahim, who is the Chief Executive Officer of the British Hospitality Association.

7. Mr Bowery's evidence is that the proprietor manages, franchises and licences hotels, resorts, timeshare properties, conference centres, residences and serviced apartments under 19 different brands. JW MARRIOTT is a luxury brand. The contested mark is the logo of the JW MARRIOTT brand. According to Mr Bowery, the proprietor operated three hotels in Europe under the JW MARRIOTT brand during the relevant periods, one of which is the Grosvenor House hotel in London.

8. Mr Bowery says that over 140k 'room nights' of accommodation were reserved at the Grosvenor House hotel in each of the years 2013 to 2015. This generated income of over $100m per annum.

9. The Grosvenor House hotel has been advertised since 2010 on the proprietor's .co.uk and .com websites under a composite sign consisting of the letters/word JW MARRIOTT together with the contested trade mark ("the composite mark")[1]. Mr Bowery exhibits historical pages from the websites obtained from the internet archive called the WayBack Machine. The entries from 1st July 2014, 18th July 2014, 3rd October 2014, 23rd December 2014 and 2nd July 2015 show use of this mark.

[1] See exhibit SB2 and SB3

10. Earlier entries from 25th October 2013, 2nd December 2013 show use of this mark[2].

11. Mr Bowery claims that customers can book rooms at the hotel directly via the proprietor's websites. This is borne out by the historical internet pages in evidence, which show room prices in pounds sterling alongside an on-line booking facility.

12. In addition to hotel rooms, the proprietor's .co.uk website shows the availability of the following facilities[3].

- Meeting space
- Event space
- Social events and weddings
- Restaurant and bar services

[2] See exhibits SB2 and SB3
[3] See exhibit SB2 at pages 14, 17, 19, 20, 21, 22, 23 ,24

The latter services appear to have been individually branded under JW Steakhouse, The Park Room, The Bourbon Bar, Corrigan's Mayfair and Park Lane Market. I note that in the 'fact sheet' making up part of the website entry from 2nd December 2013, prices are shown (in pounds sterling) for breakfasts[4].

13. Mr Bowery says that the contested mark has been used extensively within the premises of the Grosvenor House hotel during the relevant periods. Such use has been on TV screens in the lobby and in guest bedrooms, as a pin on staff uniforms, on business and welcome cards, gift bags and on the in-room guest directory. A statue of a griffin is also located in the entrance of the hotel. He provides pictures from 2013 demonstrating such use. These show use of:

- The composite mark on a TV screen;
- A statue of a griffin in the main lobby;
- A pin on a uniform in the shape of the contested mark;
- The composite mark on a pen
- A griffin device embossed on a guest directory;
- The mark shown at paragraph 10 above on welcome and business cards.

14. Mr Bowery claims that there are 2 million UK members of the Marriott Rewards program and that the contested mark is used in the material sent to them. Exhibit SB4 consists of various sample materials. The composite mark appears (together with 9 other marks) in a list of the proprietor's marks on the 'Contact Information' pages of this material.

15. Ms Ufi Ibrahim states that the British Hospitality Association ("BHA") represents various sections of the hospitality industry, including hotels and restaurants. Her evidence is that:

- She is aware through her involvement with BHA that the contested mark was used during the relevant periods as a symbol for the JW MARRIOTT brand at the Grosvenor House hotel in London;

[4] See exhibit SB3, page 38.

- She has been aware of the contested mark for 5 years and regards it as a very distinctive mark.

The hearing

16. A hearing took place on 8th July 2016. Mr Christopher Hall appeared as counsel for the proprietor, instructed by D Young & Co LLP. Mr Michael Hicks appeared as counsel for the applicant, instructed by Shakespeare Martineau LLP.

Decision

The law

17. Section 46 of the Act states that:

> "(1) The registration of a trade mark may be revoked on any of the following grounds-
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> >
> > (c).....
> >
> > (d).....
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) -

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or
(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

18. Section 100 is also relevant, which reads:

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

19. In the light of s.46(3) of the Act, I will first examine the application for revocation under s.46(1)(b). The relevant period is 2nd September 2010 to 1st September 2015.

20. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*[5], Arnold J. summarised the case law on genuine use of trade marks. He said:

> "I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:
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> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
>
> (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
>
> (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as

[5] [2016] EWHC 52

a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

21. Counsel for the applicant submitted that the proprietor's evidence was vague and lacking in specifics. He drew my attention to my own criticisms of the proprietor's evidence in *J and J Crombie Ltd v Nutter (Holdings) Ltd,* which were upheld by Asplin J. on appeal[6]. According to Mr Hicks, it would have been easy for the proprietor to have provided more compelling evidence of genuine use of the contested mark as a trade mark and it should suffer the consequences of failing to do so.

22. On behalf of the proprietor, Mr Hall pointed out that the applicant had filed no evidence of its own and had not asked to cross examine the proprietor's witnesses. Consequently, it was not now in a position to challenge the truth of their evidence.

23. Mr Hall is correct. However, the burden of proof falls on the proprietor. Therefore, the question is not whether the proprietor's witnesses are telling the truth, but whether what they say and exhibit is sufficient to show that the contested mark was put to genuine use in the relevant period. This is the matter to which I now turn.

Use of the registered mark alone

24. There is next to no evidence of use of the registered mark by itself. The closest the proprietor's evidence comes to this is the use of a statue of a griffin in the main lobby of the Grosvenor House hotel, use of a silver pin in the shape of a griffin on a staff uniform, and use of a griffin embossed on a guest directory.

25. The applicant says that (a) none of these uses are uses of the mark as registered, (b) at least in the case of the statue, the use is decorative and not trade mark use, and (c) in any event, there is no particularisation as to the extent of the use of the pin or the mark on the guest directory, and no evidence as to the length of the use of the statue in the lobby of the hotel.

[6] See [2013] EWHC 3459

26. Points (a) and (c) are correct. Point (b) also has merit if the use of the statue is considered in isolation from the other uses of a griffin device shown in the proprietor's evidence. I therefore find that the evidence of use of a griffin alone is not sufficient to constitute genuine use of the contested mark during the relevant period.

Does use of the griffin device as part of the composite mark count?

27. There is no dispute as to the relevant law on this point, which is set out in the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co*[7]. The court said that:

> "32. …..as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, 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.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.
>
> 34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

[7] Case C-12/12

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, 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 at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

28. However, the parties disagree about whether the use of the griffin device indicates the trade origin of the services when it is used as part of the composite mark. Mr Hicks submitted that relevant average consumers would perceive the composite mark as a combination of the griffin device and the word and letters JW MARRIOTT. Consequently, they would not perceive the griffin device as a trade mark in its own right. In support of this submission he pointed out that there was no evidence showing the proprietor had identified the griffin device (alone) as a trade mark in its marketing material. Mr Hicks likened the mark at issue to the one considered by Mr Geoffrey Hobbs QC as the Appointed Person in *Mary Quant Cosmetic Japan Ltd v Able C&C Co Ltd*[8]. The mark considered in the appeal before Mr Hobbs was registered like this:

and used like this.

[8] BL O/246/08

29. Mr Hobbs found that the composite mark was *"….likely to be seen and remembered as the word mark MISSHA integrated with an element of visual embroidery linked to the concept of fragrancy".* Consequently, he upheld the Hearing Officer's decision at first instance that use of the composite mark did not constitute use of the registered mark, or an acceptable variant of the mark under s.46(2) of the Act.

30. Counsel for the proprietor pointed out that (a) the *Mary Quant* case was decided prior to the guidance of the CJEU in *Colloseum,* and (b) the mark used in the former case was an integrated word and device, whereas the composite mark in this case consisted of two independent and physically unconnected elements.

31. I agree that point (b) is an important distinction from the mark in *Mary Quant*. I am less taken with point (a). Indeed, I note that Mr Hobbs accepted that *"…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 he pointed out that that the relevant question was "*whether the* [registered] *trade mark….performs an independent distinctive role* [in the composite mark].

32. In *Specsavers v Asda Stores Ltd*[9] the Court of Appeal found that the use of this mark:

counted as use of this registered mark.

[9] [2014] EWCA Civ 1294

33. It is true that this was an exceptional case. Kitchen L.J. noted *that "…in general, it is unlikely that the background of a mark will be perceived by the average consumer as an indication of origin".* However, the case shows that there is nothing radical about the proposition that use of a word mark with a device mark may qualify as use of both marks.

34. I see little merit in Mr Hicks point about the lack of any express identification of the griffin device as a [separate] trade mark of the proprietor. There is no requirement for such identification and, in general, consumers pay little attention to markings such as "tm". Whether something is perceived as a trade mark depends far more on the context in which it appears and the purpose it seems to serve. The proprietor's composite mark is plainly a trade mark. It serves no other purpose. Therefore, neither does the griffin device.

35. In deciding whether the griffin device is perceived as an indicator of the origin of the services at issue, I take into account the judgment of CJEU in *Bimbo SA v OHIM*[10], where, in a different context, the court stated that:

> "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. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle* v *OHIM* EU:C:2011:73, paragraph 36).
>
> 25 None the less, 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

[10] Case C-591/12 P

separately (see, to that effect, order in Case C-23/09 P *ecoblue* v *OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker* v *Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle* v *OHIM* EU:C:2011:73, paragraphs 36 and 37)."

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 s.46(1) of the Act.

37. The composite mark appears to have been used on the proprietor's websites from around mid-2014. Prior to that the proprietor appears to have used a version of the mark where the griffin device appears in white on a black background. This is also how the mark appeared in 2013 on in-room TV screens at the Grosvenor House hotel, and on welcome and business cards used in the hotel. Mr Hicks called this "reversed out" use. I find that the use of the composite mark (with the griffin device in black) on the proprietor's websites between mid-2014 and 1st September 2015 is sufficient, without more, to constitute genuine use of the contested mark during the relevant period. However, in case I am wrong about this I will also consider whether the use of the so-called "reversed out" mark on the website, and uses of the griffin mark inside the Grosvenor House hotel, also qualify as genuine use of the contested mark in the earlier part of the relevant 5 year period.

Does "reversed out" use also count?

38. Counsel for the applicant submitted that such use does not count as use of the registered mark, or as an acceptable variant of the mark under s.46(2). Mr Hicks made three points in support of this submission. Firstly, in *Pico Food GmbH v*

OHIM[11] the General Court rejected the argument that registration of a trade mark in black and white covers all colour combinations *"which are enclosed within the graphic representation"*. Secondly, that in *Mary Quant,* Mr Hobbs QC as the Appointed Person rejected a submission that registration in black and white was *"in all respects equivalent to registration in every possible colour and combination of colours".* Thirdly, the Common Communication issued by the EU IPO and a number of national offices (including the UK) on 15th April 2014 states that use in (other) colours of a mark registered in black and white only counts as qualifying use of the registered mark if, inter alia, *"the contrast of shades is respected".*

39. Counsel for the proprietor relied on the judgments of the Court of Appeal in *Phones 4U Ltd v Phone4u.co.uk Internet Ltd*[12] and the judgment of the CJEU in *Specsavers*[13] as support for the submission that registration of a mark in black and white covers use of the mark in any colour. In any event, Mr Hall submitted that the 'reversed out' version of the proprietor's mark did respect the contrast of shades in the registered mark.

40. The UK courts have traditionally regarded the registration of a trade mark in black and white as covering use of the mark in any colour (and vice versa). The correctness of that approach was the subject of a reference to the CJEU in *Specsavers v Asda Stores Ltd*[14]*.* Kitchen L.J. provided the CJEU with his provisional view[15], which was that *"a mark registered in black and white is, as this court explained in Phones 4u, registered in respect of all colours"*. He also gave his reasons for this view, which were, in essence, that:

> "In the case of a mark which has in fact been registered in black and white, its distinctiveness has been accepted in respect of every colour and the issue is a rather different one, namely whether, through use, it has gained enhanced distinctiveness as a whole or in one or more of its components. I see no reason why those components should not include colour. Nor do I

[11] Case T-623/11
[12] [2006] EWCA Civ 244
[13] Case C-252/12
[14] [2012] EWCA Civ 24
[15] See paragraph 96 of the judgment of the Court of Appeal in *Specsavers* [2012] EWCA Civ 24

think this creates any practical problems because third parties must consider whether a mark has acquired enhanced distinctiveness through use in any event."

41. The CJEU's answer was:

"Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision."

42. The Court of Appeal in *Specsavers* took this answer as confirming the correctness of Kitchen L.J.'s provisional view[16].

43. Prior to the CJEU's judgment in *Specsavers,* the General Court appears to have taken a similar position on marks registered in black and white.[17]. However, following *Specsavers* the General Court appears to have modified its view. As counsel for the applicant pointed out, in *Pico Food GmbH v OHIM*[18] the second chamber of the General Court stated that:

"The judgment of 18 June 2009 in Case T-418/07 *LIBRO* v *OHIM — Causley (LiBRO)*, not published in the ECR, which the applicant refers to in the reply and in which it is stated that '[the protection of an] earlier mark [which] does not designate any specific colour … also extends to combinations of colours' (paragraph 65), may be interpreted as meaning that if a Community trade mark is not registered in a specific colour, the proprietor of the mark may use it in a colour or a combination of colours and obtain for it, as the case may be,

[16] See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294
[17] See *Libro v OHIM,* Case T-418/07, a judgment of the 8th chamber of the court, at paragraph 65.
[18] Case T-623/11

> protection under the relevant applicable provisions, in particular if that colour or combination of colours has become, in the mind of a significant portion of the public, that associated with that earlier mark through the use which its proprietor has made of it (see, to that effect, *Specsavers International Healthcare and Others*, cited at paragraph 38 above, paragraph 41). That does not, however, mean, contrary to what the applicant maintains in its written pleadings, that the registration of a mark which does not designate any specific colour covers 'all colour combinations which are enclosed within the graphic representation'. (emphasis added)

44. I confess it is not entirely clear to me what this means. It could mean that colour can only be taken into account where the colour in which the registered mark has been used becomes associated in the public's mind with the registered mark. If that is what the court meant, one wonders why it included the words *"in particular"*, which suggest that colour might be relevant in some other (unspecified) circumstances. In any event, the judgment was clearly directed at the circumstances in which the proprietor of a mark registered in black and white can ask for the colour in which the registered mark has been used to be taken into account in the assessment of the likelihood of confusion with the mark of a third party. The court was not considering the related question of whether the registration of a mark in black and white could be sustained by the proprietor's own use of the same mark, but in (a different) colour.

45. The matter came up again before the Court of Appeal in *J.W. Spear & Sons Ltd v Zynga, Inc.*[19] In reliance on the CJEU's judgment in *Specsavers,* the appellant in that case argued that the trial judge should have taken into account matter extraneous to the registered trade mark in assessing the likelihood of confusion between the appellant's registered mark and the respondent's mark. Floyd L.J. rejected this argument in the following terms:

> "47 I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in *Specsavers* was the colour in which a mark registered in black and

[19] [2015] EWCA Civ 290

white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the [CJEU] speaks of colour as affecting *"how the average consumer of the goods at issue perceives* that trade mark *"* and in [38] of *"the use which has been made of it* [i.e. the trade mark] *in that colour or combination of colours"* . By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used *"in association with the mark"*. Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."

46. It is clear that the Court of Appeal regarded the CJEU's judgment in *Specsavers* as accepting that colours are an implicit component of a trade mark registered in black and white, and not something extraneous to the registered mark. On that view of the matter the CJEU's judgment in *Specsavers* served the limited purpose of setting out the circumstances in which use of the registered trade mark in a particular colour could be accepted as increasing the likelihood of confusion with a third party mark used in the same or similar colour. Thus the Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers,* that registration of a trade mark in black and white covers use of the mark in colour. If that is so it must follow that use of a mark in colour(s) qualifies as genuine use of the same mark registered in black and white, provided that colour is used in a conventional way and therefore represents a normal and fair use of the registered mark.

47. The relevant part of the Common Communication states that:

"For the purposes of **USE**, a change only in colour **does not alter the distinctive character of the trade mark** as long as:

- The **word/figurative elements coincide** and are the **main distinctive elements**.
- The **contrast of shades is respected**.

- Colour or combination of colours does **not have distinctive character in itself**.
- Colour is **not one of the main contributors to the overall distinctiveness** of the mark.

This goes in line with the MAD case (Judgment of 24/05/2012, T-152/11, `MAD´, paras. 41, 45), where the Court considers that use of a mark in a different form is acceptable, as long as the arrangement of the verbal/figurative elements stays the same, the word/figurative elements coincide, are the main distinctive elements and the contrast of shades is respected."

48. I note that the authors of Kerly's Law of Trade Marks and Trade Names (15th Ed.) are critical of this Common Communication. The relevant part of Kerly's states:

"**Marks registered in black and white but used in colour**

S8-082a - Marks registered in black and white but used in colour
Following the CJEU ruling in Specsavers v Asda (C252/12), OHIM announced a new **common** practice for trade marks registered in black and white (**Common Communication** on the **Common** Practice of the Scope of Protection of Black and White Marks, April 15, 2014). This **common** practice has been adopted by the IP offices of all Member States except for Italy, France and Finland (which did not participate) and Sweden, Denmark and Norway, which opted out). This **common** practice is said to affect issues of priority, relative grounds and genuine use, but not, apparently use for the purposes of acquired distinctiveness. So far as the UK is concerned, it is said only to apply to marks applied for after the implementation date namely July 15, 2014 and to proceedings filed after that date. Previously, marks registered in black and white were treated as registered for all colours. Under the new practice, such marks will now be treated much more literally as registered in the black and white form shown. It is questionable whether this new practice is consistent with the CJEU ruling in Specsavers. It is also questionable as to

whether the CJEU ruling required a change in practice at all. As far as we can see, this **common** practice will just create an unnecessary mess. We also question whether it is legitimate because many black and white marks were applied for and maintained for many years on the basis of the long-standing understanding that black and white marks covered all colours.

S8-082b

This statement of practice does not bind tribunals and courts, which is just as well because it may well produce incorrect results (cf. the facts in Specsavers, where the overlapping ovals were used in green). This new practice means that owners of new marks can no longer depend on black and white registrations covering uses in colour, or that their use in colour will constitute genuine use of a new registration in black and white. Thus the prudent course now will be to register marks in colour and in black and white, and to ensure use in both forms."

49. As the UK is a party to the Common Communication it is necessary to take it into account and apply it in a way that is consistent with the case law. Adopting this approach I find that use of the "reversed out" version of the registered mark does respect the contrast of shades in the registered mark. This is because the reversal of the colours black and white maintains the contrast between the colour used for the griffin compared to the colour used for the background. To put it another way, whether the griffin is white or black affects the colour used, but not the contrast between the griffin and the background. Consequently, applying the Common Communication consistently with the case law, I find that use of the "reversed out" version of the contested mark also counts as genuine use of the trade mark as registered. If I am wrong about that, I find that it counts as use of an acceptable variant of the registered mark under s.46(2) of the Act. This is because the distinctive character of the 'reversed out' mark is manifestly the same as the mark as registered.

50. I should add that if I had been unable to apply the Common Communication in a way that is compatible with the case law, I would have been required to follow the

case law. This is because (a) the Common Communication is not legally binding on this tribunal, (b) the case law of the Court of Appeal represents that court's interpretation of the CJEU's judgment in *Specsavers,* which is binding on this tribunal, and(c) neither the judgment of the General Court in *Pico Food,* nor in the *MAD* case mentioned in the Common Communication itself, compel me to apply *Specsavers* in a different way, at least so far as the question of genuine use is concerned.

51. Finally, I do not regard the decision of Mr Hobbs QC in *Mary Quant* as providing any support for the applicant's case. This is because (a) the decision pre-dates *Specsavers,* and (b) although it is true that Mr Hobbs rejected the opponent's submission that registration in black and white was *"in all respects equivalent to registration in every possible colour and combination of colours"* he went on to explain that this was because *"The true position is that registration in black-and-white provides protection unrelated to colour".* Although that statement now has to be qualified in the light of the various judgments in *Specsavers,* I respectfully agree with it. However, whether it is still right or not does not matter for present purposes, because it is of no assistance to this applicant.

52. Therefore, the evidence of "reversed out" use of the contested mark can also be taken into account. Further, in the context of the use of the contested mark on the proprietor's website, I find that all the uses of the mark, and 3 dimensional representations of it, inside the Grosvenor House hotel can also be taken into account in my assessment of whether the contested mark has been put to genuine use. Although such uses do not add much to the internet use, I accept Mr Hall's submission that, in context, they will have served to reinforce the trade mark significance of the griffin device to users of the hotel's services.

53. Taking all of this into account, I am satisfied that the proprietor made genuine use of the contested mark during the relevant period.

The services for which genuine use of the mark has been shown

54. The contested mark has clearly been used in relation to *hotel services*, and I find accordingly. The parties disagree as to whether, if there is qualifying use, it extends to any other services.

55. The correct approach to this matter was set out by Kitchen L.J. in *Roger Maier and Another v ASOS*[20] like this:

> "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."

56. The contested mark was used prominently on the top of the proprietor's websites for the Grosvenor House hotel. Some of the web pages in evidence show that, on the same page or the following page of the same section, the proprietor advertised the availability of restaurants and a bar at the hotel, and space for meetings and events, including social events and weddings. 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, including the contested mark. I do not consider that this finding is undermined by the fact that the restaurants and bar 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 that is what has

[20] [2015] EWCA Civ 220, at paragraph 64 of the judgment

occurred 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.

57. The proprietor has not provided any evidence as to the take-up of these services. However, I am prepared to infer that there would have been some sales of the advertised services at a hotel of the scale and stature of the Grosvenor House hotel, during the relevant 5 year period.

58. I find that the contested mark was put to genuine use in relation to the services mentioned in paragraph 56 during the relevant period. I therefore turn to the question of an appropriate specification which fairly reflects the use shown. In my judgment, this following specification fairly reflects the established use.

> 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.

59. I have excluded *provision of general purpose facilities for exhibitions* because there is no use of the mark in relation to these services.

60. I have excluded *reservation services for hotel accommodations* because there is no use of the mark in relation to these services. Although the proprietor provides a hotel room booking facility on its websites, this is no more than use of the mark in relation to the sale of its own hotel services. The proprietor has not shown any use of the mark in relation to any services which could fairly be described as reservation services.

61. I have excluded the services in class 36 because, although there is evidence that the proprietor provides some of these services, there is no evidence that it does so under the contested mark.

62. I have excluded *services for providing food and drink; catering, temporary accommodations; resort and lodging services* because although there is use of the

mark in relation to sub-categories of these services, there is no use in relation to other sub-categories, such as take-away food services, food delivery catering services, guest house services, or holiday park services. Further, the sub-categories of services for which use of the mark has been shown are included in the list in paragraph 58.

Outcome

63. The application for revocation under s.46(1)(b) succeeds, except in relation to the services listed in paragraph 65.

64. It follows that the application for revocation under s.46(1)(a) fails in relation to the services listed in paragraph 65.

65. The application for revocation under s.46(1)(a) succeeds to the same extent as the application under s.46(1)(b). This means that the contested mark will remain registered for:

> Class 43
> 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.

66. The registration of the contested mark will be revoked for the other services for which it is registered with effect from 1st May 2015.

Costs

67. Both sides have achieved a roughly equal measure of success. I therefore direct that each side should bear its own costs

Dated this 10TH day of August 2016

Allan James
For the Registrar