

**O-596-16**

**TRADE MARKS ACT 1994**

IN THE MATTER OF APPLICATION NOS 2581087, 2581082 AND 2581975  
IN THE NAME OF CROWN MELBOURNE LIMITED

AND

OPPOSITION THERETO UNDER NOS 102651, 102654 AND 102700  
(CONSOLIDATED)  
BY SIX CONTINENTS HOTELS INC

## Background

1. This decision relates to three applications for registration each of which stands in the name of Crown Melbourne Limited (“the applicant”). They are:

i: **Application No 2581087** for the mark **CROWN CASINO** which has a filing date of 11 May 2011 and was published on 12 August 2011. It seeks registration in respect of the following services:

### Class 36

Sponsorship of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions.

### Class 41

Gambling and casino services; amusement services; entertainment services, including cinemas, theatres, night clubs, casinos; provision of entertainment and recreation facilities, providing facilities for and arranging and conducting conferences, congresses and seminars, presentation of live performances and health club services; organisation of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions; provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services; organisation of, and provision of entertainment and educational information relating to, the aforesaid services over a global computer network; none of the aforesaid services including online gambling or online casino services.

### Class 43

Hotels, hotel reservations, hotel services, rental of temporary accommodation, accommodation reservations and accommodation bureaux; provision of food and drink; cocktail lounge services; bars; cafes; snack bars; self-service restaurants and restaurant services; catering services; hospitality services; providing facilities for exhibitions.

ii: **Application No 2581082** for the mark **CROWN** which also has a filing date of 11 May 2011 and was published on 12 August 2011. It seeks registration for an identically worded specification of services as that set out above.

iii: **Application No 2581975** for a series of two marks **CROWN ASPINALLS** and **CROWN ASPINALL'S** which has a filing date of 19 May 2011 and was published on 26 August 2011. It seeks registration for the following services:


#### Class 41


Gambling and casino services; amusement services; entertainment services, including cinemas, theatres, night clubs, casinos; provision of entertainment and recreation facilities, providing facilities for and arranging and conducting conferences, congresses and seminars, presentation of live performances and health club services; sponsorship and organisation of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions; provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services; organisation of, and provision of entertainment and educational information relating to, the aforesaid services over a global computer network; none of the aforesaid services including online gambling or online casino services.

#### Class 43

Hotels, hotel reservations, hotel services, rental of temporary accommodation, accommodation reservations and accommodation bureaux; provision of food and drink; cocktail lounge services; bars; cafes; snack bars; self-service restaurants and restaurant services; catering services; hospitality services; providing facilities for exhibitions.

2. Six Continents Hotels, Inc (“the opponent”) filed notices of opposition against each of the applications. In each case the oppositions are based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and the opponent relies on the following:

Earlier right	Dates	Services relied upon
<p><b>EUTM 1017946</b>  <b>CROWNE PLAZA</b>  Under sections 5(2)(b) and 5(3) of the Act</p>	<p><b>Filing date:</b>  16 December 1998  <b>Seniority date:</b>  18 April 1994  <b>Date of entry in register:</b>  17 December 2002</p>	<p>Hotel services, motel services, provision of accommodation, hotel reservation services, bar services; cafe services, restaurant and catering services, provision of food and drink for hotel guests.</p>
<p><b>EUTM 9500885</b></p>  <p>Under sections 5(2)(b) and 5(3) of the Act</p>	<p><b>Filing date:</b>  5 November 2010    <b>Date of entry in register:</b>  17 March 2011</p>	<p>Hotel services, motel services, provision of accommodation; temporary accommodation services; reservation services for hotel accommodation and for other accommodation; holiday information and planning relating to accommodation; bar services, cocktail lounge and nightclub services; café services, restaurant and snack bar services; catering services for the provision of food and drink; provision of conference, meeting and exhibition facilities; hotel check-in and check-out services; electronic information services relating to hotels; advisory and consultancy services relating to the aforesaid.</p>

<p><b>CROWNE PLAZA</b> Under section 5(4)(a) of the Act</p>	<p>Said to have been used UK wide since at least 1987</p>	<p>Used claimed in respect of: Hotel services, motel services, provision of accommodation; temporary accommodation services; reservation services for hotel accommodation and for other accommodation; holiday information and planning relating to accommodation; bar services, cocktail lounge and nightclub services; café services, restaurant and snack bar services; catering services for the provision of food and drink; provision of conference, meeting and exhibition facilities; hotel check-in and check-out services; electronic information services relating to hotels; advisory and consultancy services relating to the aforesaid; provision of food and drink for hotel guests.</p>
<p> <b>CROWNE PLAZA</b> HOTELS &amp; RESORTS Under section 5(4)(a) of the Act</p>	<p>Said to have been used UK wide since at least 1993</p>	<p>Use claimed in respect of: As above</p>

3. The applicant filed counterstatements in which it puts the opponent to proof of its use of EUTM 1017946 in respect of all services for which it is registered and, in essence, denies each of the claims made though does accept that some of the respective services “have aspects of similarity”. All proceedings were consolidated. Both parties filed evidence with the opponent also filing written submissions. The matter came before me for a hearing. For completeness, I mention here that the opponent requested postponement of the hearing for some four months to allow for its preferred representative to attend. Such a delay was considered excessive, the parties did not agree any other acceptable alternative date and the request was refused. That decision was not appealed. The hearing therefore went ahead as originally set down with the applicant represented by Ms Amanda Michaels of Counsel instructed by Simmons & Simmons LLP, its professional representatives in these proceedings. The opponent did not attend and was not represented nor did it file written submissions in lieu of attendance.

#### **The evidence and submissions**

4. The following was filed:

##### Opponent's evidence in chief

Written submissions dated 14 November 2014;

Further written submissions dated 14 November 2014 with Annexes 1-4, Annex 1 being a witness statement of Tamilyn Collie dated 31 October 2014 with Exhibits A-F. Ms Collie is the Global Intellectual Property Manager for the InterContinental Hotels Group of companies (“IHG”) of which the opponent is a member;

Witness statement of David Alexander Kemp dated 14 November 2014 with Exhibits DAK1-3 which duplicate Annexes 2-4 of the written submissions referred to above. Mr Kemp is a trade mark attorney with Bristows LLP, the opponent's professional representatives in these proceedings.

### Applicant's evidence

Witness statement of Patrick Henry Hayward dated 12 March 2015 with Exhibits PPH1-5. Mr Hayward is in the employ of PHH Casino Consultants, which he established in 2007;

Witness statement of Michael Ross Branson dated 16 March 2015 with Exhibits MRB1-25. Mr Branson is Chief Operating Officer at Aspinall's Club Ltd;

Witness statement of David Angus Stone of Simmons & Simmons LLP dated 16 March 2015 with Exhibits DAS1-5;

Witness statement of Melvin Jeffrey Gold dated 13 March 2015 with Exhibits MJG1-8. Mr Gold is the Managing Director of Melvin Gold Consulting Ltd which is a hotel consultancy business;

Witness statement of Daniel Graham Carr dated 13 March 2015. Mr Carr works as a dealer inspector for Aspinall's Club Limited;

Witness statement of Nicola Jessica Cattle dated 10 March 2015. Ms Cattle works as a receptionist for Aspinall's Club Limited;

Witness statement of Kevin James Batten dated 10 March 2015. Mr Batten works as the Money Laundering Reporting Officer and Security & Services Manager for Aspinall's Club Limited;

Witness statement of Steven Michael Green dated 10 March 2015. Mr Green works as an assistant Casino Manager for Aspinall's Club Limited;

Witness statement of Paul Anthony Manning dated 10 March 2015. Mr Manning works as a head doorman for Aspinall's Club Limited.

### Opponent's evidence in reply

Witness statement of Paul Jordan of Bristows LLP dated 29 March 2016 with Exhibits PJ01-17.

5. I do not propose to summarise the evidence here but confirm that I have reviewed all of it and will refer to it as necessary in this decision. In doing so, I bear in mind that some of Mr Branson's evidence has been made the subject of an order for confidentiality that it not be open to the public.

## **Decision**

6. The oppositions under sections 5(2)(b) and 5(3) are based on two trade marks each of which, as can be seen from the respective dates set out above, is an earlier mark within the meaning of section 6 of the Act. EUTM 1017946 was entered in the register more than five years before the publication dates of the applications. In its counterstatement the applicant put the opponent to proof of use of this earlier EUTM. Section 6A of the Act is therefore applicable and states:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) 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

(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

7. Section 100 of the Act is also relevant and states:

“100. 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.”

8. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, 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 Bunderversammlung Kameradschaft '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:

(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 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].”

9. The period within which use must be shown is dependent on the date of publication of the application being opposed. In these proceedings, the three applications being opposed were not published on the same dates. Bearing this in mind, the relevant periods are: 13 August 2006 to 12 August 2011 (2581087 and 2581082) and 27 August 2006 to 26 August 2011 (2581975). These periods substantially overlap.

10. The earlier mark for which proof of use must be shown is a European Union Trade Mark. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the

national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

11. As indicated above, in its counterstatement, the applicant put the opponent to proof of use of EUTM 1017946 in respect of all services for which it is registered. In its skeleton argument, the applicant makes a number of criticisms of the evidence filed by the opponent but, nevertheless, states that it:

“is prepared to concede that there has been genuine use of the earlier word mark in relation to hotel services during the relevant period. It also accepts that hotel services would usually include the provision of food and drink for hotel guests. The Applicant does not concede that use has been proved for the rest of the Class 42 specification.”

12. In her witness statement, filed on behalf of the opponent, Ms Collie states that the first Crowne Plaza hotel in Europe opened in Madeira in 1999. She states that in 2009 there was an “expansion” into Portugal and France though no specific details of this expansion are provided. She states that “today” (her witness statement is dated October 2014) there are 82 such hotels in twenty four named European countries and she provides annual revenue figures for most of these countries. As the applicant submits, not all of the listed countries are members of the EU. Revenue figures (in US \$m) are given for each of the years 2001 to 2013 as follows:

	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	2011	2012	2013
<b>Austria</b>	17.6	18.8	20.8	20.2	20.1	21.8	8.4	6.8	6.3	7.3	7.3	7.4	7.3
<b>Belarus</b>	0	0	0	0	0	0	0	1.8	3.9	5.4	5.5	6.6	7.2
<b>Benelux</b>	100.3	96.7	89.5	100.5	92.9	86.4	87.7	87.7	69.0	79.4	87.0	91.7	97.5
<b>Cyprus</b>	2.6	3.3	3.0	2.8	3.4	3.3	4.3	4.3	3.7	4.2	4.2	5.1	5.5
<b>Czech Republic</b>	6.5	5.9	5.6	7.4	6.4	5.7	8.1	8.1	5.8	5.8	6.5	4.0	3.3
<b>Denmark</b>	0	0	0	0	0	0	0	0	1.9	7.8	10.6	11.9	12.9
<b>Finland</b>	0	0	0	0	9.1	12.1	13.1	12.6	9.7	10.7	11.6	12.7	11.9
<b>France</b>	31.8	33.6	33.4	36.2	35.0	33.8	34.2	36.3	34.2	34.1	37.9	38.2	38.1
<b>Germany</b>	72.1	65.7	61.8	63.5	66.9	72.1	68.2	55.3	49.0	53.3	54.1	57.4	54.9
<b>Greece</b>	6.5	7.7	6.5	7.5	5.2	5.3	5.7	3.9	6.1	5.8	5.7	4.7	5.0
<b>Italy</b>	25.3	23.4	24.8	27.3	32.5	42.4	49.5	52.8	46.6	47.2	49.4	49.7	49.0
<b>Lithuania</b>	0	0	0.2	0.8	0.8	0.9	1.3	1.8	1.2	1.1	1.4	1.3	1.8
<b>Malta</b>	8.3	8.1	7.4	7.2	6.6	0.6	0	0	0	0	0	0	0
<b>Portugal</b>	7.1	8.1	8.2	7.5	7.3	7.6	0.4	0	0	0	6.7	9.5	10.0
<b>Romania</b>	6.5	7.1	8.4	10.2	10.3	11.2	10.2	6.5	3.6	3.1	3.7	3.5	3.5
<b>Russia</b>	0	0	0	0	0	0	7.6	33.9	21.8	24.1	33.1	50.1	54.2
<b>Slovak Republic</b>	0	0	0	0	4.0	10.8	13.3	12.2	8.8	8.3	7.9	7.7	7.8
<b>Spain</b>	12.5	12.6	11.2	10.4	10.5	3.5	3.6	2.5	1.8	1.6	2.9	3.7	1.8
<b>Switzerland</b>	29.3	52.0	49.5	57.1	68.5	27.1	51.3	52.6	41.2	47.0	31.0	27.1	25.9
<b>Turkey</b>	9.9	9.9	11.9	17.2	21.5	22.4	25.5	11.3	13.6	25.5	38.9	48.6	42.1
<b>United Kingdom</b>	134.1	137.7	146.2	147.0	169.9	194.0	207.8	229.9	221.3	232.0	243.1	249.6	247.6

These figures are not broken down in any way in terms of specific services.

13. Ms Collie gives figures for the “reported # of Guests at the European” hotels for the years 2010 to 2014. Most of these post-date the relevant periods, however, figures for 2010 total some 359,530 guests and for 2011 (some of which is likely to be within the relevant period) the figures total some 422,883. None of the figures specify how many of these guests stayed at hotels within the EU, the UK or other specific countries.

14. In relation to the UK and EU hotels, Ms Collie states that promotion and marketing of each of them is “uniquely tailored and is directed at domestic and international customers”. She gives no further details to explain this “unique tailoring”

but states that marketing materials include “promotional leaflets and brochures, event flyers, menus, in-room notepads, in-room television guides, local information brochures and complimentary gifts such as pens, stationery, calendars, food and snacks and notepad holders”. She does not provide any details of what may have been distributed to the relevant consumer at any particular point in time or how, where or to whom they may have been distributed. Clearly some of the materials to which she refers would only be available to people already staying at or using the facilities of one or other of the hotels. That said, Ms Collie does state that the hotels and brand are promoted electronically and, at Exhibit B (pages 123 to 141), she provides “a selection of marketing materials showing the promotion of the CROWNE PLAZA brand in the UK and other European countries”. Pages 123 and 124 are taken from the ihg.com website, refer only to US hotels and bear a download date of 9 September 2014 which again is after the relevant periods. Pages 125 to 133 are internet printouts taken from the ihg.com, cpbirminghamnechotel.co.uk, cplondoncityhotel.co.uk and cpleedshotel.co.uk websites which refer to hotels within the UK (Birmingham, London, Leeds and Manchester) and also bear download dates of 9 September 2014. Pages 134 to 139 refer to the Crowne Plaza hotel in Marlow and give details of various events, however, whilst the month and day of the event appear on the pages, no year is given, the pages are not otherwise dated and no information is given which shows where or when this information was displayed or who may have seen it. Page 140 appears to be a poster shown resting against a pillow and refers to a “dedicated sleep programme” being introduced at Crowne Plaza Hotels & Resorts but no indication is given as to which hotels (or in which countries) the programme was introduced, there is nothing to show where the advertisement appeared or who may have seen it and the page is not dated. Page 141 is a printout from the lux-hotels.com website, was downloaded from the lux-hotels.com website on 9/11/2014 and refers to the Crowne Plaza hotel in Istanbul which is outside the EU.

15. Approximate figures for advertising and promotional spend (said to be in US \$) relating to the Crowne Plaza brand in the UK are given as follows:

2009	2010	2011	2012	2013
25,005	361,908	44,092	109,382	31,042

Again, some of this expenditure post-dates the relevant periods and there is no indication of how, specifically, this money was spent.

16. Ms Collie states that “customers visiting the Crowne Plaza brand websites originating from users located in the European Union” number around 8 to 11 million annually between 2008 and 2014 though she does not give any information about these websites. She also refers to a presence on social media such as Facebook, Twitter, Weibo (which I am aware is a Chinese microblogging site) and Pinterest. What she does not do is give any information which indicates that these sites were in use within the relevant period nor what was shown on them and she gives details of the number of “fans” and “likes” only from September 2014 which is after the relevant periods.

17. Ms Collie states that the hotels are also promoted by third parties in the UK and throughout Europe by “a number of high-profile partners” said to include a holiday company and major airlines. Printouts from the website of expedia.com, orbitz.com, priceline.com, tripadvisor.com and travelocity.com are shown at Exhibit C (pages 145 to 238, although some of the pages are blank). With the exception of the pages downloaded from the tripadvisor site (pages 209 to 224), they appear to show booking facilities for various Crowne Plaza hotels in the UK, Rome, Ireland and the Netherlands. All of the prices are given in US\$ which suggests they are not UK or European websites and all have download dates of September 2014. The pages from the tripadvisor site provide reviews for hotels in Edinburgh and Denmark. Some of those posting reviews are indicated as being located in towns or cities in the UK. The reviews show posting dates of up to “two weeks ago”; the text elsewhere on the pages show some hotels were last reviewed in September 2014 and all these pages show download dates of 9/9/2014.

18. Ms Collie states that the hotels are often the subject of media articles and, at Exhibit D, she includes a selection of such articles. The vast majority of the 66



pages are dated before or after the relevant periods or refer to hotels or the business in the US or outside the EU. Many refer to hotels which are not branded under the trade marks relied on by the opponent in these proceedings (e.g. Holiday Inn, InterContinental). That said, page 283 is an article from *Business Traveller* dated 12 September 2007 which informs of the renovation of the reception area of the Crowne Plaza London Heathrow hotel and at pages 288 and 295 are articles from *Treehugger* dated 15 April 2010 and *The Guardian* dated 14 April 2010 which refer to the Crowne Plaza Copenhagen Towers hotel and its efforts to increase energy efficiency by offering a free meal to guests who generate sufficient energy by riding a bike in the hotel gym. The latter article refers to there being 21 Crowne Plaza hotels in the UK at that time. At page 298 is an article from *Bighospitality* dated 12 April 2011. It refers to the planned opening of a third party's Indian restaurant in the Crowne Plaza Heathrow hotel at some unspecified future date under the name Eriki. At page 301, is an article from *mailonline* dated 21 July 2011 which refers to six Crowne Plaza hotels in Britain "waging war on snoring guests". At page 304 is an article from *Spabusiness.com* reporting the opening of a new *Refettorio* restaurant in the Crowne Plaza London hotel.

19. Ms Collie gives details of a number of awards which have been won by various Crowne Plaza hotels though again, the vast majority are from outside the relevant periods or appear to be "internal" awards from the parent company. Those from within the relevant periods and which appear to be independently awarded are:

Crowne Plaza Copenhagen Towers awarded the "Greenest Hotel Award" in 2010 by Skal, said to be an international tourist organisation;

Crowne Plaza Glasgow named "Glasgow Hotel of the Year" and "Scottish Conference Hotel of the Year" in 2007 at the 4<sup>th</sup> Annual Scottish Hotels of the Year awards;

Crowne Plaza Helsinki chosen as "Finland's Best Hotel" at the 2009 World Travel Awards;

Crowne Plaza Leeds named "Best Hotel" by Leeds City Council in 2011;

Crowne Plaza Northwood (Ireland) awarded the AA's "Business Hotel of the Year" in 2006 and its "4 star award" in 2011.

20. In its written observations dated 14 November 2014, the opponent submits that Ms Collie's evidence shows genuine use of the mark in respect of *hotel services, motel services, provision of accommodation, hotel reservation services*. In respect of the remaining services, it itemises specific pages within the evidence to support its submission that genuine use of the mark has been made of each of them. Only one of these pages dates from within the relevant periods. That is page 298 of Exhibit D which, as set out above, refers to the planned opening of a restaurant under a third party mark at some unspecified future date.

21. For the reasons set out, briefly, above, the opponent's evidence is not well marshalled in terms of either the relevant periods within which use must be shown, the relevant geographical markets or the individual services for which the mark is registered, however, considering it as a whole, I am satisfied that genuine use of the earlier EUTM has been made. In determining what constitutes a fair specification for the use made, I note that in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

22. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be

adopted is, in essence, a relatively simple one. 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.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

23. The evidence shows the opponent to have operated a number of hotels under the Crowne Plaza mark both in the UK and in other major EU countries during the relevant periods. Ms Michaels criticised the opponent’s evidence submitting in her skeleton argument that “There is (for example) no evidence of the provision of restaurant services other than within the hotels, no evidence of income from provision of restaurant services, no evidence at all of use for motels, and no

evidence of provision of hotel reservation services” but accepted that “hotel services would usually include the provision of food and drink for hotel guests”. Her criticism of the opponent’s evidence is not without merit. Much of the evidence refers to the provision of rooms for hotel stays with some referring to the availability of breakfast at extra cost with most prices being shown in \$US though the evidence shows some of these hotels to be located in the UK and, to a much lesser extent, in some other EU countries. There is no evidence that the opponent has operated any motels at any time or that it has provided any other services other than as part and parcel of its hotel services. That being so, I consider a fair specification which the average consumer would use to describe the use made of the mark, and the specification that it may rely on, is: *Hotel services; provision of food and drink for hotel guests.*

### **The objections under section 5(2)(b) of the Act**

24. Section 5(2)(b) of the Act states:

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

(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”.

25. In considering whether there is a likelihood of confusion, I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

## **The principles**

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of services

26. The services to be compared are as follows:

<b>Opponent's services</b>	<b>Applicant's services</b>
<b>EUTM 1017946 (following proof of use)</b>  <b>Class 42</b> Hotel services; provision of food and drink for hotel guests.	<b>2581087 and 2581082</b>  <b>Class 36</b> Sponsorship of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions  <b>Class 41</b> Gambling and casino services; amusement services; entertainment services, including cinemas, theatres, night clubs, casinos; provision of entertainment and recreation facilities, providing facilities for and arranging and conducting conferences, congresses and seminars, presentation of live performances and health club services; organisation of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions; provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services; organisation of, and provision of

	<p>entertainment and educational information relating to, the aforesaid services over a global computer network; none of the aforesaid services including online gambling or online casino services</p> <p><b>Class 43</b> Hotels, hotel reservations, hotel services, rental of temporary accommodation, accommodation reservations and accommodation bureaux; provision of food and drink; cocktail lounge services; bars; cafes; snack bars; self-service restaurants and restaurant services; catering services; hospitality services; providing facilities for exhibitions.</p>
<p><b>EUTM 9500885</b></p> <p><b>Class 43</b> Hotel services, motel services, provision of accommodation; temporary accommodation services; reservation services for hotel accommodation and for other accommodation; holiday information and planning relating to accommodation; bar services, cocktail lounge and nightclub services; café services, restaurant and snack bar services; catering services for the provision of food and drink; provision of conference, meeting and exhibition facilities; hotel check-in and check-out services; electronic information services relating to hotels; advisory and consultancy services relating to the aforesaid.</p>	<p><b>2581975</b></p> <p><b>Class 41</b> Gambling and casino services; amusement services; entertainment services, including cinemas, theatres, night clubs, casinos; provision of entertainment and recreation facilities, providing facilities for and arranging and conducting conferences, congresses and seminars, presentation of live performances and health club services; sponsorship and organisation of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions; provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services; organisation of, and provision of entertainment and educational information relating to, the aforesaid services over a global computer network; none of the aforesaid services including online gambling or online casino services.</p> <p><b>Class 43</b> Hotels, hotel reservations, hotel services, rental of temporary accommodation, accommodation reservations and accommodation bureaux; provision of food and drink; cocktail lounge services; bars; cafes; snack bars; self-service restaurants and restaurant services; catering services; hospitality services; providing facilities for exhibitions.</p>



27. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated, at paragraph 23:

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

28. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) considered when goods can be considered identical and stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Clearly, the same, by analogy, is true in respect of services.

30. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

31. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

32. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

34. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

35. I note in passing that the earlier marks relied on by the opponent are registered in different classes despite them both including some identical services. The differing class numbers are due to changes made to the Nice Classification which took effect between the application dates of the two earlier trade marks. Nothing hangs on this difference.

36. As Ms Michaels stated in her skeleton argument, it is not always clear on what basis the opponent alleges that each of its services are similar to those of the applicant. Both parties have referred me to previous decisions issued by both the UK and EUIPO offices. I am not aware of how and on what evidence these particular decisions may have been reached but, whatever the findings in those cases, I have to consider the matter from the perspective of the average consumer in the UK taking into account the evidence in front of me and will therefore make my own comparison. I intend to consider each of the services in turn.

### **The applicant's services in class 36**

37. Whilst, in its notices of opposition, the opponent directed its objections to each of the applicant's claimed services, in its written submissions it makes no specific mention of the applicant's sponsorship services in class 36 (2581087 and 2581082). In the absence of any specific submissions from the opponent or an indication that it is no longer pursuing the opposition in relation to these services but for the avoidance of doubt and taking the above case law into account, I can find no meaningful way in which the applicant's sponsorship services in this class are similar to the services on which the opponent is entitled to rely.

38. Application 2581975 also includes “sponsorship of entertainment services including art exhibitions, sport, music, cultural and recreational events and

competitions” albeit on this occasion they are included within its specification in class 41.

39. For the reasons I have already given, I do not consider these sponsorship services are similar to any of the services on which the opponent is entitled to rely.

#### **The applicant’s services in class 41**

40. In making the comparison, I take into account that the applicant’s services are subject to a limitation that none of them include online gambling or online casino services.

41. In relation to the applicant’s *gambling and casino services* and *casinos* the opponent submits:

“There are many internationally famous resorts, including those of the Opponent, in which casinos...are an integral part of hotels presented to consumers under the same brand”.

42. The opponent has filed some evidence showing what are described as “resorts” but these appear to be located in the US and other, non-EU, countries and so do not assist in establishing what the position might be in the UK.

43. *Gambling and casino services* are licensed services which provide the user with the opportunity to undertake risk-based gaming. I compare them, first, with the opponent’s *hotel services* and its various *accommodation services*. The term *hotel services* is a broad one but included within it is the provision of (temporary) accommodation, whether [a suite of] rooms hired by a business wishing to hold e.g. a meeting, conference or other events, or rooms hired by a member of the general public to enable him to e.g. hold a social or family event or have a place to stay whilst away from home.

44. In his evidence filed on behalf of the opponent, Paul Jordan refers to what he calls “Brand extension in the Hotel Sector”. He gives examples of “hotels who offer

more than just a room for the night” and comments on the position in Australia, Malaysia, Cape Town and Las Vegas. Whilst I accept that *Hotel services* may include more than accommodation in the strict sense and I further accept that there may be a few hotels in the EU/UK whose services go much wider and may incorporate other facilities, there is nothing in the opponent’s evidence to suggest that any of its hotels in the EU/UK incorporate a casino or provide other gambling services nor has it filed evidence which shows that the relevant consumer would expect hotels or accommodation providers in the EU/UK to do so either, in the normal course of business. I consider that the users and uses of the respective services are different, the channels of trade differ and they are not complementary services. In my view, they are dissimilar services. I find support for this in the evidence filed by Mr Hayward, on behalf of the applicant. Mr Hayward states that he has worked in the casino industry for nearly forty years, was a council member of the British Casino Association for twenty years, has acted as an expert witness before both Magistrates’ and Crown Courts in licensing matters and has provided expert evidence in criminal proceedings relating to gambling matters. Mr Hayward gives very detailed evidence about the licensing and operation of casinos. He states that in May 2011, there were 26 casinos operating in London and 121 regional casinos operating outside the capital. He goes on to state:

“I am only aware of seven out of the hundreds of hotels in London which have an operating casino attached to them; the Ritz (the Ritz Club), the May Fair Hotel (the Palm Beach), the Hilton Hotel (the Park Lane Hilton Casino), the Royal Garden Hotel (the Connoisseur Club, which closed in 2013), the Park Tower Knightsbridge Hotel (which prior to 2013 was the Sheraton Park Tower), (the Park Tower Casino); the Millenium Gloucester Hotel (the G Casino); and the St Giles Hotel (the Grosvenor St Giles Casino). The Ritz operates at the upper end and the Gloucester and St Giles at the lower end with the rest in the middle.

With the exception of The Ritz, all of the London casinos in hotels are operated by separate entities to the operators of the hotels. Indeed, to my knowledge apart from The Ritz there is not a single casino in the UK that is

owned and operated by an entity that also owns and operates the hotel in which it is located (and there was not in May 2011)...

Outside London, almost all casinos attract their customers from the surrounding locality. Accordingly, the vast majority of consumers do not need to stay in hotels to access a casino, as they live locally...Of the 149 casinos in the UK in May 2011, I would estimate that no more than seven or eight are in or part of a hotel outside of London.”

45. I move on to the comparison between the applicant’s *gambling and casino services, casinos* and the opponent’s *bar services, cocktail lounge, café services, restaurant and snack bar services and catering services for the provision of food and drink* (EUTM9500885) and *provision of food and drink for hotel guests* (EUTM1017946). The opponent’s services are each for the provision of food and drink and thus the users, uses and nature of each of the respective services are different. There is no dispute that casinos and other gambling establishments may offer drinks or catering, however, the fact that these services are sometimes provided together does not make them similar. The overlap in trade channels does not change my view that the core meaning of the services are different or that the respective services are offered by different types of undertakings exploiting different types of know-how and experience i.e. a gaming provider on the one hand and a caterer on the other. Neither do I consider that one is indispensable for the use of the other. I consider each of these respective services to be dissimilar. If I am wrong in my findings, then any similarity between each of the respective services is of a low level.

46. The opponent also submits there is similarity between the applicant’s *gambling and casino services, casinos* and its *nightclub services* (EUTM 9500885). Whilst each of these services could be said to offer their respective users a form of recreational activity, the core meaning of them differ as do the nature of the services and their users. In terms of the channels of trade, I note that in his evidence, Mr Hayward gives a single example of one club in the UK, the Playboy Club, which, he states: “was developed to include a nightclub on the ground floor (below the casino, which is located on the first floor)” but there is no evidence from either party to show

that providers of gambling and casino services also typically offer nightclub services or vice versa. I consider each of these respective services to be dissimilar. If I am wrong in my findings, then any similarity between each of the respective services is of a low level.

47. I find there is no similarity between the applicant's *gambling and casino services, casinos* and the remaining services of the opponent. In all cases the users, uses and channels of trade differ and there is no complementary relationship between them.

48. I go on to consider the applicant's *amusement services and entertainment services, including cinemas, theatres, nightclubs; provision of entertainment and recreation facilities; presentation of live performances; organisation of entertainment services including art exhibitions, sport, music, cultural and recreational events and competitions*. I compare them, first, with the opponent's *hotel services* (both EUTMs), *provision of accommodation, hotel reservation services, motel services, temporary accommodation services, reservation services for hotel accommodation and for other accommodation and holiday information and planning relating to accommodation* (EUTM 9500885). The core meaning of each of the opponent's services is to provide (the reservation of) accommodation. This differs from the core meaning of the services of the applicant which are services for amusement and entertainment. The respective services have different users and uses. That said, whilst not every hotel will provide such services, I am aware that some hotels and other temporary accommodation providers such as holiday parks will sometimes offer on-site entertainment facilities including e.g. a cinema or will hold special events such as "murder mystery" evenings or offer themed stays devoted to e.g. music of a certain decade or season of the year, for all of which live performances may be a feature. Whilst I consider the respective services to be dissimilar, if I am wrong then any similarity is one of a low level.

49. I go on to compare the applicant's *amusement and entertainment services* as set out above with the opponent's *bar services, cocktail lounge and nightclub services, café services, restaurant and snack bar services; catering services for the provision of food and drink* (EUTM9500885) and *provision of food and drink for hotel guests* (EUTM 1017946). Each of the opponent's services are for the provision of food and



drink either in general or in the specific types of venues named. I do not consider that the average consumer would refer to having a meal or a drink as an “amusement” or “entertainment” service, even though that might be how they chose to spend their leisure time. I acknowledge that some amusement and entertainment venues and nightclubs may sometimes also provide food or drink and that on this basis there may be a slight overlap in trade channels though I do not consider that one is indispensable for the use of the other. Again, I consider these respective services to be dissimilar but if I am wrong in this, then any similarity is of a low level.

50. I find the applicant’s *providing facilities for and arranging and conducting conferences, congresses and seminars* in class 41 to be similar to at least a reasonable degree to the opponent’s *provision of conference, meeting and exhibition facilities* in Class 43 (EUTM 9500885) given the overlap in users and trade channels and their complementary nature.

51. I can find no similarity between the applicant’s *amusement and entertainment services* as set out above, and the remainder of the opponent’s services. In all cases the users, uses and channels of trade differ and there is no complementary relationship between them.

52. The applications also seek registration for *health club services*. I accept that the evidence shows that some (generally larger) hotels offer a gym or health club facilities, however the evidence also shows that this is far from common across the market as a whole. I do not consider that the core meaning of *hotel services* will include *health club services*, however, if I am found to be wrong then any similarity between the respective services is one of a low level.

53. The applicant’s remaining services are the *provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services* and *organisation of, and provision of entertainment and educational information relating to, the aforesaid services over a global computer network*. The applicant submits there is no similarity between these services and any of those of the opponent. I do not consider that a provider of a particular service will invariably or even generally supply education and publication services relating to them and, in the

absence of any specific submissions from the opponent or evidence on the point in relation to the particular services involved here, I find these are dissimilar services.

### **The applicant's services in class 43**

54. I consider that each of the applicant's services in this class is identical to those in the opponent's earlier marks, either on the basis that identical terms are used (e.g. *hotel services*) or on the basis that they are included within more general terms or are different ways of saying the same thing (e.g. *restaurant services* as opposed to *self-service restaurants* or *provision of conference, meeting and exhibition facilities* as opposed to *providing facilities for exhibitions*).

### **Average consumer and the nature of the purchasing process**

55. The opponent has not made any submissions as regards the average consumer but, in its skeleton argument, the applicant submits:

“The average consumer for all of the services in both sides' specifications is an average member of the public who is reasonably well informed and reasonably observant and circumspect. The average consumer of hotel services and bar/restaurant services in hotels, and for the Applicant's other services will be a member of the public (including businessmen) although there may also be some professional booking agents for hotel bookings. The services are unlikely to be selected with the highest degree of care and attention, but a reasonable level of care and attention will nevertheless be deployed, especially in the choice of a hotel. Hotel services are especially likely to be chosen after perusal of the hotel or third party website... This suggests the mark will have more visual than aural significance.”

56. I agree that for most of the respective services the average consumer will be a member of the general public or a business person. For other services, such as providing facilities etc. for exhibitions and conferences, the average consumer is more likely to be a business. Each of the services is likely to be selected with at least a reasonable degree of care. Whilst I do not exclude the aural consideration given,


for example, there may be some degree of personal recommendation, I consider the visual aspects to be primary significance not least for the reasons given by the applicant.

**Comparison of marks**

57. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

58. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they convey. For ease of reference the respective marks to be compared are:

Opponent’s earlier marks	Applicant’s marks
CROWNE PLAZA	CROWN CASINO
 <p><b>CROWNE PLAZA</b> HOTELS &amp; RESORTS</p>	CROWN
	CROWN ASPINALLS CROWN ASPINALL’S

59. The opponent submits that the respective marks are “visually highly similar and conceptually and phonetically identical.” It goes on to submit:

“The predominant elements of the CROWNE PLAZA Marks is the sign CROWNE. The predominant element of the Application Marks is the sign CROWN. These elements differ by only one letter, the “E” in CROWNE being silent when pronounced. The words “crown” and “crowne” are interchangeable and linguistically identical, “crowne” being an obsolete spelling of “crown”. Therefore, these elements are visually highly similar, given the inclusion of CROWNE and CROWN in the CROWNE PLAZA Marks and the Application Marks, and conceptually and phonetically identical conveying the identical message, namely the image of regal headwear and crowns. Indeed, two signs are to be considered conceptually similar or identical if they share the same word or expression.


The CROWN elements are positioned at the beginning of the Application Marks, so it would be the first part of the Applications Marks seen and read by customers in the UK, who generally read from left to right. The CROWN element of the Application Marks are wholly contained within the CROWNE PLAZA Marks and are situated at the beginning of the marks giving it considerable prominence and ensuring consumers will refer to CROWN when considering or referring to the Application Marks or the CROWNE PLAZA Marks.

The Application Mark CROWN is for the word alone and so is the dominant and distinctive component of this mark, and is highly similar to the CROWNE PLAZA Marks. Moreover, the descriptive term CASINO in the CROWN CASINO Application Mark renders CROWN as the dominant and distinctive component of the Application Mark which is highly similar to CROWNE in the CROWNE PLAZA Marks.

Insofar as the CROWN ASPINALLS/CROWN ASPINALL’S Application Mark the dominant and distinctive component is CROWN. The

ASPINALLS/ASPINALL'S element does not distinguish itself from the CROWNE PLAZA Marks as CROWN dominates this Application Mark.

The inclusion of PLAZA in the CROWNE PLAZA Marks does not detract from the dominance of CROWNE and at the very least renders the marks highly similar to the Application Marks. The CROWNE PLAZA Marks are highly distinctive for the services for which they are registered. On this basis, the Application Marks will serve to designate the same source of commercial origin as the CROWNE PLAZA Marks or assume a likelihood of association with the Opponent on the part of the public.

As regards the second of the CROWNE PLAZA Marks  the inclusion of PLAZA, the device element and the terms HOTELS & RESORTS which are positioned less prominently do not detract from the dominance of CROWNE and at the very least renders the mark highly similar to the

Application Marks. The mark  is highly distinctive for the services for which it is registered.

On this basis, the Application Marks will serve to designate the same source of commercial origin as the as the (sic) CROWN PLAZA Marks or assume a likelihood of association on the part of the public.

As stated in CJEU case law, the consumer does not have the ability to compare the marks side by side but must instead place his trust in the imperfect picture of them he has kept in his mind. The overall impression retained of the Application Marks and the CROWNE PLAZA Marks in the consumer's mind will be the words incorporated within each mark, in particular the CROWNE/CROWN elements. As a result, the Application Marks and the CROWNE PLAZA Marks should be considered highly similar and will be considered so in the minds of consumers."

60. The applicant claims that the above submissions are:

“plainly misconceived [because]:

- a) They are based on the unsustainable contention that the predominant element of all five marks is Crowne/Crown, and
- b) Stating that the marks are all visually *highly* similar invites the Hearing Officer completely to ignore
  - i. The additional words in each mark (save for Application 2581082); and
  - ii. The device elements of the earlier device mark.
- c) The same point can be made as to the Opponent’s argument ... that all the marks “sound virtually identical” when spoken.
- d) In order to make the submission that there is conceptual and phonetic identity, the Opponent invites the Hearing Officer completely to ignore
  - i. The word Plaza in both of the earlier marks;
  - ii. The additional words in the Opponent’s device marks; and
  - iii. The additional words Casino/Aspinalls in two of the Applicant’s marks.  
It is obviously nonsense to say that the word PLAZA sounds like CASINO or ASPINALLS. And none of them sounds anything like CROWN/ CROWNE.
- e) The submission that two signs are to be considered *conceptually* similar or identical because they share the same word is wrong as a matter of law. Additional material in a mark may lead to a conceptual difference, precluding not just conceptual identity but even similarity...

All these submissions ignore the requirement to assess the similarity of mark to sign on a case by case basis and taking into account the marks *as a whole*...

[T]he Applicant submits that CROWNE and PLAZA are of equal significance in the Opponent’s marks, and neither amounts to a single dominant feature. That is how they appear and that is how they have been used, consistently, by the Opponent and by third parties. Mr Gold’s evidence...shows that neither word is especially distinctive (even the additional “e” in “Crowne” is not original/unique) so that the distinctiveness of the earlier word mark lies in the combination of the

words, and in the case of the device mark, the combination of those words with the device.

As for the Applicant's marks, a similar point may be made about CROWN CASINO –the distinctiveness of this mark lies in the combination of the words. As to CROWN ASPINALLS, the dominant part of the mark is plainly ASPINALLS, as a very unusual and distinctive name, and certainly a far more unusual/distinctive name than Crown.

The proper analysis, it is submitted, is that there is some level of similarity between the Opponent's marks and the Applicant's marks, because of the use of "Crowne" as part of the former, and the phonetically identical "Crown" as part of the latter. However:

- a) CROWN is very different from CROWNE PLAZA.
- b) (if relevant at all) CROWN is not the same as CROWNE but the added 'e' is of significance both visually and conceptually.
- c) CROWN differs from both earlier marks because the important word PLAZA is not present, nor are any of the device elements of the device mark. It is similar to both earlier marks, but to a moderate degree, at most.
- d) CROWN CASINO differs from both earlier marks because the important word PLAZA is not present, nor any of the device elements of the device mark, and it is further differentiated by the addition of the word CASINO, which adds a conceptual distinction against the word mark, and more strongly still as against the device mark because of its reference to "Hotels & Resorts".

"Casino" is of course a descriptive term, but there are no casino services within the Opponent's specifications, and the CROWN CASINO application extends beyond the Class 41 casino services too, such that the term may be seen as distinctive in relation to many of the services applied for.

The Applicant accepts that CROWN CASINO is similar to both earlier marks, but to a low degree, at most.

- e) CROWN ASPINALLS differs from both earlier marks because the important word PLAZA is not present, nor any of the device elements of

the device mark, but is further differentiated by the addition of the word Aspinalls, which (especially as the dominant feature of the mark) adds a substantial conceptual distinction. It is similar to both earlier marks, but to a minimal degree only.”

61. The opponent’s earlier EUTM 1017946 consists of the two words CROWNE and PLAZA in plain block capitals. Neither word is highlighted in any way. There is no dispute that the word CROWNE is an obsolete spelling of CROWN. The word PLAZA is from the Spanish language but it is a word which has been adopted into the English language and will be well understood as meaning an open square or a group of buildings which share common areas (see e.g. collinsdictionary.com). In my view, the two words hang together to form a unit (a point to which I will return below). This is the overall impression the trade mark conveys and it is in the combination that the distinctiveness lies.

62. The opponent’s EUTM 9500885 is made up of a number of elements. The words CROWNE PLAZA, again in plain block capitals, are placed centrally within the mark with an underlining extending from the letter R to the letter Z. Positioned centrally above these words and extending from the letter W to the letter L is an oval-shaped device. It consists of what appears to me to be a stylised fluttering flag on a dark oval background, the whole placed within an oval border. Below the underlining are the words HOTELS & RESORTS, again in plain block capitals but in much smaller font. The words HOTELS & RESORTS are clearly descriptive of the services and, if they are noticed at all, will not be accorded any trade mark significance. Both the words CROWNE PLAZA and the device are distinctive elements within the mark, however, whilst the device will not be overlooked, it is the words CROWNE PLAZA as a unit that is the dominant element, not least because of their position and size within the mark.

63. Application 2581082 consists of the single word CROWN in plain block capitals. Its distinctiveness rests in its whole. Comparing this mark with EUTM1017946 (the words CROWNE PLAZA), the presence of the word/letters CROWN as the only or first five letters within the marks leads to some visual similarity. The presence of the letter E (which will not be overlooked) and word PLAZA within the opponent’s mark,



which are absent from the applicant's mark, mean there are also clear visual differences between them. I consider the marks to be visually similar to a medium degree. On an aural comparison, the letter E at the end of the word CROWNE being silent, the difference rests in the absence/presence of the word PLAZA. I consider the marks to be aurally similar to a medium degree. The opponent submits that the two marks are conceptually identical but, as the applicant points out, this ignores the presence in the opponent's mark of the word PLAZA. The word CROWN is an ordinary dictionary word which has connotations of royalty. Whilst CROWNE is an obsolete spelling of the word crown, the presence and positioning of the word PLAZA within the mark is most likely to bring to mind a place or location of that nature such that the two words making up the mark will form a unit and be seen as a location called Crowne Plaza. I consider the marks to be conceptually dissimilar.

64. Turning to the comparison with EUTM 9500885, this is made up of a number of elements. The device element does nothing to distinguish the respective marks to the ear to any greater extent than set out above. The words Hotels & Resorts are purely descriptive non-trade mark additions with the respective marks conceptually dissimilar for the reasons given above. The dominant element remains the words CROWNE PLAZA though the respective marks are, as wholes, less similar from a visual consideration than that set out above.

65. Application 2581087 consists of the words CROWN CASINO. The word CASINO has an obvious meaning and is not distinctive for services involving gambling and casinos. In such cases, the distinctiveness of the mark will rest in the word CROWN. For other services, such as health club services, the word CASINO has no meaning and the distinctiveness of the mark will rest in the combination. Like the opponent's EUTM 1017946, it is made up of two words. The first words differ only by the final letter E in the opponent's mark (which will not be overlooked) which means there is some visual similarity between the marks. The second words in each mark are wholly different which means there are also clear visual differences between them. I consider the respective marks to be visually similar to a low degree. The same is true on an aural comparison. The mark applied for brings to mind a casino with royal connections which is dissimilar to the geographical location brought to mind by the opponent's EUTM.

66. Turning to the comparison of application 2581087 with EUTM 9500885, for similar reasons I find there is some, but a lower, degree of visual similarity between the marks, a low degree of aural similarity and that they are conceptually dissimilar.

67. Application 2581975 is a series of two marks consisting of the two words CROWN and ASPINALLS/ASPINALL'S. The letter S added to the end of the first mark in the series is likely to be taken either as a plural or, as will be the case with the apostrophe and letter S in the second mark in the series, the possessive version of the surname Aspinall, a surname which, in my experience, is a relatively uncommon one. For this reason, it has more dominance in the mark than the word CROWN. Again, the point of similarity with both of the earlier marks comes from the inclusion in each of them of the letters CROWN as or within their first words differing only by the final letter E in the opponent's mark which means there is some visual similarity between the respective marks. The second words in each mark are wholly different which means there are also clear visual differences between them. EUTM 9500885 is less visually similar due to the additional elements within it but I consider each of the earlier marks to be visually similar to a low degree with the applicant's series of two marks. The same is true on an aural comparison. Whilst each of the respective marks contain the word CROWN/CROWNE, the second word in each mark is entirely different. Again, the earlier marks bring to mind a geographical location whilst the applicant's marks do not. The marks are conceptually dissimilar.

### **Distinctiveness of the earlier marks**

68. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

69. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

70. Although the evidence does not show how many guests stayed in any specific hotel or in any specific EU country in any particular period, there is no dispute that the opponent has operated hotels under the earlier marks in a number of EU countries including the UK. The evidence gives annual revenue figures for the UK and other countries in the millions of dollars (hundreds of millions in the case of the UK) but these are not broken down in any way to show the services provided. In his evidence on behalf of the applicant, evidence which has not been challenged by the opponent, Mr Gold states that as of 31 December 2010 there were 22 Crowne Plaza hotels in the UK which gave it around 0.67% of all hotel rooms in the UK at that time. Mr Gold also refers to Ms Collie’s evidence that as of 2014 the opponent had just over 19,000 hotel rooms in Europe which, he says, equates to less than 0.32% of market share within the EU at that time, given that some of the European hotel rooms referred to were outside the EU. I acknowledge that this is after the relevant dates, however, there is nothing to indicate the position was materially different at any earlier date and I note that according to the revenue figures provided by Ms Collie, revenue had reduced significantly in many EU countries at the relevant dates in these proceedings. Whilst advertising expenditure in the UK is given for the years 2009-2011 (some of which is likely to be outside the relevant periods) the figures are not particularly significant and the evidence of actual advertising and promotion, in terms of what was distributed at any particular time, how and to whom, is lacking. The evidence filed by the opponent, again largely post-dating the relevant dates and

in the form of pages downloaded from the internet, does refer to some its hotels around the world and gives some very brief indication that some of them have other facilities on site such as a bar or gym but is largely silent as regards the other specific services for which the earlier marks are registered both in terms of how many hotels (and where they are located) have such facilities and in terms of e.g. the turnover from such services. Taking all things into consideration, whilst the distinctiveness of the marks is likely to have been enhanced through their use in the UK, the evidence does not show that their distinctiveness has been enhanced to any material extent. The earlier marks are endowed with an average degree of inherent distinctive character.

### **Likelihood of confusion**

71. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

72. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

73. In *Annco, Inc. V OHIM*, Case T-385/09, the GC considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public’s level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue.”

74. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser

degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them (s)he has retained in mind.

75. Earlier in this decision I found:

- The applicant's *sponsorship services* to be dissimilar to any of the opponent's services;
- The applicant's *provision of education and training relating to the aforesaid services; publication services relating to the aforesaid services; organisation of, and provision of entertainment and educational information relating to, the aforesaid services over a global computer network* to be dissimilar to any of the opponent's services.

76. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

77. For the services set out above for which I have found there to be no similarity, there is therefore no likelihood of confusion and the opposition based on section 5(2)(b) of the Act fails in respect of such services.

78. In relation to the applicant's remaining services, I found some to be identical to the opponent's services, some to be similar to a reasonable degree and others I found to be dissimilar but indicated that if I was wrong in my assessment, then any similarity was one of a low level.

79. I found that each of the earlier marks is of average distinctive character which has not been shown to have been enhanced to any material extent through their use.

80. As regards the applicant's mark CROWN, and taking into account the lesser degree of visual similarity from a visual consideration in relation to EUTM 9500885, I found it to be similar to both of the earlier marks to a medium degree in terms of the visual and aural comparison but conceptually dissimilar.

81. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

82. As regards the applicant's mark CROWN CASINO, and again taking into account the lesser degree of visual similarity with EUTM 9500885, I found it to be of low similarity from the visual and aural considerations and conceptually dissimilar to the opponent's earlier marks. The applicant's marks CROWN ASPINALLS/CROWN ASPINALL'S I also found to be visually and aurally similar to a low degree and conceptually dissimilar to the opponent's earlier marks.

83. In *CARDINAL PLACE* O-339-04, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person considered the likelihood or otherwise of confusion between marks consisting of the words CARDINAL and CARDINAL PLACE and determined that there was no likelihood of confusion. He acknowledged the commonality of the word CARDINAL in each mark but determined that the differing conceptual images brought to mind by the marks (ecclesiastical v locational) far outweighed the visual and aural similarities. In



my view, that is the case here and, taking all matters into account including the imperfect picture, I find that there is no likelihood of either direct or indirect confusion between the respective marks even where identical services are involved.

### **The objection under section 5(3) of the Act**

84. Section 5(3) states:

“(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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

85. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

86. In my consideration above, of the evidence filed by the opponent, I found that whilst the evidence showed it to have made genuine use of its earlier mark that use did not show that the distinctiveness of the marks had been enhanced. The evidence I have summarised shows use of both earlier marks relied upon and the criticisms I made in relation to the one mark apply equally to the other mark relied upon. In my view, the evidence filed by the opponent does not show that it has the necessary reputation in the UK as required under this ground. There is, for example, no evidence from the relevant public. The turnover figures for the UK are not insignificant, however, no evidence is given of how many guests stayed at UK hotels at any given date, the advertising and promotional spend is modest at best and there is no evidence of what specific advertising may have taken place in the UK at or before the relevant date. Mr Gold's unchallenged evidence is that as of 31 December 2010, the opponent's 22 UK Crowne Plaza hotels accounted for less than 1% of all UK hotel rooms, a position which the opponent has not shown has increased to any material extent at any time since.

87. In the absence of evidence to show the necessary reputation, the objection under this ground fails.

### **The objection under section 5(4) of the Act**

88. Section 5(4)(a) states:

“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.”

89. Under this ground, the opponent relies on use of the sign CROWNE PLAZA in the UK since at least 1987 and use of a sign identical to EUTM 9500885 in the UK since at least 1993 with both said to have been used in relation to a range of services as set out in the table at paragraph 2 above. The opponent has not provided any specific evidence in relation to many of the claimed services, for example: *motel services, reservations services for hotel accommodation and for other accommodation, provision of conference, meeting and exhibition services, advisory and consultancy services relation to the aforesaid*. In respect of other services, whilst there is some evidence of use of the marks, that evidence is not well-directed to the dates of claimed use or actual services provided. In short, I do not consider, in view of the evidence filed, that the objections under this ground put the opponent in any better position than it is under section 5(2)(b) and I decline to deal with it further.

## **Summary**

90. The opponent has failed under each ground on which its oppositions were based.

## **Costs**

91. The applicant having succeeded is entitled to an award of costs in its favour. In her submissions at the hearing, Ms Michaels made it clear that whilst she could not:

“go as far as to say it should be costs off the scale...it should definitely be absolutely the top end of the scale. There is an awful lot of wasted time that has gone into this...They have put in all the rather hopeless evidence. We have had to deal with it at great length.”

92. Whilst these are consolidated proceedings, there is no doubt that the opponent put in a large volume of evidence, much of which was not well focussed or relevant to the issues to be determined but which would have taken quite some time to review. I take this into account. I also note that whilst two Case Management Conferences took place during the pendency of these proceedings, they were convened to discuss joint requests for stays of proceedings. Given this, I make no award of costs in respect of them.

93. I make the award on the following basis:

For reviewing the opponent’s notices of opposition and filing counterstatements:	3 x £200
For the preparation of evidence and reviewing that filed by the opponent:	£2000
Preparing for and attending the hearing:	£1000
<b>Total:</b>	<b>£3600</b>

94. I order Six Continents Hotel Inc to pay Crown Melbourne Limited the sum of £3600. In the absence of an appeal against this decision, this sum should be paid within fourteen days of the expiry of the period for appeal.

**Dated this 19<sup>th</sup> day of December 2016**



**Ann Corbett**  
**For the Registrar**  
**The Comptroller-General**