

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2018989
BY HILTON HERBS LTD TO REGISTER A MARK
IN CLASSES 5 AND 31**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO. 46854 BY HILTON INTERNATIONAL CO.**

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DECISION

On 28 April 1995 Hilton Herbs Ltd applied to register the following mark:-

The logo for Hilton Herbs features the words "Hilton Herbs" in a bold, serif font. The letter "H" is significantly larger and more ornate than the other letters. The word "Herbs" is positioned to the right of "Hilton". The letters "H" and "H" are decorated with intricate, dark floral and leaf patterns that appear to be part of the letters themselves.

The application is in respect of two classes of goods:-

Class 05

Veterinary preparations and substances; dietary supplements, nutritional supplements and vitamin preparations, all for animals; preparations for the destruction of animal parasites and mites; herbs; herbal remedies.

Class 31

Foodstuffs for animals; food supplements for animals; pet food.

The application is numbered 2018989.

On 16 May 1997 Hilton International Co. filed notice of opposition to the application. The grounds of opposition are in summary:-

- i) the opponent is the proprietor of the trade mark HILTON registered under

Nos. 1300389 and 1384342 in Class 42 and No. 1413731 in Class 41. Details of these marks are given at Annex A of this decision;

- 5 ii) use of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' trade mark and therefore registration would be contrary to the provisions of Section 5(3);
- 10 iii) the mark applied for is liable to be prevented by law, in particular the law of passing off, and therefore registration would be contrary to the provisions of Section 5(4)(a);
- 15 iv) the application was made in bad faith and therefore registration would be contrary to the provisions of Section 3(6);
- v) the mark is contrary to the provisions of Section 3(1)(a) and (b).

20 The applicants subsequently filed a counterstatement acknowledging that there are entries on the UK Trade Marks Register corresponding to the registration numbers referred to in the Notice of Opposition but denying all the other grounds of opposition. Both sides ask for an award of costs.

25 Both sides filed evidence in these proceedings. Neither side has asked for a hearing. Acting on the Registrar's behalf, and after a careful study of the papers filed in these proceedings, I now give the following decision.

Opponents' Evidence

30 The opponents' evidence comprises a Statutory Declaration dated 26 March 1998 by Iain Dixon Lindsay who is Deputy General Counsel and Assistant Secretary of Hilton International Co., a position he has held since 1996.

35 By way of background Mr Lindsay explains that his company was formed in 1949 as an international subsidiary of Hilton Hotels Corporation. In December 1964 his company was spun off as an independent publicly owned company. He says that the Agreement governing the spin-off gave Hilton Hotels Corporation the exclusive right to use the mark HILTON for hotels in the USA, and his company the exclusive right to control the use of the HILTON name throughout the rest of the world. In May 1967 his company was acquired by Transworld Airlines Inc. and became part of the Transworld Corporation Holding Company which was created in 1979. In April 1987 his company was acquired by Allegis Corporation but after only a matter of months Allegis decided to sell the company to Ladbroke Group PLC. Following this acquisition the HILTON name appeared in new locations throughout Britain.

45 Mr Lindsay states that in 1995 his company was the first hotel group to publish its Worldwide Directory on CD-ROM and since the beginning of 1996 reservations can be made directly through his company's site on the Internet. He goes on to say that his company is the only foreign hotel company with a worldwide representation to operate hotels in major cities in

Japan. Since the acquisition of his company by Ladbroke Group PLC hotel openings have included such locations as Edmonton (Canada), Margarita (Venezuela), Barcelona, Turkey, South Korea, Egypt, Cannes, Berlin, China, Glasgow etc.

5 Mr Lindsay states that representation at the world's major airports is a priority for his company and provides a list of their airport hotels. Also, he provides a list of hotels throughout the world being developed by his company, hotels in prime world resorts operated by his company, and 25 first-class UK hotels under the name Hilton National. At Exhibit "IDL-1" Mr Lindsay provides a copy of his company's Hilton United Kingdom Directory, at 10 Exhibit "IDL-2" a copy of his company's current International Directory listing approximately 163 hotels in approximately 50 countries, at "IDL-3" a copy of an extract from his company's current International Directory giving details of the locations of all the sales offices, and at "IDL-4" a copy of an extract from his company's current International Directory giving details of the Hilton Reservations Worldwide service.

15 The approximate UK sales turnover in the period 1992-97 is given as follows:-

Year	Revenue (approx.) £M
1992	183.1
1993	206.5
1994	226.8
1995	253.1
25 1996	281.3
1997	304.5

The company's worldwide turnover during the same period was as follows:-

Year	Revenue (approx.)
1992	US \$ 1,230,864,000
1993	US \$ 1,169,214,000
1994	US \$ 1,200,724,000
35 1995	US \$ 1,349,162,000
1996	US \$ 1,311,092,000
1997	US \$ 1,202,714,000

40 Mr Lindsay states that his company has actively and widely promoted the HILTON brand by means of advertisements in magazines, newspapers, periodicals and the like publications. An advertising campaign centred around the slogan "Take me to the Hilton" was employed worldwide. At "IDL-5" are copies of advertisements from UK newspapers and magazines which appeared between 1992-95. The approximate sums spent on promoting and advertising the HILTON brand in a variety of forms is given as follows:-

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Year	Advertising/Marketing Expenditure US \$ M
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5	1992	33.6
	1993	32.7
	1994	32.6
	1995	34.9
	1996	43.4
10	1997	44.4

Mr Lindsay provides at "IDL-6" a press release giving details of major awards won by his company, at "IDL-7" copies of reports commissioned over the years to assess the strength of the HILTON brand, and at "IDL-8" examples of the HILTON brand name appearing on hotel stationery, toiletry articles etc.

15 Mr Lindsay states that the trade mark HILTON is his company's most important asset and also forms part of its company name. At "IDL-9" he provides a schedule of all his company's trade mark registrations and applications for the mark HILTON and at "IDL-10", by way of example, copies of correspondence relating to proceedings taken against third parties filing applications to register trade marks consisting of or comprising the word HILTON. He goes on to say that his company has successfully enforced rights in its HILTON brand in a number of jurisdictions and at "IDL-11" are copies of correspondence relating to proceedings in Australia.

25 Finally, Mr Lindsay maintains that HILTON is his company's most valuable asset and his company has to be alert at all times to prevent erosion and deletion of this valuable asset. His company believes that the HILTON brand is one of the top ten internationally best known names, and, if the applicants are permitted to obtain a registration for HILTON HERBS in relation to equine and canine products, it is his belief that this would be detrimental to the distinctive character or repute of his company's HILTON trade mark resulting in unacceptable dilution and erosion.

35 The opponents' evidence also includes a statutory declaration dated 12 March 1998 by Inge Helga Rajeebally, who is the trade mark agent acting for the opponents. She refers to the evidence, in the form of a statutory declaration dated 11 November 1996 by Hilary Page Self, filed by the applicants during the examination procedure in support of their claim that their mark had become distinctive of their products by virtue of use. In paragraph 3 of the declaration reference is made to a total turnover of sales amounting to £1,460,939. Ms Rajeebally points out that 42% of this figure is attributed to sales in 1995 (£626,959) and the bulk of the 1995 figure relates to sales made after the date of filing the application in suit. The proviso of Section 3(1) of the Act clearly states that any use an applicant wishes to rely upon must have taken place before the date of application. Ms Rajeebally also points out that both the bulk of the 1995 advertising and marketing expenditure, and the reference to the Badminton Three Day Event post date the filing of application in suit. She claims that Exhibits HSP1, 2, and 3 of the declaration by Hilary Page Self do not illustrate use of the mark applied for.

Ms Rajebally provides at 'IHR-1' a copy of a booklet entitled "HILTON HERBS - a Completely Natural System for Today's Horses and Dogs" published by the applicants. This booklet describes the applicants' current product range which, in Ms Rajebally's view, does not appear to support the range of goods. She goes on to say the mark the subject of the opposition consists of the relatively common surname HILTON and the descriptive word HERBS with the two letters 'H' surrounded by foliage or stylised herbs which, in her view, add nothing to the overall distinctiveness of the mark. Ms Rajebally states that the Registrar's current practice on marks containing common surnames in the UK is to hold that these are "devoid of any distinctive character" and are therefore not acceptable for registration, prima facie, as a trade mark under Section 3(1)(b) of the Act. This prohibition on registration can be overcome if the applicants can demonstrate that the mark they are seeking to register has in fact acquired a distinctive character as a result of the use made of it before the date of application. Ms Rajebally submits that the evidence submitted by the applicants in support of their application is not sufficient to show that their mark has in fact acquired a distinctive character.

Applicants' Evidence

The applicants' evidence comprises two statutory declarations. The first statutory declaration is by Hilary Page Self dated 19 June 1998 who is a director of Hilton Herbs Limited. She makes the following comments on Mr Lindsay's statutory declaration:-

- a) Exhibits 'IDL 1' and 'IDL-2' were not copied to the applicants;
- b) there is no indication of the extent to which the publications containing HILTON advertisements are circulated in the UK and therefore the fact that advertisements have appeared in these publications does not establish that the trade mark is well-known in the United Kingdom;
- c) it is not clear whether the advertising expenditure are global figures or UK figures. If they are global figures, in Ms Self's point of view, they are meaningless in the absence of a UK breakdown. She also submits that the surveys referred to are irrelevant and often incomprehensible;
- d) the evidence of foreign proceedings is of no relevance in these proceedings; and
- e) there is no basis for the allegation that HILTON is one of the ten best-known marks in the world.

In response to the points raised in Ms Rajebally's statutory declaration Ms Self:

- a) provides revised 1995 (up to and including 28 April 1995) turnover and advertising expenditure figures;
- b) provides at Exhibit HPS1 invoices and documentation establishing that the 27 April 1995 issue of 'Horse and Hound' contained a full page advertisement for

the applicant and 13 April 1995 issue of 'Eventing' contained a half-page advertisement for the applicant;

- 5 c) maintains that the evidence of use filed shows extensive use of the trade mark HILTON HERBS both with and without the device which forms part of the application. She provides at Exhibit 'HPS2' documentation showing use of the mark applied for; and
- 10 d) has been advised that the goods that the applicants sell under the trade mark HILTON HERBS do support the specifications in Classes 5 and 31.

Ms Self goes on to make the following points:-

- 15 a) the applicants' mark has been in use on an extensive scale for roughly eight years and as far as she is aware no-one has even been confused into believing that the applicants' products are in any way associated with the Hilton Hotel Group;
- 20 b) at Exhibit 'HPS3' is a copy of the relevant page from the 1997 Central London residential telephone directory showing 30 entries for the name HILTON. Ms Self submits that, as a result of the surnominal significance of HILTON, confusion between HILTON trade marks is unlikely;
- 25 c) at Exhibit 'HPS4' is a copy of the relevant page from the 1995 London business directory and a copy of the relevant page from the 1997 Thompson Central London directory showing a number of businesses called HILTON and, in Ms Self's view, such frequent usage of the name HILTON will obviously lessen the likelihood of confusion;
- 30 d) at Exhibit 'HPS5' are print outs of trade marks featuring the word HILTON. Ms Self submits that there is nothing unusual about the fact that the opponents' trade mark HILTON co-exists with other HILTON marks. She maintains that it is fairly common for marks to co-exist in the name of different parties in respect of different goods and services without there being any confusion or dilution of the trade marks. At Exhibit 'HPS6' are print-outs of trade mark registrations for the marks RITZ and SHERATON. The RITZ hotel trade mark co-exists with registrations for cosmetics, furniture, cleaning cloths, foodstuffs and biscuits, and the SHERATON hotel trade mark co-exists with registrations for cleaning preparations, disinfectants, instructional materials,
- 35 furniture, clothing, fruit concentrates, cigarettes and building services.
- 40

The second statutory declaration submitted by the applicants is by Johannes Mulberg dated 24 June 1998 who is the trade mark attorney acting for the applicant. He states that he conducted an on-line search of the UK Companies Office database provided by Jordans Company Services and 662 registrations for companies containing the names HILTON or HILTONS were revealed.

45

Opponents' Evidence in Reply

This consists of a further statutory declaration dated 24 December 1998 by Inge Helga Rajeebally. I do not intend to summarise her evidence in any detail. Her statutory declaration attempts to clarify certain aspects of the earlier evidence submitted by the opponents, submits that some of the applicants' evidence which postdates the application should be disregarded, and questions the extent of both the applicants' sales figures and the use of the trade mark applied for.

That concludes my review of the evidence filed in these proceedings.

I will deal first with the grounds of opposition based on Section 3(1)(a) and (b) of the Act which read as follows:

3(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of Section 1(1),
- (b) trade marks which are devoid of any distinctive character,

Insofar as the objection based upon Section 3(1)(a) is concerned this refers back to Section 1(1) which states:

1. - (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

This defines the meaning of a trade mark. In this case the trade mark is a word which can, clearly be represented graphically and the opponents have offered no evidence as to why the mark cannot function as a trade mark i.e. distinguish the goods of one trader from those of another. The opposition under Section 3(1)(a) therefore fails.

I go on to consider the objection based upon Section 3(1)(b).

In considering an appeal against the Registrar's refusal to register the trade mark MISTER LONG (1998 RPC 401), Geoffrey Hobbs QC, acting as The Appointed Person, stated:

Section 1(1) of the Act (implementing Article 2 of the Directive) confirms that personal names are eligible to be regarded as signs capable of registration. Different persons having the same name nevertheless share the right to use it in accordance with honest practices in industrial or commercial matters under Section 11(1)(a) of the Act (which gives effect to Article 6(1)(a) of the Directive). And Section 3(1)(b) of the Act (which implements Article 3(1)(b) of the Directive) prohibits the registration of trade marks which are devoid of any distinctive character. These provisions indicate to my mind that surnames are neither automatically eligible nor

5 automatically ineligible for registration under the Act. In each case the question to
be determined is whether the surname put forward for registration possesses the
qualities identified in Section 1(1) of the Act and none of the defects identified in
Section 3. For the reasons I gave at greater length in AD2000 TM (1997) RPC 167 I
10 think that in order to be registrable a surname or any other sign must possess the
capacity to communicate the fact that the goods or services with reference to which it
is used recurrently by the applicant are those of one and the same undertaking. When
assessing that capacity at the relevant date (the date of application) it is, of course,
15 necessary to bear in mind that surnames, as such, are naturally adapted to identify all
individuals so named.”

In the light of this case it is now Registry practice not to accept words which are surnames for
registration prima facie unless having regard to:

- 15 a) the commonness of the surname;
b) the size of the market (in terms of the number of traders in it) in the goods or
services specified in the application;
c) the nature of the goods or services

20 - it is likely that the trade mark will be taken as a sign identifying goods or services
originating from a single source.

As a rule of thumb it is the Registry's practice to regard a surname as common if there are
more than 100 entries in the London telephone directory, but this rudimentary guide needs to
25 be tempered by a consideration of the goods at issue. In the applicants' evidence reference is
made to "over 30 entries" in the London telephone directory. However, I recognise that this
might well be an understatement as it refers to the Central London directory whereas it is
Registry practice to employ the Greater London telephone directory. The number of traders
in the goods in question is not huge. Also, the applicant's mark includes the word HERBS
30 and there is the addition of foliage interwoven between the initial letters of the two words.
Whilst I do not place too much weight on these additional features, they should not be
completely ignored. The overall effect is to emphasise the trade mark character of the totality
and to strengthen the applicants' case for having the mark applied for considered as not simply
the surname HILTON. I do not regard the surname HILTON as so common that the mark
35 would not be able to communicate the fact that the goods at issue were those of a single
undertaking. Consequently, taking all the above factors into account, I conclude the
opposition fails under Section 3(1)(b).

40 However, in the event I am found wrong on this point, I very briefly go to consider the
evidence submitted by the applicants in support of their application - the contention being that
the application should succeed under the proviso to Section 3 of the Act. The proviso is in the
following terms:-

45 A trade mark shall not be refused registration by virtue of paragraphs (b), (c) or (d)
above if, before the date of application for registration, it has in fact acquired a
distinctive character as a result of the use made of it.

This evidence was not re-submitted as part of these proceedings. However, the opponents' own evidence summarises the evidence in question and questions the weight to be attached to it rather than its admissibility. The applicants have filed further evidence as a result. Therefore, inasmuch as both sides have referred to this evidence, I intend to take it into account. Whilst there were a number of criticisms of the evidence expressed by the opponents, on the basis of the material made available to me I am satisfied that the applicant could have demonstrated that the mark had in fact acquired a distinctive character.

I turn next to consider the ground of opposition under Section 3(6), which reads:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

In their statement of grounds, the opponents claimed bad faith and this would appear to be on the basis that the application had been filed with the deliberate intention of exploiting the reputation enjoyed by opponents in their mark. However, I do not consider that any evidence has been filed by the opponents which supports such an allegation. I therefore find that the opposition based upon Section 3(6) of the Act fails.

I go on to consider the grounds of opposition under Section 5(3) which reads:-

5(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected.

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The term “earlier trade mark” is itself defined in Section 6(1) of the Act, which reads:

6. (1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark

in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

5 The opponents are the proprietors of three registrations - nos. 1384342, 1413731 and 1300389 - each of which qualifies as an 'earlier trade mark' within the provisions of Section 6(1)(a) above and in my view are clearly registered in respect of services which are neither identical nor similar to the goods of the opposed application.

10 This takes me on to the matter of the respective marks. The applicants' mark is a stylised form of the words HILTON HERBS, whereas two of the opponents' marks are HILTON in plain block capitals and the third is HILTON in a stylised form. (see Annex A.) The trade marks HILTON and HILTON HERBS are similar to one another. The HERBS part of the trade mark in suit is obviously the goods and the device of what I assume to be herbs or
15 foliage wrapped around the first letter of each word would not in itself be sufficient to differentiate between the two marks.

In the Oasis Stores trade mark case [1998 RPC page no. 649] the Hearing Officer said that
20 "any use of the same or a similar mark for dis-similar goods or services is liable, to some extent, to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the sweeping effect of preventing the registration of any mark which is the same as or similar to, a trade mark with a reputation. It therefore appears to be a matter of degree." I cannot disagree with this position and propose to adopt the criteria used by the Hearing Officer in that case in considering the likelihood of detriment, which is as follows:

- 25
1. the inherent distinctiveness of the earlier trade mark
 2. the extent of the reputation that the earlier mark enjoys
 - 30 3. the range of goods or services for which the earlier mark enjoys a reputation
 4. The uniqueness or otherwise of the mark in the market place
 5. Whether the respective goods/services, although dissimilar, are in some way
35 related or likely to be sold through the same outlets;
 6. Whether the earlier trade mark will be any less distinctive for the goods/services for which it has a reputation than it was before.

40 It is clear from the evidence that the opponents have substantial goodwill and reputation in relation to hotel services and hotel reservation services, and, whilst the case is not made to any great extent within the evidence, some spillover goodwill in respect of the bar, restaurant, banqueting, health and leisure club services normally associated with hotel chains. The
45 respective goods and services are totally unrelated - sales would be at completely different outlets. Therefore, I conclude that registration and use of the applicants' mark will not have a detrimental effect on the distinctive character of the opponents' marks for any services in respect of which it enjoys a reputation.

This leaves the matter of whether registration would be detrimental to the repute of the opponents mark and/or take unfair advantage of the distinctive character or repute of the opponents' trade mark. In the Oasis Stores trade mark case, the hearing officer addressed the question of detriment, saying:

5

“It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By ‘damaged or tarnished ‘ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on a scale that is more than de minimis.”

10

In the TREAT trade mark case (1996 RPC 281 at 295) Jacob J. gave the following dictum on the scope of Section 10(3) of the Act, which, contains the same wording as Section 5(3), stating:

15

“I only note that it might cater for the case where the goods were vastly different but the marks the same or similar and the proprietor could show that the repute of his mark was likely to be affected. The sort of circumstances of the Dutch *Claeryn/Klarein* (mark for gin infringed by identical sounding mark for detergent, damage to the gin mark image), may fall within this kind of infringement, even though they do not fall within section 10(1) because there is no likelihood of confusion as to trade origin.”

20

25

I therefore have to have regard to:

- (a) the potential for damage to the reputation of the earlier trade mark, with the consequential damage to its ability to add value to the services in respect of which the mark has been used: and
- (b) whether the applicants' trade mark takes unfair advantage of the distinctive character or the repute of the opponents' mark.

30

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In this case, the proprietors of the hotel chain claim that they have a reputation which will be exploited or damaged by use of a similar mark for veterinary preparations and animal foodstuffs. As stated above, there is clearly no connection between the respective goods and services and therefore it is difficult to imagine how use of the mark on the goods would take unfair advantage of the repute or distinctiveness of the earlier mark. Furthermore, HILTON is not an invented word and is likely to be recognised as a surname. Although in relation to hotel services and hotel reservation services HILTON exclusively denotes the opponents' services, that is unlikely to be the case for goods and services in far removed fields of trade, where it is far more likely to suggest the goods or services of other, possibly family businesses.

40

45

Under Section 5(3) the onus falls on the opponents to make out their case. In my view the opponents have failed to establish that use of the applicants' mark would take unfair advantage or be detrimental to the character or repute of their earlier marks. Nor can I see

that the applicants' trade could impact adversely on the opponents. The ground of opposition under Section 5(3) consequently fails.

Finally, the opponents opposed on the basis of Section 5(4)(a). Section 5(4)(a) reads:

- 5 “ (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
- 10 (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)

15 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.”

No reference is made to any rule of law other than passing off. Mr Geoffrey Hobbs QC set out the basis for an action for passing off in *WILD CHILD Trade Mark* (1998) RPC 455:

20 ‘A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Evren Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 IS (with footnotes omitted) as follows:

25 “The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- 30 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff;
- 35 and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

40 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to

45 exclude from the ambit of the tort recognised forms of the action for passing off which

were not under consideration on the facts before the House”.

5 I have already found that the opponents’ marks have acquired a substantial goodwill and reputation in respect of hotel and associated services. Also, I have previously concluded that the marks are similar and that the respective goods and services are dissimilar. Clearly, there is no requirement for the opponents and the applicants to be engaged in the same field of activity in order to succeed in a passing-off action. However, where the fields of activity are far apart - as in this case - the burden of establishing a likelihood of confusion or deception will be significantly greater. The very nature of the respective goods and services effectively rules out any likelihood that consumers are going to directly confuse the marks to the extent that they purchase one product/service in the mistaken belief that it is the other. The opponents’ case is really that their marks are so well known that people will expect goods sold under the applicants’ mark to originate from the same source.


15 Apart from stating that registration of the applicants’ mark would be detrimental to the distinctive character or repute of their HILTON trade marks resulting in unacceptable dilution and erosion, the opponents have not said exactly how they have suffered or are likely to suffer damage. There is no link, tenuous or otherwise, between the respective goods and services and there is absolutely no evidence of confusion or likely confusion through which the opponents could suffer any damage. In my view the opponents have not made out their case under this heading and consequently the ground of opposition under Section 5(4)(a) fails.

25 The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore direct the opponents to pay to the applicants the sum of £435 as a contribution towards their costs.

Dated this 14 day of September 1999.

35 D C MORGAN
For the Registrar
The Comptroller General

ANNEX A

	REG. NO/MARK	CLASS	SPECIFICATION
5	1300389 HILTON	42	Hotel, bar, restaurant, banqueting and hotel reservation services; all included in Class 42.
10	1384342	42	Hotel, motel, bar, restaurant, banqueting and catering services; hotel reservation services; all included in Class 42.
15			
20			
25	1413731 HILTON	41	Health and leisure club services; all included in Class 41.