

O-428-12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2550931  
IN THE NAME OF RACHELLE LUNNON AND RICHARD GRINDY

AND

OPPOSITION THERETO UNDER NO 101384  
BY RENAISSANCE HOTEL HOLDINGS, INC

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION  
No 2550931 in the name of Rachelle Lunnon  
and Richard Grindy and opposition thereto  
under No 101384 by  
Renaissance Hotel Holdings, Inc

**Background**

1. Application No 2550931 is for the following series of two trade marks:



**ROCK RENAISSANCE**



ROCK RENAISSANCE

2. It has a filing date of 21 June 2010, stands in the name of Rachelle Lunnon and Richard Grindy (“the applicants”) and seeks registration for the following goods and services:

**Class 9**

Recordings of sounds and images in any media; recordings of music; audio and video cassettes; compact disks; DVDs; phonograph records; CD ROMs; computer software relating to music; digital music (downloadable) provided from the Internet; video recordings (downloadable) provided from the Internet; downloadable artwork provided on-line from databases or the Internet; electronic artwork in any media; cinematographic and photographic films; animated films; instructional and teaching apparatus and instruments.


**Class 35**

Business management, business consultancy, advertising, sales promotion, marketing and agency services in the field of organisation of events and exhibitions of artists and for artists and in the field of art and artists; business management for artists; tour management for artists; public relations; promotion of artists by means of advertising; business inquiries and consultancy, in particular agencies of business contacts and business addresses; organisation of exhibitions and fairs for commercial and advertising purposes; information, advisory and consultancy services relating to the aforesaid services.

## Class 41

Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and music festivals; talent agency services, artist agencies, in particular placement of artists with event organisers; providing artists for orchestra services, for events, for sound and recording studios; booking venues and engagements for persons engaged in the fields of art and the performing arts; organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; arranging and organising of parties, private functions and corporate hospitality events; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet.

3. Following publication in the *Trade Marks Journal* on 8 October 2010, notice of opposition was filed by Renaissance Hotel Holdings, Inc. ("RHH"). Raising grounds of opposition under sections 5(2)(b) and 5(3) of the Act, RHH relies on the following marks insofar as they are registered for goods and services in the following classes, full details of which I will set out later in this decision:

Mark	No	Application/Registration date	Classes
RENAISSANCE	CTM 771980	13 March 1998/ 6 March 2000	35, 39, 41, 42
RENAISSANCE	1294338	5 December 1986/ 1 July 1994	43
RENAISSANCE	1363498	3 November 1988/ 21 October 1994	39, 41
RENAISSANCE	1521894	22 December 1992/ 27 December 1996	16
	CTM 8799504	8 January 2010/ 2 September 2010	41, 43

4. RHH also opposes the application on grounds under section 5(4)(a) of the Act, relying on use of the mark RENAISSANCE in the UK since 1988 in relation to "hotel, restaurant and related services" and on use of the mark COLLECTRENAISSANCE in the UK since 2008 in relation to alarm clocks, iPod docking stations and Bluetooth headsets.

5. The applicants filed a counterstatement denying each of the grounds of opposition and putting RHH to proof of use of CTM 771980 insofar as it is registered for services in class 35 and 42 and 1363498 insofar as it is registered for services in classes 41.

6. Both parties filed evidence and, after having been set down originally for a hearing, the parties later confirmed they wished to have a decision from the papers. I therefore give this decision after a careful review of all the papers.

## **Evidence**

### **RHH's evidence**

7. This takes the form of two witness statements. The first is by Kevin M Kimball who states he is Vice President of RHH having been associated with it since 1997 and with its parent company, Marriott International, Inc ("Marriott") since 1976. He states that Marriott operates under 17 different brands of which RENAISSANCE is one.

8. Mr Kimball states the mark RENAISSANCE was adopted by RHH's predecessor in title, Ramada Inns, Inc, in March 1981. It was acquired by RHH in 1997 and first used by it in the UK at least as early as 1998.

9. Mr Kimball states that RHH had 150 RENAISSANCE resorts and hotels in 31 countries including the UK at the time of the making of his witness statement, (20 May 2011). He states that prior to 2006, the hotels in the UK were operated under a master franchise through Whitbread Limited. He provides the following details of the RENAISSANCE hotels in the UK:

<b>Location</b>	<b>Opened</b>	<b>Closed</b>
Heathrow	1998	
Gatwick	1999	23 May 2008
Manchester	1999	
Reading	1999	24 March 2008
London (Chancery Court)	2000	
Derby	2001	30 November 2007
Solihull	2001	30 November 2007
London (St Pancras)	April 2011	

10. At Exhibit 20, are internet printouts taken from the Way Back Machine website which includes extracts dating from 1998 and 1999 showing RENAISSANCE hotels in Reading, Gatwick, Heathrow and Manchester.

11. Mr Kimball states the mark is used "inter alia in relation to hotel, restaurant, catering, bar, cocktail lounge, fitness club and spa services; transport of persons by car; concierge services that include assisting guests and other members of the travelling public in making tour and travel arrangements; otherwise arranging tours

and travel by land and water; arranging of transportation for travellers; management of hotels, resorts, restaurants, night clubs, bars, casinos, spas and facilities for meetings, events, conferences, exhibitions and weddings; hotel reservation services; and marketing and consultancy services related to these services". He states RHH also hosts musical and entertainment events and goes on to state that "brand signatures under the RENAISSANCE trade mark and trade name include the provision of printed matter, notebooks, newsletters, prospectuses, reports, advertising and business management and business administration services as well as real estate affairs and related financial and insurance services". He states that RHH also "provides training, entertainment and cultural activities at its various hotels, resorts and holiday clubs by reference to its RENAISSANCE mark". Attached to his witness statement are a number of exhibits provided to show use of the mark:

Exhibit 2: these are extracts taken from RHH's blogsite. The entries are dated between 28 October 2010 and May 2011 and are intended to show how RHH regularly hosts musical and entertainment events under the mark. With the exception of one extract, all refer to events which took place in hotels in the US. The one exception is an extract posted on 9 May 2011 (which is after the relevant date and the period relevant to the proof of use period) which refers to a party which included a performance by Jamie Cullum and which took place to mark the grand opening of RHH's St Pancras hotel "this past Thursday".

Exhibit 3: this is an extract in the form of a news article taken from RHH's website on 28 April 2011. The article is promoting the launch of the hotel-branded entertainment service by way of the RLife LIVE Entertainment Platform in October 2010. The article states that the platform has created opportunities to meet and experience emerging talent at RHH's properties. There is mention of one performance involving the American singer Bruno Mars but this took place in New York during his US tour. The extract also gives details of the programme of events for 2011 but no mention is made of any such activities taking place in the UK.

Exhibit 4: A further extract from the RLife blogsite. Whilst most of the entries refer to hotels in the US (along with one in Germany) there are two references to the Renaissance Chancery Court hotel in London. The first, at page 9 of the exhibit, was posted on 11 May 2010 and refers to the hotel having large guest rooms, a spa and the Pearl restaurant. At page 20 there is another extract, dated 1 February 2010, which refers to it having sophisticated rooms and having been voted into the GoldList 2010 by readers of "Conde Nast Traveler".

Exhibit 5: Mr Kimball states this exhibit consists of three publications issued in 2004 and 2005 by Marriott. I do not know where the publications were issued or to whom. The exhibit is made up of 60 pages which make reference to various hotels operated by Marriott under a variety of marks. Many of the pages consist primarily of pictures with some of them identified as showing various hotels across the globe. As far as I can see, there are no references to RENAISSANCE hotels in Europe other than two pages which refer to a RENAISSANCE hotel in the UK. At page 30 there is a picture of a seating

area said to have been taken in the RENAISSANCE Chancery Court hotel. The same hotel is mentioned on page 58 where the building is said to have been restored in 2001 before later becoming the first RENAISSANCE hotel in central London and a prime example of “an on-strategy hotel – one that delivers the Renaissance Three Pillars of expressive design, savvy service and street restaurant and bar”.

Exhibit 6: This exhibit consists of website printouts which set out brief details of various Marriott hotel brands. The entry for RENAISSANCE Hotels & Resorts refers to them as having “distinctive decors, imaginative dining and attentive service” and being “the stylish way to stay”. All are undated.

12. Mr Kimball states that Marriott operates a system of providing preferential and reduced rates to regular and repeat customers including those staying at its RENAISSANCE hotels. He gives details of the number of UK members of the scheme which he states stood as 118,818 in 1997 increasing steadily, year on year, to 1,574,645 in 2010. He does not say how many of these members have used RENAISSANCE hotels (whether in the UK or elsewhere) as opposed to Marriott’s other branded hotels.

Exhibit 7: This exhibit consists of 36 pages making up various Marriott Rewards booklets dating from 1997, 2004 and 2005 (x 2). There is no mention of RENAISSANCE in the 1997 brochure. I note that the 2004 booklet refers to the RENAISSANCE Chancery Court and Heathrow hotels but warns, at page 20, that only Marriott Reward points can be earned at RENAISSANCE hotels.

13. Mr Kimball states that the Marriott group of companies have offered a wide variety of goods for sale for many years under various hotel brand names and says this includes the RENAISSANCE brand. He states:

“Certain of these goods are offered through hotels (including hotel gift shops and spas), in-room catalogues and/or the websites at [www.collectrenaissance.com](http://www.collectrenaissance.com), [www.marriott.com](http://www.marriott.com) and [www.shopmarriott.com](http://www.shopmarriott.com), while other goods are offered through Ritz-Carlton hotels and catalogues.”

Exhibit 24: consists of 16 pages which Mr Kimball says show a range of hotel branded products including shirts, chocolates, candles, mints and linens. The only dated page is at page 2 (marked 05 07 2004) which shows some sweets. The nature of the printing means that I cannot see what is depicted on some of the other pages (1, 4, 6, 8, 10, 12, 13, 15 and 16) though I can see that some do not show the marks relied on. There is one page (page 11) which appears to be some sort of leaflet for the RENAISSANCE hotel at Heathrow which advises that various items such as teddy bears, cameras, items of clothing and umbrellas are available. It is not dated.

14. Mr Kimball gives details of products “currently” (May 2011) available through the [collectrenaissance.com](http://collectrenaissance.com) website which, he states, includes covers for tablet computers, Bluetooth headsets, travel lights, lamp/radios and solar-powered rotating globes.

Exhibit 8: this consists of extracts from the Marriott online store. The first two pages bear copyright dates of 1995-2005 but make no reference to RENAISSANCE. The remainder of the exhibit consists of website printouts which show a range of goods as set out by Mr Kimball and offered under collectrenaissance. They were each downloaded on 5 August 2011 and each shows the price in dollars only.

15. Mr Kimball provides what he refers to as “annual gross system-wide sales (turnover)” generated by hotel stay and hospitality services offered under the RENAISSANCE trade marks which range between \$1.6b in 1998 and \$2.8b in 2010. He does not provide details of how much of this turnover relates to RENAISSANCE hotels in the UK but does state that gross sales and turnover for RHH’s hotels in the UK in 2006 amounted to £86m.

Exhibit 23: consists of documentation dating from 2007 to 2009 relating to bookings taken at the RENAISSANCE Chancery Court and Heathrow hotels for the provision of accommodation for conference events.

16. Mr Kimball states that RHH has promoted its hotel services by way of advertisements in magazines, newspapers, on tv and radio, outdoor signs, at airports and point of sale displays in hotels and elsewhere. He gives the following details of approximate worldwide advertising and promotional costs under the mark RENAISSANCE:

2005	US\$ 11.4	(\$ 9.2 million in US and \$2.2 million outside of US)
2006	US\$ 13.3	(\$ 8.6 million in US and \$4.7 million outside of US)
2007	US\$ 14.7	(\$ 10.9 million in US and \$3.8 million outside of US)
2008	US\$ 7	(\$ 5.6 million in US and \$ 1.4 million outside of US)
2009	US\$ 9.5	(\$ 6.9 million in US and \$ 2.6 million outside of US)
2010	US\$ 10.1	(\$ 7.7 million in US and \$ 2.4 million outside of US)

17. As regards advertising costs in the UK, Mr Kimball provides the following figures which, he states, relate to use of the RENAISSANCE brand alone or in conjunction with other MARRIOTT brands:

2005	1.9 Million (USD)	-1.21 GBP
2006	3.28 Million (USD)	-2.09 GBP
2007	2.56 Million (USD)	- 1.63 GBP

18. Mr Kimball provides a selection of material to show use of the RENAISSANCE brand in the UK.

Exhibit 25: The exhibit consists of 141 pages. Many make no reference that I can see to RENAISSANCE (e.g. pages 27-38, 63) or refer only to RENAISSANCE hotels abroad (e.g. page 128). Many others appear to be internal documents such as design or printer’s proofs (e.g. pages 38, 54, 58-61, 104-108). Whilst most of the pages are undated (e.g. pages 1-4, 49-53), there are some from which it is possible to discern an approximate date of publication. Page 46, for example, shows the mark RENAISSANCE, provides a UK local rate telephone number and indicates that the offer it advertises

was valid between 15 November 2005 and 31 January 2006. At page 55, is material which gives details of RENAISSANCE hotels in Derby/Nottingham and Solihull where the offer was valid between 1 April 2006 and 7 May 2006. Similarly, at page 71, material bearing the mark RENAISSANCE shows the offer was valid until 2 September 2007. No indication is given of where this material was published or who may have seen it.

Exhibit 26: This consists of 12 articles taken from various UK national newspapers. The articles are dated between March 1998 and November 2006. Four of them refer to plans to develop or sell off RENAISSANCE hotels in the UK. Five mention RENAISSANCE hotels as places to stay when visiting various locations (not all of which refer to hotels in the UK) or as a way of gaining free car parking when using an airport. One is an article about an airline's recruitment drive and notifies readers of the various hotels that are being used, one of which is a RENAISSANCE hotel. Another refers to sales of apartments by a third party and notifies readers of the availability of such properties which appear to be located in a property which is above a RENAISSANCE hotel. The last is an article on 2 members of staff who were working at the RENAISSANCE Chancery Court hotel.

Exhibit 13 includes an article from the Daily Mail August 6 2007 which mentions the RENAISSANCE Chancery Court hotel and its restaurant and spa.

Exhibit 22: This consists of 308 pages giving details taken from the internet of each of the hotels listed at paragraph 9 above (with the exception of that at St Pancras). Each of the pages was downloaded in March 2007. They show that each hotel offered rooms, restaurants and conference and wedding facilities with most also offering a fitness or health room and spa facilities.

19. Mr Kimball states that professionals within the hospitality industry have recognised the reputation of the RENAISSANCE brand.

Exhibit 10: An extract from a book entitled Brand Asset Management-Driving Profitable Growth Through Your Brands by Scott M Davis. The extract states "Marriott is another impressive corporate brand" incorporating other brands including RENAISSANCE BY MARRIOTT. I do not know where or when the book was published.

Exhibit 11: An extract from a publication entitled "The Business of Hotels". The extract shows an appendix giving details of the "Leading Hotel Groups world-wide". The extract indicates its source to be *Hotels* July 1999. Whilst Marriott is listed, there is no mention of RENAISSANCE in the list.

20. Mr Kimball states that RHH has won numerous awards and accolades.

Exhibit 12: The exhibit consists of 24 pages. Pages 1 to 4 have been downloaded from marriott.com and make no mention of RENAISSANCE. The remaining pages are entitled "Marriott International International Hotel Awards". The vast majority refer to awards given to Marriott itself or to hotels



in other countries. There are four references to RENAISSANCE hotels in the UK. These are:

- 1998 Investors in People award to RENAISSANCE hotel at Heathrow
- 2001 London Times award to the RENAISSANCE Chancery Court hotel as “one of the twenty most exciting hotels for 2001”
- 2004 British Beauty Award for best day spa of the year to the RENAISSANCE Chancery Court hotel
- 2005 award from *Theme* magazine to the Chancery Court’s Pearl restaurant for the best new restaurant in London.

21. There is also a witness statement from Richard Burton who is a trade mark assistant with D Young & Co LLP, RHH’s legal representatives in these proceedings. Mr Burton gives details of an internet search he carried out for the words “Rock Renaissance”. He states that the search showed links to both a Wikipedia article on the English progressive rock band, Rock Renaissance and to RHH’s Eden ROCK RENAISSANCE hotel. He goes on to say that he followed the link to the hotel and found that the hotel was referred to as “Eden ROCK RENAISSANCE Miami Beach” throughout the website and, at RPB2 he exhibits a number of pages showing said hotel. Contrary to his claim, these pages show the hotel and resort to be referred to as Eden Roc Renaissance Miami Beach or Eden Roc. The exhibits show the search was carried out on 24 May 2011.

### **The applicants’ evidence**

22. This takes the form of a witness statement by Errol Sandiford, who is a partner with Sandiford Tennant LLP, the applicants’ legal representatives in these proceedings. Mr Sandiford’s witness statement primarily consists of submission which I do not summarise but will take into account in reaching my decision.

23. Mr Sandiford states the applicants adopted their mark in January 2009, that it was first used in respect of the goods and services applied for in March of that year and has been used continuously since that time. He exhibits the following:

ES1: Said to be promotional material which relate to events which took place in 2009. Page 1 relates to a Rock Renaissance event described as “An exclusive night of Rock ‘N’Roll photography” which took place on 14 March 2009. Page 2 refers to a Rock Renaissance event which is described as “An exclusive night of art and music” which took place on 23 October 2009.

ES2: material said to be used to promote events relating to rock music, concerts and festivals incorporating exhibitions with particular focus on music personalities of the early rock era. The exhibit is a single entry taken from the music-news.com website. It shows a news article added on 19 October 2009 relating to the same event as shown on page two of exhibit ES1.

ES3: consists of some 36 pages. At page 2 is the same material that appears at page 1 of exhibit ES1. The majority of other pages simply show photographs of various people.

### **RHH's evidence in reply**

24. This consists of a further witness statement of Kevin M Kimball which serves as a vehicle to exhibit the following:

Exhibit 30: Extract from the Breaking Travel News website. The article refers to musical performances at the opening Renaissance RLife event. The article is dated 10 May 2011 and refers to the opening which took place on the previous day.

Exhibit 31: Extracts from the renaissancelife.com website. Many of the blog entries were posted on dates in 2011, though there are some which show them to have been posted in October and November 2009. Those from 2009 relate to US hotels with one referring to a 'fall and winter' tour by an artist. Three invite viewers to watch a video though one of these states that the video "does not exist".

Exhibit 32: Extracts from the MOBO website referring to the "nominations launch 2011" which was to take place at the Renaissance St Pancras hotel in August 2011.

### **Decision**

25. I shall deal first with the ground of opposition under section 5(2)(b) of the Act which reads:

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

(a) ...

(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."

26. The meaning of "earlier trade mark" is set out in Section 6 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 or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

27. Each of the five registrations relied on by RHH is an earlier mark as set out in section 6(1) of the Act. The application was published on 8 October 2010 and, with the exception of CTM 8799504, each of the earlier marks was registered more than five years prior to this date and would, therefore, be subject to the proof of use provisions of section 6A of the Act, set out below. The four registrations are each for the same mark but differ in relation to the goods and services for which they are registered. In their counterstatement, the applicants put RHH to proof of use of some services of two of the earlier trade marks relied on: they are 1363498 insofar as it is registered for services in class 41 and CTM 771980 insofar as it is registered for services in classes 35 and 42. This led to the somewhat anomalous position that the applicants appeared to be seeking proof of use in relation to the class 41 services covered by 1363498 but not for the class 41 services covered by CTM 771980. On 14 June 2012, a letter was sent to the applicants seeking confirmation of the extent of their request for proof of use. In their response, they confirmed that there had been a clerical error in the completion of the form and that proof of use was sought in respect of the class 41 services in respect of both marks and I proceed on that basis.

28. This being the case, the earlier marks relied upon will be taken into account for the specifications as registered (insofar as they are relied upon as set out in paragraph 3 above) but the requirement to prove use is relevant to earlier marks CTM 771980 and 1363498 in respect of services in classes 35, 41 and 42.

Section 6A of the Act reads:

“6A (1) This section applies where-

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

there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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-

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) .....

(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)....”

29. Also of relevance is section 100 of the Act which 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.”

30. The relevant period in which RHH is required to prove use of its two earlier marks is 9 October 2005 to 8 October 2010. Given that the marks themselves are identical in both cases, I will refer to them in the singular in my consideration of whether genuine use has been made of them, whilst taking into account the different services of each registration and for which proof of use is requested and that one is a Community trade mark and the other a UK registration.

31. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]

RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the CJEU);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

32. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

"Pumfrey J in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be

carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

33. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety 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, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. 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.”

34. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group

which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

35. I also note the comments of Mr Geoffrey Hobbs Q.C. sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. 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.”

36. For ease of reference, proof of use of the mark is required for the following services for which it is registered:

35	Managing affairs for others, namely managing hotels, holiday resorts, restaurants, night clubs (CTM 771980)
41	<p>Hotel and restaurant training schools; reservation agencies for theatre and cinema tickets; club entertainment services; cabarets; organization of competitions; concerts; arranging and conducting entertainment events; arranging dance demonstrations; entertainer services; fashion shows; orchestras; social club entertainment; arranging tournaments; arranging and conducting of conferences, providing golf club services, providing facilities for recreational activities; health clubs; scuba diving equipment rental; casinos (CTM 771980)</p> <p>Educational services, booking agency services for theatre and cinema tickets; club entertainment services; cabaret services; organising of competitions; concert services; arranging and conducting of conventions relating to entertainment; organising of dancing displays; entertainer services; fashion show services; orchestra services; social club entertainment services; staging of tournaments (1363498).</p>
42	Services relating to hotels, holiday resorts, restaurants, bars, cocktail bars, night clubs, cafes, snack bars, victualling and banqueting services; managing of bars, conference halls; hairdressing and beauty salons; reservation services for hotel accommodation; management services for hotels and restaurants; providing of facilities for exhibitions and conferences; spas; saunas and gyms; banqueting facilities and facilities for ceremonies for special occasions; hotel concierges;

hotel services for privileged clients; room hire; providing of facilities for business conferences; providing of convention facilities; providing of concessions, namely offering technical assistance with the setting up and/or managing of hotels, holiday resorts, restaurants, night clubs. (CTM 771980)
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37. As indicated above, the relevant period within which RHH must show use of its mark is 9 October 2005 to 8 October 2010. In relation to use of the mark relating to hotels in mainland Europe, the evidence is almost silent. There is an occasional reference to a number of hotels which may or may not be in a particular city (e.g. Renaissance Amsterdam, Renaissance Munich and Renaissance Naples Hotel Mediterraneo at exhibit 7 page 24) but there is no evidence of e.g. when or where any such hotels were established, what trade they might have done or what services they might have provided.

38. The evidence shows that RHH had seven hotels in the UK in 2005, this number reducing to 5 in 2007 and 3 by 2010. Turnover figures for UK hotels during the whole of the relevant period have not been provided though hotel stay and hospitality services figures are said to have amounted to some £86m for 2006. Advertising costs are similarly incomplete but for the three years 2005 to 2007 and said to be between £1.2m and £2.09m though these figures are said to relate to use of the RENAISSANCE brand either alone or in conjunction with other MARRIOTT brands. Whilst the figures provided are far from comprehensive in relation to the whole of the relevant period, I accept that RHH's hotels in the UK were open and trading under the mark RENAISSANCE during the relevant period in the locations identified by Mr Kimball.

39. What is less clear from the evidence is the extent of the services RHH has offered at those hotels. Hotels are, by their very nature, somewhere for guests to stay, generally overnight. It is also common for them to provide facilities for larger numbers of people to gather for a function of some sort (e.g. a conference or wedding reception). They also provide somewhere to have something to eat and drink, whether in a formal restaurant, a bar or a lounge setting and often provide facilities such as fitness rooms and spas, all of which may be used by guests during their stay or by others e.g. local residents who pay a subscription to use those facilities. Whilst there is no direct or specific evidence of any turnover in respect of any or all of these individual services (whether in the relevant period or not), exhibit 22 to Mr Kimball's witness statement contains material dating from 2007 which shows that all of these services have been offered at RHH's hotels in the UK (see page 2 of each separate part of the exhibit as it relates to each of the hotels) and exhibit 23 consists of documentation relating to bookings for conferences. These are all standard services which the public would expect most, at least larger, hotels to offer.

40. The mark is registered, however, for a much wider specification of services than these "standard" ones. For his part, Mr Kimball claims the mark is used in relation to a very wide range of services, as set out at paragraph 11 above, at RHH's various hotels, resorts and holiday clubs but there is no evidence that RHH has any resorts or holiday clubs in the UK. There is little evidence provided in relation to these wider services in any event and what evidence there is refers to hotels etc. in the US with



some other hotels in other parts of the world, such as India or the Middle East, also being referred to in e.g. the advertising material adduced. There is no evidence of these services being offered in the UK. There is some evidence that musical and entertainment events have been held at some of RHH's hotels. The material at exhibit 2 which relates to such events, however, overwhelmingly relates to hotels in the US. The one exception relates to a performance by Jamie Cullum at the St Pancras hotel. His performance was at a party celebrating the opening of that hotel. It is arguable that a party of this nature is a one-off promotional event for the hotel itself and is not of the same nature as providing musical and entertainment services per se, however, even if that is not the case, the party did not take place until well after the relevant period. Similarly, the introduction of "a hotel branded entertainment service" as shown in exhibit 3, makes no mention of such activities having taken place in the UK or within the relevant period. At page 30 of the 2005 booklet, travellers are urged to go to London and "enjoy its fabulous nightlife and take in a show or two then return to your Marriott hotel for good food, friendly company and a great night's sleep" and offers winter deals expiring March 2006 for room and breakfast which suggests that, at that time at least, no such entertainment was available within or provided by the hotel itself.

41. Whilst some of the Renaissance hotels in other countries (mainly the US and the far East) are shown in the evidence to be somewhat larger undertakings with some being part of a very large resort offering a very wide range of services and facilities, there is no evidence that RHH's hotels in the UK are anything other than standalone hotels offering the standard, and more limited, range of services referred to above. Whilst it has managed e.g. hotels for itself, there is no evidence that RHH has provided any such services to others. And whilst it has provided rooms for conferences, there is no evidence it has actually arranged or conducted any conferences itself. Whilst there is some evidence that it has provided a concierge desk in at least one of its hotels (Exhibit 22 page 10-London Heathrow) absent specific evidence on the point, I am unable to ascertain whether, and if so what, actual services may have been provided by that desk. Similarly, whilst there is evidence that various recreational activities as disparate as golf and diving are available at some of the US resort hotels, there is no evidence of activities other than the usual ones found in a health club (e.g. spa, sauna, swimming pool, or gymnasium) being available at its UK hotels.

42. In all the circumstances, I find that genuine use of the mark has not been shown in relation to the following services:

**Class 35**

*Managing affairs for others, namely managing hotels, holiday resorts, restaurants, night clubs (CTM 771980)*

**Class 41**

*Hotel and restaurant training schools; reservation agencies for theatre and cinema tickets; club entertainment services; cabarets; organization of competitions; concerts; arranging and conducting entertainment events; arranging dance demonstrations; entertainer services; fashion shows; orchestras; social club entertainment; arranging tournaments; arranging and*

*conducting of conferences, providing golf club services, providing facilities for recreational activities; scuba diving equipment rental; casinos (CTM 771980)*

Class 41

*Educational services, booking agency services for theatre and cinema tickets; club entertainment services; cabaret services; organising of competitions; concert services; arranging and conducting of conventions relating to entertainment; organising of dancing displays; entertainer services; fashion show services; orchestra services; social club entertainment services; staging of tournaments (1363498).*

Class 42

*Services relating to holiday resorts, night clubs; managing of bars, conference halls; hairdressing and beauty salons; management services for hotels and restaurants; providing of concessions, namely offering technical assistance with the setting up and/or managing of hotels, holiday resorts, restaurants, night clubs. (CTM 771980).*

43. I find that genuine use has been shown in relation to the following services:

Class 41

*Health clubs (CTM 771980)*

Class 42

*Services relating to hotels, restaurants, bars, cocktail bars, cafes, snack bars, victualling and banqueting services, reservation services for hotel accommodation; providing of facilities for exhibitions and conferences; spas; saunas and gyms; banqueting facilities and facilities for ceremonies for special occasions; hotel concierges; hotel services for privileged clients; room hire; providing of facilities for business conferences; providing of convention facilities (CTM 771980)*

44. In my view the services as listed constitute a fair specification for the services on which use has been made and it is this specification that I shall take into account when comparing the respective goods and services insofar as CTM 771980 and 1363498 are concerned. The other marks not being subject to proof of use, will be taken into account in respect of all of the goods and services relied upon.

45. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## The principles on similarity of goods and services

46. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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."

47. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

"23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary."

48. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the General Court stated:

"82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM- Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05, *Saint-Gobain Pam v OHIM –Promamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM –Bolaños Sabri (PiraNam diseño original Juan Bolaños)* [2007] ECR-1-0000, paragraph 48)."

49. In *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

50. Finally, in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, Jacob J stated:

“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 meaning attributable to the rather general phrase.”

51. RHH relies on five earlier marks as set out above at paragraph 3. As indicated above, four of them are for the same mark. I intend to deal first with the four registrations as one mark, taking account the various goods and services involved. The objection based on CTM8799504, which is not subject to the proof of use provisions, I will deal with separately.

### Comparison of marks

52. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

53. The marks to be compared are as follows:

Earlier mark	Application
RENAISSANCE	

54. The earlier mark consists of the dictionary word RENAISSANCE. As a single word, which has no particular meaning in relation to the goods and services for which it is registered, its distinctiveness rests in its totality. The mark applied for consists of two dictionary words ROCK and RENAISSANCE. Accepting that the words are presented in a particular font, there is nothing particularly unusual about that font. Rock is a well-known genre of music and, in the context of some of the services, meaningful thus the mark's distinctiveness also rests in the word RENAISSANCE, however, the two words "hang together" in such a way that neither word is dominant.

55. The mark applied for begins with the word ROCK which is absent from the earlier mark and thus to two marks differ in this regard. Given that the word RENAISSANCE appears in both marks, however, there is a reasonable degree of similarity between them from both the visual and aural perspective.

56. The word RENAISSANCE means rebirth or revival and may be known by some to refer to a particular period in 14<sup>th</sup> century European history, especially in terms of the art and culture of the time. The word ROCK has several meanings, however, in the context of the goods and services involved, the mark ROCK RENAISSANCE is likely to be seen as referring to the revival of a particular genre of music. To the extent that each of the respective marks could be taken to refer to a revival of some sort, there is a reasonable degree of conceptual similarity between them.

#### **The distinctiveness of the earlier mark**

57. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

58. The evidence which RHH has filed of the use of its mark, suffers, as indicated above, from a number of flaws. RHH's first UK hotel is said to have opened at Heathrow in 1998. Six further hotels were opened over the following three years but four of those closed in 2007 and 2008. The maximum number of hotels open at any one time was seven. The only turnover figures given are for 2006 when hotel stay and hospitality services were said to have generated £86m. That figure has not been broken down in any way (e.g. between particular hotels or particular services) nor is there any evidence of what market share it might represent. No details are provided of how many guests might have stayed at or used the hotels at any time. Advertising costs in the UK for 2005-2007 are given, ranging from £1.2m in 2005 to £1.6m in 2007 with a high of £2.9m in 2006, but, with the exception of a few articles in newspapers where a somewhat peripheral mention is made and some, largely undated, leaflets, no evidence is provided to show how or where such advertising took place or how many people may have seen any of it. There is no evidence from

the trade, however, there is some evidence (Exhibit 12) that the Chancery Court hotel was named by the London Times as one of the 20 most exciting hotels in 2001, that it was awarded best spa day in the British Beauty Awards and best new restaurant by Theme magazine in 2001, 2004 and 2005 respectively.

59. The word RENAISSANCE is an ordinary dictionary word but in relation to the goods and services for which it is registered and which I take into account, it is a mark with a reasonable degree of inherent distinctive character. Whilst I accept that there has been use, the evidence before me is such that I cannot be satisfied that that use had any material effect on the level of distinctiveness of the mark.

### **The average consumer and the nature of the purchasing process**

60. The respective goods are somewhat diverse but all are goods which will be bought by the general public. The goods in class 9 are relatively low cost items which are widely available on the high street, via mail order or the Internet and by self selection. They will be bought with some, though not the highest, care, to ensure that e.g. the subject matter, genre or artist is suited to the purchaser's needs. The goods in class 16, such as newspapers and magazines are everyday, low cost items again made by self selection and little care will be taken over their purchase. In all cases, the purchase is likely to be, primarily, a visual one.

61. The respective services are wide ranging. Services such as hotel services may be bought by an individual or by businesses. Those looking for a place to stay or hold an event of some sort will take a reasonable degree of care over the purchase to ensure that the hotel is e.g. in an appropriate location, has the appropriate facilities and is affordable. It is well-known that various organisations award ratings to hotels and this may also come into play. Services such as business management services and sales promotion will be used generally by businesses in the course of trade. The services are likely to vary in price depending on the complexity and extent of the service. Some of the services such as arranging of tours are likely to involve a degree of research and negotiation prior to entering into an agreement and are highly likely to involve the completion of paperwork. Other services, such as artist agencies, are such as will be used by artists in the course of their profession. They are specialist services which are also likely to involve a degree of prior negotiation before agreements are reached and over which some care will be taken. Again, in all cases, the purchase is likely to be a visual one though not to the extent that other considerations can be ignored.

### **Comparison of goods and services**

62. I set out above the relevant case law to be considered. In making my comparison of the respective goods and services, I also take into account the following comments of the appointed person in *Separode* BL O-399-10,

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the

same reasons, the decision taker may address them collectively in his or her decision.”

**Earlier mark CTM 771980**

63. Taking into account the extent of, and my findings on, the proof of the use made of the mark, the services to be compared are as follows:

RHH's earlier mark	The application
<p>Class 39</p> <p>Transport and storage services; arranging of tours; arranging transport for travellers; tour operating; arranging trips, travel guide services, travel conference services, travel agencies, and travel information services; transport services by land, namely bicycle rental, motorcycle rental, car rental and transport of passengers by land using cars, limousines, vans or coaches.</p>	<p>Class 35</p> <p>Business management, business consultancy, advertising, sales promotion, marketing and agency services in the field of organisation of events and exhibitions of artists and for artists and in the field of art and artists; business management for artists; tour management for artists; public relations; promotion of artists by means of advertising; business inquiries and consultancy, in particular agencies of business contacts and business addresses; organisation of exhibitions and fairs for commercial and advertising purposes; information, advisory and consultancy services relating to the aforesaid services.</p>
<p>Class 41</p> <p>Health clubs</p>	<p>Class 41</p> <p>Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and music festivals; talent agency services, artist agencies, in particular placement of artists with event organisers; providing artists for orchestra services, for events, for sound and recording studios; booking venues and engagements for persons engaged in the fields of art and the performing arts; organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; arranging and organising of</p>



	parties, private functions and corporate hospitality events; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet.
<p>Class 42  Services relating to hotels, restaurants, bars, cocktail bars, cafes, snack bars, victualling and banqueting services, reservation services for hotel accommodation; providing of facilities for exhibitions and conferences; spas; saunas and gyms; banqueting facilities and facilities for ceremonies for special occasions; hotel concierges; hotel services for privileged clients; room hire; providing of facilities for business conferences; providing of convention facilities</p>	

64. RHH's services in class 39 are all, broadly, transport and travel services. RHH has given no explanation as to why or how these services are similar to any of the services of the application. Whilst there may be some overlap in the respective users (in that they may both be a business or someone moving from one place to another), the uses, nature and channels of trade all differ and they are not competitive or complementary. The respective services are not similar.

65. *Health clubs* are places where people go to e.g. undertake exercise or some form of treatment. I do not consider these to be similar services to any of the applicant's services as applied for. Again, whilst it is possible that some of the respective users may overlap, the uses, nature and channels of trade all differ and they are not competitive or complementary. The respective services are not similar.

66. RHH's services in class 42 can be broken down into a number of distinct areas. They relate broadly to the provision of accommodation, the provision of food and drink or the provision of facilities for health and fitness.

67. I do not find any of RHH's services in class 42 to be similar to those of the applicant in class 35. Whilst, again, it is possible that some of the respective users may overlap, the uses, nature and channels of trade all differ and they are not competitive or complementary. The respective services are not similar.

68. As for the comparison of RHH's services in class 42 with the applicant's services in class 41, I find there to be no similarity in respect of the following:

*Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and*

*music festivals; talent agency services, artist agencies, in particular placement of artists with event organisers; providing artists for orchestra services, for events, for sound and recording studios; booking venues and engagements for persons engaged in the fields of art and the performing arts: organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet.*

Again, in each case, the uses, nature and channels of trade all differ and they are not competitive or complementary.

69. That leaves *arranging and organising of parties, private functions and corporate hospitality events*.

70. RHH's earlier mark includes *reservation services for hotel accommodation; victualling and banqueting services; and banqueting facilities and facilities for ceremonies for special occasions*. These are services which may be engaged when undertaking the *arranging and organising of parties, private functions and corporate hospitality events* as included within the application and are complementary to them. They are therefore highly similar services.

**Earlier mark No 1363498**

71. In view of my findings regarding proof of use as regards RHH's earlier mark No 1363498, the services to be compared are:

RHH's earlier mark	The application
Arranging of tours and of cruises; arranging of transportation for travellers; arranging of travel; all included in Class 41	As above

72. Each of RHH's services relate to transport and travel. Whilst it is possible that the users overlap (e.g. an artist performing concerts in various locations will need transport to travel between those locations) the uses and nature of the services and channels of trade all differ and they are not competitive or complementary services. The respective services are dissimilar.

**Earlier mark No 1294338**

73. Earlier mark no 1294338 has not been subject to the proof of use requirements of the Act. The respective services to be compared are:

RHH's earlier mark	The application
Hotel, bar, banqueting and hotel reservation services	As above

74. My earlier comments regarding the lack of similarity of RHH's services to most of the applicant's services are equally applicable here. Each of RHH's services are considered complementary to *arranging and organising of parties, private functions*

and corporate hospitality events as are included within the application. These are therefore highly similar services.

**Earlier mark No 1521894**

75. The opposition based on earlier mark no 1521894 is directed to the goods of the application. The respective goods to be compared are:

RHH's earlier mark	The application
Newspapers, magazines, posters, maps, guidebooks, all included in Class 16; but not including any such goods relating to European history and art.	Recordings of sounds and images in any media; recordings of music; audio and video cassettes; compact disks; DVDs; phonograph records; CD ROMs; computer software relating to music; digital music (downloadable) provided from the Internet; video recordings (downloadable) provided from the Internet; downloadable artwork provided on-line from databases or the Internet; electronic artwork in any media; cinematographic and photographic films; animated films; instructional and teaching apparatus and instruments.

76. *Recordings of music; phonograph records; computer software relating to music; digital music (downloadable) provided from the Internet; cinematographic and photographic films; and animated films* as applied for, may have the same users as for the goods of the earlier mark, however, the uses and nature of the respective goods and their channels of trade all differ. The goods are not in competition nor are they complementary. They are dissimilar goods.

77. *Newspapers, magazines, maps and guidebooks* are items traditionally available in paper form but increasingly available in different formats e.g. either in paper or electronic versions. Electronic versions could be provided on DVD and other recordable media where the material may be presented in visual and/or audio mode. Whilst the nature of goods may differ because of the different media used, the users and uses are the same and the channels of trade may overlap given that the same publishing company may produce their goods in the various formats. Taking all matters into account, I consider these goods to be similar to a low degree to *recordings of sounds and images in any media; audio and video cassettes; compact disks; DVDs; CD ROMs; video recordings (downloadable) provided from the Internet.*

78. *Posters* as is included in the earlier mark will include posters in the form of artwork. *Downloadable artwork provided on-line from databases or the Internet: and electronic artwork in any media* will have the same users and, given that artwork in whichever format are for display, they will have the same uses. The natures of the respective goods differ somewhat in that the posters of the earlier mark are tangible goods whereas those of the applicant are virtual representations of the art but these virtual representations can be and are developed to be printed out or otherwise displayed by the user. The same publishing company may offer its products in the differing formats and to that extent the channels of trade may overlap although the respective goods will not be found e.g. on the same shelf in a supermarket. The respective goods are in competition and I find them to be similar to a low degree.

79. That leaves *instructional and teaching apparatus and instruments* as included within the application. *Newspapers, magazines, posters, maps* and *guidebooks* of the earlier mark are all items which may inform or instruct and thus the respective goods may share the same users and uses. The natures of the respective goods differ. The goods in class 9 will take the form of e.g. tools, devices and kit being equipment whereas the goods in class 16 will be paper articles. The respective goods will not use the same trade channels and they are highly unlikely to appear on the same shelf in e.g. a supermarket. They are dissimilar goods.

**The distinctiveness of the earlier mark**

80. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade 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 and services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

81. As I indicated earlier, the evidence before me is such that I cannot be satisfied that the use made of it had any material effect on the level of distinctiveness of the earlier mark. It is, however, a mark with a reasonable degree of inherent distinctive character.

**Likelihood of confusion**

82. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and 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 on the imperfect picture of them he has retained in mind.

83. Earlier in this decision, in relation to the similarity of the respective goods and services, I found:

<i>Reservation services for hotel accommodation; victualling and banqueting services; and banqueting facilities and facilities for ceremonies for special occasions (CTM771980)</i>	to be similar to a high degree to	<i>Arranging and organising of parties, private functions and corporate hospitality events</i>
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<i>Hotel, bar, banqueting and hotel reservation services (1294338)</i>	to be similar to a high degree to	<i>Arranging and organising of parties, private functions and corporate hospitality events</i>
<i>Newspapers, magazines, posters, maps, guidebooks, all included in Class 16; but not including any such goods relating to European history and art (1521894)</i>	to be similar to a low degree to	<i>Recordings of sounds and images in any media; audio and video cassettes; compact disks; DVDs; CD ROMs; video recordings (downloadable) provided from the Internet</i>
<i>Posters (1521894)</i>	to be similar to a low degree to	<i>Downloadable artwork provided on-line from databases or the Internet; electronic artwork in any media</i>

84. All other goods and services I found to be dissimilar. I found the respective marks to have a reasonable degree of similarity from the visual, aural and conceptual perspectives. I found the earlier mark to have a reasonable degree of inherent distinctive character and could not be satisfied that the use made of it had had any material effect on that level of distinctiveness.

85. Taking all matters into account, and in view of the interdependency principle which I must consider, I do not consider that there will be direct confusion (i.e. where one mark is mistaken for the other). I find however, that there is a likelihood of indirect confusion between the respective marks given the commonality of the word RENAISSANCE in each of the respective mark and in respect of the following services of the application which I have found to be similar to a high degree:

*Arranging and organising of parties, private functions and corporate hospitality events.*

86. With the interdependency principle in mind, I find that there is no likelihood of confusion between the respective marks in respect of the following services of the application which I have found to have a low degree of similarity:



*Recordings of sounds and images in any media; audio and video cassettes; compact disks; DVDs; CD ROMs; video recordings (downloadable) provided from the Internet; downloadable artwork provided on-line from databases or the Internet; electronic artwork in any media.*

87. As a finding that there is a likelihood of confusion necessitates some similarity of the respective goods and services, there is no such likelihood for the remaining goods and services which I have found to be dissimilar.

**The objection under section 5(2)(b) based on earlier mark CTM8799504**

**Comparison of marks**

88. The respective marks to be compared are as follows:

Opponent's earlier mark	Applicant's mark
	

89. The earlier mark consists of a single letter R above the word RENAISSANCE. The letter R is in much larger font than the word that appears below it. Although not a plain block capital, the single letter R is in an unremarkable font. The letter R is the first letter of the word RENAISSANCE but does not have, as far as I have been made aware, any particular meaning in relation to the services for which it is registered and it is, therefore, a distinctive element within the mark. Given its size and position within the mark, it is also a visually dominant element. As indicated above, the word RENAISSANCE is also a distinctive element. The applicant's mark is as described above. The respective marks both, therefore, consist of two elements: the first element consists of, or begins with the letter R, the second element is the word RENAISSANCE. There is a modest degree of visual similarity between the respective marks.

90. From an aural perspective, the single letter R within the earlier mark is unlikely to be articulated: the mark will be referred to as RENAISSANCE. The mark applied for will be referred to as ROCK RENAISSANCE. There is a reasonable degree of aural similarity between the respective marks. To the extent that each of the respective marks could be taken to refer to a revival of some sort, there is a reasonable degree of similarity between them from the conceptual perspective.

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

91. Each of the services of the earlier mark is such as will be used by the general public. Each is a relatively common service which is widely available, though such services will not be an everyday purchase by the user. They are services related, in a broad sense, to fitness and entertainment and are services which will be bought

with some, though not the highest level of care. Whilst many of the services of the application will also be used by the general public, some, such as talent agency services and artist agencies, will be used by those seeking employment in a particular field. Again, they are services which will not be an everyday purchase and some, though not the highest level, of care will be taken in its purchase. For those services where the user is a professional seeking e.g. employment or venues for a performance, a higher level of care (though not the very highest) is likely to be taken given the need to ensure suitability for purpose and the costs and remuneration likely to be involved.

**Comparison of services**

92. The ground of opposition based on this earlier mark was, originally, directed towards each of the applicant’s services insofar as it sought registration for services in classes 41 and 43. Following amendment of the application, the class 43 services have been withdrawn. This earlier mark is not subject to the proof of use requirements and therefore the services to be compared are as follows:

Earlier mark	Application
<p>Health and fitness club services, namely providing instruction and consultation in the field of physical exercise; rental of exercise equipment; providing fitness and exercise facilities; golf club, golf course and golf instruction services; education; providing of training , entertainment, sporting and cultural activities; education and entertainment; arranging conferences; organization of exhibitions for cultural or educational purposes; providing facilities for recreation activities; providing facilities and services for swimming pools and water sports; providing tennis facilities; rental of tennis courts; tennis instruction; providing hotel guests with educational and entertainment information about local attractions and points of interest, and distribution of materials in connection therewith; night clubs; event planning and management services.</p> <p>Hotel services, restaurant, catering, bar and cocktail lounge services, resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; and reservation services for hotel accommodations for others.</p>	<p>Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and music festivals; talent agency services, artist agencies, in particular placement of artists with event organisers; providing artists for orchestra services, for events, for sound and recording studios; booking venues and engagements for persons engaged in the fields of art and the performing arts; organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; arranging and organising of parties, private functions and corporate hospitality events; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet.</p>

93. *Organisation of cultural and musical entertainment events in the fields of art and the performing arts*; as appears in the application will be included within and are therefore identical to, *providing of entertainment and cultural activities and organization of exhibitions for cultural purposes* as covered by the earlier mark.

94. *Organising and conducting shows, displays and exhibitions*; are included within and therefore identical to, *providing of entertainment and cultural activities and organization of exhibitions for cultural purposes* as covered by the earlier mark.

95. *Arranging and organisation of concerts, guest performances and music festivals*; are included within, and therefore identical to, *providing of entertainment and cultural activities* as appears in the earlier mark.

96. *Talent agency services, artist agencies, in particular placement of artists with event organisers*; are very specific services used by artists to manage their career and performances. The nature of the service is to promote and find employment for that artist. They are not in competition with or complementary to any of the services of the earlier mark and I consider them to be dissimilar services to them.

97. *Providing artists for orchestra services, for events, for sound and recording studios*; are, again, very specific and specialist services in the nature of the provision of session musicians which is several steps removed from the provision of e.g. musical entertainment. They are dissimilar services to any of those covered by the earlier mark.

98. Similarly, *booking venues and engagements for persons engaged in the fields of art and the performing arts* are services provided to the performer in order for him to be able to perform to his audience. They are specific and specialist services which are several steps removed from the provision of the performance itself. They are dissimilar services to any of those covered by the earlier mark.

99. *Organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists* are included within, and therefore identical to, *education; providing of training, education and entertainment* as are covered by the earlier mark.

100. *Musical entertainment; discotheque, night club and cabaret services* are all services provided as part of and therefore included within, and identical to, *night clubs* as covered by the earlier mark.

101. *Theatre services* are included within and therefore identical to *entertainment and cultural activities* as covered by the earlier mark.

102. *Arranging and organising of parties, private functions and corporate hospitality events* are included within and identical to *event planning and management services* as covered by the earlier mark.

103. *Entertainment events information* includes *providing hotel guests with entertainment information about local attractions and points of interest, and*



*distribution of materials in connection therewith* as is covered by the earlier mark. The respective services are identical.

104. *Providing interactive information on entertainment events, online from data bases or on the internet* includes *providing hotel guests with entertainment information about local attractions and points of interest, and distribution of materials in connection therewith* and the respective services are, therefore, identical.

### **The distinctiveness of the earlier mark**

105. I set out above the principles to be taken into account when considering the distinctiveness of an earlier mark. With those principles in mind, I note that the evidence relating to the use of this particular earlier mark is somewhat lacking. There is, for example, no evidence of turnover or advertising under the mark nor is there any evidence from the trade. I am unable to establish from the evidence that the distinctiveness of the mark has been enhanced by its use. The mark does have, however, a reasonable degree of inherent distinctive character.

### **Likelihood of confusion**

106. Again, I set out above the principles to be taken into account. I have found the respective marks to have a reasonable degree of similarity from the visual, aural and conceptual perspectives and that the purchase of the services will involve some, but not the highest degree of care. I have found the earlier mark to have a reasonable degree of inherent distinctive character which has not been enhanced through its use. Taking all matters into account and applying the interdependency principles, I find that there is a likelihood of indirect confusion where the following identical services are concerned:

*Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and music festivals; organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; arranging and organising of parties, private functions and corporate hospitality events; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet.*

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

107. Section 5(3) of the Act states:

“ 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 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.

108. A positive finding under section 5(3) of the Act does not rely on the similarity of the respective goods or services although it can be a factor in whether a link is established and whether the relevant heads of damage arise. In order, however, to be successful in an opposition based on section 5(3) of the Act, RHH must prove that each of its earlier marks has a reputation. Reputation in this context means that the earlier trade mark is known by a significant part of the public concerned with the goods or services covered by that mark (see paragraph 26 of the CJEU's judgment in *General Motors Corp. V Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.”

109. For ease of reference I will deal with each earlier mark in turn.

110. Insofar as CTM 771980 is concerned, RHH claims a reputation in this mark in relation to services in classes 35, 39, 41 and 42. RHH was put to proof of use of its mark in relation to services in classes 35, 41 and 42. Whilst RHH was not required to prove use of its mark in relation to services in class 39, it does have to prove, in evidence, that its earlier right has a reputation in relation to these services. No evidence has been filed of any use in relation to these services. That being the case, the claim does not get off the ground and the objection under this ground reliant of services in class 39 is dismissed. In my evaluation of the proof of use of the mark, I found that no such use had been made in relation to any services in class 35 and that is similarly dismissed. In respect of the services for which a reputation is claimed in classes 41 and 42, I found that there had been use of the earlier mark in relation to the following services:

Class 41  
Health clubs

Class 42  
Services relating to hotels, restaurants, bars, cocktail bars, cafes, snack bars, victualling and banqueting services, managing of bars, conference halls; reservation services for hotel accommodation; management services for hotels and restaurants; providing of facilities for exhibitions and conferences; spas; saunas and gyms; banqueting facilities and facilities for ceremonies for special occasions; hotel concierges; hotel services for privileged clients; room hire; providing of facilities for business conferences; providing of convention facilities

111. Whilst I found the evidence of use was sufficient for RHH to be able to rely on the above services in relation to the objection raised under section 5(2)(b) of the Act, I indicated that it was insufficient to enable me to establish the extent to which the mark had been used in relation to each of the services.

112. In relation to hotel services per se, whilst I have been provided with turnover figures for a single year amounting to the not inconsiderable sum of £86m, the evidence does not provide me with any information that shows the size of the relevant markets or RHH's place within it. As RHH had, at most, just 7 hotels open in the UK at any one time this suggests that its market share was very low. There is no evidence from the public or the trade. Whilst there is some evidence of advertising and promotion of the mark, my comments above as to the deficiencies in that evidence, mean that I have been given nothing that will allow me to judge the coverage and extent of that promotion, and certainly it does not enable me to establish what the position might have been at the relevant date. In summary, RHH has not proved that its earlier mark has a reputation such that it is known by a significant part of the public concerned. That being the case, the opposition based on grounds under section 5(3) of the Act and reliant on this earlier mark, falls at the first hurdle.

113. Insofar as CTM 8799504 is concerned, as I indicated above in my consideration of the objection under section 5(2) of the Act, no evidence has been provided to show what use might have been made of this mark. That being the case, the objection founded on section 5(3) of the Act based on this mark similarly fails and is dismissed.

114. Earlier mark no 1294338 is registered in respect of *hotel, bar, banqueting and hotel reservation services*. These services are included within the specification of CTM 771980 which is for the same mark and my comments above are equally applicable here. RHH has not proved that its earlier mark has a reputation such that it is known by a significant part of the public concerned and the objection is dismissed.

115. Earlier mark no 1363498 is relied on insofar as it is registered for services in classes 39 and 41. Earlier in this decision, and in relation to services in class 41, I found that RHH had failed to prove use of the mark. The services as registered in class 39 have not been subject to proof of use. Those services are: *arranging of tours and of cruises; arranging of transportation for travellers; arranging of travel; all included in Class 39*. Whilst not subject to the requirement to prove use of the mark in relation to these services, RHH is required to prove, in evidence, that its earlier right has a reputation in relation to these services. No evidence has been filed of any use of the mark in relation to these services. That being the case, the claim does not get off the ground and the objection under this ground based on this earlier mark is dismissed.

116. Earlier mark no 1521894 is registered in respect of: *Newspapers, magazines, posters, maps, guidebooks, all included in Class 16; but not including any such goods relating to European history and art*. RHH has not filed any evidence of use in relation to any such goods. The objection under this ground based on this earlier mark is dismissed.

## The objections under section 5(4)(a)-passing off

117. Under this ground of opposition RHH rely on use of the two earlier rights. The first of these is the use of RENAISSANCE in relation to ‘hotel, restaurant, catering and related services’. I do not consider RHH can be in any stronger position in relation to this earlier right and in relation to these services than that which I have already considered under grounds brought under section 5(2)(b) and I decline to deal with this further.

118. RHH also rely on the use of COLLECT RENAISSANCE in relation to ‘alarm clocks, iPod docking stations, Bluetooth headsets” and I go on to consider this objection briefly.

119. Section 5(4)(a) of the Act states:

“5.-(4) A trade mark shall not be registered if, or 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 and “earlier right” in relation to the trade mark.”

120. The elements of passing off, often referred to as the classic trinity, can be summarised as :

- (1) Goodwill
- (2) Misrepresentation
- (3) Damage.

121. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341, Lord Oliver summarised the position and stated:

“The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly, he must demonstrate that he suffers, or in a

*quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

122. The material date at which the matter must be judged is the date of filing of the application, i.e. 21 June 2010. In his first witness statement, Mr Kimball states that a range of goods has been offered for sale via the collectrenaissance website mentioned above and, at exhibit 8, provides printouts of pages from this website which show the goods set out at paragraph 118 above. Despite the claim made that the earlier right was first used in the UK in relation to these goods in 2008, there is no evidence to support this. Neither does the evidence establish what the position was at the material date as the only dates shown on the website pages are the dates they were downloaded (5 August 2011). The prices shown on the pages exhibit are given in dollars which is indicative of the use being use in the US. No evidence has been provided of any actual sales of these goods having been made. In all the circumstances, RHH has failed to show it has the requisite goodwill or reputation. That being the case, the grounds of objection founded on section 5(4)(a) of the Act, in respect of these goods, fails.

### **Summary**

123. The opposition brought on grounds under section 5(2)(b) based on earlier marks CTM 771980 and 1294338 succeeds in relation to the following services:

*Arranging and organising of parties, private functions and corporate hospitality events.*

124. The opposition brought on grounds under section 5(2)(b) of the Act based on earlier mark CTM 8799504 succeeds in relation to the following services:

*Organisation of cultural and musical entertainment events in the fields of art and the performing arts; organising and conducting shows, displays and exhibitions; arranging and organisation of concerts, guest performances and music festivals; organising and conducting of workshops, lectures and seminars, all in the field of support of art and artists; musical entertainment; discotheque, night club and cabaret services; theatre services; arranging and organising of parties, private functions and corporate hospitality events; entertainment events information; providing interactive information on entertainment events, online from data bases or on the internet*

125. All other grounds of opposition brought under section 5(2)(b) fail in respect of the following goods and services:

*Recordings of sounds and images in any media; recordings of music; audio and video cassettes; compact disks; DVDs; phonograph records; CD ROMs; computer software relating to music; digital music (downloadable) provided from the Internet; video recordings (downloadable) provided from the Internet; downloadable artwork provided on-line from databases or the Internet;*

*electronic artwork in any media; cinematographic and photographic films; animated films; instructional and teaching apparatus and instruments.*

*Business management, business consultancy, advertising, sales promotion, marketing and agency services in the field of organisation of events and exhibitions of artists and for artists and in the field of art and artists; business management for artists; tour management for artists; public relations; promotion of artists by means of advertising; business inquiries and consultancy, in particular agencies of business contacts and business addresses; organisation of exhibitions and fairs for commercial and advertising purposes; information, advisory and consultancy services relating to the aforesaid services.*

*Talent agency services, artist agencies, in particular placement of artists with event organisers; providing artists for orchestra services, for events, for sound and recording studios; booking venues and engagements for persons engaged in the fields of art and the performing arts.*

126. To the extent that they have been considered, the opposition fails in its totality in respect of grounds brought under section 5(3) and 5(4) of the Act.

### **Costs**

127. Whilst RHH has had some success in these proceedings, the extent of that success is very limited in comparison to the breadth of the opposition it launched and the grounds on which it relied. Its evidence, whilst of some volume, was not well directed to the issues applicable in the proceedings given the number of marks and grounds relied upon. Much of it was in the nature of material simply downloaded from the Internet and which was duplicative in content or which was of no evidential value whatsoever but which is likely to have taken some time for the applicants, through their legal representative, to review in order to establish this. Neither party sought to be heard, a decision being taken from the papers. Taking all matters into account, I consider the applicants are entitled to an award of costs in their favour. I make the award on the following basis:

Preparing a statement and considering RHH's statement:	£200
Considering RHH's evidence:	£500
Written submissions:	£200
<b>Total:</b>	<b>£900</b>

128. I order Renaissance Hotel Holdings, Inc to pay Rachelle Lunnon and Richard Grindy the sum of £900. This sum is to be paid within seven days of the expiry of the

appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of October 2012**

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