

O-143-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2482479  
IN THE NAME OF GLOBAL HOTELS & RESORTS IP BV  
IN RESPECT OF THE TRADE MARK**

**TIARA**

**AND**

**AN APPLICATION (NO 83651) FOR A DECLARATION OF INVALIDITY BY  
MILLENNIUM & COPTHORNE INTERNATIONAL LTD**

## TRADE MARKS ACT 1994

**In the matter of trade mark registration 2482479  
standing in the name of Global Hotels & Resorts IP BV**

**and**

**an application (no 83651) for a declaration of invalidity by Millennium & Copthorne International Ltd**

### **The background and the pleadings**

1) The registered trade mark the subject of these proceedings stands in the name of Global Hotels & Resorts IP BV (“Global”). It was filed on 14 March 2008, was published in the Trade Marks Journal on 16 May 2008, and it completed its registration procedure on 12 September 2008. The trade mark consists of the word TIARA and is registered in respect of various services in classes 35, 36, 43 & 45.

2) On 1 January 2010 Millennium & Copthorne International Ltd (“Millennium”) applied for a declaration of invalidity in respect of the above registration. Invalidation is sought in relation to the following services covered by the registration:

**Class 35:** Hotel management services; management advisory services related to franchising; administering a special benefits programme for frequent travellers; information, consultancy and advisory services relating to the aforesaid services.

**Class 43:** Hotel services, resort lodging services, motel services, provision of accommodation, hotel reservation services; travel agency services for the reservation of accommodation; temporary accommodation services; holiday information and planning relating to accommodation; bar services, public house services, café services, restaurant and snack bar services; catering services; banqueting services; provision of conference facilities; rental of rooms for holding functions, conferences, exhibitions, seminars and meetings; providing facilities for business meetings; information, consultancy and advisory services relating to the aforesaid services.

**Class 45:** Hotel concierge services.

3) The application for invalidation is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Millennium relies upon a single trade mark of which it is the proprietor, namely UK registration 1282048, which consists of the word TARA. Millennium relies on all of the services covered by its earlier mark and it

also made a statement of use (for the purposes of the proof of use provisions<sup>1</sup> that apply to this registration) that the mark had been put to use in relation to all the services registered, which are:

Hotel and restaurant services.

4) Global filed a counterstatement denying the ground of opposition. It put Millennium to proof of use. Only Millennium filed evidence. The matter then came to be heard before me on 18 February 2011. At the hearing Global were represented by Mr Guy Tritton, of Counsel, instructed by Taylor Wessing LLP. Millennium were represented by Mr Jeffrey Parker of Jeffrey Parker & Company.

### **The evidence**

#### *Witness statement of Jeffrey Parker dated 9 August 2010*

5) Mr Parker is Millennium's trade mark attorney. He states that Millennium or its predecessors in business have operated a hotel in Scarsdale Place, Kensington, London since the early 1970s called the London Tara Hotel. He says that it is well established and was acquired by Millennium in 1995. Mr Parker has personal knowledge of the hotel and it has been known to him since the 1980s. Various exhibits are provided in Exhibit JP1 to support this, the exhibit includes:

- i) Two pages from *Building* (which appears to be a trade publication) dated 23 March 1973, about what was then a new hotel. The hotel is referred to as "London Tara Hotel". The name can also be seen in photographs of the hotel. The hotel is referred to as "economy class". The hotel has various facilities including a restaurant.
- ii) A print from LONDONTOWN.COM, a hotel booking website. An entry for "Copthorne Tara Hotel" is shown. The hotel has two onsite restaurants. The hotel is designated a "Mid-Range Chain Hotel". The print was obtained on 9 August 2010.
- iii) A print from what appears to be Millennium's own website. The print relates to "Copthorne Tara Hotel London Kensington". It is designated a 4 star hotel. The print was taken on 9 August 2010. The page has a copyright date of 2010. In addition to the name in text (as above) a logo is used:

---

<sup>1</sup> See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.



- iv) A print from [www.hotelsclick.com](http://www.hotelsclick.com), another hotel booking website. An entry for "COPTHORNE TARA HOTEL LONDON KENSINGTON" is shown. The hotel name has four stars underneath it. It is designated a "Superior First". The print refers to a restaurant and a café. The print was taken on 9 August 2010. At the bottom of the page there is a copyright notice which reads "Copyright © 2005/2008 Hotels Click. All rights reserved".
- v) A print from [www.milesfaster.co.uk](http://www.milesfaster.co.uk), a specialist website for hotels in London. The print relates to "The Copthorne London Tara Hotel". There are a number of references to the hotel in the body of the text which refer to the name: "The Copthorne Tara London". Two restaurants, a café and an "artists' corner" (which serves food) are referred to. The print was taken on 9 August 2010. The text refers to the hotel winning an award in 2006 for "best adapted facilities". At the bottom of the page there is a copyright notice which reads "Copyright © 2002-2010 Milesfaster.co.uk. All rights reserved".
- vi) A print from [www.travelpod.com](http://www.travelpod.com) for London Tara Hotel. This does not appear to be a booking website per se but has links for the checking of rates (via expedia.com). The print was taken on 9 August 2010.
- vii) A print from [www.rainbownetwork.com](http://www.rainbownetwork.com). The print contains an interview with DJ Pete Wardman dated 24 September 2005. Mr Wardman refers to having played at The London Tara Hotel in Kensington. The context of the interview is that this was when his career first started. It is difficult to ascertain exactly when this was.
- viii) A print from [www.conradhotels.hilton.com](http://www.conradhotels.hilton.com). The print contains an article about Mr Clement J Barter, president of Conrad hotels. The article is part biographical. It appears that Mr Barter worked at "London Tara Hotel" when it first opened. The print was taken on 9 August 2010 and contains a copyright date of 2010.
- ix) A print from "OpenSigle at INIST". It is not clear what this website relates to. What is clear is that a conference was held at the "London Tara Hotel" in April 1981.
- x) A print from [www.hotel-assist.com](http://www.hotel-assist.com), a hotel booking website. The hotel is referred to as Copthorne Tara Hotel. The hotel is designated as a 3

star hotel. A restaurant and café are mentioned. The print was taken on 9 August 2010.

- xi) A print from [www.caterersearch.com](http://www.caterersearch.com), a website for the hospitality sector. The print contains a timeline of Millennium's business. From this I can see that Aer Lingus bought the entity "Copthorne Hotels" in 1987 in a "deal that adds the London Tara Hotel to the portfolio". In 1995 CDL Hotels International buys Copthorne Hotels and Millennium is then formed as a subsidiary.

6) Mr Parker then provides details about the clientele of the hotel. He says that many customers come from abroad and do not speak English. He provides some statistics relating to this for the years 2005 to 2009. By way of example, for the first quarter of 2008<sup>2</sup>, the hotel was visited by people from many different countries (around 80). Of these countries, many would have a language other than English as their first language. However, of the 4569 visitors in this period, 1034 came from the UK. Furthermore, 2692 customers are recorded against the entry "NULL"; what this means is not clear.

7) Mr Parker completes his evidence by exhibiting an email (relating to a different trade mark) that Global sent to Millennium before these proceedings were instigated requesting Millennium to withdraw its application on account of the respective marks (TARA and TIARA) being "confusingly similar".

### **The proof of use provisions**

8) As stated in paragraph 3, the proof of use provisions apply to Millennium's earlier mark. An application for invalidation is governed by the provisions of section 47 of the Act, the proof of use parts of which read:

"(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if -

- (a) within the period of five years ending with the date of the application for the declaration 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

---

<sup>2</sup> The first quarter immediately preceding the relevant period.

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)”

9) Section 100 is also relevant which reads:

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

10) Millennium must show that it has made genuine use of its trade mark in the five year period ending on the date of its application for invalidation. The application for invalidation was made on 1 January 2010 so the relevant period is 2 January 2005 to 1 January 2010. In terms of the relevant principles to be applied when determining whether there has been genuine use of a trade mark, I note the judgments of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). It is also worth noting the Court of Appeal’s (“COA”) judgment ([2006] F.S.R. 5) in the latter of these cases after applying the guidance given by the ECJ. From these judgments the following points are of particular importance:

- 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);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), 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 (*La Mer* (COA), paragraph 44).

11) I also note i) *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-39/01 [2003] ETMR 98 where the General Court ("GC") stated:

"47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned."

and ii) *Laboratoire De La Mer Trade Mark* [2002] FSR 51 where Jacob J stated:

"9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted."

12) It is clear from the evidence that the hotel located in Scarsdale Place, Kensington opened for business in the early 70s and was then called “London Tara Hotel”. At some point the hotel was renamed the “Copthorne Tara Hotel” following some group/hotel buy-outs. The evidence suggests that this may have been in 1987 (see point xi of the evidence summary) but this is not altogether clear. It may not have been until 1995 when Millennium was created. Whilst there is doubt as to the exact date, all references to London Tara Hotel are either contained in documents from well before the relevant period or are otherwise historical references. The historical references are described in vii) & viii) of the evidence summary and relate to two people having played/worked in the hotel. It is unsurprising that if the people played/worked at the hotel when it was called the London Tara Hotel then the article (even if the article is more recent) may refer to it by that name. The only exception to this historical use/reference is the document described in vi) of the evidence summary. This is from the travelpod website which refers to the London Tara Hotel. This is a recent print (indeed it comes from after the relevant period) but the nature of the website is not clear. As stated earlier, it does not appear to be a hotel booking website so how the name was generated is not clear. It may have been a mistake or it may not represent how the hotel wished its name to be used. This cannot be regarded as establishing genuine use of the designation London Tara Hotel.

13) Given the above, I agree with Mr Tritton’s submission that the most that can be taken from the evidence is that the name of the hotel during the relevant period was Copthorne Tara Hotel. The reason that I say “the most that can be taken” is because much of the material exhibited to Mr Parker’s evidence consists of current prints obtained after the expiry of the relevant period. Mr Tritton also questioned whether the use by third parties (on booking websites etc) was use by Millennium. This is a not an unreasonable question. The use must be made by Millennium or with its consent.

14) Even setting aside the reliability of the evidence due to the consent issue, there are further problems. The evidence as a whole may support the proposition that a hotel called either London Tara Hotel or Copthorne Tara Hotel has stood at the same address in Kensington since the 1970s onwards. The evidence may support the proposition that during the relevant period it was called Copthorne Tara Hotel. Although the prints were obtained after the relevant period, some do have a degree of historical provenance in terms of the relevant period. One refers to an award the hotel won in 2006 and two prints also carry copyright notices which refer to earlier dates (2005/2008 and 2002-2010). However, what, exactly, these copyright notices refer to is not clear. Whilst the hotel may have been called Copthorne Tara Hotel during the relevant period, there is nothing to demonstrate how Millennium used this name. It is a requirement that the mark be used as registered or in a form which does not alter its distinctive character. Millennium may have, effectively, shielded itself from this as it has not provided a single piece of documentary evidence from within the relevant period. I do not say this is intentional; nevertheless, in this day and age is not too onerous a task



to file archive prints from websites or historical brochures etc. from the records of the company. Millennium has certainly not crossed its t's and dotted its i's in this respect.

15) Even if I were to accept that the designation Copthorne Tara Hotel had been used, a question arises as to whether such use supports the mark as registered which consists simply of the word TARA. To that extent, I must apply the relevant case-law that focuses on what I will describe as the use of "variant marks"<sup>3</sup>. One of the leading cases can be seen in the COA's judgment in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

"43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgement of the Court of Justice in *Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

also of relevance are the comments of Sir Martin Nourse where, at paragraph 12, he stated:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device.

---

<sup>3</sup> I use this expression simply as shorthand. An acceptable "variant mark" would be use of a mark in a form differing in elements but which does not alter the distinctive character of the mark from the form in which it was registered.

However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements....”

16) I also take note of the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark* (O/262/06) and in *REMUS trade mark* (O/061/08). In these cases Mr Arnold undertook a thorough analysis of the relevant case law, including judgments of the ECJ and the GC, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

“33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all....”

17) At the hearing, Mr Parker submitted that the use of TARA in the context of COPTHORNE TARA HOTEL was as a sub-brand. By way of analogy, he compared such use with that of *BIG MAC* as part of *MCDONALD’S BIG MAC*. This argument is less relevant to the traditional variant mark test which focuses on the alteration of distinctive character. The question is more akin to whether both COPTHORNE and TARA are being used as trade marks in their own right but merely positioned next to each other in use. In respect of this, I note that Ms Anna Carboni (sitting as the Appointed Person) in *Orient Express* (BL O/299/08) stated:

“78. If there is a place for the concept of one trade mark having “an independent distinctive role” within another, this is where it belongs. The essence of the argument is that there are some “composite marks” in which one or more elements within them have an independent distinctive role and therefore that use of the composite mark should be considered use of the element within it as well. In the context of section 46, there

would be no need to resort to sub-section 46(2) in such a case, as use of the composite mark would include use of the registered element *per se*.

79. The term “composite mark” in this context is perhaps misleading. Most people would not describe the repeated words BUD-BUDVAR-BUDWEISER as a composite mark, but would see them – as the Court of Appeal said – as separate marks presented adjacent to each other. Similarly, the CFI in Case T-29/04 *Castellblanch SA v OHIM* [2005] ECR II-5309 spoke of “joint affixing of separate marks or indications on the same product”, giving the example in the context of wine products of the name of the winery and the name of the product, and said that “joint use of those elements on the same bottle does not undermine the function of [one of them] as a means of identifying the products in issue”.

80. In *Nestlé*, the ECJ concluded that an inherently non-distinctive trade mark could acquire distinctive character through use under article 3(3) of the Directive, whether it was used (i) on its own, or (ii) “as part of a registered trade mark”, or (iii) “as part ... of a component of a registered trade mark”, or (iv) as “a separate mark in conjunction with a registered trade mark”. The only question of importance was whether, as a result of the use in each case, the relevant class of persons actually perceive the relevant goods or services as originating from a given undertaking.

81. The underlying issue in that case was whether the use of HAVE A BREAK ...HAVE A KIT KAT could have resulted in the element HAVE A BREAK acquiring distinctive character. The question in a non-use context would be whether the use of HAVE A BREAK ... HAVE A KIT KAT would amount to use of the registered trade mark HAVE A BREAK for the purpose of defending a revocation action.

82. I would expect the answer to be that it could do so in theory, but subject to proof on the facts that consumers perceive HAVE A BREAK to be used as an indication of origin, irrespective of the appearance of the additional words. It would be for the proprietor to overcome the practical difficulties of proving this state of affairs. I do not see why the theory should be any different in the case of a logo that contains both words and graphical elements, though the practical difficulties would be at least as great.

83. This is a difficult area, and one which has already been discussed in some detail by Richard Arnold QC in *REMUS*. Luckily, I do not need to take the argument any further in this case because it is too far from a situation where the submission could be made good on the facts. It is clear from my analysis in paragraph 74 above that I do not agree with the proprietor’s contention that the words ORIENT EXPRESS would be perceived as being used independently within the Logo. Additional evidence might have persuaded me of that, but none was available. The

Hearing Officer was thus right to treat the case as one to which section 46(2) applied, and I have already made my decision in relation to that.

18) Whether TARA will be perceived as an indication of origin per se is for Millennium to establish. All it has presented to the tribunal are examples, primarily, of hotel booking websites identifying a particular hotel that can be booked. The hotel is called COPTHORNE TARA HOTEL. There is nothing inherent in this construction to send a main brand/sub brand message. Whilst many hotels are owned by particular groups and that a main brand/sub brand designation may often be used, no detailed evidence has been presented in relation to the COPTHORNE name and its resulting perception as a group name. Strictly speaking, it is not really, in any event, a matter of reputation. It is a matter of the nature of the actual use made. There is nothing in the evidence relating to COPTHORNE TARA HOTEL to lead the public to the perception that COPTHORNE is the name of the hotel group and TARA the name of a particular hotel in that group. The previous use of London Tara Hotel does not help given that the hotel has ceased to be called that name for some time. The only use that may have assisted would have been the stylized version used on Millennium's website. It at least separates the two elements. However, this is just one example of use and it was obtained after the relevant period. There is nothing to show that the name was presented to the public in this way during the relevant period. It is a step too far to infer that this stylised version was presented to the public during the relevant period. This is particularly so when one bears in mind the case-law identified in paragraph 11 above. The use of COPTHORNE TARA HOTEL does not support genuine use of the word TARA alone. For this reason, and for the reasons referred to in paragraph 14, the use conditions have not been met. As a consequence of this, the earlier mark may not be relied upon. The application for invalidation fails on this point alone.

19) Whilst the above finding disposes of the application for invalidation I will, in case I am wrong, go on to give my views on the likelihood of confusion.

### **Section 5(2)(b) of the Act**

20) This section 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.”

21) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

22) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective services are similar, other factors are relevant including:

The nature of the average consumer of the services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

#### The average consumer

23) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on the particular goods or services in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Hotel services (and also the ancillary services listed in Global's application) are used by the public at large. Whilst business users will also use them, this is more akin to a business traveller who is, in any event, part of the general public. I do not consider that any materially different form of consideration will go into the process whether someone is using a hotel for business or for pleasure.

24) Whilst it cannot be ruled out that hotels are, occasionally, used on impulse with someone coming in off the street for a room for the night, I consider, generally speaking, that a stay at a hotel is a planned event. A hotel will normally be booked in advance. The traveller will pay attention to various factors, the location, the room type, the facilities, the price, the rating, reviews etc. The use of a hotel is not a frequent activity, however, it is not, generally speaking, as infrequent a process as buying, for example, a new car. I consider the process of choosing a hotel to stay at to be at least a reasonably considered one, indeed, I consider it to be slightly more considered than the norm, but not of the highest degree of consideration.

25) Mr Parker's evidence refers to the clientele of Millennium's hotel having a predominance of non-English speakers. There are a number of problems with any argument that the average consumer in the UK of hotels is a non-English speaker. Firstly, the statistics provided relate to one hotel only and may not be representative of hotels generally. Furthermore, the statistics provided do not actually support that the client base is non-English speaking. Whilst some visitors come from overseas, the majority come either from the UK or have not been listed in terms of origin (the "null" entry in the statistics). There are also, as Mr Tritton submitted, visitors who come from countries that are English speaking or at least will have a good understanding and knowledge of the English language. For these reasons, the average consumer cannot be considered to be a non-English speaker. On the contrary, it is considered that the average consumer of hotel services in the UK can speak English.

26) In terms of the process for selecting a hotel, in this day and age the average consumer will use the Internet (as per the booking sites in the evidence, or by using the hotel's own website) or may look in brochures etc. However, some bookings may be made orally, perhaps over the telephone or via a travel agent. Visual and aural considerations apply equally.

27) Millennium's earlier mark also covers restaurant services. The average consumer is a member of the general public. Restaurants vary in terms of cost, formality etc. Generally speaking, the degree of care and consideration is no higher than the norm. Having said, I do not consider it a completely casual process either. A reasonable (no higher or lower than the norm) degree of care and consideration will be used by the average consumer. Again, both visual and aural considerations are important.

#### Comparison of services

28) All relevant factors relating to the services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

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

29) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(a) 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.”

30) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“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-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

31) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade”<sup>4</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>5</sup>. However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) 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 meanings attributable to the rather general phrase.”

32) Finally, when comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play<sup>6</sup> even if there may be other services within the broader term that are not identical.

33) Mr Tritton conceded that the following services were similar to those of the earlier mark:

**Class 35:** Hotel management services; information, consultancy and advisory services relating to the aforesaid services.

**Class 43:** Hotel services, resort lodging services, motel services, provision of accommodation, hotel reservation services; temporary accommodation services<sup>7</sup>; bar services, public house services, café services, restaurant and snack bar services; catering services; banqueting services; provision of conference facilities; rental of rooms for holding functions, conferences, exhibitions, seminars and meetings; providing facilities for business meetings; information, consultancy and advisory services relating to the aforesaid services.

**Class 45:** Hotel concierge services.

---

<sup>4</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>5</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>6</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

<sup>7</sup> This term, initially, was not conceded by Mr Tritton, but he reversed his initial argument after I asked him whether such a term would, on a normal interpretation, include providing temporary accommodation in a hotel.



34) Whilst the concession is helpful, I must, in view of the interdependency principle, identify whether the services are identical or merely similar and, also, where similarity is involved, I must assess its degree. Looking firstly at class 43, the core meaning of a hotel service (covered by the earlier mark) is the provision of a room for travellers to stay in. In view of this, I consider the following services to be identical (or at least similar to the highest degree possible): Hotel services, resort lodging services, motel services, provision of accommodation.

35) It is also well-known that hotels provide a number of additional services such as letting out function rooms etc. The users and channels of trade overlap very strongly. I, therefore, consider there to be a reasonably high degree of similarity with: provision of conference facilities; rental of rooms for holding functions, conferences, exhibitions, seminars and meetings; providing facilities for business meetings; information, consultancy and advisory services relating to the aforesaid services.

36) Some of the services demonstrate a clear complementary relationship which is likely to give rise to the consumer believing that the responsibility of the services will lie with the same undertaking. The degree of complementarity is strong, giving rise to a reasonably high degree of similarity in respect of: hotel reservation services; Hotel concierge services.

37) I think there is a lesser degree of similarity with hotel management services as this strikes me as more of a business to business service. Similarity has, though, been conceded. Weighing the relevant factors, there is at least a moderate degree of similarity.

38) That leaves:

“bar services, public house services, café services, restaurant and snack bar services; catering services; banqueting services”

39) These are identical (in the case of restaurant services) or similar to a very high degree (in the case of cafe, snack bar, catering and banqueting services) to the restaurant services of the earlier mark. The purposes, natures, users, channels of trade all overlap and there is a clear competitive relationship. Bar and public house services are similar (to restaurant services) to a reasonably high degree given that they commonly provide food as well as drink and the consumer will often make a choice between going to a restaurant or a bar for a meal.

40) That leaves the services Mr Tritton argued to be dissimilar, namely:

management advisory services related to franchising; administering a special benefits programme for frequent travellers (Class 35)

travel agency services for the reservation of accommodation; holiday information and planning relating to accommodation (Class 43)

41) The attack on “management advisory services related to franchising” was withdrawn by Mr Parker at the hearing. In relation to the remaining services the argument from Mr Tritton was that the services were too remote being, effectively, travel agency type services. Whilst I agree with Mr Tritton that the degree of overlap is not as obvious as with the other services, they all relate, to a degree, to the provision of services to travellers for their holiday/business trip needs. There is often a fine line between a travel agency and a travel company. There may be a degree of similarity with hotel services but it is only of a low degree.

#### Comparison of marks

42) For reference purposes, the competing marks are depicted below:

Millennium’s mark	Global’s mark
<b>TARA</b>	<b>TIARA</b>

43) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

44) In terms of distinctive and dominant components, neither trade mark separates into distinctive and dominant components. They will be seen as single words, the respective words being their only constituent parts.

45) From a visual point of view, both marks are relatively short (4 and 5 letters respectively). Each of the letters contained in TARA are also in TIARA and in the same order, albeit TIARA has the letter I as its second letter. However, the impact of the additional letter is by no means lost in the overall impression of TIARA. In terms of the comparison, I note the comments in *Inter-Ikea Systems BV v OHIM* where it was stated:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the

Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.”

46) The above judgment relates to the words IDEA/IKEA. In the case before me the difference (like IDEA/IKEA) is towards the beginning of the mark (the additional letter I being the second letter of TIARA). There is also the fact that one word is slightly longer than the other. Whilst in IDEA/IKEA the visual difference between a D and a K is quite stark, I still consider the rationale from this case to be good. Mr Tritton conceded that there was a degree of visual similarity. There is, inevitably, some. However, in line with the case-law and the assessment I have made, the degree of similarity is not of a high degree.

47) In terms of aural similarity, similar principles apply. The construction of the marks and the way in which they will be pronounced (TAR-UH against TEA-AR-UH) brings a degree of similarity, but the additional letter I brings a point of difference that will not be lost and gives TIARA an additional syllable compared to TARA. Again, whilst there is some similarity, it is not of a high degree.

48) When considering the issue of conceptual similarity, the following explanation from *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] helpfully sets out the position:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

49) The above is a judgment of the GC, the ECJ has made similar findings on a number of occasions<sup>8</sup>. For a conceptual meaning to be relevant it must be one capable of immediate grasp. A conceptual difference occurs when one mark has a meaning which is not shared by the other. I should, though, be careful not to assume too readily the degree of knowledge that the average consumer may or may not possess<sup>9</sup>.

50) The word TIARA is an English dictionary word for a jewelled semi-circular headdress. In my view, this meaning is obvious and well-known. It is by no means an unusual word. The argument that non-English speakers may not know of the word's meaning is not relevant given my earlier findings in relation to the average consumer. For the average consumer in the UK the word TAIRA has a meaning capable of immediate grasp. The word TARA does not have the same (or even similar) meaning to TIARA. This, in itself, creates a conceptual difference. The position is, though, strengthened by the fact that TARA is a girl's name. Mr Parker did not know of it (although by the end of the hearing he recalled it as the forename of the celebrity Tara Palmer Tomkinson) whereas Mr Tritton did. I am personally aware of the name. It is the average consumer, though, that matters. The name TARA is not the most common of female forenames. However, it does not strike me as a particularly unusual one either. I believe that the average consumer in the UK encountering the word TARA will perceive it as a female forename. TARA, therefore, also has a meaning capable of immediate grasp. This creates a clear conceptual dissonance. Even if I am wrong on that and that TARA were to be perceived as an invented word, there is still, as stated earlier, a conceptual difference.

51) The conceptual counteraction test described above certainly has the capacity to operate here given the clear and specific meaning of one of the marks and the other mark having a different meaning or no such meaning. Given this, my view is that the conceptual divergence between the marks will counteract, to some extent, the visual and aural similarities between them. However, whether such counteraction will avoid a likelihood of confusion is a matter I will come to later.

---

<sup>8</sup> See, for example, Case 361/04P (*Picaro/Picasso*).

<sup>9</sup> See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Chorkee* (BL O-048-08).

### Distinctiveness of the earlier mark

52) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The earlier mark is TARA. As observed earlier, this is likely to be perceived as a female forename. It has no real allusive or suggestive qualities to the services in question. It is of a reasonable degree of inherent distinctiveness. The use filed is not sufficient to enhance the earlier mark's degree of distinctiveness. The hotel has only one location. This factor itself is not fatal, the majority of consumers in the UK will likely have heard of the *Ritz* or the *Savoy*. However, there is nothing to suggest that the hotel in question falls into this category. There is no advertising material other than the various booking/information websites. There is no reason to assume that the mark is known to an extent that it is deserving of an enhanced degree of distinctiveness.

### Conclusions under section 5(2)(b)

53) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

54) I will firstly consider the position in terms of the identical services I identified earlier. If Millennium cannot succeed here then it is in no better position in terms of the other services it has challenged. In terms of the other relevant factors, the marks are not highly similar from a visual and aural perspective and there is a conceptual difference. The earlier mark has a reasonable degree of inherent distinctive character. The degree of care and attention likely to be used by the average consumer is at least of a reasonable degree (restaurant services) but in relation to hotel services a slightly higher degree than the norm.

55) Whilst I must bear in mind the concept of imperfect recollection, it is unlikely, in my view, for this to be particularly significant here. TIARA has a known meaning which forms that mark's conceptual hook. If that concept is stored away then it is unlikely to be misrecalled as the forename (or invented word) TARA. The same operates in reverse in that TARA will be stored away as a forename (or as an invented word) and it is unlikely for it to be misrecalled as TIARA which has a clearly different conceptual meaning. There is, of course, the danger of simply misreading or mispronouncing/mishearing the respective marks. A conceptual difference does not always trump visual and aural similarities as per

the judgment of the GC in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*:

“66 Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

56) However, at least a reasonable degree of care and attention will be used by the average consumer which, combined with the conceptual difference and the fact that the degree of similarity is not at the higher end of the scale militates, in my view, against confusion being caused. Be it for hotel or restaurant services, there is no likelihood of confusion. The application for invalidation is dismissed.

57) I add one point for sake of completeness. Millennium’s evidence contained an email from before these proceedings were initiated in respect of a different conflict whereby Global suggested that confusion may arise. I asked Mr Parker at the hearing whether he was claiming that some form of estoppel was in play. After a brief discussion, Mr Parker confirmed that no form of estoppel was being claimed. I need say no more about this.

### **Costs**

58) Global has been successful and is entitled to a contribution towards its costs<sup>10</sup>. I hereby order Millennium & Copthorne International Ltd to pay Global Hotels & Resorts IP BV the sum of £1500.

Preparing a statement and considering the other side’s statement - £500  
Considering Copthorne’s evidence - £300<sup>11</sup>  
Attending the hearing - £700

59) The above sum should 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 27 day of April 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

---

<sup>10</sup> Costs are normally awarded on the basis of the registrar’s published scale in Tribunal Practice Notice 4/2007.

<sup>11</sup> Whilst this is below the scale minimum, the scale relates to the consideration and filing of evidence – Global did not file any evidence.