

O-011-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3141427 BY
LONDON HOTELS CORPORATION LIMITED TO REGISTER:**



AS A TRADE MARK IN CLASSES 35 & 43

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 406218 BY
GENTING CASINOS UK LIMITED**

BACKGROUND & PLEADINGS

1. On 18 December 2015, London Hotels Corporation Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 15 January 2016 for the following services:

Class 35 - Business management and administration services; Commercial information services; Consultancy services relating to franchising; Advertising, marketing, publicity and promotion services and information services relating thereto; Business administration services for the processing of sales made on the Internet; Communications (public relations); Operation and supervision of loyalty schemes and incentive schemes; International business representation services; Information consultancy and advisory services relating to all the aforesaid services.

Class 43 - Hotel services, motel services, provision of accommodation, hotel reservation services; Temporary accommodation services; Holiday information and planning relating to accommodation; Bar services, public house services, café services, restaurant and snack bar services; Catering services; Provision of conference and convention facilities; Hotel and motel services comprising a rewards programme for frequent hotel guests in the nature of special benefits being accumulated for use in relation to hotel and motel services; Advisory and consultancy services relating to the aforesaid; providing facilities for business meetings, conferences and exhibitions; Provisions of social function facilities for special occasions; Reservation services for hotel accommodation.

2. The application is opposed by Genting Casinos UK Limited (“the opponent”) under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition under both grounds is directed against all of the services in the application with the opponent relying upon all the services (shown below) in the following United Kingdom trade mark registration:

No. 2442689 for the trade mark **PARK LANE MEWS HOTEL** which was applied for on 3 January 2007 and entered in the register on 12 October 2007:

Class 43 - Hotel services; temporary accommodation; services for providing food and drink; restaurant and catering services; food cooking services; serving and provision of facilities for the consumption of alcoholic and non-alcoholic beverages; bar and lounge services; hospitality services; hotel management services; accommodation services; reservation services for accommodation; room hire; provision of facilities for meetings, conferences, exhibitions, events, lectures; provision of temporary office accommodation; information, advisory and consultancy services relating to all the aforementioned services.

The opponent states:

“The mark applied for is visually, phonetically and aurally confusingly similar to the opponent’s trade mark by virtue of the identity of the word elements PARK, LANE and HOTEL(S). We do not believe that the “S” appearing in the applicant’s mark is sufficient to distinguish it from the opponent’s mark.”

The opponent identifies a range of services in class 43 of the application which it considers to be identical to its services in class 43, adding:

“The remainder of the applicant’s services in class 43 are similar to the opponent’s services in class 43.”

In relation to the applicant’s services in class 35, the opponent states:

“The applicant’s services in class 35 are identical to the opponent’s class 43 “Management services” and similar to the opponent’s services in class 43, insofar as they are offered by hotels as complementary services. As a result, members of the relevant public would believe that the services offered by the

applicant under the opposed mark originate, are authorised by, endorsed by, or are connected in trade with the opponent, which would lead the public into erroneously believing that the control over the services in question are in the hands of a single or economically-linked undertaking...”

3. In relation to its objection based upon section 5(3) of the Act, the opponent claims that the similarity between its trade mark and the application is such that the relevant public will believe that they are used by the same undertaking or that there is an economic connection between the users of the competing trade marks. It further states:

In relation to unfair advantage

“The opponent’s mark PARK LANE MEWS HOTEL has been extensively used in the UK since 2001 in respect of all the services for which it is registered. By virtue of its extensive use, the mark PARK LANE MEWS HOTEL has acquired an enhanced distinctive character as well as substantial reputation and goodwill in respect of hotel services and the like.

It is submitted that the use of a trade mark highly similar to the opponent’s mark in respect of identical services amounts to free-riding the reputation, power of attraction and prestige of the opponent’s mark. The opponent’s aura of prestige will be damaged as would its ability of creating an immediate association with its services offered under the mark PARK LANE MEWS HOTEL.

As a result, the applicant will benefit from the investments made by the opponent to establish its earlier mark and maintaining the mark’s image, thus making the applicant’s advertising and marketing activities easier, involving far less risk and financial resources to the applicant in establishing its brand on the market.”

In relation to detriment to reputation

“Use and registration of the applicant’s mark would weaken the opponent’s ability to identify its services, thus amounting to dilution by blurring of the opponent’s earlier mark. In addition, there is a serious risk that the aspirational image of the opponent’s mark, including the characteristics it projects in terms of prestige, quality, and comfort are transferred onto the services provided by the applicant, which stands to damage the distinctive character of the opponent’s mark in all those areas.

The advertising, communication and investment functions of the opponent’s earlier mark are damaged as the images and expectations are transferred onto the applicant’s services, which do not originate from the opponent. The applicant would unfairly benefit from the established selling power of the opponent’s services.”

In relation to detriment to distinctive character

“We discussed above the serious risk of image transfer and the damage this does to the opponent’s mark. The applicant has no due cause for adopting this mark. The applicant’s will enjoy the benefit from the reputation associated with the distinctive character of the opponent’s mark. The opponent keeps a very tight control over the PARK LANE MEWS HOTEL mark to ensure that the services offered under the mark are exclusive and prestigious. If the applicant’s mark is used and allowed to be registered, the exclusivity and selling power of the opponent’s mark will be likely to be diluted.

In addition, the reputation of the opponent’s earlier mark would be diluted by tarnishment and its guarantee function impaired if the applicant’s mark were used in relation to services which are inconsistent with the image of the opponent’s mark or of an inferior quality. There is a serious risk that the detriment to the

distinctive character of the opponent's mark will affect the economic behaviours of the general public, who will no longer associate the opponent's mark with the image of prestige of the services it offers, thus preferring competitor's services over them and resulting in loss of revenues."

4. The applicant filed a counterstatement in which the basis of the opposition is denied. It states:

"The applicant's applied for mark is figurative, and, accordingly, is plainly not confusingly similar to the opponent's registered word mark. In its argument suggesting a likelihood of confusion, the opponent seeks to rely on the presence of the words "PARK", "LANE" and "HOTEL" in the applied for figurative mark, ignoring the fact that each of the words "PARK", "LANE" and "HOTEL", when taken individually, are descriptive/generic and are therefore not capable of distinguishing a UK mark. The applicant's applied for figurative mark is a unique and distinctive "round tree with a shadow" which is not confusingly similar to the opponent's registered word mark.

Whilst the applicant accepts that the services in the application are similar to those covered by the opponent's earlier mark, the applicant notes that many UK hotel businesses operate under a name using one or more of the words "PARK" and/or "LANE" and/or "HOTEL" and that in the vast majority of such cases, members of the relevant public are not confused or are saved from confusion by the presence of a logo."

5. In these proceedings, the opponent is represented by Reddie & Grose LLP and the applicant by Clintons Solicitors. Only the opponent filed evidence; the applicant filed written submissions during the course of the evidence rounds. Although no hearing was sought, the opponent filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind, referring to them, as necessary, below.

The opponent's Evidence

6. This consists of two witness statements. The first, accompanied by eleven exhibits, comes from David Davis, the opponent's Director of Commercial Operations – International Markets. The second statement, accompanied by one exhibit, comes from Erika Coccia, a trade mark attorney at Reddie & Grose LLP; I will return to these statements later in this decision.

DECISION

7. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which read as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) 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.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(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.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark completed its registration process more than 5 years before the publication date of the application in suit, it is subject to proof of use, as per section 6A of the Act. In its Notice of opposition, the opponent states that its earlier trade mark has been used upon all of the services shown above and, in its counterstatement, the applicant asked the opponent to make good this claim.

10. The opponent complied with this request by filing the evidence of Mr Davis (mentioned above). It is at this point in my decision that I would normally consider this evidence to determine whether, inter alia, the earlier trade mark had been used and upon which services. However, in its submissions provided after this evidence had been filed, the applicant stated:

“The applicant does not dispute the opponent’s evidence showing that the opponent owns and has used within the UK, its mark.”

11. The applicant does not, however, state upon which services it accepts the opponent has used its earlier trade mark. However, having reviewed Mr Davis' evidence and bearing in mind the scope of the services upon which the opponent relies (the vast majority of which are typically, in my experience, provided by a hotel), I think it is reasonable for me to proceed on the basis that in the five year period preceding the filing of the application, the applicant accepts that the opponent has used its earlier trade mark upon all the services upon which it relies.

The opposition based upon section 5(2)(b) of the Act

12. I will deal first with the opposition based upon section 5(2)(b) of the Act.

Section 5(2)(b) – case law

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

14. The competing services are as follows:

The opponent’s services	The applicant’s services
<p>Class 43 - Hotel services; temporary accommodation; services for providing food and drink; restaurant and catering services; food cooking services; serving and provision of facilities for the consumption of alcoholic and non-alcoholic beverages; bar and lounge services; hospitality services; hotel management services; accommodation services; reservation services for accommodation; room hire; provision of facilities for meetings, conferences, exhibitions, events, lectures; provision of temporary office accommodation; information, advisory and consultancy services relating to all the aforementioned services.</p>	<p>Class 35 - Business management and administration services; Commercial information services; Consultancy services relating to franchising; Advertising, marketing, publicity and promotion services and information services relating thereto; Business administration services for the processing of sales made on the Internet; Communications (public relations); Operation and supervision of loyalty schemes and incentive schemes; International business representation services; Information consultancy and advisory services relating to all the aforesaid services.</p> <p>Class 43 - Hotel services, motel services, provision of accommodation, hotel reservation services; Temporary accommodation services; Holiday information and planning relating to accommodation; Bar services, public</p>

	<p>house services, café services, restaurant and snack bar services; Catering services; Provision of conference and convention facilities; Hotel and motel services comprising a rewards programme for frequent hotel guests in the nature of special benefits being accumulated for use in relation to hotel and motel services; Advisory and consultancy services relating to the aforesaid; providing facilities for business meetings, conferences and exhibitions; Provisions of social function facilities for special occasions; Reservation services for hotel accommodation.</p>
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In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

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

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

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

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

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases

in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by 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).”

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

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

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

15. As I mentioned earlier, in its counterstatement, the applicant stated that it:

“accepts that the services in the application are similar to those covered by the opponent’s earlier mark...”

16. In its submissions, the opponent notes this admission. It goes further, arguing that all of the applicant’s services in class 43 are identical to its services in class 43, adding that the applicant’s services in class 35 are “highly/similar and/or complementary” to its services.

17. In view of the applicant’s admission, my starting point is that all of its services are similar to at least a low degree to those of the opponent. However, as the degree of similarity between the competing services is a material factor in the assessment of the likelihood of confusion, it remains necessary for me to compare the competing services in more detail.

Class 35

18. As I mentioned earlier, in its Notice of opposition, the opponent stated:

“The applicant’s services in class 35 are identical to the opponent’s class 43 “Management services” and similar to the opponent’s services in class 43, insofar as they are offered by hotels as complementary services...”

In its submissions, it modifies its position, claiming instead that the applicant’s services in class 35 are “highly similar and/or complementary” to its services in class 43. As an example it states:

“7...”business management and advertising/marketing” related services, are general categories of services which fall within the scope of the hotel and hospitality industry.”

19. In approaching the comparison of services, it is important to remind oneself of the comments of Jacob J in *Avnet* when he 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.”

20. The vast majority of the opponent’s services relate to what, in my view, are the “core” services one would normally associate with the operation of a hotel. Although a hotel inevitably uses many of the services in class 35 of the application in the course of its trading activities (advertising for example), that does not make such services similar to hotel services. The nature and intended purpose of the competing services is quite different as are likely to be the undertakings which provide them. The services are clearly not in competition nor, absent evidence to the contrary, is one likely to look to a hotel to provide for, for example, advertising or marketing advice. Similarly, using the words in *Boston*, there is, in my view, no complementarity in the sense that there is a close connection between the opponent’s hotel services and the applicant’s services in this class to the extent that “one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the [services] lies with the same undertaking.” However, in view of the applicant’s admission, I intend to proceed on the basis that all of the applicant’s services in this class are similar to at least a low degree to the opponent’s hotel services.

21. “Hotel management services” appears in in the earlier trade mark’s specification in class 43. There are, however, no management services proper to class 43. As a consequence, I intend to give the words “hotel management services” what I consider to

be their natural meaning. Although there is, in my view, nothing in the opponent's evidence which indicates that it actually provides such services, let alone provides such services to others, as the applicant accepts that the opponent has used its trade mark and as it has not commented upon the scope of the services upon which it has been used, I shall proceed on the basis that the opponent is entitled to rely upon these services and will compare them with the applicant's services in class 35.

22. As "hotel management services" in the earlier trade mark would be included within the general phrase "business management and administration services" in the application, these services are identical on the *Meric* principle. The phrase "hotel management services" is broad enough in my view to incorporate a wide range of activities. For example, one could easily imagine "business administration services for the processing of sales made on the Internet", "operation and supervision of loyalty schemes and incentive schemes" and "information consultancy and advisory services relating to the aforesaid services" being services provided in relation to the management of a hotel or information etc. relating to such services and, once again, identical on the *Meric* principle. The remaining services in the application are, despite its broad nature, much less likely in my view to be included within the phrase "hotel management services" and much more likely to be provided by specific undertakings (an advertising agency for example).

Class 43

23. The earlier trade mark's specification in this class includes a number of broad terms, for example, "hotel services", "services for providing food and drink", "hospitality services" and "accommodation services", terms which, arguably, include many of the services contained in the application in this class. However, for the sake of completeness, I have identified below terms in the earlier trade mark's specification which are either identical to terms in the application's specification or which are broad enough to include terms in the application and which are, on the principles outlined in *Meric*, to be regarded as identical. While I have identified what, in my view, are the most

obvious examples, some terms in the applicant's specification may also be considered to be included within one or more other terms which appear in the opponent's specification.

Both parties' specifications in this class include the identical term "hotel services".

"accommodation services" in the earlier trade mark includes the following services in the application: "motel services" "provision of accommodation", "temporary accommodation services" and "holiday information and planning relating to accommodation";

"hotel services" and "accommodation services" in the earlier trade mark includes "Hotel and motel services comprising a rewards programme for frequent hotel guests in the nature of special benefits being accumulated for use in relation to hotel and motel services";

"reservation services for accommodation" in the earlier trade mark includes "hotel reservation services" and "reservation services for hotel accommodation" in the application;

"bar and lounge services" in the earlier trade mark is identical to "bar services" in the application;

"services for providing food and drink; restaurant and catering services; food cooking services" and "serving and provision of facilities for the consumption of alcoholic and non-alcoholic beverages" in the earlier trade mark includes "public house services", "café services, restaurant and snack bar services" and "catering services" in the application;

"provision of facilities for meetings, conferences, exhibitions, events, lectures" in the earlier trade mark includes "provision of conference and convention facilities", "providing

facilities for business meetings, conferences and exhibitions” and “provisions of social function facilities for special occasions” in the application.

The “advisory and consultancy services relating to all the aforementioned/aforesaid” in the competing specifications are identical.

The average consumer and the nature of the purchasing decision

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. In its submissions, the opponent states:

“8...The services at issue in these proceedings are for the provision of hotel and hospitality services for which the average consumer will be the public at large, as opposed to a specialised public.

9. Looking at how the marks will be encountered, the services at issue are by their very nature most likely to be offered and provided in hotels but are booked

and purchased beforehand and consumers have a range of channels to make these bookings.

14. A consumer's initial interest in a hotel is sparked through a number of different channels including by word of mouth recommendations from previous guests, from e-mails displaying the latest offers and incentive schemes, or by looking online on booking sites either on their smartphone, tablet or other device. They may have read something in the newspapers and magazines a while ago. As a result, we submit that the consumer's level of attention when searching for and booking hotel accommodation is likely to be average and in some cases, low.

15...Switching between search ads, devices and websites is likely to mean that the consumer is relying on what they think they remember as the name of the hotel that they had looked at previously. Their imperfect recollection of the name of the hotel cannot be overlooked..."

26. Although the opponent goes on to provide information it has obtained which it considers supports these conclusions, had it wanted to rely upon this information it should have filed it as evidence at the appropriate stage of the proceedings. As it did not, it will play no part in my considerations. The opponent further states:

"16. Imperfect recollection is also perhaps more relevant in the case of buying hotel rooms because they are usually not regular, frequent purchases. A consumer may visit a particular hotel once and it is many years later they try and remember the name of the hotel when recommending to others, or trying to plan a return visit."

27. In its submissions, the opponent states that the services at issue are "for the provision of hotel and hospitality services" for which the average consumer is "the public at large" as opposed to a "specialised public." Whilst that may be true of the services in

class 43, it is not, in my view, true of the services in class 35 of the application all of which are more likely that not to be directed at business users.

28. As to the manner in which the services in class 43 will be selected, the opponent's submissions point to a combination of visual and aural considerations. I agree, although in my experience, visual considerations are likely to be the principal method by which the services are selected. As to the degree of care the average consumer will display when selecting "hotel accommodation", the opponent suggests this will be "average and in some cases low." When booking hotel accommodation the average consumer will, in my experience, be conscious of factors such as cost, location, amenities etc. all of which point to at least an average degree of attention and in most cases a level of attention somewhat higher than average. The average consumer's attention is, however, likely to be relatively low when selecting, for example, snack bar services and high when selecting a venue for, for example, a wedding.

29. A business user selecting the services in class 35, is likely to do so having researched the services both on-line/in documentation in hard copy and having sought advice from others in business. This points to a combination of visual and aural considerations with, once again, in my view, the visual component of the selection process likely to dominate. Given the nature of the services concerned, their potential impact on the well-being of a commercial undertaking, the sums of money likely to be in play and what may be the long-term nature of the relationships established, all point to a fairly high degree of attention being paid to their selection.

Comparison of trade marks

30. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
PARK LANE MEWS HOTEL	

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

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

32. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

33. In its submissions, the opponent states:

“10. We cannot assume that everyone knows of Park Lane in London. Nor can we assume that the uses of the respective marks are solely in relation to services provided in the Park Lane area of London...”

34. The opponent’s trade mark consists of the words “PARK LANE MEWS HOTEL” presented in block capital letters; it is registered in respect of, broadly speaking, hotel services; in relation to such services the word “HOTEL” has no distinctive character (I return to this point below). In its submissions, the opponent points to the meaning of the word “MEWS” which appears in its trade mark. Although it cites a definition for this word without providing its source, I am satisfied that the meaning it provides i.e. “a building that was used in the past for keeping horses and is now used as a house” will accord with that of the average consumer; considered in isolation, the word “MEWS” also has no distinctive character. I shall return to the words “PARK” and “LANE” in a moment.

35. The applicant’s seeks registration in respect of a range of business services (in class 35) and, like the opponent, broadly speaking, hotel services in class 43. Its trade mark consists of a number of components. The first, is a device presented in varying shades of grey which I note the applicant describes as its “round tree with a shadow.” This device appears at the top of the trade mark, is distinctive and is clearly significant within the context of the trade mark as a whole. Below this device there appears the words “PARK LANE HOTELS” presented in block capital letters in a bold font, followed by the letters TM. Below these words appears the word “LONDON” presented in block capital letters in a much smaller light grey font. Assuming they are noticed by the average consumer, the letters TM would be understood as indicating a trade mark and the word “LONDON” as geographical. Neither the letters TM nor the word “LONDON” have any distinctive character and will make no contribution to the overall impression the applicant’s trade mark conveys.

36. As to the distinctiveness of the words “PARK”, “LANE” and “HOTEL/HOTELS” which appear in the competing trade marks, in her statement dated 19 August 2016, Ms Coccia states:

“4. I have performed a Google search on Google UK pages to see whether hotels or hotel companies in the UK are using a name or a brand encompassing the words PARK, LANE, and HOTEL. I have not investigated for how long these hotels have been in business.

5. My strategy was to use the strings “PARK LANE”, and “PARKLANE” and “PARK LANE HOTEL” and “PARKLANE HOTEL.”

6. I found seven hotels: the Sheraton Grand London Park Lane, the London Hilton on Park Lane, the Four Seasons Hotel London at Park Lane, the InterContinental London Park Lane, the London Marriott Hotel Park Lane, 45 Park Lane, part of the Dorchester Collection, and the Park Lane Mews Hotel [i.e. the opponent].”

37. Attached to Ms Coccia’s statement as exhibit EC1 are printouts obtained in August 2016 from the websites of the undertakings mentioned. The applicant responded to this evidence in its submissions. However, as it referred to the results of a search it had conducted which is not in evidence in these proceedings, like the information provided by the opponent mentioned in paragraph 26 above, the information it has provided will play no part in my considerations. In its submissions, the opponent states:

“39...The witness identified seven hotels all of which refer to PARK LANE in the descriptive sense in that the hotel is on Park Lane, London. These hotel companies do not use the words PARK, LANE and HOTEL in the same structure as the opponent. They rely on their house brands [shown above], which consumers are more likely to remember and recognise...”

38. In its submissions, the applicant states:

“In its argument...the opponent seeks to rely upon the presence of the words “PARK”, “LANE” and “HOTEL” in the applicant’s applied for figurative mark, ignoring the fact that, in this context, each of the words “PARK”, “LANE” and “HOTEL”, whether taken individually or together, are descriptive (i.e. generic) and/or geographic and therefore are not capable of distinguishing a UK mark. Whilst this may not necessarily be the case for all goods and services, it does of course apply to the location-sensitive services such as hotels and other services detailed in the instant application.”

39. The opponent accepts that the majority of the websites referred to by Ms Coccia use the words “PARK LANE” in a purely descriptive/geographical context. Although the opponent goes on to argue that it uses the words “PARK”, “LANE” and “HOTEL” in a different structure, the fact remains that the opponent’s hotel is located at: 2 Stanhope Row, Park Lane, London, W1J 7BS and in its own promotional material it refers to, for example:

“The Park Lane Mews Hotel is a luxury 4 star hotel, located in the prestigious Mayfair district, Park Lane...”

40. The words “PARK”, “LANE” and “HOTEL(S)” may, as the applicant suggests, be “descriptive/generic” when considered individually. Regardless, and notwithstanding the opponent’s submission to the contrary, I am satisfied that the average consumer of the services at issue (be they a member of the general public or a business user), is more likely than not to be familiar with the combination of words “PARK LANE” and when they encounter these words together with the word “HOTEL” or “HOTELS” will construe them as relating to a location in London. That was my initial view of the matter and one which I consider to be more than adequately supported by the opponent’s own evidence.

41. Having reached the above conclusion, I am satisfied that the various words which make up the opponent's trade mark and in particular the words "PARK LANE", do not perform an independent and distinctive role within the trade mark as a whole. Rather, the average consumer will, as the opponent clearly intends, construe the words "PARK LANE" in its trade mark as a reference to the location of its hotel. As a consequence, the overall impression the opponent's trade mark conveys and any distinctiveness it possesses stems from the trade mark as a whole.

42. As to the applicant's trade mark, the overall impression conveyed resides primarily in the device element and the words "PARK LANE HOTELS" each making a roughly equal contribution. However, when considered in relation to all the services in its trade mark, my conclusion in relation to the words "PARK LANE" in the opponent's trade mark apply, as the applicant accepts, with equal force to the words "PARK LANE HOTELS" in its trade mark which, once again, in my view, do not perform an independent and distinctive role within the trade mark as a whole.

43. I now turn to consider the degree of visual, aural and conceptual similarity with the above in mind. Notwithstanding that the opponent's trade mark also contains the word "MEWS" and the applicant's trade mark the device element, the fact that the overall impressions conveyed stems from competing trade marks which share the words "PARK", "LANE" and "HOTEL"/"HOTELS" in the same order, inevitably results in a fairly high degree of visual similarity between them.

44. As it is well-established that when a trade mark consists of a combination of words and figurative elements, it is most likely to be referred to by the word elements, the competing trade marks will, in my view, be referred to as "PARK LANE MEWS HOTEL" and "PARK LANE HOTELS" respectively; aurally, the competing trade marks are similar to a high degree, a conclusion which would not be affected if the word "LONDON" in the applicant's trade mark was verbalised (which, in my view, is unlikely).

45. Finally, the conceptual comparison. As the competing trade marks are likely to convey the concept of a hotel on Park Lane located in a mews or which has mews accommodation and a number of hotels in Park Lane respectively, they are conceptually similar to a fairly high degree.

Distinctive character of the opponent's earlier trade mark

46. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. Not only does the applicant accept that the opponent has used its earlier trade mark, at no point in its submissions does it challenge any aspect of Mr Davis' evidence. As the degree of distinctiveness an earlier trade mark possesses is a material factor in determining the likelihood of confusion, it is, however, necessary for me to consider the use that has been made of the earlier trade mark to establish if its inherent credentials have been built upon and, if so, to what extent. The material date for the purpose of this assessment is the date of filing of the application for registration i.e. 18 December 2015.

48. I shall begin by considering the inherent distinctiveness of the earlier trade mark. As I mentioned earlier, the opponent's trade mark is, in my view, likely to be understood as meaning a hotel on Park Lane located in a mews or which has mews accommodation. It has, in my view, a very low degree of inherent distinctive character. As to the use that has been made of the earlier trade mark, the following points emerge from Mr Davis' evidence:

- Prior to the opponent acquiring the PARK LANE MEWS HOTEL (with all the related Intellectual Property rights) in 2011 (exhibits DD1 and DD2), Chelsfield Partners were the owners, having acquired the business from the Hilton Group in 2005;
- In 2005 a company was established called Park Lane Mews Hotel Limited;
- The hotel has been named PARK LANE MEWS HOTEL since at least 2006 (exhibit DD3);
- Exhibit DD5 consists of printouts obtained from the Wayback Machine Internet archive showing the hotel's website (parklanemewshotel.net) between 2008 and 2014, all of which contain references to the earlier trade mark;
- Exhibit DD6 consists of a printout of sections from the hotel's website mentioned above (downloaded in July 2016) which Mr Davis states describes the services "we currently provide under the mark PARK LANE MEWS HOTEL";
- Enquiries and bookings can be made directly with the hotel or via a range of online accommodation booking websites. Exhibit DD7 consists of printouts downloaded in July and August 2016 from booking.com, hotels.com, tripadvisor.co.uk. expedia.co.uk and letsbookhotel.com all of which refer to the earlier trade mark;
- Restaurant and bar services are offered under the earlier trade mark at the hotel's Stanhope Bar and Restaurant. Exhibit DD8 consists of printouts downloaded in July 2016 from what Mr Davis describes as "some of the largest restaurant review and booking websites" i.e. opentable.co.uk, squaremeal.co.uk, fluidlondon.co.uk, zomato.com and londontown.com. All of the printouts refer to the "Stanhope Bar and Restaurant" and/or "Stanhope Restaurant" and the earlier trade mark. Mr Davis note that zomato.com lists the "Stanhope Restaurant" in the

“Luxury Dining” category with opentable.com describing the restaurant as a “super desirable dining destination”;

- Turnover in the United Kingdom under the earlier trade mark has been as follows: 2011 - £1,172m, 2012 – £3,145m, 2013 - £3,236m, 2014 - £3,381m, 2015 – “in excess of £3m” i.e. at least £13.9m;
- The hotel has been active on LinkedIn since 2008, Facebook since at least 2013 and Twitter since 2011. Exhibit DD11 consists of pages downloaded from these social media platforms in July 2016, all of which contain references to the earlier trade mark;
- Advertising expenditure in the United Kingdom under the earlier trade mark has been as follows: 2011 - £5,174, 2012 - £13,898, 2013 - £26,508, 2014 - £14,366, 2015 - £1,930 – a little under £62k in total;
- The opponent’s hotel has been awarded “The Most Improved Hotel” in The Simply The Guest Awards 2013 and “Top Rated Hotel in London” (by the same organisation) in 2016. Mr Davis explains that The Simply Guest Awards are “awarded by the well-known travel website www.laterooms.com and recognises the best properties around the world on the basis of customer’s feedback and reviews.” He adds that the hotel “has been “Recommended” on HolidayCheck 2015, an award given out, on an annual basis, to the best hotels in the world on the basis of traveller’s reviews” and that the hotel was awarded “Top Choice” on the website www.lianorg.com for the years 2015 and 2016, a professional tourist information website for Asian tourists.” Although no evidence has been filed in support of the above statements, as I mentioned earlier, the applicant has not challenged the opponent’s evidence.

49. The opponent’s evidence indicates that its earlier trade mark has been in use by it or its predecessors in title since at least 2006 and has appeared on its own website

since at least 2008. Printouts obtained from after the material date indicate that the earlier trade mark appears on a range of on-line accommodation and restaurant booking websites. Turnover between 2011 (when the opponent acquired the hotel business conducted under the earlier trade mark) and 2015 amounts to a little under £14m with advertising expenditure in the same period amounting to approximately £62k. The earlier trade mark has appeared on various social media platforms since 2008 and has received a number of awards both prior to and after the material date.

50. The opponent's evidence is not without fault. For example, a number of the exhibits provided are from after the material date, no turnover or advertising figures have been provided prior to 2011 (although the opponent only acquired the hotel business conducted under the earlier trade mark in 2011, it is likely that, at the very least, estimates could have been provided) nor has any indication of the size of the market in which the opponent competes. In relation to the latter, my own experience tells me that the size of the hotel market in the United Kingdom is substantial as are the London hotel/London luxury hotel markets.

51. However, considering the totality of the evidence provided, it is clear that prior to the filing of the application in 2015, the earlier trade mark has been used in relation to the vast majority of the services for which it stands registered with, inter alia, the turnover achieved between (at least) 2011 and 2015 and a number of the awards mentioned, attesting to the success of the hotel business conducted under the earlier trade mark. Whilst it would be unrealistic for me not to accept that this use will have built upon the earlier trade mark's inherent distinctiveness, without even an approximation of the size of the relevant market in which it operates, I am unable to gauge with any confidence the extent of any enhancement. With that in mind, I find that on the balance of probabilities, the extent of the opponent's use is likely to have elevated the distinctive character of the earlier trade mark from very low to average.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- Whilst some of the applicant's services in class 35 are to be regarded as identical to the opponent's "hotel management services", all of the applicant's services in class 35 are to be regarded as similar to the opponent's services to at least a low degree;
- The competing services in class 43 are identical;
- The average consumer of the services in class 35 is more likely than not to be a business user whereas the average consumer of the services in class 43 is a member of the general public;
- Both sets of average consumers will select the services at issue by a combination of visual and aural means, with the visual component likely to dominate;
- When selecting the services in class 35 the average consumer will pay a fairly high degree of attention;

- When selecting the services in class 43 the average consumer's attention will range from low to high;
- The overall impression conveyed by the opponent's trade mark stems from the trade mark as a whole;
- The overall impression conveyed by the applicant's trade mark stems from a combination of the device component and the words "PARK LANE HOTELS" each making a roughly equal contribution;
- The words "PARK LANE" (in particular) do not perform an independent and distinctive role within either party's trade mark;
- The competing trade marks are visually and conceptually similar to a fairly high degree and aurally similar to a high degree;
- While the opponent's earlier trade mark is possessed of a very low degree of inherent distinctiveness, the use that has been made of it since at least as early as 2006 is, on the balance of probabilities, likely to have enhanced its distinctive character rendering it distinctive to an average degree.

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

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

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

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

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

54. In reaching a conclusion, I shall begin by considering the position on the basis most favourable to the opponent i.e. that all of the services are identical, the average consumer will pay only a low degree of attention to the selection of the services at issue (thus making them more prone to the effects of imperfect recollection) and the earlier trade mark is distinctive to a high degree. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 Mr Iain Purvis Q.C. as the Appointed Person Pointed out that the level of

'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

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

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

55. Although the competing trade marks share the words “PARK”, “LANE” and “HOTEL(S)” in the same order, even if one proceeds on the basis that the opponent’s use has made its earlier trade mark highly distinctive, any enhanced distinctiveness would lie in the trade mark as a whole and not in either the individual words or a combination of these words. As none of these words perform an independent and distinctive role in either parties’ trade mark, the average consumer will not rely upon them to indicate origin. Rather, the average consumer will rely upon the overall impressions the competing trade marks convey for this purpose. Having reached that conclusion on the basis most favourable to the opponent, it follows that the position is even starker when my actual conclusions are applied to the matter.

Conclusion under section 5(2)(b)

56. For the reasons indicated above, the opposition based upon section 5(2)(b) fails and is dismissed accordingly.

The objection based upon section 5(3) of the Act

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

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

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

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

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

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

58. I begin by noting that the applicant makes no claim to any defence based upon “due cause”.

59. The trade mark upon which the opponent relies under section 5(3) of the Act is a United Kingdom registration. In order to get an objection based upon section 5(3) of the Act off the ground, the opponent must first establish that its earlier trade mark is known by a significant part of the relevant public in the United Kingdom. In this regard, I have already commented upon the opponent’s evidence when I considered the distinctive character of its earlier trade mark (paragraph 51 refers). On the basis of the evidence provided and my conclusions upon it, I am prepared to accept that the opponent’s use since (at least) 2006 in relation to hotel services is likely to be sufficient to form the basis of a claim under section 5(3) of the Act. As to the nature of this reputation, the opponent’s evidence indicates that it is a “luxury 4 star hotel located in the prestigious Mayfair district Park Lane.”

60. Having established the necessary reputation, the opponent must also satisfy me that when confronted with the applicants’ trade mark the average consumer will make a link with its earlier trade mark; such a link is made if on seeing the applicants’ trade mark the average consumer calls the opponent’s trade mark to mind. In reaching a conclusion on this point, I must bear in mind factors such as the degree of similarity between the competing trade marks, the degree of similarity in the competing services, the distinctive character of the earlier trade mark and the strength of the earlier trade mark’s reputation.

61. Having already concluded there will be no likelihood of confusion because the words the competing trade marks have in common do not perform an independent and distinctive role, I see no reason why on seeing the applicant’s trade mark the opponent’s trade would be called to mind. Without the necessary link, the objection based upon section 5(3) cannot succeed and is dismissed accordingly.

Overall conclusion

62. The opposition has failed on both grounds and, subject to any successful appeal, the application will proceed to registration.

Costs

63. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement:	£300
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Considering the opponent's evidence (including filing written submissions):	£500
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Total:	£800
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64. I order Genting Casinos UK limited to pay to London Hotels Corporation Limited the sum of **£800**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of January 2017



C J BOWEN
For the Registrar