

**BL O/150/22**

**ON APPEAL FROM THE UK INTELLECTUAL PROPERTY OFFICE**

**Monday, 14th February 2022**

**Before:**

**MR. GEOFFREY HOBBS QC  
(Sitting as the Appointed Person)  
(VIA MS TEAMS)**

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**In the matter of the Trade Mark Act 1994 (as amended)**

**- and -**

**In the Matter of UK Trade Mark Registration No. UK000034540583 in the name of  
Mohammad Hadi Rajabi for the Trade Marks TRANSFORM DENTAL and  
TRANSFORM WHITENING (as a series of two) in Classes 3 and 44  
("the Appellant")**

**- and -**

**In the Matter of an Application for Invalidity in relation thereto under No. 503376 by  
Transform Hospital Group Limited  
("the Respondent")**

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**In the Matter of an Appeal in front of  
the Appointed Person Mr. Geoffrey Hobbs QC**

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**(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,  
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**THE APPELLANT appeared in person.**

**THE RESPONDENT did not appear and was not represented.**

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**APPROVED DECISION**

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THE APPOINTED PERSON:

1. Trade mark number 3454058 was registered in the name of Dr. Mohammad Hadi Rajabi on 9 August 2020 with effect from 25 December 2019. The registration protected the designations TRANSFORM DENTAL and TRANSFORM WHITENING as a series of two trade marks for use in relation to “Teeth whitening preparations” in Class 3 and “Teeth whitening services; dental clinic services” in Class 44. The marks were registered in series on the premise stated in section 41(2) of the Trade Marks Act 1994:

“ A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

2. It is clear and I believe it stands accepted for the purposes of the present proceedings that the suffixes DENTAL and WHITENING are basically explanatory in relation to goods and services of the kind for which the marks were registered.
3. On 7 October 2020, Transform Hospital Group Limited applied under No. 503376 for a declaration to the effect that the trade mark registration was and remained invalid for impinging upon the rights to which it was entitled under section 5(2)(b) of the 1994 Act as proprietor of the earlier trade mark TRANSFORM registered under number 2262125, with effect from 22 February 2001, for use in relation to “Medical services; cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services” in Class 44.

4. In his Form TM8 and counterstatement filed in defence of the registration, Dr Rajabi required proof of use of the cited earlier trade mark. In answer to the claim for invalidity he maintained:

“We have only the ‘Transform’ word in common with them. Both full names are different, services we provide are different and so no conflict of interest.”

5. The applicant for invalidity filed evidence both in response to the proprietor’s request for proof of use and in support of its position with regard to its claim for invalidity of the registration in issue. The proprietor filed submissions which may have been intended to be evidential in nature. However, these were not provided in a form acceptable for filing as evidence and he was informed by the UK IPO that the documents would not be admitted as evidence in the pending proceedings. Neither side requested a hearing and the claim for invalidity proceeded to a determination on the basis of the papers on file.
6. The registration in issue was declared invalid for the reasons given by Ms Laura Nicholas in a decision issued on behalf of the Registrar of Trade Marks under reference BL O/585/21, on 5 July 2021. The proprietor was ordered to pay £1,100. to the applicant for invalidity in respect of its costs of the Registry proceedings.
7. Having carefully examined the evidence filed in response to the proprietor’s response for proof of use, the Hearing Officer concluded in paragraph 50 of her decision that the cited earlier trade mark should be deemed registered for “Cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services” in Class 44. There is no appeal against her decision to that effect.

8. Shortly stated, the question for determination by the Hearing Officer under section 5(2)(b) of the Act was whether there were similarities in terms of marks and goods or services that would have combined to give rise to the existence of a likelihood of confusion if the marks in issue were used concurrently for goods or services of the kind for which they were respectively registered and deemed registered. The relevant date for the purposes of the assessment was 25 December 2019.
9. The Hearing Officer directed herself fully and correctly as to the applicable legal principles in paragraphs 51 to 57, 63 to 65, 69, 70, 79, 80, 83, and 84 of her decision.
10. Her reasoning and conclusions are sufficiently apparent for present purposes from paragraphs 59 to 62, 66 to 68, 72 to 78, 82 and 85 to 89:

59. The applicant's services are 'cosmetic surgery and treatments' and the proprietor's marks are registered for 'teeth whitening services'. Teeth whitening is considered to be a type of cosmetic treatment and therefore, applying the *Meric* principle, I find these services to be identical.

60. Regarding the Class 3 goods in the proprietor's registration, I would consider that the average consumer of the goods and services at issue might reasonably expect 'teeth whitening preparations' to be provided by the same undertaking that offers 'teeth whitening services' as it will need those preparations in order to provide the services. In my opinion, channels of trade, users and purpose are the same. As I have found the applicant's 'cosmetic surgery and treatments' to encompass the 'teeth whitening services' found in the proprietor's registration, I find there would also be complementarity between 'cosmetic surgery and treatments' and 'teeth whitening preparations' and I therefore find them to be similar to a medium degree.

61. Next I will consider the proprietor's 'Dental clinic services'. I believe that this is a wider classification covering all different types of dentistry including forms of cosmetic dentistry. I therefore believe that 'Dental clinic services' would be similar to at least a medium degree to 'Cosmetic surgery and treatments' which encompasses cosmetic dental surgery and treatments.

62. I have therefore found the proprietor's Class 3 goods to be similar to a medium degree and the Class 44 services are similar to at least a medium degree for the 'Dental clinic services' and identical for the 'Teeth whitening services'.

[...]

66. I consider that the average consumer for ‘cosmetic surgery and treatments’ would be a member of the general public mostly likely with a specific concern about aspects of their appearance. These treatments could vary from injections and minor surgical procedures to more major open surgery. The treatments will usually be expensive, as can be seen in the sample invoices averaging several thousand pounds although some of the non-surgical treatments may be lower in price and would likely not be a regular purchase or perhaps even a one off event. As with any medical procedure, these treatments and surgeries carry a degree of risk. The average consumer is likely to view the information on a website or via a brochure/pamphlet. There may be consultations with the practitioner prior to a final decision being undertaken. I would therefore consider the average consumer would pay a high degree of attention when purchasing these services.

67. In relation to teeth whitening preparations, I believe that there would be both professional consumers and members of the general public. In either case, the level of attention in selecting these goods will need to encompass factors relating to suitability, quality and safety considerations especially in relation to patient wellbeing. The price point is likely to be lower than the above surgeries and treatments but higher than every day purchases like groceries or toiletries and they have the potential to be recurring purchases. Again, I believe the purchasing process will involve viewing the products on a website or in a brochure. I do not discount the potential for the marks to [be] spoken, particularly by medical professionals when making a purchase from a catalogue, over the telephone. I consider that the average consumer would pay at least a medium degree of attention when purchasing these goods.

68. Finally, in relation to ‘Teeth whitening services; Dental clinic services’ once again, the average consumer would likely be a member of the general public mostly likely with a specific concern about their dental health or appearance. The services could range from basic dental check-ups up to dental surgery, whether for cosmetic reasons or health reasons, again these would have potential risks associated with them. The price of these services is likely to range from relatively low to very high. As above, the average consumer is likely to view the information on a website or via a brochure/pamphlet. There may be consultations with the practitioner prior to a final decision being undertaken. I therefore consider the average consumer would pay a high degree of attention when purchasing these services.

[...]

72. The earlier mark comprises a single word which could be said to have an allusive quality within the context of the services at issue, e.g. the idea of transforming the way you look by cosmetic surgery. The overall impression lies solely within the word.

73. The contested marks also contain the word 'TRANSFORM' with the addition of the words 'DENTAL' and 'WHITENING' respectively. Both of these additional words may be said to be descriptive of the services offered by the proprietor. As such, both words can be said to play a lesser role in the mark and therefore it is the word 'TRANSFORM' which can be said to be the more distinctive aspect of each of the contested marks. No single element can be said to dominate the contested marks however the word 'Transform' does constitute the initial element. As the words 'Dental' and 'Whitening' are descriptive of the services provided by the applicant it is the word 'Transform' that plays the greater role in the contested marks and that is where the overall impression lies.

74. Comparing the marks visually, all contain the word 'TRANSFORM' with the applicant's mark wholly contained within, and forming the beginning of, the proprietor's marks. The proprietor's marks also contain the words 'DENTAL' and 'WHITENING' which are placed at the end of the respective marks and these additions represent approximately half of the proprietor's mark.

75. I remind myself of the comments of Mr Iain Purvis QC, sitting as the Appointed person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation* case BL O/281/14 who found that: 'It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark.

76. I therefore acknowledge that all the above marks may be presented in any font, sizing, or combination of upper and lower-case fonts. When considering notional and fair use, it is also true that the proprietor's marks may be used in the same or a similar font, colour, or style to the applicant's mark. Taking all the above into account, I therefore find that these marks are visually similar to at least a medium degree.

77. The competing marks are aurally similar to the extent that the first words of the proprietor's marks will be pronounced identically to the applicant's earlier mark. It is possible that the further verbal elements of 'DENTAL' and 'WHITENING' in the proprietor's marks may not be articulated by the average consumer as to them they are likely to be perceived as describing the services. For the consumer that will not articulate those secondary elements, the marks are aurally identical. Where it is the case that either of the second elements are articulated then the marks can be said to be aurally similar to at least a medium degree.

78. All three marks contain the word Transform which conveys the concept 'to alter or be altered radically in form, function, etc.' The additional elements in the two marks of the proprietor 'DENTAL' - things that relate to teeth or to the care and treatment of teeth - and 'WHITENING' - the act or process of making or becoming white - will be commonly understood by

their dictionary definitions and serve to provide a description of the services provided by the proprietor. When ‘DENTAL’ and ‘WHITENING’ are read together with ‘TRANSFORM’, the concept that comes to mind is the transformation of someone’s dental health or appearance- therefore, the concept here would be slightly more specific than the term ‘TRANSFORM’ on its own. The words ‘dental’ and ‘whitening’ will both be understood to relate to services or treatments that change, enhance, or improve the appearance. I therefore find the marks to be conceptually similar to a medium degree.”

[....]

82. The applicant’s mark consists of the word ‘TRANSFORM’ which can be said to be an ordinary dictionary term that will be readily understood. The word does not directly describe the services being provided however it could be said to be suggestive of the transformative qualities associated with cosmetic surgery. Therefore, the applicant’s earlier mark can be said to be inherently distinctive to no more than a medium degree.”

[...]

85. To determine whether there is a likelihood of confusion, I must bear in mind a number of factors. I have found the marks to be visually similar to at least a medium degree, aurally similar to at least a medium degree or identical and conceptually similar to a medium degree. The goods and services at issue are identical, similar to at least a medium degree, or similar to a medium degree. I have also found the earlier mark to be inherently distinctive to no more than a medium degree.

86. I am satisfied that although I have found that the average consumer, be that a professional or a member of the general public, would be paying a high degree of attention when selecting the goods and services at issue, the similarities between the marks and the goods and services are sufficiently high so as to counteract that attention level. I therefore find that the average consumer will mistake one of these marks for the other and consequently there is a direct likelihood of confusion between these marks.

87. In making my assessment, I have kept in mind 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.

88. In the event that I am found to be wrong in my finding of direct confusion, I will now consider the likelihood of indirect confusion and I take guidance again from Mr Purvis in *L.A. Sugar Limited* where he stated:

“17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume

that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a subbrand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example)....

89. It is clear that the proprietor’s marks would fall under the second category, the addition of a non-distinctive element expected of a brand extension. The words ‘DENTAL’ and ‘WHITENING’ are both descriptive of the services offered and therefore would be the type of wording expected in a sub brand or brand extension of the primary ‘TRANSFORM’ brand of the applicant. I therefore find there would be indirect confusion between the marks.

11. The proprietor contends on appeal before me that the Hearing Officer’s decision was wrong and should be reversed on the grounds identified in his Form TM55P Notice of Appeal:

“Unfair decision as applicant, Transform Hospital Group, are in a separate industry, separate CQC registrations, no history of confusion amongst customers, no permission to carry out dentistry treatment & most importantly, our trade mark is totally different “Transform Dental” & “Transform Whitening”, both very clear what they are explaining for the product/treatment/industry.”

With particular reference to the arguments addressed to me at this morning’s hearing as to the difference between the marks, I must emphasise that paragraphs 72 to 78 of the Hearing Officer’s decision explain why they fall to be regarded as similar despite the differences due to the presence of the words DENTAL and WHITENING in the proprietor’s marks.

12. In support of his appeal the proprietor sent the Tribunal a witness statement with ten exhibits numbered JS1 to JS10, on 4 February 2022 attached to an email with the subject

heading “Requested skeleton argument”. This was done without permission to put the material in evidence. I have looked at it. The witness statement goes into matters which could have all have been the subject of evidence put forward for consideration by the Registrar at first instance if the proprietor had taken steps to prepare and file it in the required manner when given the opportunity to do so. They do not appear to me to be matters which can fairly be raised in evidence for the first time at this stage of the proceedings. Letting the evidence in would effectively return the parties to the position they were in during the evidence rounds before the Hearing Officer delivered her decision.

13. I can see no justification for setting any such process in train. Still less can I do so in circumstances where the aim and objective of it from the proprietor’s point of view would be for the claim for invalidity under section 5(2)(b) to be determined by reference to the specifics of the context and manner in which he has actually been using the marks in question in relation to the services of his dental clinic based in Wilmslow, Cheshire and the specifics of the context and manner in which the applicant for invalidity has actually been using its earlier trade mark.
14. It is settled law that the required comparison for the purpose of determining an objection under section 5(2)(b) is between the list of goods and services of the earlier trade mark registration as written (or, as in the present case, deemed written) and the list of goods and services of the contested trade mark registration as written, in each case taking account of all the ways in which goods and services of that kind may be offered under the relevant trade marks. This means that the objection can succeed on the basis of what may constitute a ‘paper conflict’ rather than a ground-level collision between the commercial activities of the parties.

15. The Hearing Officer would have erred substantially in her approach to the case if she had dealt with it in the manner for which the proprietor contends. She adopted the correct approach in point of law, and I am satisfied, having reviewed the evidence and considered her decision, that it was open to her on the evidence and materials before her to come to the conclusions she did for the reasons she gave.
16. For the reasons I have given, I refuse permission for the evidence sent to the Tribunal on 4 February 2022 to be admitted and I dismiss the appeal.
17. I have no reason to believe that the applicant for invalidity has incurred any, or any significant, costs in defence of the Hearing Officer's decision on this appeal. The appeal is therefore dismissed with no order for costs. The Hearing Officer's order for costs remains in place. That is my decision on this appeal.

**(Proceedings continued, please see separate transcript)**

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