BLO/168/22

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

IN THE MATTER OF UK Trade Mark Registrations

3029024 'HARLEY'
3013723 'HARLEY HOSPITAL / HARLEY HOSPITAL (stylised) (series of two)'
3013725 'HARLEY PAEDIATRICIAN'
3025580 'HARLEY DENTIST' and
3025581 'HARLEY GYNAECOLOGIST'

in the name of Harley Hospital Ltd

-and-

IN THE MATTER OF Consolidated Applications for Declaration of Invalidity CA000502887, CA000502888, CA000502889, CA000502890 and CA000502891

by 16HARLEYCO LIMITED

APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF LEISA DAVIES, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF TRADE MARKS DATED 19 JULY 2021

DECISION OF THE APPOINTED PERSON

Introduction

1. This is an appeal from the Decision of Leisa Davies on behalf of the Registrar in a series of Applications for Declarations of Invalidity of marks held by Harley Hospital Limited. The marks are as follows:

   3029024 'HARLEY'
   3013723 'HARLEY HOSPITAL / HARLEY HOSPITAL (stylised) (series of two)'
   3013725 'HARLEY PAEDIATRICIAN'
   3025580 'HARLEY DENTIST' and
   3025581 'HARLEY GYNAECOLOGIST'

2. The marks were registered for a range of goods and services including in particular medical goods and services. The grounds of invalidity relied on were under s3(1)(b), s3(1)(c) and s3(1)(d), but the underlying point behind all of them was the contention that the word Harley, when used in connection with medical services, lacked distinctive character because Harley Street is synonymous with the provision of those services.

3. The Hearing Officer upheld the applications for declarations of invalidity under s3(1)(b) (devoid of distinctive character) and s3(1)(c) (descriptive of the characteristics of the goods and services provided under the mark) in relation to all the marks insofar as they were registered for goods or services of the kind which would be expected to be provided by medical, surgical, dental, paediatric and gynaecological practitioners (ie those who might be expected to practise in Harley Street). Insofar as the marks were registered for other goods and services, they were upheld.

4. The proprietor, Harley Hospital Limited, appeals that Decision and is represented before me by Mr Julian Stobbs. The Respondent, 16HarleyCo Limited, is represented by Mr Ed Cronan.

5. By way of Appeal, Mr Stobbs relies on two grounds. First he said that the Hearing Officer had 'taken judicial notice' not only of the fact that Harley Street is well-known to the general public as a place where high quality medical services are provided (something which was denied at the hearing before her) but also of the 'fact' that the word Harley itself will be equated to Harley Street in the mind of the average consumer. Whilst he now accepted that the Hearing Officer was entitled to take judicial notice of the first, he said that she was not entitled (without evidence) to do so of the second.

6. The second ground is that in any event the Hearing Officer's conclusion was flawed because there was no adequate basis for a conclusion that the average consumer would equate Harley with Harley Street to such an extent that they would immediately perceive Harley (when used as part of

the trade marks and in relation to the goods and services in issue) as carrying a geographical or descriptive meaning.

7. I will deal with these two grounds in turn.

The 'judicial notice' argument

8. Before turning to the detail of the point taken in relation to the Hearing Officer's decision, it is worth making a few general remarks.

9. It is of course clear that a tribunal may 'take judicial notice' of a fact which is so well-known that no evidence is necessary to establish it. In reality, tribunals constantly take 'judicial notice' of unremarkable or self-evident facts as part of their evaluation of issues without anyone really noticing that it is happening at all.

10. In the context of trade marks, for example, it is necessary (as part of the overall assessment of likelihood of confusion) to take into account the degree of care likely to be taken over a purchase. A submission that a high degree of care is likely to be taken when buying an oboe (as opposed to, say, a packet of processed cheese) would not normally be challenged. However, if the representative making that submission were to be asked to give reasons for it, the answer would presumably be some combination of the following propositions: (i) oboes are expensive items, (ii) people tend to take more care when buying expensive items, (iii) oboes are normally purchased by musicians, (iv) musicians care a lot about the instruments they play. All those propositions are factual, but it would be unreasonable to reject them on the basis that no evidence had been provided. This is because the propositions are obviously true to any normal person with experience of the world. It would be impossible to operate a legal system without being able to proceed on this basis.

11. All this is well established, and for the purposes of this Decision it is not necessary to consider how to define the boundary between facts which can

be assumed to be true as a matter of judicial notice and those which cannot. This issue has been usefully and comprehensively considered by Daniel Alexander QC sitting as the Appointed Person in O2 Holdings Plc [2011] RPC 22, paragraphs 39-52 and more recently by Phillip Johnson sitting as the Appointed Person in Brewdog O-048-18 paragraphs 12-18.

12. The point which arises in the present case is more fundamental – namely the distinction between taking judicial notice of facts and drawing judicial conclusions from facts. Here, Mr Stobbs sought to persuade me that the decision of the Hearing Officer in this case that HARLEY (if used in relation to medical services) would be understood by the average consumer as shorthand for 'Harley Street' was an exercise in taking judicial notice, and (because the answer was not self-evident) could not be reached without evidence. In this respect he heavily relied on certain other paragraphs of the Brewdog decision (in particular paragraphs 8-11 and 21-24).

13. The Brewdog case concerned *inter alia* the question of whether the mark applied for (ELVIS JUICE) would, when used in relation to beer, be likely to cause confusion with the mark ELVIS registered for beer. One of the findings of the Hearing Officer was that the ELVIS element (in both marks) would be understood by the average consumer of beer as a reference to the singer Elvis Presley.

14. The relevant passage in Brewdog is worth setting out in full:

8. Ms Michaels submits that the Hearing Officer was not entitled to take judicial notice of certain facts regarding Elvis Presley and the mark ELVIS. The relevant part of the Hearing Officer's decision is at paragraph 35:

> *I can deal with Mr Hicks' point about the degree of knowledge of Elvis Presley fairly quickly. Put simply, and notwithstanding that Mr Presley died nearly 40 years ago, he was/is such an iconic figure, that I would be very surprised if many people (including those at the younger end of the average consumer age spectrum) had not heard of him. There may be some exceptions, but this is likely to be few and far between. The mark is, though, Elvis not Elvis Presley. However, on the basis that Elvis is a relatively uncommon name, and given that Mr Presley is the most famous of Elvises, I consider that most average consumers, on seeing the name Elvis alone, are likely to conceptualise that on the basis of Elvis Presley.*

9. Ms Michaels accepted that the Hearing Officer was entitled to take judicial notice of the fact that Elvis Presley was a very famous singer. Notice was taken of the same fact twenty years ago by Laddie J in Elvis Presley TM [1997] RPC 543 at 545 and similarly on appeal [1999] RPC 567. While twenty years have passed and fame diminishes, Ms Michaels does not seek to challenge the finding that the name Elvis Presley is well-known as that of the now deceased singer.

10. She took issue with the judicial notice being take on other facts, namely that when seeing the name Elvis (as an unusual name) the average consumer is likely to conceptualise that on the basis of Elvis Presley.

11. Ms Michael also suggests that the finding by the Hearing Officer that consumers would 'conceptualise' Elvis as referring to Elvis Presley was not a finding of fact but was an inference from other facts the Hearing Officer had already noticed. While there was clearly no evidence about consumer conceptualisation, it was still a finding of fact as to the mental processes which notional consumers go through. Even if it was inferred from other findings of fact (by notice or evidence) it remains a finding of fact. The question relating to this finding, as for the others, was whether it was something which could be found proved by way of judicial notice.

15. The Appointed Person, Mr Johnson, goes on in paragraph 21 to find as follows:

'On balance I do not think that the Hearing Officer was entitled to take judicial notice that beer consumers who see the word Elvis will always think of Elvis Presley. It is well beyond day-to-day knowledge and is based on supposition. Such a finding therefore would require evidence.'

16. I agree that there are significant similarities between the 'shorthand issue' in this case and the issue which arose in Brewdog in relation to ELVIS. If Mr Johnson was correct in his analysis in that case, it would apply equally to the present case. However, I do not agree that his analysis is correct. I will explain why.

17. The indented paragraph from the decision of the Hearing Officer which is quoted in paragraph 8 of Mr Johnson's decision in Brewdog comes from the

part of that decision concerned with the distinctiveness of the earlier mark ELVIS (a factor which is ultimately taken into account on the issue of likelihood of confusion).

18. Properly analysed, this paragraph can be seen to fall into two parts. The first part (in the first three sentences) finds as a fact that Elvis Presley is very famous so that nearly everyone in the UK will have heard of him. This is dealt with as a matter of judicial notice (which the Appointed Person accepts as quite proper). The second part (in the last two sentences) involves applying that fact (together with other facts) to evaluate the concept which would be conveyed to the average consumer by the earlier mark ELVIS when used in relation to beer. This conclusion is later used as one of the building blocks of an overall evaluation of the distinctiveness of the earlier mark and (later) of a finding of likelihood of confusion.[1]

19. The important point is that the conclusion in the second part of the paragraph is not a finding of fact at all. It is a legal evaluation which is inherently artificial and hypothetical. The average consumer is a legal construct, not a real person (the Hearing Officer has earlier decided what the characteristics of that legal construct are). And the mark ELVIS was not even alleged to be have been used in relation to beer. Expanded from the laconic way in which it is expressed, the finding of the Hearing Officer was that *'if the mark ELVIS alone were to be used in a normal and fair way in relation to beer, a person having the legal attributes of the 'average consumer' would derive the concept of Elvis Presley'.*

20. The distinction between facts and a legal evaluation based on facts is well illustrated by the way the Hearing Officer approaches the issue in the final sentence of the second part. He feeds three facts into his determination. As it happens each of these individual facts are matters of judicial notice. The first is that nearly everyone has heard of Elvis Presley (his initial finding in

[1] I should say that the reference to 'most average consumers' (as opposed to 'the average consumer') was unhelpful as it may have given the impression that the Hearing Officer was considering actual people in a real situation, but of course he was not.

the first three sentences). The second is that Elvis is an uncommon name. The third is that Elvis Presley is the most famous person called Elvis. The Hearing Officer combines those facts with his earlier evaluation of the nature of the average consumer (implicitly taking into account all the usual considerations about the approach which that artificial person takes when notionally confronted with a trade mark) to reach his conclusion.

21. I therefore cannot agree with the approach taken in paragraph 21 of Mr Johnson's Decision. The Hearing Officer in Brewdog was not making a finding of 'fact' when determining the likely response of the average beer consumer to the mark ELVIS on beer. Still less was taking judicial notice of this response.

22. For the avoidance of doubt, I also disagree with his comments in the latter part of paragraph 11 insofar as it equates the process of drawing an inference from known facts with taking judicial notice of a fact. It is commonplace for a tribunal, as part of a fact finding exercise, to draw an inference from a set of facts which have themselves been established at least in part on the basis of judicial notice. For example *'It is established that the outside temperature at the relevant time was minus 5 degrees C. It is established that there had been heavy rainfall the day before. I take judicial notice of the fact that rain stays on a road surface in cold conditions and that water freezes around 0 degrees. I therefore infer that there was ice on the road surface.'* There is no direct evidence of the presence of ice on the road here, but the inference does not involve 'taking judicial notice' of the presence of ice. Indeed the test for judicial notice could never be met in such a case.

23. Finally I disagree with the conclusion at paragraph 21. The Hearing Officer's decision about the likely reaction of average consumers in a hypothetical situation was a reasoned conclusion on a legal issue based on three facts, as I have explained above. It was not 'supposition', any more than the finding of ice on the road in the example above. It may also be

remarked that it is hard to see what useful 'evidence' could in fact have been given on the subject.

24. Turning to the present case, there is no dispute that the Hearing Officer was entitled to take judicial notice of the fame of Harley Street. The extent of that fame is properly a question of fact ('is Harley Street famous for medical services?') and can be considered to be proved on the basis of sheer notoriety. But the finding that the average consumer would be likely to take the mark HARLEY (if used in relation to medical products and services) to be 'shorthand' for Harley Street, and therefore descriptive of the character of the services, is (like the finding about ELVIS) not a finding of fact at all. It involves the hypothetical response of an artificial legal construct (the average consumer) to a notional assumed use of the mark. The answer is influenced by the facts (including the fact of the fame of Harley Street), but is not a fact itself.

25. Similarly, the finding is not a matter of 'judicial notice' so cannot be attacked on the basis that the answer did not meet the necessary standard of notoriety.

Lack of justification for the Hearing Officer's conclusion

26. Mr Stobbs also attacked the Hearing Officer's decision on the basis that there was simply no proper basis in the evidence for concluding that the average consumer of the relevant goods and services, seeing the marks in issue being used in a reasonable and fair way, would think that the word HARLEY indicated the geographical origin of the services in Harley Street, or (by extension) the quality of the services.

27. The issue before the Hearing Officer under s3(1)(b) and (c), given the finding about the fame of Harley Street, may be characterized as follows

    (i) Bearing in mind the notoriety of Harley Street in the specific context of medical services, would the trade mark HARLEY applied to such

services, either solus or in combination with words associated with medical services such as GYNAECOLOGIST, HOSPITAL, DENTIST or PAEDIATRICIAN, be immediately perceived by the average consumer as indicating a business based in Harley Street?

(ii) If so, does this also apply to medical goods?

28. The reasoning of the Hearing Officer is contained in paragraph 35:

35. All the above services are ones provided by medical, surgical, dental, paediatric and gynaecological practitioners. They are general medical services concerned with the health and well-being of patients and the types of services offered by those practitioners in their respective disciplines. I consider that Harley Street has such a significant reputation for such services that when the relevant public sees the Proprietor's marks, in the context of these services, that they will immediately without further thought perceive and associate the provision of the respective services as those based in Harley Street or associated with Harley Street. I bear in mind that marks may be suggestive or allusive without crossing the line to descriptiveness. However, in this case the association is so clear, that the reference to HARLEY will be taken and perceived as a description that the services are provided or originate in Harley Street. The strength of the association will simply lead to the relevant public perceiving HARLEY as a shorthand version of HARELY STREET and that the Proprietor's marks refer to a gynaecologist, dentist, hospital, paediatrician or medical practitioner located in Harley Street, London.

29. She went on to find that this association also applied to medical goods which are intimately connected with the provision of medical services.

30. It seems to me that this is a classic example of a determination with which reasonable people could well disagree, but is within the spectrum of opinions which can reasonably be held.

31. In J.W. Spear v Zynga [2015] FSR 19 at [83] Floyd LJ said this:

83. I have found helpful and agree with the analysis of the Advocate General in his opinion in Doublemint at [61] to [64]. He draws attention to the fact that that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it and suggests three considerations which may determine on which side of the line the indication lies. Although the entire passage repays reading, I will summarise his three points as: (i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? and (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods.

32. The Hearing Officer had to decide what side of 'the line' the mark fell in this case – whether it was merely 'allusive' as contended for by the proprietor, or whether it was actually designating a characteristic of the services and goods in question. Floyd LJ's observation that there is *'no clear-cut distinction'* between these positions is plainly right and means that an Appellate tribunal should be particularly unwilling to interfere with a decision. I agree that in the present case the reasoning of the Hearing Officer on the point is quite laconic. However, she is plainly emphasising the combination of (i) the fame of Harley Street and (ii) the direct relationship between the services for which Harley Street is known and the services being offered under the marks (indeed in many cases directly referred to in the suffix of the mark). This is the 'strong' association to which the Hearing Officer is referring and which she clearly considered to be enough to cause the average consumer to think that HARLEY was simply a shorthand for Harley Street, and therefore indicative of the geographical origin of the services.

33. Looking at this reasoning through the lens of the 3 points made by the Advocate General and approved by Floyd LJ:

    (i) the factual and objective relationship between the indication and the product was considered to be very strong. Harley Street is extremely famous for quality medical services.

(ii) the message of the indication was considered to be conveyed reasonably readily – all that is missing is the word 'Street', and the Hearing Officer plainly considered that Harley would be seen as 'shorthand' for Harley Street when used in the context of medical services. It may be noted that she had earlier (in paragraph 33 of her Decision) referred to evidence of the use of the name Harley *solus* by other providers of medical services.

(iii) the characteristic here (quality medical services) is fundamental to the services and goods protected by the mark.

34. Mr Stobbs contended before me that the likelihood of the 'shorthand' assumption is undermined by the fact that it is rare for street names to be 'shortened' in this way. This is of course true, and it is a perfectly reasonable argument in favour of the case that the mark is 'allusive' rather than 'descriptive'. However, the Hearing Officer plainly considered that the force of that argument was diluted by the evidence (referred to in paragraph 33) of other traders using Harley in respect of medical services, plainly on the basis that the public would see the link with Harley Street.

35. In all the circumstances, I do not consider that this is a case which justifies interference with the Hearing Officer's evaluation of a difficult point on which reasonable people could disagree.

36. I should add that Mr Stobbs made two other points. First he pointed out that another Hearing Officer, in Harley Hospital and Harley Academy Limited O-597-19, considering the distinctiveness of the name Harley appeared to take a different view from the Hearing Officer in this case, saying at [35]

I am not persuaded that, shorn of the familiar "Street", "Harley" used on its own will produce the same strong and immediate association, at any rate in the minds of the general public

and going on to find that the mark HARLEY had an average degree of distinctiveness in relation to medical and dental services. But it is in the

nature of difficult questions of this kind, where there is no clear cut distinction between 'allusiveness' and 'descriptiveness', that different Hearing Officers (perhaps looking at different evidence) may disagree.

37. Second, he relied on a passage in paragraph 39 of the Hearing Officer's decision.

> *To my mind those practitioners practising medicine, gynaecology and dentistry based in Harley Street would wish to use the term Harley to describe the origin of their location given that Harley Street has such a prestige and reputation associated with the name.*

38. Mr Stobbs made the point that whilst 'freedom to use' descriptive terms is the purpose of s3(1)(c), it is not the test for descriptiveness. I agree with this, and it is important to keep this distinction in mind. However, it seems to me that it may nonetheless be useful to ask, as a cross-check of a decision on a question of this kind, whether the result achieves the purpose of the section. If one can well imagine other traders in the same field wishing to use the term in a descriptive way, then this does tend to confirm that the term is indeed properly descriptive.

Conclusion

39. I reject the Appeal. The Appellant will pay £1200 towards the Respondent's costs of the Appeal.

IAIN PURVIS QC
The Appointed Person
28 February 2022