

O-171-20

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3366592
BY HARLEYDIETITIANS TO REGISTER:

harleydietitians

IN CLASS 44

AND

THE OPPOSITION THERETO UNDER NO 416106 BY
HARLEY HOSPITAL LTD

Background and pleadings

1. On 14 January 2019, harleydietitians (the applicant) applied to register 'harleydietitians' in class 44, as follows:¹

Class 44

Dietitian services.

2. The application was published on 22 February 2019, following which it was opposed by Harley Hospital Ltd (the opponent).

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act), because, it submits, there is a likelihood of confusion between the mark applied for and its own earlier marks when used for identical or similar services.

4. The opponent relies upon the following earlier UK Trade Marks (UKTM):

Mark details and relevant dates	Services relied upon
UKTM: 3029024 HARLEY Filed: 1 November 2013 Registered: 9 May 2014	Class 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; medical clinics; provision of hygienic and beauty care services; plastic surgery; cosmetic surgery; cosmetic treatments; services for the treatment and care of the skin; face lifts; hair implantation, hair replacement and hair transplant services; fertility treatment; health screening services; sexual health services; sexual health screening services; private doctor services; body cosmetic surgery; breast cosmetic surgery; facial cosmetic surgery; laser treatments; information,

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>advice and consultancy services relating to all the aforesaid services.</p>
<p>UKTM: 3069038</p> <p>HARLEY CLINIC</p> <p>Filed: 18 August 2014</p> <p>Registered: 2 January 2015</p>	<p>Class 5</p> <p>Pharmaceutical preparations and substances; sanitary preparations for medical purposes; nutritional and dietary supplements; medicated skin, scalp and hair preparations.</p> <p>Class 10</p> <p>Surgical, medical and dental apparatus and instruments; medical equipment; scanners; monitors; parts and fittings for all the aforesaid goods.</p> <p>Class 35</p> <p>Provision of office facilities; office management services [for others]; office administration services [for others]; telephone answering [for others]; operation of telephone call centres for others; office administration services [for others]; office machines and equipment rental; rental and hire of photocopying machines; photocopying; data processing services and reproduction of documents services; provision of support staff; provision of receptionist services; arranging for the redirection of post; consultancy and advisory services relating to all the aforesaid services.</p> <p>Class 43</p> <p>Rental of consulting rooms and medical rooms; provision of facilities for meetings and consultations.</p> <p>Class 44</p> <p>Medical services; medical clinics; provision of hygienic and beauty care services; plastic surgery; cosmetic surgery; cosmetic treatments; services for the treatment and care of the skin; face lifts; hair implantation, hair replacement and hair transplant services; fertility treatment; health</p>

	screening services; sexual health services; sexual health screening services; private doctor services; advice and consultancy services relating to all the aforesaid services.
<p>UKTM: 3150295</p> <p>HARLEY SMILE</p> <p>Filed: 17 February 2016</p> <p>Registered: 22 July 2016</p>	<p>Class 5</p> <p>Pharmaceuticals, medical and veterinary preparations; Sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; dental rinse; dental wax for the preparation of dental moulds; materials for dental fillings; gases for dental use; medicated mouthwash; antiseptic mouthwashes; medicines for dental purposes; pharmaceutical preparations for dental use; disinfectants for dental apparatus and instruments; parts and fittings for all the aforesaid goods.</p> <p>Class 44</p> <p>Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; dentistry services; dental consultations; cosmetic dentistry; dental hygienist services; teeth whitening services; information, advisory and consultancy services relating to the aforesaid.</p>

5. The opponent's marks are earlier marks which are not subject to proof of use. This is because, at the date of the contested application, they had not been registered for five years.²

6. The applicant filed a counterstatement in which it denied the ground raised by the opponent.

² See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

7. The applicant filed evidence. Neither party requested to be heard nor filed submissions in lieu of a hearing. I make this decision based on careful consideration of the papers before me.

8. The applicant is represented by Beck Greener LLP. The opponent is represented by Stobbs IP.

The applicant's evidence and preliminary issues

Witness statement by Kashif Syed of Beck Greener LLP and exhibits KS1-KS5

9. The witness statement is dated 25 November 2019. The statement and attached exhibits are primarily concerned with the significance and history of 'Harley Street' and include, inter alia, prints of an internet search for 'Harley Street', an article from Tatler magazine about Harley Street and a Wikipedia print concerning the term 'Harley Street'.

10. I do not intent to present an evidence summary here, but will consider any relevant content at the relevant point in the decision.

11. As well as evidence relating to Harley Street, the applicant's evidence also includes a print from the National Health Service website where, the applicant submits, "the word 'Harley' is referred to many times in relation to various practices.³" With one exception, all of the listed service providers use Harley Street rather than Harley solus. 'Harley Eyecare' is the only exception and no further information is provided by the applicant in relation to this particular undertaking. It may relate to a person called Harley providing eyecare services; it may be an eyecare clinic based in Harley in Shropshire. Without further information this exhibit does not assist the applicant's case.

12. Similarly, exhibit KS5 relates to a business called 'rhitrition' which the applicant describes as a nutritional/dietitian business in Harley Street. The applicant does not explain why this is relevant to its case. The undertaking providing these services is

³ See exhibit KS4.

'rhitrition' which has no relationship to the application or the earlier rights. I will say no more about this exhibit.

The opposition

13. Section 5(2)(b) of the Act states:

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

(a)...

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

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

14. 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.

(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 great 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

15. The applicant's counterstatement includes the following:

"3. That the services claimed in the Application are either identical or similar to some of the goods and services asserted in the Opponent's registrations under section 5(2) of the Act, is admitted."

16. I agree. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ the General Court ("GC") stated that:

"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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

17. The application is made in respect of 'dietitian services'. The opponent's earlier marks all include 'medical services'. Neither side has defined these terms but it is my understanding that, dietitians provide advice concerning nutrition and regulation of diet which may be a stand-alone service or part of the management of any number of medical conditions. In other words, 'dietitian services' are a subset of 'medical services' and, in accordance with the decision in *Merick*, the services are identical.

18. Having found all of the applicant's services in class 44 to be identical to the opponent's services in class 44, I do not intend to consider the opponent's goods and

⁴ Case T- 133/05

services in classes 5, 10, 35 and 43 as they do not put the opponent in any better position.

The average consumer and the nature of the purchasing act

19. In accordance with the above cited case law (paras. 12 and 14), I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

20. 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*⁵, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

21. The parties’ specifications cover a broad range of medical and dietitian services that can be aimed at an ordinary member of the public and/or at a medical practitioner or institution. A medical practitioner selecting services for a patient is likely to pay a higher degree of attention to the selection of those services than a member of the general public seeking general day to day health or dietary advice. That said, the purchasing act for all of the respective services will be at least well considered as the average consumer, whether an individual or a medical professional, will take note of, inter alia, suitability, cost and accessibility of services, before entering into the purchasing act.

⁵ [2014] EWHC 439 (Ch)

22. In all cases the purchase may be made visually from a website, brochure, prospectus, etc., or aurally such as in their local medical centre, clinic, GP surgery or pharmacy.

Comparison of marks

23. I will begin by comparing the opponent's HARLEY trade mark with the application. The marks to be compared are as follows:

Opponent's earlier mark	The application
HARLEY	harleydietitians

24. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁶, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

25. The applicant denies any similarity between the respective trademarks. The opponent submits that the contested mark is highly similar to the earlier rights visually, aurally and conceptually.

26. The opponent's mark is the word HARLEY in plain black type with no additional stylisation. The overall impression of the mark rests in that word.

27. The applicant's mark consists of the two words 'harley' and 'dietitians' conjoined. Both words can be clearly identified within the mark, meaning that the omission of the space between them has little effect, there being no other obvious way that the elements can be divided. The second word, 'dietitians' is descriptive of the services

⁶ Sabel v Puma AG, para.23

provided, but given the presentation of the mark, I find that the overall impression of the mark rests in the whole mark.

Visual similarity

28. Visual similarity rests in the fact that both marks include the word 'HARLEY'. It is the totality of the earlier mark and the first part/word in the application. The visual differences are that the opponent's mark is presented in lower case letters and the application in upper case, a fact that will go largely unnoticed by the average consumer and would be covered by fair and notional use of the marks. In addition, the application includes the word 'dietitians' joined to the first word 'harley'. Overall, I find these marks to be visually similar to a medium degree.

Aural similarity

29. With regard to aural similarity, both marks are made up of common English words, the pronunciation of which will be easily understood by the average consumer. The opponent's mark and the first part of the application is the word 'HARLEY'. The additional word 'dietitians', which is the second part of the applicant's mark, adds the four syllables 'DIE'- 'ET'- 'ISH'- 'ANS'. The fact that it is conjoined with the first element 'harley', means that it is likely to be pronounced, despite being simply a description of the services provided. The marks are aurally similar to a medium degree.

Conceptual similarity

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁸

⁷ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁸ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, *BL O/048/08*, paragraphs 36 and 37.

31. The applicant submits:

“The term 'harley' which is incorporated in all of the marks in the Opponent's registrations and in the Applicant's mark was at the filing date of the Application and continues to be inherently non-distinctive and descriptive for the goods and services asserted in the Opponent's registrations, and was not at the filing date of the Application and has not become factually distinctive for those goods and services through use in trade.”

32. The applicant has not given me any indication of why it finds 'HARLEY' in the opponent's earlier marks to be non-distinctive but it has filed evidence which relates to the use of the term 'Harley Street' which it submits, 'employs thousands of medical specialists'. The relevance of this is not explained in the counterstatement nor in the applicant's evidence, which is a list of exhibits with little supporting narrative.

33. It seems to me that the applicant is, in effect, asking me to take judicial notice of the fact that 'we all know' that 'HARLEY' is a reference to Harley Street. I refer to the *Chorkee* case⁹ in which Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case.

⁹ BL O-048/08

No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

34. Whilst I am aware of the meaning of Harley Street as a location for prestigious medical services, I am unable to take judicial notice of the fact that ‘Harley’ will be seen as referring to it. It is not the type of notorious fact that can be accepted without evidence of it. In my view, some average consumers would know the reference, others may not. The term ‘HARLEY’ in both parties’ marks will either be seen as referring to a first name or surname, particularly where the services may be provided by a particular individual with that name. In the alternative, it may be seen as a reference to Harley Street. In either case, the meaning given to the term will be the same for both marks and I find there to be a medium degree of conceptual similarity between them.

Distinctive character of the earlier marks

35. 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*.¹⁰

¹⁰ Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. No evidence has been filed, so I have only the inherent distinctiveness of the earlier mark to consider. The word HARLEY is likely to be seen as a first name or surname, or may allude to Harley Street. If seen as a name then it may suggest the name of the person providing medical services, or may allude to the location of those services. Overall, I find the earlier mark HARLEY is a trade mark, possessed of a slightly lower than medium degree of inherent distinctive character.

Likelihood of Confusion

37. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them they have kept in their mind.¹¹ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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.

38. I have found:

- The applicant's services are included within the opponent's services in class 44, which means they are identical.
- The marks share a medium degree of visual and aural and conceptual similarity.
- The average consumer, who is a member of the general public or a medical professional, will pay at least an average degree of attention during selection processes for the services which will be purchased primarily visually, but I do not discount an aural element.
- The opponent's mark has a slightly lower than medium degree of distinctive character for the services in class 44.

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹² as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’”.

40. In *Duebros Limited v Heirler Cenovis GmbH*, the Appointed Person emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately, the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark as this is mere association, not indirect confusion.

41. With regard to the ‘common element’, I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed

¹² BL O/375/10.

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 said:

“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.”

42. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43. 'HARLEY' is the common element in the competing marks. It is the totality of the earlier mark and the first part of the conjoined mark 'harleydietitians' in the application. As I have found above, 'HARLEY' has a slightly lower than medium degree of inherent distinctiveness, however, it is in that element, the totality of the earlier mark, in which its distinctiveness rests. Bearing in mind the concept of imperfect recollection, this may be direct, where the average consumer gives no attention to the descriptive word 'dietitians' joined to the word 'harley' in the application, or it may be indirect, where 'dietitians' is noticed but the consumer presumes an economic link.

44. In this case I find indirect confusion more likely. Earlier in the decision I said that the lack of space between 'harley' and 'dietitians' in the application made little difference as the consumer would see the two individual words, both being easily understood. The only difference the lack of a space does make is that the average

consumer is unlikely to ‘fail to notice’ ‘dietitians’, it being attached to the first word ‘harley’, in the application. This means that the ‘dietitians’ element is a point of difference between the respective marks, albeit a descriptive one. A consumer familiar with medical services provided by HARLEY is likely to consider dietitian services provided under the applicant’s mark ‘harleydietitians to be a specific ‘dietary’ service provided by the HARLEY brand. In other words, an economically linked undertaking. When the applicant’s mark is used for identical services to those of the opponent, I find that there will be a likelihood of confusion.

CONCLUSION

45. The opposition succeeds prima facie, under section 5(2)(b) of the Act and the application will be refused. The opponent has succeeded in full based on its earlier UK trade mark HARLEY for services in class 44, therefore, I will not go on to consider the remainder of its specification, or two other earlier rights which puts it in no better position.

COSTS

46. The opposition having succeeded, the opponent is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that no evidence was filed by the opponent and the decision was made from the papers:¹³

Official fees:	£100
Preparing the notice of opposition and considering the counterstatement:	£400
Considering the other side’s evidence:	£200

¹³ The scale of costs applicable to proceedings before the Comptroller can be found in Tribunal Practice Notice 2/2016.

TOTAL

£700

47. I order harleydietitians to pay Harley Hospital Ltd the sum of £700. These costs should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 17th day of March 2020

Al Skilton

For the Registrar,

The Comptroller-General