

O-585-21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3454058

IN THE NAME OF MOHAMMAD HADI RAJABI IN RESPECT OF THE TRADE  
MARKS

Transform Dental

Transform Whitening

IN CLASSES 3 & 44

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 503376

By TRANSFORM HOSPITAL GROUP LIMITED

1. Registration 3454058 stands in the name of Mohammad Hadi Rajabi (“the proprietor”). The relevant details of this registration are:

Series of two Marks:

Transform Dental

Transform Whitening

Filing date: 25 December 2019

Registration date: 09 August 2020

For the following goods and services:

**Class 3:** Teeth whitening preparations

**Class 44:** Teeth whitening services; Dental clinic services.

2. On 07 October 2020, Transform Hospital Group Limited (“the applicant”) filed an application for invalidation against all of the goods and services under this registration under Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of the following mark and goods/services.

**UK2262125**

Mark: TRANSFORM

Filing date: 22 February 2001

Registration date: 12 July 2002

For the following services:

**Class 44:** Medical services; cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services.

3. In its statement of grounds, the applicant argues that the respective marks are phonetically, visually and conceptually similar and that the proprietor’s marks wholly incorporate the applicant’s earlier mark with the addition of descriptive words. It states that the class 44 services are identical or highly similar and the class 3 goods are related and therefore similar. It also states that it has used the name TRANSFORM for cosmetic procedures throughout the UK since at least 2001 and, as a result of this extensive use, has acquired a substantial reputation.

4. The proprietor filed a counterstatement denying the claims made. It states that the goods and services offered by the respective parties are different, asserting that the proprietor offers dental treatments as opposed to the applicant who offers procedures such as face lifts and gastric bands. It states that 'TRANSFORM' is a generic name and does not apply to this company alone.
5. The applicant provided evidence in these proceedings. The proprietor filed submissions which may have been intended to be evidential in nature however, these were not provided in the required format and the proprietor was therefore advised that these documents would not be admitted as evidence.
6. No hearing was requested and therefore, this decision is taken following a careful perusal of the papers before me.
7. The proprietor is unrepresented. The applicant is represented by Novagraaf UK.
8. The applicant's above mentioned trade mark is an earlier mark, in accordance with Section 6 of the Act. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the filing date of the proprietor's mark, as per section 6A of the Act. The proprietor has requested that the applicant provides proof of use for their mark.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **Evidence**

10. The applicant's evidence consists of the witness statement of Mr Jeremy Rouch dated 26 March 2021. Mr Rouch is the Company Secretary and has held the position since 2010. The statement is accompanied by 9 exhibits.

11. He states that the applicant's business has existed since 1977 and the TRANSFORM mark has been used by them in the UK since June 1997 with the mark being registered in 2001. He claims that it is one of the leading providers of Medical Aesthetics and Cosmetic Surgery in the UK and has a national network of clinics and specialist hospitals where they carry out cosmetic surgery and medical aesthetic treatments. They also work with the NHS.
12. Mr Rouch states that the applicant previously undertook dentistry procedures but are not currently offering these however, there are plans to revisit this in the near future.
13. Exhibit JR1 shows the annual turnover for the company from 2011 (£40million) to 2020 (£32.5million). Mr Rouch states that the brand and mark have provided exceptionally high values consistently and show high success and turnover throughout the relevant periods.
14. Mr Rouch mentions that the applicant has invested heavily in the brand and mark and its advertising and products, by way of TV advertisements and television programmes. Exhibit JR2 shows a table of advertising expenditure for the business under the TRANSFORM mark. From 2011 to 2019 £4.5million has been spent each year, with £2million being spent in 2020.
15. Exhibit JR3 is comprised 54 sample invoices issued to clients from between 2/6/2010 and 10/02/2020. The services shown on the invoices include: abdominoplasty, rhinoplasty, hair grafts, breast augmentations, necklift and liposuction. The invoices also show the range of clinics that the applicant operates from in Birmingham, Manchester, Leeds, Newcastle, Sheffield, Bristol, Brentford and Bowdon. The total revenue from the invoices was £291,683 and the approximate average total of the invoices is £5400.
16. Mr Rouch explains that exhibit JR4 comprises invoices relating to business costs. The items included within the exhibit are a business rates invoice dated 12 March 2021, a web events agency invoice dated 3 August 2020, an invoice from Beattie Comms for an ITV Tonight show clip dated 30 September 2020 and an invoice from Allergan for an order of Botox dated 16 March 2021.

17. Exhibit JR5 contains articles and publications that reference the business. There is an article regarding the expansion of the company into Scotland. This appears to be from the applicant's website dated 28 September 2020. From 18 October 2020 there is an article from the Manchester Evening News website discussing a customer's nose operation. There is an undated article from the Mirror which shows a journalist's visit to one of the applicant's clinics for the day. Finally, there is an article whereby the date is mostly covered, only the year 2020 can be seen. This is from Wales Online and discusses a woman who has paid £35,000 for cosmetic surgery with the company.

18. Exhibit JR6 comprises several undated client testimonials from the applicant's website. This information includes quotes from clients and some basic details around the client and their surgeries.

19. Under exhibit JR7 Mr Rouch has provided historical extracts from the applicant's website from 24 July 2003 to 15 November 2019. From 8 February 2004 onwards the word 'TRANSFORM' has been placed at the top of the applicant's website pages in various different fonts and colours as follows:



20. Screenshots of the applicant's Twitter, Facebook and Instagram pages are provided in Exhibit JR8. The pages all appear to have a print date of 23 March 2021 however, the Twitter pages shows tweets from 22 December 2020, 14 October 2020, 13 October 2020, 18 August 2018, 27 December 2018, 12 July 2019, 5 December 2019, 18 February 2020 and 13 October 2020. The tweets are of various treatment offers and also snippets of client comments regarding their surgeries. The page has 2658 followers and shows the mark 'Transform' as the name of the page. The Facebook page has 2 posts from March 2021 shown in the print out and shows 19,877 people follow the page. There are then screenshots of posts from 8

December 2019, 9 February 2020 and 13 October 2020 with similar content to the aforementioned Twitter posts. The Instagram page shows numerous posts but it does not show the date of them. The page has 16,000 followers.

21. Exhibit JR9 comprises two customer guides, one in relation to breast augmentation procedures and one which is a warranty/aftercare guide. There is a print date of September 2020 on the first guide but no print date on the second. There is also no indication as to how long these guides have been used and actually provided to consumers.

22. Mr Rouch claims that the applicant's TRANSFORM brand is widely recognised in the UK due to the extensive use of the mark and the promotional investment made by the applicant, and that the revenue generated is significant.

## **DECISION**

23. Section 5(2) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. The relevant legislation is as follows:

24. Section 47 states:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

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

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in

section 46(1)(a) has expired, or

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

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),  
and

(b) use in the United Kingdom includes affixing the trade mark to goods  
or to the packaging of goods in the United Kingdom solely for export  
purposes.

(2D) [...].

(2DA) [...].

(2E) Where an earlier trade mark satisfies the use conditions in respect of some  
only of the goods or services for which it is registered, it shall be treated for the  
purposes of this section as if it were registered only in respect of those goods  
or services.

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

(2G) An application for a declaration of invalidity on the basis of an earlier trade  
mark must be refused if it would have been refused, for any of the reasons set  
out in subsection (2H), had the application for the declaration been made on  
the date of filing of the application for registration of the later trade mark or  
(where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be  
declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet  
acquired a distinctive character as mentioned in the words after  
paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section  
5(2) and the earlier trade mark had not yet become sufficiently distinctive  
to support a finding of likelihood of confusion within the meaning of  
section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...].

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

25. Section 5(2)(b) of the Act is 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”.

### **Proof of Use**

26. I will begin by assessing whether there has been genuine use of the earlier mark.

27. Section 100 of the Act states that:

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

28. Pursuant to section 47(2B) of the Act, there are two relevant periods for assessing whether genuine use has been made of the earlier mark. The first is the 5 year period prior to the filing date of the proprietor’s mark, so this will be 25 December 2014 to 24 December 2019. The second is the 5 year period prior to the filing date of the TM26 form by the applicant. This will therefore be 7 October 2015 to 6 October 2020.

29. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark,

including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### **Form of the mark**

30. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period

following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

31. In Nirvana Trade Mark, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

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

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

32. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as required. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

33. Where the applicant’s mark has been used as registered this will, clearly, be use upon which the applicant can rely. As the mark filed is a word mark, it may also be used in a range of standard fonts and colours, as well as in upper or lower case.

34. The applicant has also used the earlier mark in the following variants:



Transform  
medical group



Transform <sup>Est. 1974</sup>  
When you feel good, we feel good



Transform



TRANSFORM  
Cosmetic Surgery

35. The examples are all shown in standard fonts, the first three have the first letter capitalised and the rest of the word in lower font. The final variation is in all capitals. Various strap lines or additional wording have been added to three of the marks. I do not consider that the additional text alters the distinctive character of any of these representations as per *Nirvana*. Consequently, these examples show use upon which the applicant may rely.

### **Sufficient/genuine use**

36. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>1</sup>

37. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

38. As the earlier mark relied upon is a UKTM, I must consider the UK as the market in which the applicant is required to show genuine use.

39. The applicant’s evidence confirms that the TRANSFORM business has existed since 1977 and the mark TRANSFORM has been in use since 1997 and was subsequently registered in 2001. The applicant’s business is based in Manchester with the invoices in Exhibit JR3 showing that the applicant also provides clinics in Preston, Nottingham, Leeds, Sheffield, Bristol, Newcastle amongst others. Examples of use have been provided on the applicant’s website<sup>2</sup> and on the invoices provided as mentioned above.

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<sup>1</sup> New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09

<sup>2</sup> Exhibit JR7

40. I must focus on the evidence provided that covers the relevant period. Mr Rouch has provided turnover figures for the company from 2011 to 2020 in JR1. The total figures for sales within the relevant period are approximately £176million.
41. Sample invoices with 'TRANSFORM' at the top of each page were provided for the relevant period (and outside of this also).<sup>3</sup> The invoices showed sales of the services such as: liposuction, rhinoplasty, breast augmentation, PIP removal and abdominoplasty. The invoice totals from within the relevant period range from between £2950 to £9499 and were from various clinics across the UK.
42. The applicant provided screenshots from their website with the mark being shown used (in various fonts and colours) over the relevant period, usually at the top of the home page. It is also used in other areas of the webpages, to refer to the company.
43. The applicant provided screenshots of their social media pages. Most of this evidence falls outside of the relevant dates or is not dated so I cannot take that information into account. However, there are tweets from 2018 and 2019 that show offers on treatments such as lip injections, facials, and peels. A Facebook post from 8 December 2019 also shows an offer on lip fillers. The mark is used as the main name for all the social media pages.
44. The applicant has not provided details of market share and some of the evidence is either undated or falls outside of the relevant periods however, from the evidence that is acceptable for the relevant periods, given the significant advertising expenditure and the consistently high level of turnover for the years covering the relevant period combined with the consistent use of the mark relied upon, as well as acceptable variants, on their website and the sample invoices showing a spread of the income over various clinics geographically, I am satisfied that the applicant has demonstrated genuine use of its earlier mark in the UK during the relevant period.

### **Fair Specification**

45. I now turn to consider whether, or the extent to which, the evidence shows use of the services relied upon.

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<sup>3</sup> Exhibit JR3

46. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

47. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

48. The applicant's specification covers the following services in class 44: Medical services; cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services. From the evidence provided, it is clear that the invoices show a range of different cosmetic surgeries. I find that 'Medical services' is a wider category and there is an absence of evidence to support this. It would be unfair to allow a wider specification than the evidence covers, as per *Maier v Asos Plc* (see above). I find that the consumer would fairly describe the applicant's services as 'Cosmetic surgery and treatments.

49. It would also be reasonable for the consumer to expect that information, advisory and consultancy services would be provided in relation to cosmetic surgery and treatments by the same undertaking. This is supported by the Breast Augmentation

guidance leaflet which the applicant provides to its clients and which is contained within Exhibit JR9.

50. I therefore consider a fair specification for the earlier mark to be:

Class 44: Cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services.

### **Section 5(2)(b) – case law**

51. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 goods and services

52. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

53. 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”.

54. 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 uses of the respective goods or services;

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

55. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), Case T-133/05, the General Court ("the 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 fur 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".

56. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the General Court 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”.

57. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings.

58. After determining a fair specification in respect of the applicant’s services, based on the evidence before me, the competing goods and services are as follows:

Proprietor’s Goods & Services	Applicant’s Services
<p><b>Class 3:</b> Teeth whitening preparations</p> <p><b>Class 44:</b> Teeth whitening services; Dental clinic services.</p>	<p><b>Class 44:</b> Cosmetic surgery and treatments; information, advisory and consultancy services relating to the aforesaid services.</p>

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'.

### **Average Consumer and the Purchasing Act**

63. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

64. 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.”

65. In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41, the General Court considered the average consumer for and level of attention which would be paid in the selection of pharmaceutical and medical products in class 5. It said:

“39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis v OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma v EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).

40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).

41 [...]

42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”.

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 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.

### **Comparison of the marks**

69. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

71. The respective trade marks are shown below:

<p>Transform Dental Transform Whitening</p>	<p>TRANSFORM</p>
<p>Contested trade marks</p>	<p>Earlier trade mark</p>

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.'<sup>4</sup> The additional elements in the two marks of the proprietor 'DENTAL' - things that relate to teeth or to the care and treatment of teeth<sup>5</sup>- and 'WHITENING' - the act or process of making or becoming white<sup>6</sup>- 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.

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<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/transform>

<sup>5</sup> <https://www.collinsdictionary.com/dictionary/english/dental>

<sup>6</sup> <https://www.collinsdictionary.com/dictionary/english/whitening>

## Distinctive Character of the Earlier Mark

79. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

80. 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 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.”

81. The applicant submitted evidence to prove genuine use of its mark and claimed that due to the extensive use made of the mark it had gained a reputation in the UK. Whilst I have concluded that the evidence does show genuine use in the UK during the relevant period, I do not find that the evidence supports a finding of enhanced distinctiveness in the word TRANSFORM for the services offered by the applicant.

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.

### **Likelihood of confusion**

83. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

84. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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 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.

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 sub-brand 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.

## **Conclusion**

90. The application for a declaration of invalidity has succeeded in its entirety.

## **Costs**

91. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the applicant is appropriate as follows:

Official fee

£200

Preparing the Application for Invalidation and considering the Counter Statement	£250
Preparing evidence	£650
<b>TOTAL</b>	<b>£1100</b>

92. I therefore order Mohammad Hadi Rajabi to pay Transform Hospital Group Limited the sum of £1100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5<sup>th</sup> day of August 2021**

**L Nicholas  
For the Registrar**