

O-597-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3235397 BY
HARLEY ACADEMY LTD**

TO REGISTER THE TRADE MARK:

HARLEY ACADEMY

FOR SERVICES IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000752
BY HARLEY HOSPITAL LIMITED**

BACKGROUND

1) On 05 June 2017 Harley Academy Limited (“the Applicant”) applied to register the following trade mark:

HARLEY ACADEMY

The application was published for opposition purposes on 18 August 2017. The application originally also covered goods and services in Classes 5, 10, 44 and 45, but was subsequently amended, so that these classes have now been withdrawn. Class 41 is the only remaining class included in the Application, and covers the following services:

Class 41: *Conducting of educational seminars relating to medical matters; courses (training-) relating to medicine; education services relating to health; education services relating to medicine; educational services relating to beauty therapy; medical education services; medical training and teaching; providing continuing dental education courses; providing continuing medical education courses; providing continuing nursing education courses; teaching of beauty skills; teaching services relating to the dental field; teaching services relating to the medical field. organising, conducting and providing workshops, courses, seminars and conferences in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures; publication of books and journals in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures; publishing services; publication of books and journals; publishing services, namely on-line publication of electronic books, journals and magazines; providing on-line electronic publications (non-downloadable); publication of material which can be accessed from databases or from the internet; education; training; organising, conducting and providing workshops, courses, seminars and conferences; publication of texts and books including online publishing; providing online electronic publications (not downloadable); organisation of competitions; production, presentation and distribution of text, audio, video, images, animations, games, databases and other data via telecommunication networks and/or global computer networks; film, video, audio-visual and music production; presentation of live performances;*

organisation of exhibitions for cultural or educational purposes; information, consultancy, advisory and training services relating to the aforesaid.

2) The application is opposed by Harley Hospital Limited (“the Opponent”). The opposition is brought under the “fast track” procedure and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the following UK registrations for the following marks and their respective goods and services:

UK 3029024

(which was filed on 1 November 2013 and completed its registration procedure on 9 May 2014)

HARLEY

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, advice and consultancy services relating to all the aforesaid services.*

UK 3069038

(which was filed on 18 August 2014 and completed its registration procedure on 2 January 2015)

HARLEY CLINIC

Class 3: *Soaps; perfumery, essential oils, cosmetics, hair lotions; toiletries; preparations for the cleaning, care, treatment and beautification of the skin, scalp and hair; personal cleansing preparations for the face, hands and body; anti-ageing preparations, creams for anti-ageing, lotions for anti-ageing.*

Class 5: *Pharmaceutical preparations and substances; sanitary preparations for medical purposes; nutritional and dietary supplements; medicated skin, scalp and hair preparations.*

Class 10: *Surgical, medical and dental apparatus and instruments; medical equipment; scanners; monitors; parts and fittings for all the aforesaid goods.*

Class 35: *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.*

Class 43: *Rental of consulting rooms and medical rooms; provision of facilities for meetings and consultations.*

Class 44: *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 screening services; sexual health services; sexual health screening services; private doctor services; advice and consultancy services relating to all the aforesaid services.*

UK 3025580

(which was filed on 9 October 2013 and completed its registration procedure on
14 March 2014)

HARLEY DENTIST

Class 3: *Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; toothpaste; medical toothpastes; mouthwash; gels (dental bleaching).*

Class 5: *Pharmaceutical preparations; sanitary preparations for medical purposes; materials for dressings; dental preparations and articles; material for stopping teeth; dental wax; disinfectants and antiseptics; antiseptic mouthwash; medicated mouthwash; medicated swabs; dental composites; dental cements; adhesives for dentures; dental abrasives; abrasive fluids for dental use; abrasive pads for dental use; alloys of precious metals for dental use; amalgams for dental use; colouring reagents for detecting dental plaque; dental anaesthetics; antibiotics for use in dentistry; dental bonding material; chromatic alginate dental impression material; sterilisers; crowns for use in dental restorative work; dental veneers for use in dental restoration; dental lacquer; mastics (dental); porcelain for dental purposes; rubber for dental purposes.*

Class 10: *Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials supportive bandages; furniture adapted for medical use; dental equipment; dental apparatus (electric); dental furniture; dental tools; dental instruments; latex gloves for medical use; face masks for medical use; dental prostheses; dental x-ray apparatus; dental syringes; braces for teeth; dental drills; parts and fittings for the aforementioned goods.*

Class 21: *Articles for cleaning purposes; electric and non-electric toothbrushes; dental cleaning articles; dental floss; dental picks for personal use.*

Class 44: *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; health screening services; dental services; dental hygienist services; private doctor services; advice and consultancy services relating to all the aforesaid services.*

3) The significance of the dates given above is that (1) the Opponent's marks all constitute earlier marks in accordance with section 6 of the Act, and (2) they are not subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed less than five years before the publication of the Applicant's mark.

4) The Opponent claims that the mark applied for is similar to the earlier marks and that the goods and services of the competing marks are highly similar, so that there is a likelihood of confusion. The Applicant filed a counterstatement, denying the grounds of opposition. The Opponent is represented in these proceedings by STOBBS and the Applicant is represented by Kilburn & Strode LLP.

5) Rules 20(1)-(3) of the Trade Marks Rules ("TMR" – the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

6) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) provides that arguments in fast track proceedings shall be heard orally only if (1) the Registrar requests it, or (2) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. Neither side requested a hearing. Both parties filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b)

7) Section 5(2)(b) of the Act reads 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”.

8) 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9) In the judgment of the 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”.

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

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

11) 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”.

12) 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 (in that case, for example, *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. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

13) The position on the interpretation of terms used in specifications was explained as follows by Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch):

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49].

Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

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

15) I will make the comparison with reference to the Applicant's goods. Though I do not accept all the Opponent's submissions on the comparison of goods and services, I broadly agree that the Applicant's services fall into five categories and, for convenience, I shall follow this approach¹.

(Group A) Education and training services, including the organisation of seminars, workshop and conferences in the field of medicine health beauty therapy dentistry, nursing and cosmetic procedures

16) The services of the Applicant falling into this Group (A) are as follows: *conducting of educational seminars relating to medical matters; courses (training-) relating to medicine; education services relating to health; education services relating to medicine; educational services relating to beauty therapy; medical education services; medical training and teaching; providing continuing dental education courses; providing continuing medical education courses; providing continuing nursing education courses; teaching of beauty skills; teaching services relating to the*

¹ See the comments of the Appointed Person in *Separode* BL O-399-10

dental field; teaching services relating to the medical field. organising, conducting and providing workshops, courses, seminars and conferences in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures.

17) The services falling within this Group (A) of the Applicants specification thus consist of the provision of education and training in the fields of medicine, dentistry, beauty therapy and cosmetic procedures. The relevant public, whether consisting of professionals at some level or of the general public, will see a close connection between these services and the Opponent's *medical services* in Class 44 (earlier marks 3029024 and 3069038), *cosmetic surgery* in Class 44 (earlier mark 3029024) and *dental services* in Class 44 (earlier mark 3025580), in the sense that these services are indispensable or important for the use of the Opponent's services in such a way that the average consumer will readily assume that the responsibility for them lies with the same undertaking. There will be a high degree of complementarity – and 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.

18) The relevant public will also be well aware of the close relationship which has always, for obvious practical reasons, existed between the provision of medical and dental services and the provision of training and education in those fields, so that there will be a perceived concurrence of channels of trade too. Analogous considerations apply when comparing the Applicant's *educational services relating to beauty therapy* and the Opponent's *provision of hygienic and beauty care services* of the Opponent's mark's specification in Class 44. There is a high degree of similarity between the Applicant's services in Group (A) and the Opponent's *medical services* in Class 44 (of earlier marks 3029024 and 3069038), *provision of hygienic and beauty care services* in Class 44 (of the earlier mark 3029024) specification in Class 44 and *dental services* in Class 44 (of earlier mark 3025580).

19) Moreover, I also consider that there is a considerable overlap in nature and purpose between the Applicant's Group (A) services and the *information, advice and consultancy services relating to [medical services and cosmetic surgery]* in the Class 44 specification of the earlier mark 3029024, also leading to a high degree of

similarity. The Opponent made further submissions on similarity on the basis of other goods and services in the earlier marks but I do not consider these here, since I consider that none of these other goods and services offer the Opponent a more favourable comparison than the high degree of similarity I have already found above.

(Group B) Education and training services at large

20) The services of the Applicant falling into this Group (B) are as follows: *education; training; organising, conducting and providing workshops, courses, seminars and conferences*. These services at large, of course, also encompass the more specific services considered above in Group (A). Insofar as they do so, there will be the same high degree of similarity with the Opponent's respective services on the same basis as discussed above for Group (A). Insofar as they do not, I shall discuss the consequences later in this decision.

(Group C) Publishing services in the field of medicine, health, beauty therapy, dentistry nursing and cosmetic procedures

21) The services of the Applicant falling into this Group (C) are as follows: *publication of books and journals in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures*. I consider that the relevant public, whether consisting of professionals at some level or of the general public, will see a close connection between these services and the Opponent's *medical services* in Class 44 (earlier marks 3029024 and 3069038), *cosmetic surgery* (earlier mark 3029024) and *dental services* in Class 44 (earlier mark 3025580), in the sense that these services are indispensable or important for the use of the Opponent's services in such a way that they will readily assume that the responsibility for those services lies with the same undertaking. As the Opponent points out, such publications are clearly complementary to clinical practice, particularly in the context of education and training. There is a high degree of similarity between these services and those of the Opponent.

(Group D) Publishing services at large

22) The services of the Applicant falling into this Group (D) are as follows: *publishing services; publication of books and journals; publishing services, namely on-line publication of electronic books, journals and magazines; providing on-line electronic publications (non-downloadable); publication of material which can be accessed from databases or from the internet; publication of texts and books including online publishing; providing online electronic publications (not downloadable).*

23) These services at large either encompass the more specific services considered above in Group (C) or can cover analogous material and subject matter which the relevant public will see as having a similarly high degree of complementarity with the Opponent's *medical services* in Class 44 (of earlier marks 3029024 and 3069038), *cosmetic surgery* in Class 44 (earlier mark 3029024) and *dental services* in Class 44 (earlier mark 3025580) on the same basis as discussed above for Group (C). Insofar as they do so, there will be the same high degree of similarity with those services of the Opponent. Insofar as they do not, I shall discuss the consequences later in this decision.

(Group E) Provision of film, video, audio-visual and musical production and the presentation of live performances

24) The services falling into this Group (E) of the Applicant's services are as follows: *organisation of competitions; production, presentation and distribution of text, audio, video, images, animations, games, databases and other data via telecommunication networks and/or global computer networks; film, video, audio-visual and music production; presentation of live performances; organisation of exhibitions for cultural or educational purposes.*

25) Applying the *Canon* criteria I can find no similarity between any of the goods or services of any of the earlier marks and the following services of the Applicant's specification: *organisation of competitions; production, presentation and distribution of games via telecommunication networks and/or global computer networks; music production.*

26) This leaves the following services in Group (E): *production, presentation and distribution of text, audio, video, images, animations, databases and other data via telecommunication networks and/or global computer networks; film, video and audio-visual production; presentation of live performances; organisation of exhibitions for cultural or educational purposes*. All these services may contain sub-sets relating to the medical services and dental services of the Opponent's Class 44 specifications as detailed above. Cosmetic medical and dental services and procedures in particular are widely advertised to the general public; they may be promoted through publications and brochures including online, through information courses, workshops and other events, or documentary or promotional material on TV, radio, DVD, or online. Events such as exhibitions and live presentations may be held to raise awareness of medical conditions and the availability of medical, dental and cosmetic procedures. Video, images and animations may also serve these purposes.

27) In such cases the relevant public, whether consisting of professionals at some level or of the general public, will see a close connection between these services and the Opponent's *medical services* in Class 44 (earlier marks 3029024 and 3069038), *cosmetic surgery* (earlier mark 3029024) and *dental services* in Class 44 (earlier mark 3025580), in the sense that these services are indispensable or important for the use of the Opponent's services in such a way that they will readily assume that the responsibility for those services lies with the same undertaking. There will be a high degree of similarity. Insofar as such services do not relate in this way to the services of the earlier marks, I shall discuss the consequences later in this decision.

28) The Applicant's *Information, consultancy, advisory and training services relating to the aforesaid* will be provided as part and parcel of the above services to which they relate, and will share their respective degrees of similarity, or lack of similarity, to the Opponent's services.

The average consumer and the purchasing process

29) 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*. 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.”

30) The average consumer of the Opponent’s medical and dental services, or information advice and consultancy relating to them, and of the Applicant’s education, training and publication services, may be drawn from a range of potential users: health care professionals from both within and outside the NHS, from surgeons and clinicians to nurses, healthcare assistants, and administrative staff charged with procurement, professional beauticians and potential patients. Thus, they may include not only highly qualified and skilled operators in the provision of such services – who may be expected to show a higher than average level of care and attention – but also professional and commercial consumers at all levels, and members of the general public. When I come to make my assessment of the likelihood of confusion I must bear in mind that it is the section of the public which has the lowest level of attention which must be taken into consideration². In choosing medical and dental services, or cosmetic procedures, or selecting education, information or advice relating to them, members of the general public will show a level of attention appropriate to matters touching on their health and/or appearance. This will be at least an average level of care and attention.

² See *Uzstato sistemas administratorius v EUIPO*, T-477/18 paragraph 55, *The Cookware Company Ltd*, T-535/14, paragraph 27 and *Kido v OHIM – Amberes (SCORPIONEXO)*, T 152/08, EU:T:2010:357, paragraph 40.

31) Training, education workshops and publications can range from those adapted to the needs of highly qualified practitioners to members of the general public who wish to inform themselves about medical and dental treatments, particularly cosmetic procedures. Cosmetic medical and dental services and procedures in particular are widely advertised to the general public; they may be promoted through publications and brochures including online, through information courses, workshops and other events, or documentary or promotional material on TV radio DVD, or online. It cannot therefore be assumed that the average consumer will necessarily have a particular level of professional experience or knowledge. The purchasing process for such services will be predominantly visual but could also, for example include telephone bookings following radio promotions, so oral considerations will also play a role in my assessment.

The distinctive character of the earlier marks

32) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, on the basis either of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

33) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. The Applicant submits that the HARLEY element in the competing marks “*is of inherently lower distinctive character relative to any medical goods or services. Harley Street is a street in Marylebone, synonymous with medical services in Central London, which has been noted since the 19th century for its large number of private specialists in medicine and surgery.*”

34) I fully accept that “Harley Street” is well-known, not only in the medical profession but also among the general public, as a street in London where many eminent and well-known private physicians and surgeons have their consulting rooms. I also accept and that when the expression “Harley Street” is used in common speech it is very widely understood, including by members of the general public, to be a reference to medical practitioners at the top end of their profession. While arguably perhaps not actually directly descriptive of top-end medical services as such, it is nevertheless at the least highly allusive of them.

35) However, it is the expression “Harley Street” as a whole which produces this strong association. The individual word “Harley” is not used on its own in this connection. “Harley” is a not uncommon English name, and 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. Though I think it likely that, when used in connection with services related to medicine or dentistry, a significant proportion of the public at large will recognise in the word “Harley” an indirect allusion to “Harley Street”, I do not consider that this will significantly weaken their perception of HARLEY as an indication of origin (i.e. its capacity to distinguish the goods and services of one enterprise from those of another) even when used in connection with the services in question. I do not think

that this indirect element of allusiveness results in a low degree of distinctiveness. I consider that the earlier mark 3029024 (HARLEY) has an average degree of distinctive character for the services in question.

36) The words CLINIC and DENTIST in the earlier marks 3069038 and 3025580 respectively are descriptive of the relevant services. Both, however, contain the word HARLEY as their initial element, and I consider that, overall, the same degree of distinctive character as I have found above for the earlier mark 3029024 can also be attributed to marks 3069038 and 3025580.

Comparison of the marks

37) 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, to dissect the trade marks artificially, 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.

38) The marks to be compared are shown below:

The opposed mark
HARLEY ACADEMY

The earlier mark 3029024	The earlier mark 3069038	The earlier mark 3025580
HARLEY	HARLEY CLINIC	HARLEY DENTIST

39) I have already found at paragraph 35 above that HARLEY has an average degree of distinctiveness when used in connection with services related to medicine or dentistry; the same considerations apply when it is used in connection with the Applicant’s education, training and publication services related to medicine or dentistry. The word “academy” is directly descriptive of an educational institution. When used in connection with educational, training or teaching services, or the provision of seminars, workshops, etc. it is either descriptive or, at any rate, highly allusive. When used in connection with publications, particularly in the fields of medicine, dentistry or cosmetic surgery, it is highly allusive. Though ACADEMY does contribute to the overall impression of the Applicant’s mark, the mark’s distinctive weight lies predominantly on the word HARLEY.

The distinctive element of the earlier mark 3029034 is the word HARLEY, this being the mark’s sole component.

40) The word “clinic” is descriptive when used in connection with services specified in Classes 43 and 44 of the earlier mark 3069038. Though CLINIC does contribute to the overall impression of the earlier mark 3069038, the mark’s distinctive weight lies predominantly on the word HARLEY.

41) The word “dentist” is descriptive, or at any rate highly allusive, when used in connection with the services specified in Classes 43 and 44 of the earlier mark 3025580. Though DENTIST does contribute to the overall impression of the mark, its distinctive weight lies predominantly on the word HARLEY.

42) The Applicant’s mark HARLEY ACADEMY and the earlier marks HARLEY CLINIC and HARLEY DENTIST all consist of two words of roughly equal length. The second words in the Opponent’s earlier marks, CLINIC and DENTIST respectively, obviously represent points of visual difference from the Applicant’s mark, the second word of which is ACADEMY. However, there is a rough rule of thumb in the settled case law that the consumer normally attaches more importance to the beginnings of word marks. This is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks³. In this case I consider the rule of thumb to be a useful guide, particularly in view of my findings with regard to the relative distinctiveness of HARLEY on one hand and ACADEMY, CLINIC or DENTIST respectively on the other, and my conclusion that, as a result, the second words will in each case receive less attention, the focus lying heavily on the initial HARLEY. Viewed overall, there is a high degree of visual similarity between the Applicant’s mark and the Opponent’s earlier marks 3069038 and 3025580.

43) The absence of a second word in the earlier mark 3029024 obviously creates an immediate visual difference. On the other hand, I have found that the second words in the other marks already discussed will in any case receive less attention, the focus lying heavily on the initial HARLEY. Viewed overall, I still consider that there is a fairly high degree of visual similarity between the Applicant’s mark and the earlier mark 3029024.

44) In oral use all of the marks will usually be spoken in their entirety. For the same reasons as I have given in my assessment of visual similarity in paragraph 42 above, however, the consumer’s focus will in each case lie heavily on the initial HARLEY, the second words ACADEMY, CLINIC and DENTIST respectively receiving less

³ See Case T -438/07 *Spa Monopole, compagnie termiere de Spa SA/NV v OHIM* at paragraph 23.

attention. Viewed overall, there is a high degree of aural similarity between the Applicant's mark and the Opponent's earlier marks 3069038 and 3025580 and, despite the lack of the extra word, still a fairly high degree of aural similarity with the earlier mark 3029024.

45) The word ACADEMY in the Applicant's mark represents a conceptual difference both from the earlier mark 3029024, which contains no second word, and from the CLINIC and DENTIST of the earlier marks 3069038 and 3025580 respectively; but owing to the descriptive or highly allusive nature of these words, the impact of these conceptual differences on the overall impressions of the respective marks will be limited. The General Court has held that a name which does not convey a 'general and abstract idea', and which is devoid of semantic content, is lacking any 'concept', but that there may be cases where a name has a recognisable semantic content⁴. I have already observed that I am not persuaded that, shorn of the familiar "Street", "Harley" used on its own will produce the same strong and immediate association. Some consumers may not make the association. I consider it likely, however, that at least a significant proportion of the relevant public will find in the word "Harley" an indirect allusion to "Harley Street". For these consumers, this will be an element of conceptual similarity, although an allusive one, between all the marks in question. Viewed overall, I think there is at least a reasonable level of conceptual similarity between the Applicant's mark and all the earlier marks.

Likelihood of Confusion

46) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

⁴ See *Luciano Sandrone v EUIPO*, T-268/18, at paragraphs 81-90.

47) I have found the earlier marks to have an average degree of distinctive character⁵. I have found a high degree of visual and aural similarity between the Applicant's mark and the earlier marks 3069038 and 3025582, a fairly high degree of visual and aural similarity with the earlier mark 3029024, and at least a reasonable level of conceptual similarity between the Applicant's mark and all the earlier marks. I have found a high degree of similarity between the services of the various earlier marks and those of the Applicant which I have categorised under Group (A) and Group (C). I have also found a high degree of similarity with those in Groups (B), (D), and (E), insofar as these encompass the more specific services in Group (A) and Group (C), or insofar as they relate to the medical and dental services of the Opponent's Class 44 specifications.

48) I have found as follows: that the average consumer of the Applicant's services may include a broad spectrum of potential users, ranging from highly skilled health professionals – who may be expected to show a higher level of care and attention – to members of the general public; I must bear in mind that in making my assessment of the likelihood of confusion it is the section of the public which has the lowest level of attention which must be taken into consideration; and that in choosing medical and dental services, or cosmetic procedures, or selecting education, information or advice relating to them, members of the general public will show a level of attention appropriate to matters touching on their health and/or appearance – which will be at least an average level of care and attention. Moreover, I also bear in mind that in *Swemac Innovation v EUIPO*, T-287/17, a case involving medical apparatus and equipment, where the signs and goods were similar to a high degree, the General Court in any case found that it was not possible to exclude a likelihood of confusion even where goods and services were marketed in the context of public procurement procedures, and even taking into account the high degree of attention of the relevant public (see paragraphs 70-71).

⁵ It is perhaps worth noting that even if I had found a weaker degree of distinctive character this would not have affected the result of my assessment in this case. Even where an earlier mark is of weak distinctive character there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered. See *L'Oréal v OHIM*, T 112/03 at paragraph 61.

49) I have found that the distinctive weight of all the marks to be compared lies heavily on the word HARLEY and that, by virtue of their descriptive or highly allusive character, the second words in the opposed mark and the earlier marks 3069038 and 3025580 will receive less attention. This being so, and taking into account the considerations I have outlined above, I think it likely that at least a substantial proportion of the relevant public will directly confuse those marks – i.e. mistake them for one another where they are used for services which I have found to be highly similar. I consider that this also holds true with regard to the earlier mark 3029024. Though I accept that the lack of a second word in that mark creates more difference between it and the Applicant's mark, I still consider that at least a substantial proportion of the relevant public will directly confuse them. Even if I am wrong about this, however, there will in any case be indirect confusion.

50) Sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis, QC, explained (at paragraph 16) that indirect confusion can occur where the consumer has actually recognised 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". Bearing in mind the considerations I have outlined above, and the descriptive or highly allusive nature of the second word element in the Applicant's mark and the earlier marks earlier marks 3069038 and 3025580, I consider that that part of the relevant public which notices the differences between the marks will assume that the Applicant's mark and any of the earlier marks are brands belonging to the same or related undertakings where they are used for services which I have found to be highly similar.

51) To summarise: I find a likelihood of direct or indirect confusion in respect of all the Applicant's services in Group (A) and (C), and in respect of those services in Groups (B), (D), and (E) which encompass the more specific services in Group (A) and Group (C), or which relate to the medical and dental services of the Opponent's

Class 44 specifications. I have given some thought to the question of whether, in view of their broad nature, the Applicant's specifications in Groups (B), (D), and (E) could be amended so as to avoid confusion. However, in view of the degree of similarity between the marks and services, and the penumbra of protection of the earlier marks, I have found it difficult to formulate express qualifications which would unambiguously "do the trick"⁶.

52) I have considered the possibility of inviting the parties to make further submissions on this question and then issuing a further supplementary decision. I have concluded that this would not be appropriate in this case, however, bearing in mind that the parties failed to reach an accommodation following the Applicant's amendment deleting parts of its specification, and that the Applicant did not submit a further fall-back submission or suggest the possibility of such further amendment in its submissions.

Outcome

29) **The opposition succeeds insofar as the application is refused in respect of the following services:**

Class 41: Conducting of educational seminars relating to medical matters; courses (training-) relating to medicine; education services relating to health; education services relating to medicine; educational services relating to beauty therapy; medical education services; medical training and teaching; providing continuing dental education courses; providing continuing medical education courses; providing continuing nursing education courses; teaching of beauty skills; teaching services relating to the dental field; teaching services relating to the medical field. organising, conducting and providing workshops, courses, seminars and conferences in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures; publication of books and journals in the field of cosmetic surgery, medical care, aesthetic medicine and cosmetic procedures; publishing services; publication of books and journals;

⁶ See Mann J's observations in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939 (Ch) at paragraph 53.

publishing services, namely on-line publication of electronic books, journals and magazines; providing on-line electronic publications (non-downloadable); publication of material which can be accessed from databases or from the internet; education; training; organising, conducting and providing workshops, courses, seminars and conferences; publication of texts and books including online publishing; providing online electronic publications (not downloadable); production, presentation and distribution of text, audio, video, images, animations, databases and other data via telecommunication networks and/or global computer networks; film, video, audio-visual and music production; presentation of live performances; organisation of exhibitions for cultural or educational purposes; information, consultancy, advisory and training services relating to the aforesaid.

The opposition fails in respect of the following services, which I have found to be dissimilar to those in the specifications of the Opponent's earlier marks, and which may therefore proceed to registration:

Class 41: *Organisation of competitions; production, presentation and distribution of games via telecommunication networks and/or global computer networks; music production; information, consultancy, advisory and training services relating to the aforesaid.*

Costs

30) Though the opposition did not succeed in its entirety, the Opponent has been very largely successful and is entitled to a contribution towards its costs to reflect this. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. I hereby order Harley Academy Ltd. to pay Harley Hospital Ltd. the sum of £500. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£150
Preparing written submissions	£250

The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful

07 October 2019

**Martin Boyle
For the Registrar,
The Comptroller-General**