

O/541/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NOS. 3025581, 3013725, 3029024, 3025580  
AND 3013723

IN THE NAME OF HARLEY HOSPITAL LTD FOR THE FOLLOWING TRADE  
MARKS:

HARLEY GYNAECOLOGIST  
(IN CLASSES 1, 5, 10 AND 44)

HARLEY DENTIST  
(IN CLASSES 3, 5, 10, 21 AND 44)

HARLEY PAEDIATRICIAN  
(IN CLASS 44)

HARLEY  
(IN CLASS 44)

AND

HARLEY HOSPITAL/  (SERIES OF TWO)  
(IN CLASS 44)

AND

CONSOLIDATED APPLICATIONS FOR A DECLARATION OF INVALIDITY  
UNDER NUMBERS 502887, 502888, 502889, 502890 AND 502891  
BY 16HARLEYCO LTD

## Background and Pleadings

1. This is an application dated 6 November 2019 by 16HarleyCo Ltd (“the Applicant”) to invalidate each of the UK trade mark registrations as set out below in the name of Harley Hospital Ltd (“the Proprietor”). The proceedings were consolidated on the 11 February 2020.

(i) HARLEY GYNAECOLOGIST

UKTM no. 3025581

Filed 9 October 2013

Registered 24 January 2014

Class 1: Diagnostic kits comprising specimen receptors and reagents for testing for selected bacteria.

Class 5: Pharmaceutical preparations; sanitary preparations for medical purposes; materials for dressings; disinfectants and antiseptics; antiseptic cleansers; medicated swabs; test kits; lubricants for medical use; preparations for use in vaginal lubrication; vaginal lubricants; vaginal washes; feminine hygiene products; pads for feminine protection; tampons; anaesthetic preparations; local anaesthetics; ovulation test kits; pregnancy testing preparations.

Class 10: Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs; orthopaedic articles; suture materials supportive bandages; furniture adapted for medical use; urine testing glasses; clamps for surgical use; surgical and wound treating equipment; medical equipment for gynaecological use; surgical equipment for gynaecological use; parts and fittings for the aforementioned goods.

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; fertility

treatment; health screening services; sexual health services; sexual health screening services; pregnancy testing; gynaecological services; private doctor services; advice and consultancy services relating to all the aforesaid services.

(ii) HARLEY PAEDIATRICIAN

UKTM no.3013725

Filed: 12 July 2013

Registered: 20 December 2013

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; advice and consultancy services relating to all the aforesaid services.

(iii) HARLEY

UKTM no.3029024

Filed: 1 November 2013

Registered: 9 May 2014

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; medical clinics; provision of hygienic and beauty care services; plastic surgery; cosmetic surgery; cosmetic treatments; services for the treatment and care of the skin; face lifts; hair

implantation, hair replacement and hair transplant services; fertility treatment; health screening services; sexual health services; sexual health screening services; private doctor services; body cosmetic surgery; breast cosmetic surgery; facial cosmetic surgery; laser treatments; information, advice and consultancy services relating to all the aforesaid services.

(iv) HARLEY DENTIST

UKTM no.3025580

Filed: 9 October 2013

Registered: 14 March 2014

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.

(v) HARLEY HOSPITAL and  (series of two)

UKTM 3013723

Filed: 12 July 2013

Registered: 18 October 2013

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; advice and consultancy services relating to all the aforesaid services.

2. The grounds of invalidation are based on sections 47 and 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”). The Applicant filed an application for invalidation and statement of grounds against each of the Proprietor’s trade marks and for all the goods and services of its registrations, pleading that the term HARLEY is synonymous with Harley Street being a renowned street in London for the provision of medical services and associated goods and is therefore said to be, in relation to all the Proprietor’s marks, descriptive, used in the trade and consequently devoid of distinctive character. In particular the Applicant pleaded that:

- (1) Under section 3(1)(b) the trade marks are devoid of distinctive character, being descriptive of the services of the registrations in suit and cannot serve to distinguish the goods/services from those of other undertakings.

Harley Street is a location in London which is known for its large number of dental, surgical and medical practices such that the word HARLEY is synonymous with for example the dental, medical, surgical and cosmetic surgery area;

The word GYNAECOLOGIST (meaning: “a physician or surgeon qualified to practice in gynaecology”) is a simple descriptive term in relation to the goods and services in suit.

The word HOSPITAL (meaning: “an institution providing medical and surgical treatment and nursing care for sick or injured people”) is a simple descriptive term in relation to the services of the registration in suit.

The word DENTIST (meaning: “a person who is qualified to treat diseases and other conditions that affect the teeth and gums especially the repair and extraction of teeth and the insertion of artificial ones”) is a simple descriptive term in relation to the goods and services of the registration in suit.

The word PAEDIATRICIAN (meaning “a medical practitioner specializing in children and their diseases”) is a simple term in relation to the services of the registration in suit.

The word HARLEY has a direct meaning in relation to the services meaning for example an establishment based on HARLEY STREET offering for example dental, medical, surgical or cosmetic services.

The combination of HARLEY and GYNAECOLOGIST/DENTIST/HOSPITAL/PAEDIATRICIAN has a direct meaning in relation to the goods and services meaning a practitioner/establishment based on Harley Street offering dental, medical, surgical or cosmetic services or gynaecological/dentistry services and associated goods. As such it is descriptive of such goods/services in the registrations in suit and cannot serve to distinguish the goods/services of the registration in suit from those of other undertakings.

- (2) Under section 3(1)(c) the trade marks consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purposes, value, geographical origin, the time of production of goods or rendering of services or other characteristics of goods or services.

The trade marks HARLEY, HARLEY GYNAECOLOGIST, HARLEY DENTIST, HARLEY HOSPITAL and HARLEY PAEDIATRICIAN are descriptive of the goods and services in suit.

The trade marks comprise of a term/two terms that have readily understandable and descriptive meanings in relation to the goods and services of the registration in suit and the combinations of the terms do not create a different meaning. On the contrary the combinations enhance the descriptive meaning of both elements such that the descriptive meaning is clear.

The trade marks are either synonymous with or a combination of the geographical location and a word describing the goods and services of the registration and would be seen by the average consumer as simply meaning a place on Harley Street where a practitioner offering goods and services in suit practices.

The word HARLEY or the phrases HARLEY GYNAECOLOGIST, HARLEY DENTIST, HARLEY HOSPITAL and HARLEY PAEDIATRICIAN are descriptive signs in relation to the characteristics of the goods and services in respect of which registration is granted and should be used freely by all traders offering such goods and services.

- (3) Under section 3(1)(d) the trade marks consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

The location Harley Street has become synonymous with practices offering for example dental, medical, surgical or cosmetic services and associated goods. Many such practices in the general location of Harley Street, and elsewhere, have the word HARLEY as part of their name to show an association with the perceived quality service that practices located in the Harley Street area have.

The words GYNAECOLOGIST, DENTIST, PAEDIATRICIAN and HOSPITAL are common English words with a direct meaning in relation to the goods and services.

The word HARLEY and the phrases HARLEY HOSPITAL, HARLEY GYNAECOLOGIST, HARLEY DENTIST and HARLEY PAEDIATRICIAN are an apt description of any medical etc practice or practitioner providing gynaecological, dentistry or medical services and/or associated goods on Harley Street or the general area or a practice that wishes to be associated with the location and is thus a sign that is used to describe such practices.

3. The Proprietor filed a defence and counterstatement denying each ground of invalidation against each of its trade marks. In particular denying that its trade marks are devoid of distinctive character, or are descriptive or are customary in the trade. In addition it denies that the word HARLEY is synonymous with HARLEY STREET or the geographical area described by the name Harley Street. It pleaded that its trade marks are sufficiently inherently distinctive.



4. The Applicant is represented by Lewis Silkin LLP. The Proprietor is represented by Stobbs IP. Only the Applicant filed evidence. No evidence was filed by the Proprietor. Following a request from the Proprietor a hearing took place before me on Thursday 29 April 2021 via video conference. At the hearing the Proprietor was represented by Mr Julius Stobbs of Stobbs IP, who filed skeleton arguments prior to the hearing. Neither the Applicant, nor its representative, attended the hearing nor did it file submissions in lieu. This decision is taken following a careful perusal of all the papers.

5. 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 Summary**

6. The Applicant's evidence is the witness statement of Ms Helene Whelbourn dated 30 September 2020, accompanied by 8 exhibits marked GH 1-8. Ms Whelbourn is a trade mark attorney at Lewis Silkin LLP, instructed to act on behalf of the Applicant in these proceedings.

7. Ms Whelbourn's statement is a combination of evidence of fact and submissions. Whilst I have read the statement in its entirety, in particular I note the following:

"2. Each of the marks should not have been registered or remain registered because they are devoid of distinctive character or are descriptive. Further they essentially comprise of the word HARLEY which has become synonymous with practices offering for example dental medical surgical or cosmetic services and associated goods. Many such practices in the general location of Harley Street, and elsewhere, have the word HARLEY as part of their name to show an association with the perceived quality of service that practices located in the Harley street area. The marks are comprised of the word HARLEY together

with a word that simply describes the goods/services for which the marks are registered and one registration of the word HARLEY alone.

3. The grounds of invalidity are based on the premise that HARLEY is non distinctive and/or descriptive of services in the medical, dental and associated fields due to the reputation of Harley Street for goods and services in those areas. Use of the word HARLEY in trade marks is solely for the purposes of indicating either a connection to that geographical location or to the goods/services for which that area is known.

4...the word HARLEY is used by a number of businesses in the UK, predominantly, it is admitted as part of the phrase HARELY STREET, to denote a link to the famous centre of medical practices in London. However not all use the phrase HARELY STREET to emanate a link to that area and the high quality services the practices in that area are reputed to provide.”

8. Accompanying Ms Whelbourn’s statement are a number of screenshots taken from the websites of various companies said to either use the word HARLEY as part of their name/trade mark to indicate a link to Harley Street or who do not have a direct connection to Harley Street but nevertheless use the word HARLEY as part of their name/trademark. These exhibits include:

- Harley Dietitians

An undated screenshot (save for a copyright date of 2019) is produced from [www.harleydietitians.co.uk](http://www.harleydietitians.co.uk).<sup>1</sup> It is stated that this is an example of a company based on Harley street but who do not use “street” in their name. The company was incorporated in 2017 and provides paediatric and women’s health nutritional consultancy services. The business’ address as displayed on the website is 10 Harley Street, W1G 9PF. The symbol ® is displayed in superscript after the name.

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<sup>1</sup> GH1

- Harley Medical Group

An undated printout is produced taken from the website [www.harleymedical.co.uk](http://www.harleymedical.co.uk).<sup>2</sup> The business it is stated has clinics throughout the UK including on Harley Street London, but who do not include the word “street” in their name. The names Harley Medical Group and Harley Medical were both registered as trade marks in 2008 and the business offers a wide range of medical and health services. It is submitted that the company use HARLEY as an indicator of their origins in Harley Street but do not use the word “street” in order to establish a connection to the location.

- Harley Therapy Limited

The company is based on Harley Street offering counselling and therapy services. Its trade mark HARLEY THERAPY was registered in the UK in 2009. An undated print out (save for a copyright date 2020) is produced taken from their current website [www.harleytherapy.com](http://www.harleytherapy.com).<sup>3</sup> Its address is displayed as 1-7 Harley Street, London.

- Harley Health Village

Harley Health Village is said to be located on Harley street offering a range of medical facilities and equipment. An undated printout (save for a copyright date of 2018) is produced taken from their current website [www.harleyhealthvillage.com](http://www.harleyhealthvillage.com).<sup>4</sup> Their address is shown as 64 Harley Street, London.

- Harley Plastic Surgery

Harley Plastic Surgery is run by Oliver Harley and relates to a plastic surgery practice based in East Grinstead. The trade mark was registered in 2015. An

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<sup>2</sup> GH2

<sup>3</sup> GH3

<sup>4</sup> GH4

undated printout (save the copyright date of 2020) taken from the current website [www.harleyplasticsurgery](http://www.harleyplasticsurgery) is produced.<sup>5</sup>

- Harley Skin and Laser Ltd

The company, incorporated in 2011, is based in Newcastle-Under-Lyme and offers skin care treatments. The trade mark was registered in 2016. The sole director is named Harley Spencer. An undated printout is produced from the current website [www.harleyskinandlaser.co.uk](http://www.harleyskinandlaser.co.uk). The home page includes a testimonial that the clinic is “designed to bring Harley Street skin treatments without the need to travel.”<sup>6</sup>

- Harley Eyecare

The business is based in Braintree offering ophthalmic services. It is noted that the opticians has been in business for over 30 years. Save for a copyright date of 2018 an undated screen shot is produced from [www.opticiansbraintree.co.uk](http://www.opticiansbraintree.co.uk).<sup>7</sup>

9. In addition Ms Whelbourn produces a printout of 12 marks found on the UKIPO website which contain the word HARLEY.<sup>8</sup>

## Decision

10. Section 47(1) of the Act applies to an application for invalidation under section 3 which reads as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

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<sup>5</sup> GH5

<sup>6</sup> GH6

<sup>7</sup> GH7

<sup>8</sup> GH8

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

11. Sections 3(1)(b), 3(1)(c) and 3(1)(d) read as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of product of goods or of rendering of services, or other characteristic of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

12. For the purposes of a claim under these sections the relevant date is the respective filing dates of the registrations namely for HARLEY GYNAECOLOGIST and HARLEY DENTIST, 9 October 2013, for HARLEY PAEDIATRICIAN and HARLEY HOSPITAL (series of two), 12 July 2013 and for HARLEY, 1 November 2013.

13. Although the Proprietor originally pleaded, within its TM8 Forms, a case of acquired distinctiveness by virtue of the use it has made of its trade marks, it did not file evidence, therefore, I only have the inherent distinctive position to consider.

14. The grounds of opposition are threefold; (1) that each of the Proprietor's marks are devoid of distinctive character, (2) are descriptive, consisting exclusively of a sign that may serve in the trade to designate the kind, quality or quantity, intended purpose, value or geographical origin or other characteristics of the goods and services or (3) has become generic and customary in the trade. At the hearing Mr Stobbs submitted that given the limited evidence filed by the Applicant it has not proved its case.

15. I bear in mind that each of the above grounds must be assessed on their own merits as they are independent and have differing general interests. It is possible therefore for a mark not to offend section 3(1)(c) but still be objectionable under sections 3(1)(b) and/or s 3(1)(d). In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

16. I also note that the above grounds must be assessed from the perspective of the relevant public including those in the trade who are deemed to be reasonably observant and circumspect. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant

and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 29; Case C-363/99 Koninklijke KPNNederland [2004] ECR I-1619, paragraph 77; and Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50).”

17. The Applicant in its pleadings submitted that:

“The average consumer of the goods and services is the general public who will pay no more than an average attention to the trade marks but would still be aware of the reputation of Harley street as a location providing the goods and services... as well as professionals in the service area who will be aware of the location Harley street and derive a meaning from the marks accordingly. The words GYNAECOLOGIST, PAEDIATRICIAN, DENTIST and HOSPITAL [are] common words whose meanings [are] readily known to all English speakers.”

18. In his skeleton and at the hearing Mr Stobbs submitted that:

“16. In order to assess the perception of the mark, it is necessary to consider the average consumer. It is settled case law that whilst the average consumer is reasonably well informed and circumspect, the level of attention is likely to vary according to the category of goods or services in question (*C-342/97 Lloyd Schuhfabrik Meyer*, para 26).

17. Where the goods are of a medical or health related nature, the relevant public will take reasonable care to ensure that the products will meet their health and personal needs (*O-122/21 Case O-122/21 CBD Wellness v Thomas Whettem and CBD Healthfoods*, para 43). It follows that a greater degree of attention will be paid in respect of the relevant services due to the price point and medical or health related nature of the services.”

19. The goods and services of each of the registrations in so far as they relate to health care are directed towards both members of the general public seeking medical, dental, surgical or cosmetic services (and the related goods) and professionals within those fields who would wish to refer a patient for specialist attention. Therefore, in either case, I agree with Mr Stobbs that a higher than average level of attention will be undertaken in selecting the services or in purchasing/prescribing the goods since factors such as suitability, quality and safety considerations would factor given their regulatory nature and that they relate to the health and well-being of the patient. Similarly, in relation to those goods and services that relate to animal care and veterinary, agriculture/forestry services, absent submissions to the contrary, they would in my view also be directed at both groups of relevant public.

## **Grounds**

20. Moving on to the specific grounds, I shall deal with each in turn and follow the order in which Mr Stobbs addressed me in his skeleton and at the hearing.

## **Section 3(1)(c)**

21. This provision prevents the registration of trade marks which are descriptive namely that they consist exclusively of signs that designate a characteristic, which in the context of this case, includes their geographical origin. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. zo.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article



7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign

could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

22. The Applicant’s case is that the use of the element HARLEY in each of the Proprietor’s marks solely indicates either a connection to the geographical location Harley Street and/or to the quality of the goods/services for which that area is known. According to the Applicant “Harley Street is a location in London which is known for its large number of dental, surgical and medical practices such that the word HARLEY is synonymous with dental, medical, surgical and the cosmetic surgery area.” Furthermore, it contends that HARLEY solus is descriptive in relation to the characteristics of the services and in combination with GYNAECOLOGIST, PAEDIATRICIAN, DENTIST and HOSPITAL is the combination of a geographical location and a word describing the goods and services and will simply be seen by the relevant public to mean a place on Harley Street offering such gynaecological, dental, paediatric and hospital services and associated goods. In essence the Applicant states, due to the reputation of Harley Street, that HARLEY solus or in combination with a descriptive medical term will immediately be equated to HARLEY STREET and consequently as a result of the highly reputed image that Harley Street brings to mind will also be indicative of the quality of those goods and services.

23. Mr Stobbs refutes this contention arguing that the relevant class of persons have only a limited degree of familiarity with the geographical name Harley Street and therefore HARLEY (absent street) is not (prima facie) descriptive of medical services or the related goods or designate the geographical origin of the goods and services as a result.

24. There appears to be no issue between the parties that the elements GYNAECOLOGIST, PAEDIATRICIAN, DENTIST and HOSPITAL are all descriptive

terms, albeit that Mr Stobbs submitted at the hearing that they were so, only so far as they related to the specific medical services or goods relating to the actual word in question. He considered that the specifications were broader and therefore in relation to some goods and services these terms were not purely descriptive; I will come back to this point later. I am therefore asked to consider whether these marks (HARLEY plus descriptor) also designate the geographical origin and the category/quality of the goods and services concerned.

25. When assessing whether a trade mark offends section 3(1)(c) I keep I mind the guidance relating to geographical names as set out by the CJEU in *Windsurfing Chiemsee v Boots Attenberger* (“*Chiemsee*”), C108/97 and C-109/97:

“31. Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or ‘UKTMA’], the competent authority must assess whether a geographical name in respect of which an application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regards must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive [section 3(1)(c) UKTMA] does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

34. However, it cannot be ruled out that the name may serve to designate geographical origin within the meaning of Article 3(1)(c) [section 3(1)(c) UKTMA], even for goods such as those in the main proceedings [being, in that particular case, items of sports clothing], provided that the name could be understood by the relevant class of persons [to include the shores of the lake or the surrounding area].

35. It follows from the foregoing that the application of Article 3(1)(c) [section 3(1)(c) UKTMA] does not depend on there being a real, current or serious need to leave a sign or indication free.

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) [section 3(1)(c) UKTMA] applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

26. Although not bound by the same I also keep in mind the guidance as set out in the Registry’s Work Manual which states as follows:

“the ‘association’ between place name and product, which the Court has confirmed is central to the assessment, need not be limited to a consideration of whether the word designates the ‘place of manufacture’ (or, in the case of services, the ‘place of rendering’).

Beyond the more conventional forms of geographical place names (being countries, cities, and towns), section 3(1)(c) can equally apply to any other designation of geographical area be it inter alia a district, a mountain, a lake (see Chiemsee, for example), a commercial district, see Canary Wharf [2015] EWHC 1588 (Ch) a natural spring, a resort, or a place of natural beauty. Wherever it is considered that the relevant consumer will make an association between the place name and the product(s) intended for protection, then an objection will be likely. Equally, where it is considered that other traders may genuinely seek to use the geographical place-name in their future course of

trade (most likely, again, because of the existence of an association between the place and the product) then an objection will apply.

Where the geographical place name intended for protection has no obvious reputation, it must still be considered how the mark will be perceived in trade. In order to do so, consideration will be given to all facts related to the place name including, but not limited to, the size of the location, and the extent and nature of commercial activity that goes on within its boundaries.

Whilst every town, regardless of size, would likely offer library services, not every town would produce tea bags, and so the consideration of reputation becomes more prevalent. For example, Oxford Leisure Centre would face an objection under 3(1)(c), however, Oxford Tea Bags would not. The names of places which are likely to be the source of natural produce are unlikely to be registrable as trade marks for such goods even if the place identified by the mark has no specific reputation. A place will have to be obscure before its name can be registered as a trade mark for unprocessed products of the kind frequently sold from roadsides and farm shops, such as fruit and vegetables, flowers, potatoes, water, eggs and milk. This may not be the case in respect of processed foodstuffs, which are less likely to be associated with local producers and providers. In the case of such products, the names of a larger, more populous areas may be objectionable if the examiner considers them likely to be perceived as a reference to where the foodstuff was processed.”

27. Little evidence was put before me as to the meaning of HARLEY or HARLEY STREET to the relevant public, and so I am asked in effect to take judicial notice of the relevant public’s knowledge of HARLEY STREET as a geographical location in London, and its claimed reputation for specialist medical, dental and surgical practitioners and by association in the context of the goods and services that HARLEY would automatically give rise to the same meaning.

28. Mr Stobbs submitted that I should take care against taking judicial notice of the reputation of Harley Street. He, nevertheless, conceded at the hearing that perhaps medical professionals would be more familiar with the specialised nature of those practising in Harley Street but that he did not consider this extended to the general public. At best, he considered that some may associate the word Harley with Harley Street but argued for the most part the majority would not.

29. I agree that I must be cautious in my approach. I remind myself of the decision in *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08, where Ms Anna Carboni as the Appointed Person described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts. She said:

“While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.”

30. Ms Carboni found that it was not correct for the hearing officer to take judicial notice of the meaning of the word Cherokee (being understood to mean a native American tribe) without evidence; she considered that it was not sufficiently a known fact to the average consumer of casual clothing. Whilst this decision was in relation to a likelihood of confusion test, the issue in suit has application in my assessment.

31. Harley Street is defined in the Collins online dictionary as “a street in central London famous for its large number of medical specialists consulting rooms”<sup>9</sup> and in

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<sup>9</sup> <https://www.collinsdictionary.com/dictionary/english/harley-street>



the Cambridge online dictionary as “a street in London where many well-known private doctors treat their patients.”<sup>10</sup> It is my understanding that Harley Street is known worldwide as a street in London renowned as the location of specialists in the field of medicine, dentistry and surgery, particularly cosmetic surgery. Whilst keeping in mind the caution described above, I come to the view that it is a notorious fact that cannot be the subject of serious dispute; the name HARLEY STREET will be well known not only to those in the medical field, but also to members of the general public, as a place where high quality healthcare services are provided.

32. I accept that there may be a proportion of the public within the UK, as submitted by Mr Stobbs, who do not understand the origins or the implications of this geographical location and merely see it as the name of a generic street named after an individual, thus Harley will be perceived as a forename or surname with no connection to the location. However, such a view will represent only a minority of people.

33. In its evidence the Applicant referred me to a number of businesses that used the word Harley as part of their name where it is said to indicate a link with Harley Street. These include Harley Dietician, Harley Medical Group, Harley Therapy Limited, and Harley Health Village. A number of these companies do not use street within their name, yet still, it is argued, are able to establish a connection to the location by solely using the word HARLEY as an indicator of their origin. Mr Stobbs argued at the hearing that the marks are not descriptive and are not being used descriptively to refer to Harley Street; he submitted that the element Harley is being used by several of these businesses as a brand element. He submits that both Harley Therapy and Harley Dietician have ® and/or ™ beside their logos which clearly show it is intended to be regarded as a brand rather than descriptive. Whilst I accept that the exact nature of the uses of these names are inconclusive, according to the above caselaw for a mark to fall foul of section 3(1)(c) it is not necessary for it actually to be in use in a way that is descriptive. If a mark has the potential to be used descriptively then this is sufficient.

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<sup>10</sup> <https://dictionary.cambridge.org/dictionary/english/harley-street>

34. Having found that Harley Street has a reputation, I will now go on to consider whether this extends to the marks in suit, none of which make use of the word STREET, in the context of certain of the services for which they are registered (returning to the goods and other services later). The Proprietor's marks include the following services:

#### HARLEY GYNAECOLOGIST

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; fertility treatment; health screening services; sexual health services; sexual health screening services; pregnancy testing; gynaecological services; private doctor services; advice and consultancy services relating to all the aforesaid services.

#### HARLEY PAEDIATRICIAN

Class 44: Medical services; hygienic and beauty care for human beings; 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.

#### HARLEY

Class 44: Medical services; hygienic and beauty care for human beings; 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.

#### HARLEY DENTIST

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.

HARLEY HOSPITAL and  (series of two)

Class 44: Medical services; hygienic and beauty care for human beings; 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.

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

perceived as a description that the services are provided or originate in Harley Street. The strength of the association will simply lead to the relevant public perceiving HARLEY as a shorthand version of HARLEY STREET and that the Proprietor's marks refer to a gynaecologist, dentist, hospital, paediatrician or medical practitioner located in Harley Street, London.

36. The principles behind section 3(1)(c) are to keep descriptive marks relating to geographical location free to use by all traders offering such goods and services. To my mind those practitioners practising medicine, gynaecology and dentistry based in Harley Street would wish to use the term Harley to describe the origin of their location given that Harley Street has such a prestige and reputation associated with the name. In respect of each of the marks namely HARLEY, HARLEY GYNAECOLOGIST, HARLEY DENTIST, HARLEY HOSPITAL and HARLEY PAEDIATRICIAN, in my view, they are all marks that serve in trade to designate the geographical origin of the services and as a result of the highly reputed image this street brings to mind an indication as to the quality of those services. I consider that the objection under section 3(1)(c) is upheld for the reasons outlined.

37. I will now consider the section 3(1)(c) ground in relation to the following goods:

#### HARLEY GYNAECOLOGIST

Class 1: Diagnostic kits comprising specimen receptors and reagents for testing for selected bacteria.

Class 5: Pharmaceutical preparations; sanitary preparations for medical purposes; materials for dressings; disinfectants and antiseptics; antiseptic cleansers; medicated swabs; test kits; lubricants for medical use; preparations for use in vaginal lubrication; vaginal lubricants; vaginal washes; feminine hygiene products; pads for feminine protection; tampons; anaesthetic preparations; local anaesthetics; ovulation test kits; pregnancy testing preparations.

Class 10: Surgical, medical, dental ....apparatus and instruments; artificial limbs; orthopaedic articles; suture materials supportive bandages; furniture adapted for medical use; urine testing glasses; clamps for surgical use; surgical and wound treating equipment; medical equipment for gynaecological use; surgical equipment for gynaecological use; parts and fittings for the aforementioned goods.

#### 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 ....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.

38. I accept that Harley Street is predominantly known for medical services and having come to the conclusion I have, I must now assess whether the finding I have made applies to the above goods. The goods in question are medical instruments/apparatus and pharmaceutical goods. Whilst it would be clear to the relevant public that the goods are unlikely to be manufactured in Harley Street, having regard to the decision in *Chiemsee*, I must also consider whether they will perceive a connection between the category of goods and the geographical location, based on other ties, for example that they consider the goods to be conceived and designed in the geographical location concerned.

39. I take into account the comments of Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Fourneaux De France Trade Mark*, Case BL-O/240/02, who stated that:

“Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression "cookers from France" is descriptive at a high level of generality. That makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern cooker installations including not only grilling and roasting units, but also hood and extractor units”.

40. On this basis and taking account of Mr Hobbs' comments in *Fourneaux*, and having regard to the decision in *Chiemsee*, such is the degree of familiarity amongst the relevant public with the name Harley Street and consequently Harley, it is reasonable to conclude that such a name would be regarded by the relevant public as also designating the geographical origin of the category of the goods concerned. It is reasonable to conclude that the relevant public will consider that the goods are supplied or provided by an undertaking located in Harley Street, even if not manufactured there. The goods will be regarded as intrinsically linked to the services

rendered and an integral part of the commercial context so as to be covered by the descriptive words HARLEY GYNAECOLOGIST and HARLEY DENTIST.

41. The Proprietor's marks also include the following goods and services:

HARLEY GYNAECOLOGIST

Class 10: Veterinary apparatus and instruments; parts and fittings for the aforementioned goods.

HARLEY DENTIST

Class 10: Veterinary apparatus and instruments; parts and fittings for the aforementioned goods.

HARLEY PAEDIATRICIAN

Class 44: Veterinary services; hygienic and beauty care for .....animals; agriculture, horticulture and forestry services; advice and consultancy services relating to all the aforesaid services.

HARLEY

Class 44: Veterinary services; hygienic and beauty care for .....animals; agriculture, horticulture and forestry services; information, advice and consultancy services relating to all the aforesaid services.

HARLEY HOSPITAL and  (series of two)

Class 44: Veterinary services; hygienic and beauty care for ...animals; agriculture, horticulture and forestry services; advice and consultancy services relating to all the aforesaid services.

42. Mr Stobbs argued that these marks were not descriptive for such goods and services and would not bring to mind Harley Street since the location had no current reputation for such goods and services. However, following the decision in *Chiemsee* I must not only consider the current position but also the position as to whether it is reasonable to assume that such names are capable to be used in the future as designating the geographical origin of the goods and services concerned. It may be possible for veterinary practitioners and those involved in horticulture, agriculture and forestry to establish themselves in the location of Harley Street in the future such that the location becomes synonymous with the goods and services relating to these sectors, however, I do not consider that this is a reasonably foreseeable occurrence. I do not consider that the relevant public will consider it to be either, given the longstanding connection between Harley Street and medical practitioners. There has been no evidence provided of the prospect of this happening. I do not consider that the relevant public would reasonably assume a connection between Harley and Harley Street for goods and services relating to animal care, veterinary services, horticulture, agriculture and forestry, nor would they assume that the Proprietor's marks are capable in the future of designating the geographical origin for these sectors of goods and services. The invalidation therefore fails for these class of goods and services.

### **Conclusion**

43. The invalidation claim based on section 47(1) and section 3(1)(c) succeeds, for the reasons already outlined, in relation to those goods and services as set out above at paragraphs 34 and 37 but fails in relation to those goods and service as set out in paragraph 41.

### **Section 3(1)(b)**

44. The provisions under this section prohibit the registration of marks which are devoid of distinctive character. The question is therefore whether HARLEY, HARLEY GYNAECOLOGIST, HARLEY PAEDIATRICIAN, HARLEY DENTIST and HARLEY HOSPITAL are capable of distinguishing medical, dental and surgical goods and services for which they are registered. The principles to be applied under article 7(1)(b)



of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of

applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

45. Even though it is well established that the grounds for refusing registration is to be examined separately, there is a degree of overlap. It is clear that the Applicant's case under section 3(1)(b) is intrinsically linked to its 3(1)(c) claim ie that the contested marks are devoid of distinctive character because they are descriptive of the geographical origin and quality of the goods and services at issue.

46. For the reasons already set out, having come to the conclusion that the Proprietor's marks are descriptive by designating the origin of the goods and services, it follows, that they are therefore also devoid of distinctive character. The invalidation under section 47(1) and 3(1)(b) succeeds in relation to those same goods and services as outlined in paragraphs 34 and 37, however, fails for those goods and services as outlined in 41.

### **Section 3(1)(d)**

47. This provision prevents the registration of marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the

mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

48. At the hearing Mr Stobbs argued that the Applicant had not pleaded this ground appropriately but even if it were found to have been pleaded properly, then it had provided insufficient evidence to support its claim that the term had become customary in the trade. He submitted that the term had not “been adopted by providers in the trade and used to indicate the nature of the goods or services. It is claimed that the Applicant has not demonstrated any use of this kind or if it has, has not sufficiently demonstrated the scale necessary to uphold an objection.

49. I agree. In order for the invalidation to succeed under section 3(1)(d) I must be satisfied that the Proprietor’s trade marks, at the relevant dates in 2013, have become customary in the current language or in the bona fide and established practices of the trade to designate the goods and services in question. There appears to be no dispute between the parties that the terms GYNAECOLOGIST, PAEDIATRICIAN, DENTIST and HOSPITAL are terms within the medical profession to describe the field of practice. Whilst some evidence has been provided to show some use of HARLEY absent street in the trade, I note that the majority were undated and other than copyright dates for the websites, very limited evidence was filed to reflect the position as at the relevant dates in 2013. Absent cogent evidence, I do not consider that the Applicant has sufficiently satisfied this ground. The invalidation under 3(1)(d) fails.

## **Conclusion**

50. The application for invalidation is successful in relation to the following goods and services relating to the following marks. Under section 47(6) of the Act the registrations are deemed never to have been made in respect of these goods/services.

HARLEY GYNAECOLOGIST no. 3025581

- Class 1: Diagnostic kits comprising specimen receptors and reagents for testing for selected bacteria.
- Class 5: Pharmaceutical preparations; sanitary preparations for medical purposes; materials for dressings; disinfectants and antiseptics;

antiseptic cleansers; medicated swabs; test kits; lubricants for medical use; preparations for use in vaginal lubrication; vaginal lubricants; vaginal washes; feminine hygiene products; pads for feminine protection; tampons; anaesthetic preparations; local anaesthetics; ovulation test kits; pregnancy testing preparations.

Class 10: Surgical, medical, dental apparatus and instruments; artificial limbs; orthopaedic articles; suture materials supportive bandages; furniture adapted for medical use; urine testing glasses; clamps for surgical use; surgical and wound treating equipment; medical equipment for gynaecological use; surgical equipment for gynaecological use; parts and fittings for the aforementioned goods.

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; fertility treatment; health screening services; sexual health services; sexual health screening services; pregnancy testing; gynaecological services; private doctor services; advice and consultancy services relating to all the aforesaid services.

HARLEY PAEDIATRICIAN no.3013725

Class 44: Medical services; hygienic and beauty care for human beings; 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.

HARLEY no.3029024

Class 44: Medical services; hygienic and beauty care for human beings; 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.

HARLEY DENTIST no.3025580

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 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.

HARLEY HOSPITAL and  (series of two)no. 3013723

- Class 44: Medical services; hygienic and beauty care for human beings; 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.

51. The application for invalidity is unsuccessful in relation to the following goods and services for which the marks will remain registered:

HARLEY GYNAECOLOGIST no. 3025581

Class 10: Veterinary apparatus and instruments; parts and fittings for the aforementioned goods.

HARLEY DENTIST no. 3025580

Class 10: Veterinary apparatus and instruments; parts and fittings for the aforementioned goods.

HARLEY PAEDIATRICIAN no.3013725

Class 44: Veterinary services; hygienic and beauty care for .....animals; agriculture, horticulture and forestry services; advice and consultancy services relating to all the aforesaid services.

HARLEY no.3029024

Class 44: Veterinary services; hygienic and beauty care for .....animals; agriculture, horticulture and forestry services; information, advice and consultancy services relating to all the aforesaid services.

HARLEY HOSPITAL and  (series of two) no. 3013723

Class 44: Veterinary services; hygienic and beauty care for ...animals; agriculture, horticulture and forestry services; advice and consultancy services relating to all the aforesaid services.

## **Costs**

52. On the whole, I consider that the Applicant has had the greater share of success and therefore it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice 2/2016. I note that the invalidation action involved 5 sets



of proceedings but that they were consolidated. I also note that the pleadings for each set effectively mirrored the other and other than one or two paragraphs which differed, the statement of grounds in each application was identical. On this basis, I will award costs taking account of the totality of the proceedings across all five applications. Taking this into account and applying the guidance I award costs to the Applicant on the following basis:

Preparing five statements of grounds and considering each of the Proprietor's defences and counterstatements	£300
Drafting evidence	£500
Official Fee (5 x £200)	£1000
<b>Total</b>	<b>£1800</b>

53. I order Harley Hospital Ltd to pay 16Harley Co Ltd the sum of £1800. This sum is to be paid within twenty one days of the expiry of the appeal or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19<sup>th</sup> day of July 2021

Leisa Davies  
For the Registrar