

## DISPUTE RESOLUTION SERVICE

D00010856

### Decision of Independent Expert

HCA International Limited

and

Sam Elisa

#### 1. The Parties:

Complainant: HCA International Limited  
242 Marylebone Road  
London  
NW1 6JL  
United Kingdom

Respondent: Sam Elisa  
1-7 Harley Street  
London  
W1G 9QD  
United Kingdom

#### 2. The Domain Name(s):

harleystreet-clinic.co.uk

#### 3. Procedural History:

31 January 2012 16:59 Dispute received  
01 February 2012 13:23 Complaint validated  
01 February 2012 13:39 Notification of Complaint sent to parties  
23 February 2012 12:17 No Response received  
23 February 2012 12:17 Notification of no Response sent to parties  
07 March 2012 12:35 Expert decision payment received

## 4. Factual Background

- 4.1 The Complainant operates a business known as The Harley Street Clinic in London, UK (the “Clinic”).
- 4.2 The Clinic was founded in 1965, and it houses both adult and paediatric intensive care units. Its paediatric intensive care unit is the largest private paediatric unit in the country. Treatments offered include chemotherapy, radiotherapy and oncology treatments in all tumour types.
- 4.3 A wide range of adult cardiac procedures are also undertaken at the Clinic. The Clinic engages leading consultant neurosurgeons and neurologists. A brochure promoting the services of the Clinic is attached to the Complaint.
- 4.4 The Clinic is described as a “*world famous hospital*” with “*an international reputation for its adult and paediatric cardiac surgical programme*” on a website developed by an independent watchdog, the Society for Cardiothoracic Surgery in Great Britain and Northern Ireland, and by patients who have had experience of heart surgery (<http://heartsurgery.cqc.org.uk>).
- 4.5 The Complainant is also the operator of the following private hospitals and treatment centres in London:
- London Bridge Hospital
  - The Lister Hospital
  - The Portland Hospital
  - The Princess Grace Hospital
  - The Wellington Hospital
  - Harley Street at UCH (University College Hospital NHS Trust).
- 4.6 The Complainant has established Centres of Excellence in the following areas of medical practice across each of its private hospitals in London:
- Cancer
  - Cardiology / heart care
  - Neurosciences (brain and spine injuries)
  - Paediatrics (children and babies)
  - Obstetrics (maternity)
  - Intensive Care
  - Fertility treatments.
- 4.7 The Complainant is the owner of UK trade mark registration number 2308643 for the mark THE HARLEY STREET CLINIC, which was filed at the UK Intellectual Property Office (“UK IPO”) on 22 August 2002 and registered by the UK Intellectual Property Office on 7 May 2004.

- 4.8 HCA Information Technology Services, a related business to the Complainant, is the registrant of the following domain name registrations:
- theharleystreetclinic.com
  - theharleystreetclinic.net
  - theharleystreetclinic.co.uk
- 4.9 The Domain Name was registered on 12 July 2011 in the name of the Respondent. The WHOIS information attached to the Complaint lists the registrant's address as 1-7 Harley Street, London W1G 9QD, United Kingdom.
- 4.10 An extract from the website to which the Domain Name resolves, dated 19 September 2011 and attached to the Complaint, shows this same address under the 'Contact Us' section.
- 4.11 The Website promotes a business offering hair removal and cosmetic treatments, including soprano laser, skin rejuvenation, skin peels and smart lipo.

## **5. Parties' Contentions**

### The Complainant

#### Registered Rights

- 5.1 The Complainant owns registered trade mark rights in the UK in respect of the mark THE HARLEY STREET CLINIC. Details of the trade mark registration are set out in Section 4 above.

#### Unregistered Rights

- 5.2 The Clinic is one of the most prestigious private hospitals in London and is one of London's premier cancer centres.
- 5.3 The Clinic and some of its constituent parts have achieved many accreditations, including from the likes of ISO, Macmillan and BUPA. It has also been awarded Centre of Excellence status by the Clinical Cardiovascular Management Network in association with HCA's Quality, Safety and Improvement Department in the USA.
- 5.4 As a result of its longstanding use of the name The Harley Street Clinic in the UK, the Complainant has built up considerable goodwill under common law in the name in the medical field.

#### Similarity

- 5.5 The Domain Name is similar to (i) the registered trade mark THE HARLEY STREET CLINIC and (ii) the name The Harley Street Clinic, in both of which

the Complainant has rights. The only differences between the registered mark and the Domain Name are the generic domain suffixes “.co.uk”, the hyphen in the Domain Name and the additional word “THE” in the Complainant’s registered mark.

- 5.6 The dominant and distinctive components in (i) the Complainant’s mark are the words HARLEY STREET CLINIC and (ii) the Domain Name are the words HARLEYSTREET and CLINIC. The Domain Name therefore shares highly similar, if not identical, distinctive and dominant components with the Complainant’s registered mark and the name The Harley Street Clinic to which the Complainant has unregistered rights.

#### Abusive Registration

- 5.7 Use of HARLEY STREET CLINIC, which is all but identical to the Complainant’s registered and unregistered trade mark rights, within the Domain Name goes beyond “nominative fair use”.
- 5.8 Though parties operating a facility on Harley Street may legitimately refer to their location, the registration of a domain name containing the registered mark’s dominant components is not in accordance with honest practices. There is no legitimate reason for the Respondent to have adopted the Domain Name. It could have registered and used a genuinely descriptive domain name such as “harley-street-hair-removal-clinic.co.uk”.
- 5.9 The Respondent is therefore riding on the coat tails of the international reputation of The Harley Street Clinic for healthcare services. By associating their hair removal treatments with the specialist care provided by The Harley Street Clinic, the operator of the Website is deriving commercial benefit from the Complainant’s reputation and goodwill. Such use is taking unfair advantage of the reputation and goodwill established by the Complainant in its THE HARLEY STREET CLINIC mark, as well as taking unfair advantage of the registered rights of this mark.
- 5.10 By using HARLEY STREET CLINIC in relation to hair removal treatments, the operator of the Website is diluting the reputation and goodwill established by the Complainant in the name THE HARLEY STREET CLINIC. By such use, consumers will cease to associate the name THE HARLEY STREET CLINIC exclusively with the high quality healthcare provided by the Complainant. Therefore, the ability of the Complainant’s mark to identify its high quality healthcare services will be adversely affected.
- 5.11 The Respondent is using the Website in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This is unsafe in view of the sensitive nature of healthcare provision. As an issue of public policy, it is hazardous for consumers to be led to believe that cosmetic treatments offered by the operator of the Website are associated with a world class healthcare provider with a particular reputation in the oncology and cardiac field.

- 5.12 Correspondence with the business operating at the Website supports the view of likelihood of confusion. In particular, Elisa Choudhary in her email of 4 August 2011 to the Complainant (see section 5.19 below) acknowledges the fact that The Harley Street Clinic is a registered trade mark, and that she could “*completely appreciate your [HCA’s] concerns*”. This indicates that the business operating at the Website acknowledged that the name of their website was confusing.
- 5.13 An extract from the Website dated 27 January 2012 and attached to the Complaint shows (i) that in the ‘About Us’ section of the Website, the business still uses the name ‘Harley Street Clinic’ and (ii) a copyright notice claiming that copyright in the Website belongs to Harley Street Clinic. This suggests to consumers that it is associated with or a part of the Complainant’s business.
- 5.14 Neither the business trading as Harley Street Clinic nor the Respondent has a connection or commercial relationship with the Complainant and does not have the permission of the Complainant to use the mark HARLEY STREET CLINIC or variations thereof.
- 5.15 Use of a hyphen to break up a domain name consisting of several words is a common convention in domain names. Consumers searching for The Harley Street Clinic may therefore type the Domain Name into a browser. Given the goodwill and reputation existing in the Complainant’s mark it is legitimate to expect that a business operating under the Domain Name is connected with the Complainant. This initial interest confusion may harm the Complainant’s business and goodwill through diversion of trade, or diluting the repute of the Complainant’s rights.
- 5.16 The Respondent has used the Domain Name abusively within the meaning of paragraph 3a.ii of the Policy. It has adopted a domain name registration and trading style confusingly similar to that of the Complainant and has sought to associate the prestige and expertise of a leading healthcare operator with its own hair removal services. The correspondence between the parties and the continued use of the Domain Name after being alerted to the Complainant’s rights serves to reinforce the abusive behaviour of the Respondent and the business operating at the Website.

### Correspondence

- 5.17 The Complainant has attached to the Complaint copies of correspondence between it and the operator of the Website.
- 5.18 This correspondence commenced on the 28 July 2011, by way of a letter from the Complainant’s legal adviser to “Harley Street Clinic” at the address listed on the WHOIS search for the Domain Name, notifying them of its rights in The Harley Street Clinic and demanding, inter alia, that all use of the trade mark Harley Street Clinic ceased with immediate effect.
- 5.19 On 4 August 2011, Elisa Choudhary, the Clinic Manager for “Harley Street Clinic”, responded by email stating that they were not aware that The

Harley Street Clinic was a registered trade mark and undertaking to “update” all promotional material by Monday (which would have been 8 August 2011), including brochures and website.

- 5.20 As no action was taken within the stated timeframe, the Complainant’s legal adviser sent a follow up letter dated 11 August 2011, requesting that the promised actions be completed.
- 5.21 On 1 September 2011, the Complainant’s trade mark attorneys sent a letter to the operator of the Website requesting that they cease all use of the trade mark Harley Street Clinic or anything similar thereto, and surrender or assign the Domain Name to the Complainant.
- 5.22 Elisa Choudhary responded on the same day confirming that “*our company name will change to Harley Street Hair Removal as from Friday 2nd September. We are anticipating our website to be update [sic] by the weekend with the new name and domain change.*”
- 5.23 The correspondence concluded with the Complainant’s trade mark attorneys sending a further letter dated 7 September 2011 in which it reiterated the request that the Domain Name be surrendered or assigned.
- 5.24 The Complainant has attached screen shots of the Website dated 19 August 2011 and 13 September 2011 to the Complaint, which show updates to the home page between these two dates. The Complainant notes in particular, that the name on the home page was changed from Harley Street Clinic to Harley Street Hair Removal Clinic, but that the Domain Name is still visible despite assurances from the operator of the Website to the contrary. The Website also bears a copyright notice stating that copyright in the Website belongs to Harley Street Clinic. In addition, attached to the Complaint are extracts from the Website dated 27 January 2012 showing that a business is still operating under the name Harley Street Clinic, and that the Complainant’s cause for complaint in respect of the Domain Name remains.

#### The Respondent

- 5.25 The Respondent did not file a Response.

## **6. Discussions and Findings**

#### General

- 6.1 The Complainant is required under paragraph 2b. of the Policy to prove to the Expert, on the balance of probabilities, that:
- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainant's Rights

- 6.2 Paragraph 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".
- 6.3 Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.4 The Complainant has been granted a UK trade mark registration for THE HARLEY STREET CLINIC, which provides it with exclusive rights to use the mark in relation to the services for which the mark is registered, being medical, hospital, clinical and healthcare services, and therapeutic and medical diagnostic services. The Expert finds that the Complainant has Rights in the mark THE HARLEY STREET CLINIC.
- 6.5 For the purpose of assessing similarity under this head of the Policy the generic domain suffix may be ignored. The only other differences between the mark in which the Complainant has Rights and the Domain Name are (i) the omission of the generic English word "The" at the start of the Domain Name and (ii) the hyphen separating the words HARLEYSTREET and CLINIC in the Domain Name. Neither of these differences are material and do not detract from the distinctive and dominant elements of the Complainant's mark, namely HARLEY STREET CLINIC.
- 6.6 The Expert therefore finds that the Complainant has Rights in a mark (THE HARLEY STREET CLINIC) which is similar to the Domain Name.

### Abusive Registration

- 6.7 Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:
  - i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
  - ii. has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.8 Paragraph 3a. of the Policy sets out a non-exhaustive list of five factors that may be evidence that a domain name is an abusive registration. The Complainant bases its case on Abusive Registration mainly on paragraph 3a.ii, which reads as follows:

“ii. *Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant*”

6.9 The Complainant has not put forward any evidence of actual confusion, despite it alleging in correspondence with the clinic manager of the business promoted under the Website that it had received reports that use of the Domain Name was confusing members of the public who are trying to contact the Clinic.

6.10 However, taking the following factors into account, the Expert finds that use of the Domain Name by the Respondent will be likely to lead to confusion as anticipated under paragraph 3a.ii:

- The Complainant has been operating the Clinic since 1965. It has achieved numerous accreditations and received accolades for the nature and scope of medical treatment and care that it provides.
- The Complainant has also submitted evidence (which, in light of the Respondent not submitting a response, is unchallenged) to show that the Clinic is renowned in medical circles, both within and outside of the UK.
- It is also relevant that the extract from the UK IPO submitted by the Complainant to prove its Rights in the mark THE HARLEY STREET CLINIC shows that the application proceeded to registration “*because of distinctiveness acquired through use and trade evidence*”. In short, this means that upon initial examination of the trade mark application, the UK IPO objected to the registration of the mark due to the mark lacking inherent distinctiveness (and therefore not fulfilling the function of a trade mark).
- In order to overcome such a hurdle to trade mark registration, the Complainant would have had to have proved (through evidence of use of the mark) that the relevant public would associate the mark with the Complainant and no other party.
- The Expert is therefore satisfied that the Complainant has established that the Clinic is recognised as indicating services offered by the Complainant.
- The high degree of similarity between the Complainant’s mark THE HARLEY STREET CLINIC and the Domain Name means that consumers searching online for the Clinic are likely to expect there to be some connection between the website operated under the Domain Name and



the Complainant, even before they arrive at the Website. As stated in Paragraph 3.3 of the Expert's Overview<sup>1</sup>:

*"This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived."*

- 6.11 Further, on reaching the Website, Internet users are presented with a business offering hair removal and cosmetic treatments, and a notice stating that copyright belongs to Harley Street Clinic. In light of the reputation and goodwill generated by the Complainant in respect of its mark THE HARLEY STREET CLINIC and the Complainant's business, the Expert is satisfied that use of the Domain Name to promote a business offering such treatments has been unfairly detrimental to the Complainant's Rights.
- 6.12 A further issue to consider in this case is whether the Domain Name could be considered generic or descriptive. If so, and if the Respondent is making fair use of it as per paragraph 4a.ii of the Policy, the Domain Name is not an Abusive Registration.
- 6.13 The Domain Name comprises a 'location' (Harley Street) and 'generic' term (Clinic). The Website promotes a hair removal clinic which is located on Harley Street.
- 6.14 The Complainant acknowledges that parties operating a facility on Harley Street may legitimately refer to their location, and that the Respondent and the hair removal clinic promoted through the Website is located on Harley Street.
- 6.15 The Complainant's Rights lie in the term THE HARLEY STREET CLINIC, but the Domain Name does not include the word THE. However, in the Expert's opinion, the omission of the definite article (THE) in the Domain Name is not material and does not detract from the distinctive and dominant elements of the Complainant's mark. The Expert is satisfied that consumers are unlikely to make a distinction between the term THE HARLEY STREET CLINIC and the Domain Name and in light of the reputation and goodwill in the Complainant's mark, the Respondent can not be making any fair use of it.
- 6.16 The Expert is supported in this conclusion by the facts that (i) the Complainant has acquired registered trade mark rights in the UK for the word mark THE HARLEY STREET CLINIC and that such registration was obtained by the Complainant proving to the UK IPO that the mark has acquired distinctiveness through use, (ii) the Domain Name was registered

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<sup>1</sup> The Experts' overview is a document put together by Nominet's panel of Experts which deals with a range of issues that come up in DRS disputes. It is published on Nominet's website at: [http://www.nominet.org.uk/digitalAssets/39192\\_DRS\\_Expert\\_Overview.pdf](http://www.nominet.org.uk/digitalAssets/39192_DRS_Expert_Overview.pdf).

more than seven years after the Complainant's UK trade mark registration was granted, (iii) the Respondent and the business promoted on the Website are located on the same street as the Clinic and (iv) the manager of the clinic promoted on the Website seems to admit, in correspondence with the Complainant, that the Domain Name could cause confusion.

- 6.17 The Expert therefore finds, on the balance of probabilities, that the Domain Name, in the hands of the Respondent, is an Abusive Registration within the meaning of the Policy.

## **7. Decision**

- 7.1 The Expert finds that the Complainant has Rights in the mark THE HARLEY STREET CLINIC which is similar to the Domain Name, and further that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name should be transferred to the Complainant.

**Signed Ravi Mohindra**

**Dated 23 March 2012**