

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2041293 BY
THE HARRODIAN SCHOOL LIMITED TO REGISTER
THE MARK HARRODIAN IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 46377 BY HARRODS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2041293 by
The Harrodian School Limited to Register
the mark Harrodian in Class 41**

AND

**IN THE MATTER OF Opposition thereto under
No 46377 by Harrods Limited**

DECISION

1. On 16 October 1995 the Harrodian School Limited applied to register the mark HARRODIAN for a specification of services in Class 41 which reads “preparatory school services; public school services; secondary school services; sixth form college services”. The application is numbered 2041293.
2. On 5 February 1997 Harrods Limited filed notice of opposition to this application. The opponents are the owners of Harrods, the well known London department store. They are the proprietors of numerous trade mark registrations for the mark HARRODS in relation to a range of goods and services. Details of these registrations are appended to their statement of grounds.
3. The opponents are also the proprietors of the mark HARRODIAN under No 1570095 in class 41. That application was the subject of an opposition action between the parties under the Trade Marks Act 1938. That case was not decided until 8 August 2000 so the opponents would not have known the outcome when they filed the current opposition. In the event The Harrodian School’s opposition was partially successful with the result that the application was allowed to proceed to registration for the following services:

“Operation of Cookery Schools; conduct of gymnastic and sporting activities; training in equestrianism and carriage driving; all included in Class 41.”
4. It seems that no appeal was lodged against the Hearing Officer’s decision and that the specification of the registration is therefore in the above terms.
5. The opponents raise a number of grounds of objection. Those under Section 5(1), 5(3), 5(4)(a) and 3(6) were not pursued at the hearing. The remaining ground is under Section 5(2)(a) having regard to a conflict of services that appears to be based on a part of the opponents’ original specification for No 1570095 which does not feature in the specification of that registration (see the preliminary point dealt with below).

6. The applicants filed a counterstatement which denies the above ground.
7. Both sides ask for an award of costs in their favour.
8. Both sides filed evidence.
9. The matter came to be heard on 15 February 2002 when the applicants were represented by Mr T Mitcheson of Counsel instructed by J A Kemp & Co and the opponents by Mr D Alexander of Counsel instructed by D Young & Co.

Opponents' Evidence

10. The opponents' filed a statutory declaration by Gillian Mavis Deas, their professional representative in this matter. By the time the opponents' came to file their evidence in chief the outcome of opposition to No 1570095 was known. Ms Deas notes the details of the resulting registration (GMD 1) and files evidence (GMD 2) in the form of definitions from Collins English Dictionary to show what the terms in the applicants' specification mean.
11. She goes on to file an extract from the Good School Guide published by Harpers & Queen (GMD 3) to show that the services protected by the opponents' registration No. 1570095 are offered in preparatory schools, public schools, secondary schools and sixth form from colleges. As further support for this proposition she refers to skeleton arguments filed by Counsel on The Harrodian School's behalf in the previous opposition action (GMD 4).
12. Further or alternatively Ms Deas submits that HARRODIAN is the adjectival form of the trade mark HARRODS and that both of these words have been widely used by the opponents such that the name is synonymous with the opponents' goods and services. She exhibits (GMD 5) copies of two declarations completed by Michael Rogers, formerly Legal Director of Harrods Ltd, in the previous action. The Hearing Officer's decision in that case can be found under BL reference 0-270-00. The Hearing Officer's summary of the evidence is not, it would seem, disputed and can be found on pages 3 to 8 of that decision.

Applicants' Evidence

13. The applicants filed a witness statement by Monica Anne Marshall, their professional representative in this matter. She exhibits a copy of the evidence filed in relation to the opposition proceedings to No 1570095 along with papers from Court proceedings between the parties (MM1 and 2) and the Decision in the Registry opposition case (MM 3). The latter is referenced above. She goes on to submit that the issues dealt with in Ms Deas evidence (that the services protected under No 1570095 are offered as part of the schools services that the applicants seek to register) were decided in the previous opposition. Ms Marshall further submits by reference to the previous decision that the question as to whether Harrods Ltd had any relevant use or reputation in HARRODIAN was also dealt with in that decision.

Opponents' Evidence in Reply

14. Ms Deas has filed a witness statement in which she refers to Ms Marshall's evidence. No

new evidence is filed but Ms Deas makes a number of submissions. Her main points are that the only services on which the applicants can claim use at the material date are preparatory school services and not the other services contained in the specification of the application now under attack; and that the Hearing Officer's decision in the previous case revolved entirely around preparatory school services and therefore has no bearing on the applicants' attempt to extend their rights to "public school services; secondary school services; sixth form college services".

15. It will be apparent from the above brief review of the material in this action that neither side has filed evidence that points to any significant change in their trading positions in the period since the previous opposition action. That action was, of course, under the 1938 Act and the tests applicable to the grounds brought under that Act. The underlying facts, however, are essentially the same.

16. In his skeleton argument Mr Alexander gave up all grounds of opposition save for Section 5(2)(a). That ground is put on the following basis in the opponents' statement of grounds

"Further or alternatively, the "preparatory school services" covered by Application No. 2041293 HARRODIAN are similar to the "operation of nursery schools and provision of pre-school facilities" covered by the Opponents' prior Trade Mark Application No. 1570095 HARRODIAN and, consequently, registration of the mark applied for under No. 2041293 would be contrary to section 5(2)(a) of the Trade Marks Act 1994."

17. The services "operation of nursery schools and provision of pre-school facilities" were part of the original specification of No. 1570095 but were lost as a result of the previous partially successful opposition by the Harrodian School Ltd (Opposition No. 43446 under No. 0-270-00). That seemed to result in a situation where there was no remaining basis for the ground as originally pleaded. Mr Alexander sought to address this problem by requesting an amendment so that the ground would now read

"Further or alternatively, the services covered by Application No. 2041293 HARRODIAN are similar to the services covered by the Opponents' prior Trade Mark Application No. 1570095 HARRODIAN and, consequently, registration of the mark applied for under No. 2041293 would be contrary to section 5(2)(a) of the Trade Marks Act 1994."

18. I heard submissions on the proposed amendment as a preliminary point.

19. Mr Alexander pointed out that the evidence effectively dealt with the issue as to similarity of services as if the ground were expressed in the above terms. It was important in his view for the real issues between the parties to be dealt with.

20. Mr Mitcheson commented on the lateness of the request and the fact that the applicants could have reasonably expected the opponents to put their best possible case forward. He also noted the guidance on pleadings in Tribunal Practice Notice 4/2000 and the COFFEEMIX case [1998] RPC 717. He also referred me to correspondence with the Registry (JA Kemp's letter of 20 December 2000) drawing attention, inter alia, to the reduction in the specification of No. 1570095 as a result of the previous opposition proceedings.

21. A number of reported cases have emphasised the need for parties to plead their cases fully and succinctly at the outset and the inherent difficulties if issues are poorly pleaded (see Julian Higgins Trade Mark Application [2000] RPC 321, Club Europe Trade Mark [2000] RPC 329 and Demon Ale Trade Mark [2000] RPC 345). Clearly the opponents' request has come at a very late stage. As the previous opposition proceedings between the parties had not been resolved at the time the present opposition was launched the opponents can say with some justification that they could not have been certain of the specification (for No. 1570095) that would be available to them to support this opposition. But that in itself does not explain why the ground was not pleaded on a broader basis to start with. It is nonetheless the case that the issues addressed in the evidence have been directed towards the full specification applied for and have been based on the services for which No. 1570095 is now registered. I do not think that the applicants can say that they have been taken by surprise by the amended ground or that they would be significantly prejudiced on this account by allowing the amendment.

22. I am also somewhat concerned that the correspondence with the Registry referred to above failed to result in a resolution of the problem. J A Kemp's (the applicants' attorneys) letter of 20 December 2000 was itself written in response to the Registry's request for comments on a letter from the opponents' attorneys giving their views on the position following the resolution of opposition No. 43446 to application No. 1570095. This correspondence should in my view have prompted the parties and the Registry to review the grounds as pleaded and clarify the basis on which the case would progress. In the event the parties' respective requests that the present proceedings be terminated were rejected and no amendment to or striking out of grounds was pursued. Instead the Registry indicated in a letter dated 29 December 2000 that the proceedings would continue and the opponents were invited to submit their evidence. Any deficiencies in the pleadings thus went unresolved.

23. In all the circumstances, and not without hesitation, I decided to allow the amendment requested by Mr Alexander. This case involves a continuation and extension of arguments that have been developed in previous Court and Registry proceedings between the parties. There can be no real doubt as to the points in dispute or the materials to be relied on in arguing the merits of the parties' respective positions. Neither side has sought leave to file further evidence. It seemed sensible, therefore, to allow the real issues between the parties to be reflected in the amendment and dealt with in the decision which follows.

24. The sole remaining ground of opposition is thus under Section 5(2)(a) which reads

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

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

(b)

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

25. I take into account the guidance provided by the European Court of Justice (ECJ) in,

particularly, *Sabel v Puma* [1998] ETMR 1 and *Canon v MGM* [1999] RPC 117.

26. It is not disputed that the marks are identical. Mr Alexander did not claim any enhanced level of protection through use by the opponents of their earlier trade mark (*Sabel v Puma*, paragraph 24). Nevertheless I cannot see any reason why HARRODIAN should not be considered an inherently distinctive mark in relation to the services in question.

27. For convenience I set out as follows the services in issue before me

Applicants' services

Preparatory school services; public school services; secondary school services; sixth form college services.

Opponents' services

Operation of cookery schools; conduct of gymnastic and sporting activities; training in equestrianism and carriage driving.

28. As noted above, the likelihood of confusion must be assessed globally. In *Canon*, the ECJ indicated that this implied some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks (and vice versa); *Canon* paragraph 17, page 132.

29. That said, it has been recognised by the ECJ that section 5(2), (Article 4(1)(b) of the Directive) requires that the goods/services are similar. In particular in *Canon* at paragraph 22 the court stated:

"22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

30. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296 (the TREAT case). Adapted to the instant case, it can be stated as:

- (a) the uses of the respective services;
- (b) the users of the respective services;
- (c) the nature of the acts of service;
- (d) the trade channels through which the services reach the market;
- (e) [not relevant]
- (f) the extent to which the respective services are competitive. This inquiry may take into account how those in trade classify services, for instance whether market research companies, who of course act for industry, put the services in the same or different sectors.

31. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

32. I was also referred at various points in the hearing to the judgments of Mr Justice Harman and the Court of Appeal in the passing off proceedings between the parties (the Court of Appeal decision is reported at [1996] RPC 697) and the decision of the Registry Hearing Officer in opposition No. 43446 to (then) application No. 1570095. I have borne in mind these previous cases and the findings contained in them. I derive some limited assistance from them but they are not in my view determinative of the issues before me for a number of reasons. The High Court/Court of Appeal case was a passing off action based on the wide range of commercial activities conducted through the Harrods department store (but not extending to the running of schools) whilst the Harroddian School's partially successful opposition to Harrods' application for registration of HARRODIAN was a case under Section 11 of the antecedent law based on the opponents' use of the mark HARRODIAN in relation to a co-education preparatory school.

33. Mr Alexander relied in part on Counsel's submissions in the previous opposition case where (with roles reversed) it had been argued that there was a significant overlap between the services for which No. 1570095 is now registered and the preparatory school services of The Harroddian School. The Hearing Office addressed the issue as follows

"It seems to me that the opponents 'educational services' are in respect of those associated with the education of children in a co-educational preparatory school. Thus, the direct clash exists between those services and the applicants' operation of nursery schools and provision of pre-school facilities. The physical education which the opponents are likely to provide as part of their educational services for children are of a different nature to the 'provision of fitness training and conduct of sporting activities' which the applicant's specification covered. Therefore there is no clash there. Nor is there any clash between the opponents services and the remainder of the applicants' specification; operation of cookery schools; training in equestrianism and carriage driving are terms that are outwith the normal use of the term educational services. In simple terms I do not see that these activities would appear on the curriculum of a preparatory school."

34. The test under Section 11 of the 1938 Act was not restricted to a "services of the same description" test and permitted a broader approach to be taken to the issue of confusion. Even if the finding under that Section cannot be conclusive as to the issue of similarity between the opponents' services and preparatory school services it is nevertheless a strong indicator as to the outcome. I believe Mr Alexander was inclined to accept that his case was not at its strongest in relation to the opposition to preparatory school services. However, I bear in mind that the services now applied for go beyond preparatory school services and cover school and college

services in respect of which the applicants have not claimed use prior to the material date. I must therefore consider the matter in the light of the provisions of the 1994 Act and the guidance in, particularly, the CANON and TREAT cases.

35. A key part of the opponents' case is that the services covered by their registration would feature as part of the compulsory or voluntary range of activities associated with a variety of schools. The point arises most obviously perhaps in the context of gymnastic and sporting activities. It was said that schools are obliged by law to conduct such activities. In any case it is in my view common knowledge that sporting activities and (basic at least) gymnastic activities form part of schools' curricula. The position in relation to cookery is likely to be the same. Perhaps a rather narrower range of students take cookery as a subject but I do not think it would come as a surprise to any parent with children of school age that cookery is available as a subject. Training in equestrianism and carriage driving is a somewhat different proposition. Mr Alexander was able to point to an 'Activities' sheet which forms a loose leaf insert to the St Swithins' School brochure (at GMD3) showing that riding is offered as an after school activity. It is fair to say that it is an extra curricular activity rather than forming part of the normal range of subjects offered by the school. The point is, rightly, not pressed as a main plank of the opponents' case. However that does not detract from the fact that it can with justification be said that sporting and gymnastic activities and cookery are offered as part of the normal range of school subjects.

36. Turning to the CANON/TREAT criteria the uses of the respective sets of services are quite different. The applicants' services are educational in nature whereas the opponents' are sporting or leisure pursuits. They may, of course, share the same users at least to the extent that a significant part of the public could be actual or prospective users of either sets of services. But that is altogether too broad a level of generality to provide a meaningful test.

37. The nature of the services being offered are again different. Even if a school had a record of excellence in say the sporting field it is but one of the factors that parents would take into account in choosing a school. It does not make the provision of sporting facilities similar to educational services. The brochures that are in evidence before me (GMD3) suggest that schools emphasise the breadth of their academic, sporting and extra curricular offerings to attract students.

38. Similar considerations apply in relation to cookery classes. I note that in the High Court proceedings Mr Justice Harman commented on the proposed Harrods cookery school by saying that "as I understand it the School is not an educational establishment for children or even teenagers but for adults to learn the higher gastronomic arts." That could equally be said to characterise the difference between the opponents' cookery school services and the wider range of educational services covered by the applicants' specification.

39. The TREAT case also suggests I should consider the trade channels by which the services reach the market. There is no evidence that these services share routes to the market place and it seems inherently unlikely that they would. Someone wishing to undertake a sporting activity or a cookery school course would be unlikely to direct his or her enquiries to any of the categories of schools within the applicants' specification. The evidence suggests that some schools produce their own brochures or promote themselves more widely particularly where

they are seeking to draw pupils from other than purely the local catchment area. No doubt they also advertise in appropriate educational publications. But there is nothing to suggest that the opponents' services would be promoted through the same channels.

40. Nor it seems to me can the respective services be said to be complementary to one another or in competition with one another. Mr Mitcheson was right in my view to emphasise the care that is likely to be taken in selecting his clients' services. Quite apart from the natural inclination of any parent to want the best possible schooling for their children, the choice of schools is likely to represent a commitment for some years ahead and could (particularly in the case of say a boarding school) involve considerable expense. I ask myself the question as to whether anyone looking for the applicants' schooling/college services would be likely to direct their enquiries to providers of the services of the opponents' registration (or vice versa) or to consider them similar. In my view that question has to be answered in the negative. In *Avnet Incorporated v Isoact Limited* [1998] FSR16 Jacob J said

".... definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

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

41. Those remarks are applicable in the context of the services before me in this case.

42. In summary the marks are identical but for the above reasons I find that there is some distance between the respective sets of services when the core meaning and purpose of the services are considered. Accordingly there is no likelihood of confusion within the meaning of the Act and the opposition fails.

43. The applicants are entitled to a contribution towards their costs. Mr Mitcheson sought an award which reflected the time spent preparing to address grounds which were not in the event pursued. This was resisted by Mr Alexander. Although a number of grounds were raised but not pursued the direction of the case was largely mapped out by the evidence filed. The applicants have not been put to significant additional expense in terms of gathering evidence to counter the full range of grounds raised against them. Nevertheless there is some force in Mr Mitcheson's submission that he had at least to prepare to meet all the grounds. The concession by Mr Alexander came too late in the day to avoid some wasted work on Mr Mitcheson's part. In all the circumstances I order the opponents to pay the applicants the sum of £1000 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11TH day of March 2002

M REYNOLDS
For the Registrar
the Comptroller-General