

O-335-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3134430

BY SOUTH DOC SERVICES LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 & 44:



AND

OPPOSITION THERETO (NO. 406200)

BY HORIZON GLOBAL (HEALTHCARE) LIMITED

Background and pleadings

1. This dispute concerns whether the trade mark



should be registered for¹:

Class 9: Provision of digital platforms for use in connection with medical and healthcare services; computer software and mobile phone applications enabling access to medical information and medical booking services; computer software and mobile phone applications for ordering medication, obtaining access to self-help guides, producing personal care plans and checking personal medical symptoms; computer software and mobile phone applications for obtaining access to, and the ability to update, personal medical information remotely; downloadable publications; electronic publications; electronic notice boards.

Class 44: Medical and healthcare clinics; medical services; booking services for medical appointments; online booking services for medical appointments; face to face and telephone appointments with doctors and other medical professionals; appointments with doctors and other medical professionals via videotelephony or other communication applications; medical consultations; emergency doctor call out services; medical house call services; medical assistance services; medical consultations; medical examination; medical analysis for the diagnosis and treatment of patients; provision of medical treatment; medical care services; advisory services relating to medical problems; medical information and advice; access to clinical pharmacists for information and advice relating to medication; access to physiotherapists for orthopaedic queries; maintaining personal medical history records; providing access to medical records and information; providing online medical record services; issuing of medical reports; medical screening services; medical testing services; medical counselling services; access to doctors, medical consultants, paediatricians, nurses, physiotherapists, speech therapists,

¹ This is an amended (limited) specification requested by the applicant during the proceedings. The opponent choose to continue its opposition despite the amendment.

occupational therapists, counsellors, therapists, pharmacists and other healthcare professionals; fertility services; mental health services.

2. The mark was filed on 3 November 2015 by South Doc Services Ltd (“the applicant”) and it was published for opposition purposes on 4 December 2015.

3. Horizon Global (Healthcare) Limited (“the opponent”) opposes the registration of the mark under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following four earlier marks:

i) EUTM² 13630884 for the mark  which was filed on 9 January 2015 and registered on 10 October 2015. It is registered for the following services:

Class 35: Retail services connected with the sale of pharmaceutical goods including dispensary medicines, non-prescription medicines, toiletries, cosmetics and electrical medical equipment; business management assistance and consulting services, all for hospitals, nursing, medical, convalescent, retirement and dental institutions; administration of medical practices and surgeries; administration of hospitals, nursing, medical, convalescent, retirement and dental institutions.

Class 36: Medical insurance services provided to companies.

Class 41: Gymnasiums; gymnasium services; gymnasium club services; provision of gymnasium facilities; providing health club services; gymnasium services relating to body building; gymnasium services relating to weight training.

² European Union Trade Mark

ii) EUTM 3341724 for the mark  which was filed on 23 September 2013 and registered on 18 September 2013. It is registered for a variety of goods and services including:

Class 35: Retail services connected with the sale of pharmaceutical goods including dispensary medicines, non-prescription medicines, toiletries, cosmetics and electrical medical equipment; business management assistance and consulting services, all for hospitals, nursing, medical, convalescent, retirement and dental institutions.

Class 42: Medical laboratory services for the analysis of samples taken from patients; medical research services.

Class 44: Medical services; medical assistance services; medical information services; medical care services; medical treatment services; hospital services; advisory services relating to medical problems; advisory services relating to medical services; dentist services; dental services; dental hygienist services; advice relating to dentistry; therapy services; physiotherapy services; osteopathy services; acupuncture services; nutritional guidance; nutritional advisory and consultation services; dietetic counselling services; speech therapy services; anti-smoking therapy services; insomnia therapy services; physical therapy services; in vitro fertilization services; advisory services about in vitro fertilization services; nursing services; nursing care services; nursing home services; medical screening; surgical diagnostic services; medical evaluation services; medical imaging services; medical testing and diagnostic services; medical assessment services.

iii) EUTM 13630926 for the mark  which was filed on 9 January 2015 and registered on 28 December 2015. It is registered for a variety of goods and services including:

Class 35: Retail services connected with the sale of pharmaceutical goods including dispensary medicines, non-prescription medicines, toiletries, cosmetics and electrical medical equipment; business management assistance

and consulting services, all for hospitals, nursing, medical, convalescent, retirement and dental institutions; administration of medical practices and surgeries; administration of hospitals, nursing, medical, convalescent, retirement and dental institutions.

Class 36: Medical insurance services provided to companies; brokerage and arrangement of dental insurance; administration and management of dental insurance; computerised services for the broking, arranging, administration and management of dental insurance; information relating to dental insurance and payment plans, provided on-line from a computer database; information, organisation, customer care and telephone help-line services relating to all of the aforesaid services.

Class 41: Gymnasiums; gymnasium services; gymnasium club services; provision of gymnasium facilities; providing health club services; gymnasium services relating to body building; gymnasium services relating to weight training.

Class 42: Medical laboratory services for the analysis of samples taken from patients; medical research services.

Class 44: Dentist services; dental services; dental hygienist services; advice relating to dentistry; acupuncture services; nutritional guidance; nutritional advisory and consultation services; dietetic counselling services; anti-smoking therapy services; nursing services; nursing care services; nursing home services; orthodontistry services.



iv) EUTM 13630918 for the mark  which was filed on 9 January 2015 and registered on 15 December 2015. It is registered for the same services as the previous mark.

4. Under section 5(2)(b), the opponent claims that the goods/services are identical or similar, that the marks are highly similar as they differ only in elements with low distinctiveness (GP/CLINIC/DOCTOR) or that the application encompasses the (first)

earlier mark, with the result being that there is a likelihood of confusion. It should be noted that given their dates of registration, none of the earlier marks are subject to the use conditions set out in section 6A of the Act and may be taken into account for all of the services for which they are registered.

5. Under section 5(4)(a), which relates to the law of passing-off, the opponent relies on the use of a sign corresponding to the above MY HEALTHCARE CLINIC mark, which is claimed to have been used in Wandsworth since 2013 as the name of a practice and, also, throughout the UK via its website. Use is said to have been made in the field of various medical services (and the administration of a medical practice) and, also, the provision of access to GPs, dentists and other medical professionals and membership and payment plan services relating to this.

6. The applicant filed a counterstatement denying the claims. It does not accept that all of the goods/services are identical or similar. It does not accept that the opponent has the requisite goodwill. In relation to the marks, it considers the words MY HEALTHCARE to lack distinctiveness so that the respective marks are distinctive only on account of their respective stylisations, which it considers to be sufficiently different to avoid confusion.

7. Both sides filed evidence and written submissions. Neither side requested a hearing. The applicant filed written submissions in lieu of attendance. Both sides are professionally represented, the applicant by Vault IP Ltd, the opponent by Venner Shipley LLP.

The evidence

8. I will summarise the parties' evidence briefly, but will return to any pertinent aspects of it, if and when required, in more detail later in this decision.

The opponent's evidence

9. The opponent's witness is Mr Barat Patel, a director of the opponent company. He sets out the use that has been made of the marks by the opponent or, more accurately,

by a company called MyHealthcare Clinic Limited who, Mr Patel states, uses the mark with the consent (under license) of the opponent.

10. Put simply, MyHealthcare Clinic is a private medical practice based in Wandsworth, a district in south west London. Use is said to have begun in December 2013. The clinic provides a number of different medical services under one roof (such as GP services, dentists, health assessments, vaccines etc.). The website which promotes the practice is said to be important because patients are not limited by geographical location, however, it is probable, in my view, that most of its patients come from Wandsworth and the surrounding areas. It appears from accompanying leaflets that patients pay an ongoing monthly fee, dependant on the services required, it's so called membership plans. Visits to its website were 21.5k in 2014 and 38.6k in 2015. Revenue was £200k and £500k respectively in the same two years with an estimate of £980k for 2016. Google advertising has taken place which cost the opponent £25k in 2014 and £53k in 2015, creating 345k and 966k impressions respectively.

11. Accompanying exhibits include promotional material, leaflets etc. which show that the stylised MyHealthcare Clinic mark is the one most often used, but, there are also uses of the words MyHealthcare Clinic without any stylisation.

12. The opponent also filed some written submissions which I take into account, but will not summarise here.

The applicant's evidence

13. The applicant's witness is Mr Nirmal Vora, its Chief Operations Officer. The background to the applicant is that it wished to bid for money from a Government fund called the £50 Million Challenge Fund (a further £100 million was subsequently added to the fund) set up to improve access to the healthcare system. It was awarded £2.4 million in March 2015 by which time the applicant had 23 "My Healthcare" surgeries" in Birmingham (around 123k patients) and by May 2016, 36 surgeries with 220k patients (20% of the population of Birmingham).

14. Mr Vora does not fully explain the way in which the applicant's business operates, although he states that the aim was to make more people responsible for their own healthcare, by providing easier access to services. It enables the applicant to offer direct access to physios, GPs etc. seven days a week as well as having the opportunity to access telephone and video consultations. The described patient responsibility is why the words MY HEALTHCARE were chosen as "a descriptive term". In terms of accompanying exhibits, these include pages from the NHS website which are headed My Healthcare, and an extract from a trade publication which describes the My Healthcare project. The information shows that the participating surgeries offer a central point of contact, with enhanced services (including 7 days a week) via both traditional and digital means. I could find no use in any of the exhibits of the mark as filed.

15. Mr Vora states that in view of the applicant's use, the opponent cannot claim to be the exclusive user of the words MY HEALTHCARE. Indeed, he refers to two other users:

- i) My Healthcare Passport – used by East Kent NHS Hospital since 2011 and,
- ii) My Healthcare Agency - a company in the global healthcare market

16. A witness statement was also provided by Ms Michelle Bishton of Vault IP where she gives her opinion on the distinctiveness of the words my healthcare. Her opinion is founded on the basis that the opponent's EUTM 13630884 (MyHealthCare stylised) was limited (to exclude medical services per se) during its examination stage because of an objection raised by the EUIPO on absolute grounds. She also refers to comments made by the opponent in its written submissions where reference is made to the UK IPO's MY practice, with the opponent suggesting, essentially, that MY (plus descriptive) marks are acceptable.

17. Ms Bishton was surprised by this so she has located (and provided) the relevant work manual extract (I refer to this later) which she interprets as meaning that MY (plus descriptive) marks are not acceptable in relation to any personal services and, thus, the opponent had misrepresented the manual to the EUIPO.

18. The applicant also filed some written submissions which I take into account, but will not summarise here.

Section 5(2)(b)

19. Section 5(2)(b) of the Act states that:

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

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

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

20. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach

21. I will adopt the following approach. For ease of writing and understanding, I will focus, in the first instance, on the opponent's MyHealthcare Clinic mark, and will consider, initially, the applied for "medical and healthcare clinics". I will then come back to the other goods/services and the other earlier marks to the necessary extent. The benefit of beginning with these services is that one of the factors that needs to be considered can be determined quickly, namely, the identity of the services. This is because services (and goods) which fall within the ambit of a competing specification are to be considered as per the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ("*Meric*") where it was stated:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

22. The opponent's MyHealthcare Clinic mark covers "medical services" at large, which clearly encompass the applied for "medical and healthcare clinics". These services are identical.

Average consumer and the purchasing act

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. I consider the average consumer to be a member of the general public who is seeking treatment or advice for a particular medical issue. The services, given their likely importance with regard to one’s health, are likely to be selected with a reasonably high level of care and attention. Websites, brochures, leaflets will all be considered, which highlights the importance of the visual characteristics of marks in this area, however, the aural impacts of the marks are also important as word of mouth recommendations may be given and appointments booked/contact made by telephone etc.

Distinctiveness of the words MyHealthcare within the respective marks

25. The applicant clearly considers this to be an important aspect of its case. The opponent’s main points are that:

- i) Whilst the word HEALTHCARE may be descriptive for some of the services, MyHealthcare combined is not.
- ii) The conjoining of the words in the respective marks adds further distinctiveness.
- iii) The IPO work manual indicates that MY marks may be accepted – the opponent refers to the mark MY TRAVEL which is highlighted in the work manual as an example of an acceptable mark.
- iv) Other MY marks have been registered, including MY DENTIST.

26. The applicant’s main points are that:

- i) The opponent's reference to the work manual is misleading because it actually suggests that MY marks are not generally acceptable unless the goods/service concerned are not of a personal nature.
- ii) That the services at issue here are clearly of a personal nature, as each person's treatment etc. will be unique to them.
- iii) That the conjoining of the words does not help and that the opponent's reference to the conjoining adding further distinctive is symptomatic of the words not being acceptable.
- iv) That the MY DENTIST mark may have been accepted in error.
- v) That if the word lacks distinctiveness/is descriptive then the distinctiveness of the marks lies in their totalities and cannot, therefore, provide a monopoly to prevent the registration/use of other marks containing those words, otherwise a back-door monopoly in those words has been created.

27. These proceedings are not, of course, based on absolute grounds - this is a relative grounds opposition. In considering whether this relative ground arises, one must assume notional (trade mark) use of the marks as a whole. However, I accept that the perception of the average consumer of the marks in question is an important factor, as is the role that elements may play within a mark, including whether a word(s) plays purely a descriptive or non-distinctive role. Of course, the actual context of use must be considered in that assessment, measured against the relevant services.

28. The point about back-door registrations is an important one. A similar point was raised by Mr Justice Arnold in *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc & Others* [2012] EWHC 1842 (Ch), albeit he was guarding against the registration of what he described as marks with fig-leaves of distinctiveness due to the undesirable consequence of proprietors being able to rely on words contained in earlier marks (to prevent the use/registration of the words/similar words) even though they had been accepted purely on the basis of their figurative elements:

"I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence

of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

29. Marks are not generally accepted with any form of express indication that they have been so accepted purely upon the basis of a figurative element as would have been the case when disclaimers were routinely requested, although, I accept that EUTM 13630884 appears to have been accepted only for certain services with the implication that the examiner considered the words (and the mark as a whole) to lack distinctiveness for medical services per se. Of course, I am not bound by the views of the examiner at the EUIPO. I must make my own considerations based on the likely impact on the average consumer. In that regard, and notwithstanding what I have said thus far about the potential impact on the average consumer of descriptive/non-distinctive elements, a balancing needs to be followed because a weak distinctive character of an earlier trade mark (or by extension words within it) does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

30. Reference has been made to the manual of trade mark practice, the relevant parts of which read:

“• “MY” and “MY FIRST” marks

The use of “My” in trade marks has become increasingly common as a way of marketing goods and services of a personalised nature. Examiners must consider whether the goods or services applied for are such that “My” will fail to indicate to the average consumer that they are giving their custom to a single undertaking. As a guide, the following may be helpful:

What sorts of goods and services are “personal”?

“My” plus the name of such personalised goods or services will be likely to be unacceptable. This is not intended to be an exhaustive list, but examples include diaries, calendars, photograph albums, recipe notebooks, gardening notebooks, address books, birthday books, wedding planners, baby books, guest books etc. Services of a personalised nature, e.g. pet insurance, colour analysis and wedding planning, may also attract an objection.

Not all “my” marks will necessarily face an objection; practice should not be applied blanket- fashion, without due regard to the merits of each case. For example, “MY TRAVEL” is acceptable for travel agency services and “MY PLACE” is acceptable for night-club services: their imprecise meanings create a distinctive impression.

“My First...”

.....”

31. In relation to the work manual, it is, of course, just a guide. Although I bear it in mind, it is not binding on me. Before proceeding further it is, I think, worthwhile looking at the marks in question as one must assess these things in context. The opponent’s mark looks like this:



the applicant's mark like this:



32. The marks as whole must be considered as distinctive trade marks, notionally being used as indications of trade origin in relation to the identical medical services I am currently considering. Whilst I accept that the words *per se* are not highly distinctive ones, and whilst I accept that medical services are personal in nature (in the sense that appointments are normally private, behind closed doors and treatment will be particular to a person's needs), the words within the opponent's mark do, in my view, contribute to the distinctive character of the mark. The average consumer is likely to consider that the distinctiveness lies not just in the get-up, but that the words contribute to the distinctiveness as a whole, with MyHealthcare being seen as the name of the clinic referenced in the mark. For sake of completeness, I should add that the evidence relating to two other uses of the words MY HEALTHCARE, and, also, the registration of the mark MY DENTIST, have not influenced my views either way. The evidence does not show what impact this will have had on the average consumer and, thus, it does not support that the average consumer's perception of the respective marks here will be influenced in any way.

33. I think the same applies to the applicant mark. Although no clinic is specifically referenced in the mark, the words still contribute to the distinctive character of the mark.

34. This feeds into the comparison of the marks, because the comparison must be based upon the overall impressions of the marks made on the average consumer.

Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

37. In terms of the overall impression of the earlier mark, it comprises the words “MyHealthcare [conjoined] Clinic”, with the word “My” being presented in a fancy script with the “Y” of that word swooping below the word “Healthcare” (which itself is in fairly plain script) to underline it, with the word “Clinic” below the underline in smaller (and fairly plain) font. Neither the word MY or HEALTHCARE dominate each other. The word Clinic has less visual impact on account of its position and size, but it is not negligible. The stylisation plays a reasonable role in the overall impression as it has a reasonable visual impact, but the words themselves still represent the element likely to draw most attention.

38 The applicant’s mark comprises a cross-like device element, alongside which are the words “myhealthcare” conjoined, with those words in a fairly plain script with the “my” being differently shaded than “healthcare”. The device element is a reasonably striking one but, although it is taller than the words, it is much narrower. The device, though, is far from negligible and plays a reasonable role in the overall impression. It

may not dominate the mark, but it plays a roughly equal role (roughly equal with the words) in the overall impression.

39. Visually, the common presence of the words MyHealthcare/myhealthcare creates a point of similarity, but there are a number of differences on account of the stylisation/the figurative element, together with the presence of the word clinic. The marks are also in different colours. However, despite these differences, given my assessment of the overall impression of the mark and the point of similarity between them, I still conclude that there is a medium level of visual similarity.

40. The marks will be articulated as: MY-HEALTHCARE-CLINIC v MY-HEALTHCARE. There are differences and similarities. I conclude that there is a reasonable (between medium and high) degree of aural similarity.

41. Conceptually, both marks are allusive of a person's healthcare. The marks are high in conceptual similarity.

Distinctiveness of the earlier mark(s)

42. The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s), based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

43. Inherently, I consider the earlier mark to be moderate (between low and medium) in distinctiveness on account of the words (which I would have pitched as low) and its stylisation (which adds to its distinctiveness). I note and bear in mind that it is the distinctiveness of the common element (the words) which are key in the assessment of whether there exists a likelihood of confusion, as per the decision of Mr Iain Purvis QC (as the Appointed Person) in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, where he stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

44. The opponent referred in its written submissions to distinctiveness through use. However, I do not consider that its use has materially improved the opponent’s position

because it is relatively short in length, is geographically limited in impact, and the revenue does not strike me as overly significant.

Likelihood of confusion

45. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

46. I have, of course, already rejected one of the arguments put forward by the applicant as to why confusion would not arise. The words MyHealthcare/myhealthcare will not be seen purely as a descriptive/non-distinctive element of the marks. However, when considering whether confusion will arise in respect of the identical services I am currently considering, I must still consider all the factors including the level of care and attention that will be deployed by the average consumer, the low degree of inherent distinctiveness of the point of similarity together with the degree of similarity between the marks. Having done so, my finding is that there is a likelihood of confusion. As I have said, the use of the words MyHealthcare/myhealthcare in the respective marks contribute to their distinctive character. It will be seen by the average consumer as the name of the service provided, or as in the opponent’s mark, the name of the clinic referred to in the mark. Whilst the name may not be greatly distinctive, the average consumer will still put the commonality of those words down to the respective undertakings being the same or economically linked. It is possible that through imperfect recollection the presentational differences may not be recalled perfectly, leading to direct confusion. However, even for those who recall the marks with greater precision, they will simply regard the presentational differences as a variant form of branding as opposed to indicating that the services are provided by a different (economically) undertaking. The opposition succeeds under section 5(2)(b) for the identical services being considered.

Other goods/services

47. I now consider whether the above finding also applies to the other goods and services of the application. I will, of course, need to assess the similarity of those goods/services to the services of the earlier mark (still focusing, for the time being, on the MyHealthcare Clinic mark). In doing so, I bear the following guidance in mind.

48. When making a comparison of goods/services, all relevant factors relating to them should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

49. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

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

50. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

51. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

52. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

53. In its written submissions, the applicant appears to accept that the services in class 44 are identical or similar. However, I must differentiate between identity and similarity in view of the interdependency of the various factors. In my view, the following applied for services in class 44 are identical to services in the earlier mark because they all clearly fall within the term “medical services”:

Medical services; face to face and telephone appointments with doctors and other medical professionals; appointments with doctors and other medical professionals via videotelephony or other communication applications; medical

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

consultations; emergency doctor call out services; medical house call services; medical assistance services; medical consultations; medical examination; medical analysis for the diagnosis and treatment of patients; provision of medical treatment; medical care services; advisory services relating to medical problems; medical information and advice; medical screening services; medical testing services; medical counselling services; access to doctors, medical consultants, paediatricians, nurses, physiotherapists, speech therapists, occupational therapists, counsellors, therapists, pharmacists and other healthcare professionals; access to clinical pharmacists for information and advice relating to medication; access to physiotherapists for orthopaedic queries; issuing of medical reports; fertility services; mental health services.

54. Given this, and given that there is no material difference in terms of the average consumer or the degree of distinctiveness, or any of the other relevant factors, I consider that there is a likelihood of confusion in respect of these services also.

55. I next consider the following class 44 services:

booking services for medical appointments; online booking services for medical appointments

56. Whilst the above are not medical treatment services, they still, in my view, fall within the general term “medical services”. I consider the term to be broad enough to encompass both treatment and, also, more general medical support services (that fall in class 44) in the medical field. As such, the services are identical and the same analysis as the other identical services is applicable – there is a likelihood of confusion.

57. I should add that even if I am wrong to have concluded that the services are identical on the inclusion principle, they would still, in my view, be highly similar. This is because of the strong complementary relationship that would exist between these terms and medical services per se, with one being used to arrange the provision of the other. In all the circumstances, I still consider that there is a likelihood of confusion.

58. The remaining services are:

maintaining personal medical history records; providing access to medical records and information; providing online medical record services

59. By parity of reasoning with my previous finding, I again consider these services to be medical services and, as such, are identical to services covered by the earlier mark. If not, they are highly similar as there is still a strong complementary relationship in play. The one potential difference in the assessment here is that the specification (of the first term) includes a reference to personal medical history, language which at least ties into the applicant's point that the services are personal ones and that the words myhealthcare do not contribute to the mark's distinctive character when these services are considered. Whilst I acknowledge this as a potential argument, and whilst I accept that the role words in a mark play may change dependent on the exact context of use (including in relation to which goods/services), I still consider that the words within the mark have the capacity to indicate trade origin and contribute to the distinctive character of the mark. By parity of reasoning with my earlier assessments, there still exists, in my view, a likelihood of confusion.

60. I next consider the following class 9 goods:

Class 9: Provision of digital platforms for use in connection with medical and healthcare services; computer software and mobile phone applications enabling access to medical information and medical booking services; computer software and mobile phone applications for ordering medication, obtaining access to self-help guides, producing personal care plans and checking personal medical symptoms; computer software and mobile phone applications for obtaining access to, and the ability to update, personal medical information remotely;

61. Clearly, only similarity is applicable here. Nevertheless, the goods are ones which, in my view, demonstrate a clear and strong complementary relationship to a medical service/practice. They strike me as the sort of things that the average consumer (the same average consumer as medical services) would use to facilitate the use of medical services and that relationship is in such a way that consumers may think that the responsibility for those goods lies with the same undertaking (as the medical services). Whilst the nature is of course different, and the exact purpose not the same (but overlaps), I still consider there to be a reasonably high degree of similarity. The goods will, in my view, be selected with slightly less consideration than a medical service per se, but still of a medium level. Consistent with my earlier findings, the words in the competing marks contribute to their distinctive character. Even though the goods/service similarity is less, overall, I still consider there to be a likelihood of confusion.

62. I next consider:

downloadable publications; electronic publications

63. Such goods are downloaded over the Internet (or viewed online without download) and read on a computer, tablet or phone. They could also then be printed for reading in hard copy format. Such publications can self-evidently be about healthcare and medical matters, providing relevant information to the reader.

64. Whilst I have focused thus far on the opponent's medical services, it is worth highlighting here that the opponent's specification also contains the term "medical information services". Thus, the purpose of the goods and services is very similar in that they both will provide information to the consumer in potentially the exact same fields. The nature of any good and any service is clearly different, but the users are the same and it may be the case that a consumer will choose either to obtain and read information online, or alternatively enquire with a medical information service provider. I would also imagine that a medical information service provider is the very type of undertaking that would offer downloadable/electronic publications so the channels of trade overlap and this would also create some complementarity, complementarity which is of such a nature that consumers may think that the responsibility for those

goods lies with the same undertaking (as the service). I consider there to be a reasonably high degree of similarity between these goods and the opponent's services.

65. I see no reason to come to a different view on the impact of the words MyHealthcare/myhealthcare in the context of this specific clash - the words contribute to the distinctive character of the marks. Although the goods/services have less similarity than some of the terms assessed already, there is still a reasonably high degree of similarity. There is no greater degree of care and attention either. I consider that there is a likelihood of confusion in respect of these goods also.

66. The final class 9 goods to consider are:

electronic notice boards

67. Whilst an electronic notice board has the capacity to be used in, for example, a medical clinic, the nature and purpose of such goods compared to the services of the earlier mark are very different. The goods and services do not compete. The average consumer is not the same - electronic notice boards will be purchased by businesses (although I accept that this includes those in the healthcare field) as opposed to members of the public. Whilst end users are also important, I am doubtful if a person visiting a medical clinic who may wish to view information on an electronic notice board can truly be said to be an end user. The end user is more likely to be a member of staff who has the responsibility for operating the thing. An electronic notice board does not strike me as indispensable for the operation of the opponent's services, nor is it really that important. Thus, notwithstanding the comments of Mr Alexander in *LOVE* where he warned against applying too rigid a test, the opponent is not in a strong position as the goods may only be used together in a fairly loose manner and certainly not in a way where consumers would think that the responsibility for those goods lies with the same undertaking (as the medical services). The goods are not similar with the consequence that there can be no likelihood of confusion⁵.

⁵ Some similarity is a pre-requisite for this ground of opposition – see, for example, *Waterford Wedgwood plc v OHIM* - Case C-398/07.

Other marks/services

68. The opponent has failed only in relation to electronic notice boards. None of its other earlier marks or other services put it in any better position. I need make no greater assessment than this.

Section 5(4)(a) – passing off

69. I will deal with this ground briefly. I only intend to consider this ground in relation to electronic notice boards, the only term the opponent has failed to oppose under section 5(2)(b). The reason why I can be brief is that even if one were to accept that the opponent had the requisite goodwill (which, for the record, I do), I see no prospect for a misrepresentation to arise given the differences between electronic notice boards and the medical services which the opponent has offered. Put simply, it will not be assumed that an electronic notice board sold under the applied for mark is the economic responsibility of the opponent.

Conclusion

70. The opposition succeeds save in relation to electronic notice boards, for which the applicant's mark may proceed to registration.

Costs

71. The opponent has been largely successful and is entitled to a contribution towards its costs. My assessment is as follows:

Official fee - £200

Considering the statement of case and preparing the counterstatement – £300

Filing and considering evidence/submissions – £800

Total – £1300

72. I order South Doc Services Ltd pay Horizon Global (Healthcare) Limited the sum of £1300 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of July 2017

Oliver Morris

For the Registrar,

The Comptroller-General