

O/392/17

TRADE MARKS ACT 1994

**TRADE MARK REGISTRATIONS 3076376 AND 3083236
IN THE NAME OF NOW HEALTHCARE GROUP LIMITED**

AND

APPLICATIONS 501142 AND 501143

BY DOCTOR NOW LIMITED

FOR THE REGISTRATIONS TO BE DECLARED INVALID AND CANCELLED

Background and pleadings

1. These proceedings concern two applications by Doctor Now Limited (“the applicant”) to invalidate trade mark registrations 3076376 and 3083236 in the name of Now Healthcare Group Limited (“the proprietor”).

2. Each of these registrations consists of a series of the same two marks, as shown below.



3. Nothing seems to turn on the variation in colours, so for convenience I will refer to the marks in the singular. However, my findings will apply to both marks.

4. The application to register trade mark 3076376 was filed on 10th October 2014. The mark is registered in relation to:

Class 5: Pharmaceutical compositions; Pharmaceutical preparations.

Class 44: Provision of health care services; Health care.

5. The application to register trade mark 3083236 was filed on 26th November 2014. The mark is registered in relation to:

Class 35: Order and purchasing services for others relating to medicine provided online or via a mobile link.

Class 42: Design and development of computer software for mobile and desktop applications.

6. Again, nothing seems to turn on the slightly different filing dates of the applications so, for convenience, I will refer to both dates as simply “the relevant dates”.

7. The grounds for invalidation are that:

- The applicant is the proprietor of earlier UK trade mark **DOCTOR**_{now} which has been registered under 2415692 since 2006 in class 44.
- The earlier mark is registered, used, and has a reputation for *private medical practice services, private general practice services, vaccination services, corporate healthcare services*.
- The earlier mark is similar to the later marks.
- The goods and services covered by the later marks are identical or similar to the services covered by the earlier marks.
- There is a likelihood of confusion on the part of the public.
- Use of the later marks would, without due cause, take unfair advantage of the reputation of the earlier marks and/or be detrimental to the reputation or distinctiveness of the earlier marks.
- Use of the later marks is liable to be prevented under the law of passing off.
- The registrations of the later marks were therefore contrary to sections 5(2)(b), 5(3) and/or s.5(4)(a) of the Act, and should be cancelled under section 47(2).

8. The proprietor filed counterstatements denying the grounds for invalidation of the later marks. I note, in particular, that the proprietor:

- Accepted that the services in class 44 covered by the respective marks are the same.
- Denied that the services covered by class 44 of the earlier mark are similar to the services covered by classes 35 and 42 of the later marks.
- Did not request proof of use of the earlier marks for the purposes of s.6A of the Act.

9. Both sides seek an award of costs.

10. The invalidation proceedings are consolidated.

Representation

11. The applicant is represented by Sheridans, solicitors. The proprietor is not legally represented. However, it has filed written submissions from which it is evident that it has, at least, a basic understanding of trade mark law.

The evidence

12. The applicant filed two witness statements by Dr Brian McGirr. The first statement had 80 exhibits amounting to 492 pages of evidence. The applicant had not sought leave to file more than 300 pages of evidence as indicated in Tribunal Practice Notice 1/2015. Consequently, the evidence was examined for relevancy. It was subsequently pointed out to the applicant that some of the material in the exhibits was dated after the relevant dates, or at least not dated prior to those dates. This included the entirety of 13 of the exhibits. The applicant was directed to remove this material. The direction was not contested and, at the registrar's request, the applicant subsequently filed an amended witness statement with the references to the excluded material removed.¹

13. Dr McGirr is the Managing Director of the applicant. He established the business in 2003. The business is a private general medical practice. The first practice opened in April 2003 in Wooburn Green. In 2006 it moved to an address in Beaconsfield, Bucks. A second practice was opened in Tring in December 2014, but as this was after the relevant dates it cannot be relevant to the applicant's reputation at those dates. As at the date of Dr McGirr's statement on 21st September 2016, the applicant's combined medical practices consisted of 14 doctors, 4 nurses and twenty five support staff. I infer that the single practice that existed at the relevant dates had fewer staff than this. Dr McGirr claims that the earlier trade mark is used throughout the UK. In the context of a single medical practice, it is not clear what he means by this. However, he goes on to mention the applicant's website (doctornow.org) and

¹ Except for one reference, which appears to have been missed, and the Office then redacted on the applicant's behalf

Facebook and Twitter social media accounts, so this may be what he means by the mark being used throughout the UK. He also mentions (at the date of the statement in 2016) that the applicant operated four cars on which the mark appeared.

14. At the date of Dr McGirr's statement in 2016, the applicant's practices had seen over 39k individuals and had over 2300 current patients. The number of patients seen prior to the relevant dates in 2014 would have been lower, but probably not of a different order of magnitude. The applicant's practice(s) turned over £1.36m in 2012, £1.7m in 2014 and £2.35m in 2016. It spent about £20k advertising and promoting its services in 2012, about £9k in 2013 and £16k in 2014. The applicant also spent between £31k and £38k per annum between 2012 and 2014 on what Dr McGirr calls 'marketing consultancy'. I am not sure what this means.

15. Dr McGirr provides some examples of how the earlier **DOCTORnow** mark is used. This includes on invoices to patients and other patient documents, such as appointment and vaccination cards.²

16. The applicant's mark was also used on the front cover of an In-Pharmacy Flu Vaccination Programme for October 2013 to March 2014.³ Dr McGirr states that between 2009 and 2014 the applicant provided "*clinical governance on the training package and the Patient Group Directive which is the bulk prescription required for this service to go ahead to Tesco, Boots, Day Lewis to be able to vaccinate patients in-store.*" 350k vaccinations were administered through this programme. I take Dr McGirr's evidence to mean that the material relating to this programme was provided to Tesco, Boots etc. However, he also claims that the information given to the public, and the correspondence to be passed on to their GPs, was also co-branded. In support of this statement Dr McGirr refers to the content of exhibit BM-04. However, I cannot see anything in this exhibit which appears to be intended for people receiving vaccinations and which carries the applicant's trade mark. I am, therefore, not sure what exactly Dr McGirr is referring to when he talks of the material given to the public having been co-branded (presumably with the applicant's mark and that of the

² See exhibit BM-5 and BM-11 to BM-14 to McGirr 1

³ See exhibit BM-4 to McGirr 1

dispensing pharmacist). Nor can I tell whether the applicant provided support to the pharmacists mentioned on a national (as opposed to a regional or local) basis.

17. Dr McGirr provides numerous examples of the applicant's mark having been used in advertisements. The mark appeared in the Families (Chiltern) Magazine in September 2006, which has a circulation of about 16700 copies per month.⁴ In 2010, it appeared in The Schools Advertiser, 15k copies of which are distributed through independent schools and private nurseries.⁵ Judging from the advertisement, this appears to have been promoting the applicant's vaccination service. Similar advertisements appeared in The Health and Beauty Magazine most months between February and November 2014. From the pages in evidence, the advertisements appeared somewhere between pages 55 to 60 of these publications. This appears to be a national publication for the general public, but in contrast to the other examples of advertising relied upon, no circulation figures are provided.

18. Dr McGirr's first statement also includes details of 4 instances of what he claims is actual confusion between the parties' trade marks. In his second statement, Dr McGirr provides information about three more instances of claimed actual confusion. I return to this evidence in more detail below.

19. The proprietor's evidence consists of a witness statement by Miss Rachael Lyons, who is the Account Manager of the proprietor. Ms Lyons states that "*The innovative Dr Now health platform connects users with fully qualified doctors via remote video consultation.*" The service is intended to supplement the NHS and provide access to doctors when patients are experiencing difficulty in seeing a GP through normal routes. Miss Lyons goes on to explain that patients can search for appointments, specifying their preferred time and the gender and language of the doctor they wish to see. There is an 'integrated pharmacy solution' through which medicines are dispensed and delivered directly to patients. Payment is taken within the 'app'. Users are not able to visit any of the applicant's locations to seek medical treatment or advice.

⁴ See BM-19 to McGirr 1

⁵ See BM-60 to McGirr 1

20. According to Miss Lyons, the proprietor's client base is large businesses. However, the service is ultimately provided to their employees and their families or users of the client business service. The proprietor does not directly market its service to the public. At the date of Miss Lyons' statement on 3rd March 2017, the proprietor provided access to its digital health services to over one million UK users through, inter alia, Thomas Cook insurance and IBM.

21. There is no evidence that the proprietor's mark was in use at the relevant dates.

22. Finally, Miss Lyons exhibits extracts from the applicant's website showing that the applicant only provides certain services, such as house doctor calls, within a 15 mile radius of its surgeries.⁶

The law

23. The relevant parts of section 47 are set out below:

“47. - (1) -

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

⁶ See exhibit RL-9

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) –

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

The section 5(2)(b) ground

24. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

25. There is no dispute on the pleaded case that the respective services in class 44 are the same. In the written submissions filed in lieu of a hearing, the proprietor appears to water down that acceptance by saying that the services in class 44 (and class 5) are similar “*to some extent*”. The earlier mark is registered for *private medical practice services, private general practice services, vaccination services,*

corporate healthcare services. The later mark is registered in class 44 for *provision of health care services; health care*. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁷ the General Court stated that:

“29....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 für 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”.

26. The services covered by the earlier mark are clearly specific descriptions of healthcare services, i.e. the same services also covered by the broader terms used to describe the class 44 services for which the later mark is registered. The services in class 44 must therefore be regarded as identical.

27. So far as the proprietor’s goods in class 5 are concerned, these are plainly not identical to medical/healthcare services. However, as the proprietor appears to acknowledge, there is plainly some similarity between these goods/services.

28. In *Canon*,⁸ the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

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

29. In *Kurt Hesse v OHIM*,⁹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between

⁷ Case T- 133/05

⁸ Case C-39/97

goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,¹⁰ the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

30. Goods are fundamentally different in nature to services, but the purpose of *pharmaceutical compositions; pharmaceutical preparations* is plainly similar to the purpose of *medical practice services* and *vaccination services*. The goods and services are used to prevent or treat illnesses. Further, the goods are self-evidently complementary to the services in the legal sense that one is important for the use of the other and the public may believe that the same undertaking is responsible for the goods and the services.¹¹ This is most obviously the case with *pharmaceutical preparations/compositions* and *vaccination services*. I therefore conclude that there is a medium degree of similarity between the applicant’s services in class 44 and the proprietor’s goods in class 5.

31. Turning to the proprietor’s *order and purchasing services for others relating to medicine provided online or via a mobile link* in class 35, the applicant submits that these are similar to the medical/healthcare services covered by the earlier mark. This is partly justified by a suggested analogy with pharmaceuticals in class 5, and partly because both are “*services for others relating to medicine.*” The proprietor’s description of services in class 35 would cover services provided to the public so that they can obtain pharmaceutical products via an intermediary such as a medical professional or pharmacist. The proprietor’s registered services in class 35 therefore appear to cover the actual services described in Miss Lyons’ statement, particularly insofar as they relate to the ordering and purchasing of medicines via the proprietor’s on-line platform or ‘app’. In this connection, I note that although Miss Lyons says that

⁹ Case C-50/15 P

¹⁰ Case T-325/06

¹¹ See the judgments of the General Court in *Procaps v OHIM*, Case T-35/09, and *Pensa Pharma v OHIM*, Case T-544/12.

the proprietor's actual services are not in competition with NHS practices, she also states that they are an alternative to seeing a GP through a conventional consultation. Admittedly, the part of the proprietor's services which fall in class 35 may not be the whole service described in Miss Lyons' statement (the rest of the service falling in class 44). Nevertheless, it appears to cover an important part of the proprietor's actual services. In these circumstances, I find that the respective services in classes 35 and 44 are in competition, in the sense that the services in class 35 are part and parcel of an alternative to the applicant's conventional medical and healthcare services in class 44. It follows that the purposes of the respective services are similar. On the other hand, the services are different in nature and method of use. I conclude that there is a low to medium degree of similarity between the applicant's services in class 44 and the proprietor's services in class 35.

32. Finally, as regards the comparison between the medical/healthcare services covered by the applicant's earlier mark and the proprietor's *design and development of computer software for mobile and desktop applications*, the applicant says that the services are similar because:

- They are complementary as the software is not limited and therefore could relate to medical professionals and doctors.
- The relevant public of the proprietor's class 42 services would be the same as for *private general practice services* because it would include "*individuals using computer software for medical purposes.*"

33. In this connection, the proprietor places emphasis on the importance of the words *design and development* [of software]. It says that it is a software development company and that the applicant is not in this field.

34. In my view, the *design and development of computer software* does not cover the sale of pre-written software applications, but services for the design and development of software on request. It is true that medical companies and doctors may be part of the market for such services. However, they are not the main users of *private general practice services*: they are the providers of such services. It is also

true that companies of all kinds may commission the design and development of computer software for their businesses, and those companies may also provide private medical services to their employees. However, that represents only a limited overlap between the users of the respective services. Moreover, the nature and skills required for software design and development on the one hand, and medical and healthcare services on the other, are very different. It follows that the public will not usually expect providers of these services to be the same or economically related.

35. I therefore find that these services are not complementary in the sense described in the case law. They do not appear to be similar in any other material way. Simply saying that they could both be related to medicine does not make them similar.

36. The applicant drew my attention to the decision of the EU IPO in Opposition B 2616079. This case involved the same parties and the same marks. Whilst generally finding in favour of the applicant under the equivalent provision of the EU Trade Mark Regulation, the EU IPO found that the services covered by the proprietor's earlier trade mark in these proceedings were not similar to "*technology services*" in class 42 of the proprietor's EU trade mark application. *Technology services* seems wide enough to cover the specific class 42 services that I have considered in these proceedings. Therefore, my decision appears to be consistent with that of the EU IPO.

37. This means that the ground for invalidation based on s.5(2) of the Act is bound to fail insofar as it is directed at the registration of the contested mark in relation to *design and development of computer software* in class 42. I will proceed to the required global comparison of all relevant factors in assessing the likelihood of confusion as a result of the use of the contested mark in relation to the goods and services in classes 5, 35 and 44 which I have found to be identical or similar to the services covered by the earlier mark.

The case law

38. The following principles are gleaned from the decisions 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.

The principles

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

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

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

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

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

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

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

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

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

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

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

Average consumer and the method of selection

39. 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*.

40. The proprietor submits that the relevant public for its goods/services is comprised of business customers. Given that Miss Lyons' evidence is that the proprietor had over 1 million UK users at the date of her statement (and several million more in prospect), I take this to mean that the proprietor sells its services to business users for the benefit of many more end users of the services. However, it appears from Miss Lyons' description of the way that pharmaceuticals are prescribed for, and delivered directly to, end users, after payment within the proprietor's 'app', that end users are exposed to the proprietor's trade mark. They are in fact the ultimate

consumers, or at least one category of end users, of the goods/services in classes 5, 35 and 44. In any event, it is well established that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.¹² In this connection, I note that there is nothing in the specification of goods/services in classes 5, 35 or 44 of the contested mark which limits the end users to business users. I therefore find that the relevant consumer for the services covered by class 44 of the contested mark is the general public. The general public is also likely to be the end users of the goods and services covered by classes 5 and 35 of the contested mark. This is so whether the public select pharmaceuticals directly for themselves, or after a consultation with a medical professional or pharmacist.¹³ In the latter case, the relevant public for the goods and services in classes 5 and 35 also includes medical professionals and pharmacists.

41. The general public are likely to pay an average to high level of attention when selecting a provider of healthcare services, pharmaceutical products, or using services through which they may receive medicines, depending on the seriousness of the condition to be treated and/or the degree of risk involved in using the wrong medicine.

42. Medical professionals are likely to pay a high level of attention when selecting pharmaceutical products or ordering prescription medicines for their patients. This is because of the potentially serious consequences if they make a mistake.

43. The goods and services covered by the contested mark are likely to be selected primarily by eye, but word of mouth discussions and recommendations are also likely to pay an important part in the customer or end users ordering and/or re-ordering of the goods/services.

¹² See paragraph 66 of the judgment of the CJEU in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

¹³ See *Alcon V OHIM* Case C-412/05P, CJEU at paragraphs 61 and 62 of the judgment.



Comparison of marks

44. 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 *Bimbo SA v OHIM*¹⁴ 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.”

45. It would be wrong, therefore, artificially to 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.

The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

¹⁴ Case C-591/12P

46. The applicant submits that:

- 'DR' is a well known abbreviation for Doctor and would be seen as such in the contested mark.
- Despite the modest stylisation, the earlier mark is clearly comprised of two words: 'Doctor' and 'Now'.
- The only words present in either of the marks are therefore 'Doctor' and 'Now'.
- The marks are therefore visually highly similar, as well as being aurally and conceptually identical.

47. The proprietor submits that:

- The use of the colours blue and green in the contested mark and the stethoscope to the right of the word 'DR', mean that the visual appearance of the marks is distinctly different: one is a brightly coloured logo with graphics, while the other is in plain text.
- The applicant's submission that the marks are aurally identical is flawed because it is based on only part of the contested mark (presumably the word part).
- The marks are conceptually different, the contested mark creating "*multiple and diverse images as a result of the mark's word and design portions combined*", whereas the earlier mark conveys only the non-distinctive meaning of a 'doctor' 'now'.

48. I accept that the colours and figurative elements of the contested mark are not negligible and must therefore be taken into account. However, there is nothing particularly striking or unusual about the use of two contrasting colours, such as blue and green. The stethoscope device reinforces the meaning of the word 'Doctor' in the contested mark. In any event, it is visually subservient to the more dominant words DR and NOW. I return below to the distinctive character of the word combination 'Doctor' and 'Now'. It is sufficient to record here that the level of distinctive character of this word combination is not so low that it causes me to

reassess my initial reaction, which was that the relevant public will regard the words DR and NOW as the dominant and most distinctive element of the contested mark. Therefore, even after taking account of the colours and figurative element of the contested mark, I find that the marks are visually similar to at least a medium degree.

49. It is true that the respective marks are aurally identical only so far as the comparison is based on the word element of the contested mark. However, as it has not been suggested that the public would give oral expression to any other feature of the contested mark, this appears to me to be a distinction without significance. I find that the marks are aurally identical.

50. The proprietor has not explained what is meant by the “*multiple and diverse images*” said to be created by the contested mark. The only conceptual meaning that I can see is that of a doctor and immediacy (now). As I have already noted, the inclusion of a device of a stethoscope reinforces the ‘doctor’ meaning. The earlier trade mark conveys the same concept or idea. Therefore, the marks are conceptually identical.

51. I conclude that, overall, the marks are highly similar.

Distinctive character of the earlier trade mark

52. In *Lloyd Schuhfabrik Meyer* 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 *Windsurfing Chiemsee 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).”

53. The proprietor submits that the fact that the earlier trade mark has been registered establishes that it has no more than ‘ordinary’ distinctiveness. Further, the proprietor submits that the earlier mark has become less distinctive since it was registered in 2006 as a result of changes in market conditions. I take this to mean that a statement made in the course of trade, offering immediate access to a doctor, is more likely to be literally accurate now than it was in 2006. In support of this point, the proprietor points out that the applicant applied in 2016 to register DOCTORNOW in uppercase letters (with the words in contrasting colours) and that application was unsuccessful.

54. The applicant states that the application referred to by the proprietor was withdrawn for commercial reasons and nothing should be inferred from that decision.

55. I accept that the fate of the 2016 application is irrelevant. I must make my own assessment of the distinctive character of the earlier mark in these proceedings. The relevant dates for doing so are the dates of the applications to register the contested marks in October and November 2014.

56. In the absence of an application to invalidate the earlier mark on absolute grounds, the parameters within which I must assess the distinctive character of the earlier mark were set out by the CJEU in *Formula One Licensing BV v OHIM*¹⁵ as follows:

¹⁵ Case C-196/11P

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

57. Consequently, as the proprietor appears to acknowledge, it is not open to me to declare that the applicant’s earlier mark had no distinctive character at the relevant dates.

58. In my view, the earlier mark is highly allusive, but not directly descriptive, of the medical and healthcare services for which it is registered. As such I find that, at the relevant dates, the mark **DOCTORnow** had a low degree of inherent distinctiveness. Conjoining the words and/or the use of upper/lower case makes little distinctive impact and therefore does not affect my finding on this point.

59. The applicant has filed evidence of use of the earlier mark going back to 2006. However, at the relevant dates the applicant was operating a single medical practice. At the date of Dr McGirr's statement in 2016, the applicant's by-then-two practices had seen over 39k individuals and had over 2300 current patients. This is after the relevant dates in 2014. However, even if this represented the position at the relevant dates, the number of patients covered by the applicant's practices under the earlier trade mark represents only a tiny minority of the relevant UK public. This is reflected in the applicant's turnover and promotional expenditure, which is very modest by comparison with that of the healthcare sector as a whole. Further, although there may have been a small degree of wider exposure of the earlier mark through the applicant's provision of services to other organisations, the applicant's use of the earlier mark appears to have been primarily geographically concentrated in the area surrounding its practice(s). In all these circumstances, I do not accept that the applicant has established that the earlier mark had acquired a higher level of distinctiveness in the UK as a result of the use made of the mark prior to the relevant dates.

60. I therefore find that, at the relevant dates, the mark **DOCTORnow** had only a low degree of distinctiveness in relation to the services for which it is registered.

Likelihood of confusion

61. The proprietor appears to consider that the low level of distinctiveness of the earlier mark, at least when taken together with the visual differences between the marks, is sufficient to exclude the likelihood of confusion. In *L'Oréal SA v OHIM*¹⁶ the CJEU considered a similar argument but held 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

¹⁶ Case C-235/05 P

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.”

62. Therefore, the relatively low distinctiveness of the earlier mark is but one factor in the global assessment of the likelihood of confusion.

63. So far as the proprietor’s services in class 44 are concerned, I have found that the respective services are identical and the marks are highly similar. The average consumer is likely to pay an average to high degree of attention when selecting a service provider. Even if I take the latter as the usual level of attention and factor in the low distinctiveness of the earlier mark, I find that the high similarity/identity between the marks/services is sufficient to create a likelihood of confusion.

64. So far as the proprietor’s goods in class 5 are concerned, I have found that the respective goods/services are similar to a medium degree and the marks are highly similar. The average consumer is likely to pay an average to high degree of attention when selecting a service provider. Even if I take the latter as the usual level of attention and factor in the low distinctiveness of the earlier mark, I find that the high similarity between the marks and the medium degree of similarity between the respective goods and services is sufficient to create a likelihood of confusion.

65. So far as the proprietor’s services in class 35 are concerned, I have found that the respective services are similar to a low to medium degree and the marks are highly similar. The average consumer is likely to pay an average to high degree of attention when selecting a service provider. Even if I take the latter as the usual level of attention and factor in the low distinctiveness of the earlier mark, I find that the

high similarity between the marks and the low to medium degree of similarity between the respective services is sufficient to create a likelihood of confusion.

66. In particular, I consider that there is a risk of direct aural confusion as well as confusion through imperfect recollection of one or other of the marks. There is also a likelihood of confusion if the similarity between the trade marks (together with the other factors) causes the average consumer to 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 [or services] from different traders.*” In my judgment, there is plainly such a likelihood in this case. I find that this is so irrespective of whether I take the average consumer of the goods/services in classes 5 and 35 as being a medical professional or a member of the public. It follows that there is also a likelihood of indirect confusion, or ‘association’ as it is called in the Act.

67. As I mentioned earlier, Dr McGirr provides 7 examples of claimed actual confusion. One of these concerns a ‘flyer’ for a music event on which a third party printed the applicant’s name incorrectly as ‘Dr Now’.¹⁷ Dr McGirr suggests that this may have been the result of confusion caused by use of the proprietor’s mark. However, it could just as easily have been a simple error of spelling. I therefore attach no weight to this.

68. There is evidence that a Doctor based in Pakistan applied to the applicant for a position as an on-line doctor.¹⁸ The applicant does not provide on-line services. This may have been a consequence of confusion with the proprietor’s mark, but not by anyone in the UK, and not during the course of trade in goods/services. Accordingly, I attach little weight to this.

69. Dr McGirr provides hearsay evidence about telephone calls received by Hannah Shrimpton and Rachael Whitby, who are employees of the applicant, from a magazine and from the applicant’s marketing company.¹⁹ The people concerned had

¹⁷ See exhibit BM-79 to McGirr 1

¹⁸ See exhibit BM-78 to McGirr 1

¹⁹ See exhibit BM-76 to McGirr 1 and BM-1 to McGirr 2

seen Dr Now exhibiting at an exhibition and being advertised on digital billboards in London, respectively. Both are said to have been confused. Again these may be instances of actual confusion, but not during the course of trade in the goods/services covered by the contested mark.

70. Dr McGirr provides an email from 2017 sent to one of the applicant's patients called 'Michael' by a marketing company. The company had seen a testimonial that Michael had left on the applicant's website and wanted to speak to him as part of an investigation into on-line GP services. Michael was suspicious enough to have the company call back on a number on which he could record the telephone call. A transcript of the call is in evidence.²⁰ It appears from this that Michael already knew about this trade mark dispute. Michael himself has not given evidence and although it is difficult to be sure from the transcript, Michael does not appear to have been confused. The marketing company may have been confused, but not during the course of trade in the goods/services covered by the contested mark.

71. Dr McGirr says that Lynne Smith, the applicant's Practice Manager, took a telephone call in October 2016 from a John Ward of Regenerative Medical Group requesting information about the applicant's screening process for prescribing Viagra via the applicant's 'app'. Ms Smith sent an email about it at the time.²¹ The applicant does not have an 'app', but the proprietor does. Although hearsay, this may well be an instance of confusion on the part of a potential customer, albeit not clearly in the course of trade in the goods/services covered by the contested mark.

72. Finally, Dr McGirr says that Lynda Hunter, who is also employed by the applicant, took a phone call in August 2015 from a man who made various enquiries about how the applicant works, during the course of which he mentioned the applicant's monthly £4.99 fee and that he had downloaded the applicant's "website" onto his phone. Ms Hunter sent an email about this at the time.²² The applicant does not have a monthly £4.99 fee. Dr McGirr suggests that the caller was confused into believing that the applicant was the proprietor. He may well have been, although I

²⁰ See exhibit BM-3 to McGirr 2

²¹ See exhibit BM-2 to McGirr 2

²² See BM-77 to McGirr 1

am cautious about reaching such a finding on the basis of hearsay evidence providing only brief details of a phone call from an unidentified caller.

73. In *Roger Maier and Another v ASOS*²³ Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

74. The relatively limited geographical scope and size of the applicant’s business is one reason why there is not more evidence of confusion. The short period of time that the proprietor has used its mark, and the fact that it does not directly market to the public, are further reasons. In any event, although the applicant’s evidence of actual confusion may not be conclusive, it is certainly sufficient to prevent me ruling out the possibility that confusion has already occurred.

75. Overall, I find the applicant’s evidence of actual confusion to be consistent with the findings I would have made even without it, i.e. that there is an inherent likelihood of confusion.

76. The application for invalidation based on s.5(2)(b) therefore succeeds in classes 5, 35 and 44 of the contested registrations.

²³ [2015] EWCA Civ 220

The Passing-off right ground

77. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented – (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or (b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

78. The basic requirements to establish a passing off right are well established. They are, essentially, (1) goodwill in a business identified by a sign, (2) a misrepresentation (or prospective misrepresentation) by the defendant through the use of a sign similar enough to the claimant’s sign to deceive (intentionally or otherwise) a substantial number of the claimant’s customers or potential customers into believing that the defendant’s goods or services are those of the claimant, or are connected with the claimant, and (3) damage to the claimant’s goodwill caused by the defendant’s misrepresentation.

79. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,²⁴ Mr Daniel Alexander QC, as the Appointed Person, approved of the following passage from my decision in *SWORDERS TM* about the relevant date for the purpose of proceedings under s.5(4)(a):

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour

²⁴ BL O-410-11

complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

80. Therefore, the relevant dates, at least in the first instance, are again the dates of filing the applications to register the contested mark. As I have already noted, the proprietor has not shown any earlier use of the contested mark. Accordingly, in order to establish a passing off right the applicant must show that it had customers or clients in the UK who regarded DOCTORnow as distinctive of the applicant's business as at 10th October and 26th November 2014. As nothing turns on the difference between them, I will consider the position at the later date.

81. The applicant had been trading under the sign for at least 7 years by the relevant date in relation to *private medical practice services, private general practice services, vaccination services, corporate healthcare services*. The business had seen thousands of patients. Although the applicant's business was relatively small in scale, it was not trivial. The goodwill of the business was clearly sufficient in scale to warrant protection under the law of passing off.

82. The next question is whether use of the proprietor's mark in relation to the goods/services covered by the contested mark would have constituted a misrepresentation at the relevant date. In *Neutrogena Corporation and Another v Golden Limited and Another*,²⁵ Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

²⁵ [1996] RPC 473

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

83. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*,²⁶ Lewison L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a *substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd*²⁷), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. However, in *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd*,²⁸ Jacob L.J. stressed that merely being caused to wonder whether the use of two similar signs indicates a trade connection is not sufficient for passing off. He concluded:

“This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally.....be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.”

84. In slight contrast, for the purposes of trade mark law an association between the marks which creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings constitutes a likelihood of confusion. This suggests that the test for trade mark infringement may, in some circumstances, be easier to satisfy than the test for misrepresentation for passing off purposes. In any event, I find that applying the appropriate test under the

²⁶ [2012] EWCA (Civ) 1501

²⁷ [2004] RPC 40

²⁸ [2007] RPC 5 at 16–17

law of passing off does not, on this occasion, improve the applicant's position over that based on s.5(2) of the Trade Marks Act. That is to say that whilst it is likely that use of the proprietor's mark at the relevant date in relation to the goods/services in classes 5 and 35 would most likely have fallen foul of the law of passing off, and use in relation to healthcare services would almost certainly have done so, use of the mark in relation to the services in class 42 would have been unlikely to mislead a substantial number of the applicant's customers or potential customers. In this regard, I adopt the factual reasoning set out in paragraph 34 above.²⁹ Therefore, such use of the proprietor's mark would not have constituted a misrepresentation to the public.

85. Further, even if I am wrong about this, I would still have rejected the applicant's case based on passing off in relation to the registered services in class 42. For the reasons given earlier I regard *design and development of computer software for mobile and desktop applications* (even for medical use) as being in a very different field of activity to *private medical practice services, private general practice services, vaccination services, corporate healthcare services*. Cogent evidence of damage, or a real likelihood of damage, is required in a case where the parties are engaged in very different fields of commercial activity.³⁰ There is no such evidence before me.

86. I conclude that the ground for invalidation based on s.5(4)(a) of the Act takes the applicant's case no further.

Ground for invalidation based on s.5(3) of the Act

87. Section 5(3) states:

- “(3) A trade mark which-
- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international

²⁹ I have kept in mind that the services do not have to be similar for the purposes of passing off law. Nevertheless, the similarity of the services and fields of trade remain relevant factors under the law of passing off.

³⁰ *Stringfellow and Anr. v McCain Foods (G.B.) Limited and Another* [1984] RPC 501

trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

88. The s.5(2) ground having succeeded in classes 5, 35 and 44, it is only necessary to consider this ground in relation to the services in class 42 covered by the contested mark, i.e. *design and development of computer software for mobile and desktop applications*.

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a

reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

90. The applicant submits that it has used its trade mark for 10 years, has invested significant sums promoting the mark, and that its business is growing, as reflected in the turnover figures provided. Further, the applicant points out that the CJEU stated in *General Motors* that it is not necessary for a mark to be well known in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property.

91. The proprietor disputes that the evidence shows that the earlier mark is known to the requisite part of the UK public. In particular, the proprietor disputes that the earlier mark has any more than a local reputation.

92. The relevant dates under s.5(3) are the same as for s.5(2). Therefore, the matter must be judged in October/November 2014. At that time the applicant's mark had been in use for at least 7 years. However, the sums spent promoting the mark and the applicant's likely share of the market for medical services (or even private medical services) was very modest when judged against the norms of the sector concerned. Although it may have provided vaccination services more widely, the applicant was essentially operating a single medical practice covering an area with a diameter of about 30 miles. Most of the applicant's customers are likely to have concentrated in this geographical area.

93. In *Iron & Smith kft v Unilever NV*,³¹ the CJEU was asked whether a CTM (now a EU TM) with a qualifying reputation 'in the Community' (now the European Union), but not in the member state where infringement was alleged, was capable of being infringed under a provision of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation), which is equivalent to s.5(3) of the Act. The court answered that:

"If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the

³¹ Case C-125/14

relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

94. A European Union trade mark may therefore be known to “*a significant part of the public concerned by the products or services covered by that trade mark*” in the EU, without meeting that threshold in a particular Member State. Nevertheless, provided that the mark is known to “*a commercially significant part of*” the relevant public in the relevant Member State in question, it may be entitled to extended protection in that Member State on account of its reputation in the Union. This is confirmed by other language versions of the judgment. The French version says that a “*commercially non-negligible*” part of the relevant public in the Member State must be aware of the earlier CTM (now EU TM) and make a link with the later national trade mark. If a ‘commercially non-negligible’ part of the relevant public represents a lower threshold than the standard requirement for the earlier mark to be known amongst ‘a significant part of the [relevant] public’, it follows that the standard requirement must be for more than a non-negligible or minimal level of reputation. This makes sense because s.5(3) is based on an optional provision of the 1989 Trade Mark Directive and is intended to provide more extensive protection to marks with a certain level of reputation. This suggests that the level of reputation required under s.5(3) is more than minimal, and higher than that which is required in order to support a passing off right under the common law of the UK.

95. If I am right about this, then I find that the reputation of the earlier mark was insufficient at the relevant dates amongst the relevant section of the UK public, which is comprised of all potential UK users of the parties’ services in classes 42 and 44, to support a ground of cancellation based on s.5(3). I note that this was also the decision of the EU IPO in the parallel EU opposition proceedings concerning the

same marks. Further, so far as I can tell from the decision, the Opposition Division appears to have decided the matter based on similar evidence.

96. If I am right then the ground for invalidation based on s.5(3) falls at the first hurdle. However, even if the earlier mark had a qualifying reputation, then I would still reject the case based on s.5(3) in relation to the services in class 42 on the ground that the relevant public would not make a link between the marks. My reasons for this are:

- (i) If the earlier mark has a qualifying reputation, it is at the lowest end of the spectrum of reputations of possible strengths.
- (ii) The distinctive character of the earlier mark is low: it is not the sort of mark that would easily prompt consumers to make a connection with a similar mark used for very different services.
- (iii) Although similarity of services is not a pre-requisite for s.5(3), the degree of difference between medical/healthcare services on the one hand, and on the other hand, software development and design services (even for software with medical application), points away from the relevant public making a link between the marks.
- (iv) There is only limited overlap between the users of the respective services, which are likely to be mainly business users.
- (v) Again although it is not decisive, I have already found that there is no likelihood of confusion with regard to the use of the marks in relation to the respective services under consideration here.

97. Consequently, even if the earlier mark scrapes over the threshold of having a reputation known to a significant part of the relevant UK public, and also taking account of the high level of similarity between the marks, the case based on s.5(3) of the Act must still fail. This is because in the absence of the public making a link between the marks, there is no possibility of the contested mark taking unfair advantage of, or being detrimental to, the reputation or distinctive character of the earlier mark.

98. The s.5(3) ground for invalidation therefore fails in relation to the services in class 42 covered by the contested mark.

Overall outcome

99. The application to invalidate the contested marks succeeds in classes 5, 35 and 44, but fails in class 42. This means that the registration 3076376 will be cancelled and the marks deemed never to have been registered. Registration 3083236 will be partially cancelled and the marks deemed never to have been registered so far as class 35 is concerned. However, the marks covered by registration 3083236 will remain registered in class 42.

Costs

100. The application for cancellation has succeeded to a greater extent than it has failed. Therefore, the applicant is entitled to a contribution towards its costs. I assess these as follows:

- (i) £350 for filing an application for invalidation (including the official fee) and considering the proprietor's counterstatement;
- (ii) £375 for filing evidence and considering the proprietor's evidence;
- (iii) £200 for filing written submissions.

101. I have reduced the amount awarded in costs for filing the applicant's evidence by 50% to reflect the inconvenience caused by the applicant filing over 300 pages of evidence (without seeking directions), a significant part of which turned out to be irrelevant because it went to use of the earlier mark after the relevant dates.

102. I order Now Healthcare Group Limited to pay Doctor Now Limited the sum of £925 within 21 days of the end of the period allowed for appeal.

Dated this 21st day of August 2017

**Allan James
For the Registrar**