



TRADE MARKS ACT 1995

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by My Doctor Online Pty Ltd to registration of trade mark application 821160(41, 42) – MY DR - filed in the name of MIMS Data Systems Pty Ltd.

Background

On 24 January 2000, ('the priority date') MIMS Data Systems Pty Ltd ('the applicant'), of St Leonards, NSW, filed application to register the trade mark MY DR in respect of the services appearing below in Classes 41 and 42 of the *International (Nice) Classification of Goods and Services*.

Publication and provision, on-line or in electronic format, of information referring to health and medical practitioners, services and other related information

Provision of health and medical information including information on the availability of health and medical services and the provision of appointment, reservation and other interactive services connected with that information

The application was examined and subsequently advertised as accepted for registration in the *Australian Official Journal of Trade Marks* on 19 October 2000.

On 23 November 2000, within the time allowed to do so, My Doctor Online Pty Ltd, ('the opponent') filed Notice of Opposition ('the Notice') to the registration of the trade mark. The first of the grounds stated in the Notice is not clearly stated; it reads:

Section 57

The trade mark is substantially identical or deceptively similar to the opponent's trade mark (application #854408), and for similar services. The opponent's trade mark was in use in Australia prior to the priority date for registration of [the opposed] trade mark, and the applicant is aware of this use.

The second ground is under section 41, that the opposed trade mark is not capable of distinguishing the applicant's services from those of other traders.

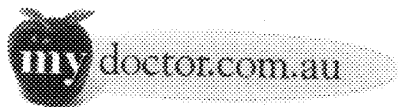
Angela Hodge's declaration, in evidence which I detail below, clarifies the first ground of opposition, above, as being under section 60 of the Act. However, this ground is also capable of being read as referring to section 58 of the Act which allows opposition to registration based on the proprietorship of a trade mark. The applicant has read it this way and has addressed the provisions of section 58 in written submissions. For the sake of completeness, therefore, I will give my reasons also in terms of section 58 of the Act.

Evidence

Subsequently, the opponent has filed evidence in support of the opposition, which is a statutory declaration by Angela Hodge. The applicant's evidence in answer is a statutory declaration by Christopher Wills.

Angela Hodge is a director of the opponent, My Doctor Online Pty Ltd, which plans to do business on the Internet. Ms Hodge avers that she started developing a business plan and seeking funding in 1999. She declares that she registered the business name My Doctor Online in March 1999 in her own name and that, subsequently, ownership of the business name was transferred to the opponent. In May 1999, Ms Hodge registered the Internet domain name 'mydoctor.com.au' and then, in her words, 'started building the opponent's business, a health portal web site'. The opponent filed its own trade mark application – details of which appear below - in October 2000.

Reg Number: 854408
 Priority Date: 23 October 2000
 Class: 38
 Services: Telecommunications (specifically the Internet)



Trade Mark:

At about the date of filing the above application, 23 October 2000, Ms Hodge obtained a license to use the Australian Medical Association ('AMA') AMPCO data-base of doctors registered in Australia. Ms Hodge also had discussions, concerning funding and content of the proposed website, 'at the beginning of the year 2000', with the HCF Health Fund, Pricewaterhouse Coopers, the Health Communication Network and Viper Productions.

Ms Hodge says that she has also attended various conferences, the subject matter of which is health business on the Internet, in the second half of the year 2000.

The balance of Ms Hodge's declaration gives examples of confusion between the opponent's trade mark and that of the applicant. Ms Hodge also makes submission in terms of the deceptive similarity of the trade marks and the inherent capacity of the opposed trade mark to distinguish the services of the applicant. While I consider these viewpoints in my reasons, below, they do not constitute evidence.

The applicant's declarant, Christopher Wills, is the Managing Director of MediMedia Australia ('Medimedia'), which is a member of the Vivendi Universal group of companies. The applicant, (MIMS Data Systems Pty Ltd), atmedica Pty Ltd ('atmedia') and Medimedia are all members of the Vivendi Universal group of companies. The applicant, atmedia and Medimedia have published two major healthcare publications in Australia for the past 38 years – *MIMS Bi-Monthly* and *MIMS Annual*. These publications are aimed at healthcare professionals and are drug reference systems. The applicant also publishes the *Disease Index*, a summary of diseases, for use by healthcare professionals. A further electronic publication, the *E-MIMS CD* contains the drug reference system, the summary of diseases and a software package that allows doctors to write prescriptions which incorporate data from the drug reference system.

The above publications have a wide circulation among healthcare professionals.

In early 1999, the applicant decided to adopt the MY DR trade mark and establish an Internet website for healthcare professionals and the public. The Managing Director of the applicant, Dr John Ainge, coined the term. I understand from the declaration that the preferred form of the trade mark was MY DOCTOR, but the applicant found that mydoctor.com.au was already registered as a domain name by a business called Angela My Doctor, which in turn was registered by a company called Degova Pty Ltd.

Within the period July 1999 to March 2000, the applicant had discussions with a number of organizations concerning content, and in these talks, referred to the proposed service by allusion to the MY DR trade mark. The applicant has also licensed use of the AMA AMPCO database.

The applicant's Internet site was launched on 3 February 2000 at the 10th Royal College of General Practitioners Computer Conference in Sydney, which was attended by approximately 1000 people.

Mr Wills provides details of how the applicant advertises and promotes its website service, and also details of the numbers of people who visit its website on the Internet. These numbers are considerable.

Neither party requested to be heard in the matter and, accordingly, the matter has come to me to decide, on the basis of the material on file, as a delegate of the Registrar of Trade Marks. The applicant has tendered written submissions by its solicitors, Rohan Singh and Rebecca Ordish of Baker & McKenzie in Sydney.

Reasons

Section 60

Section 60 of the Act provides:

60 Trade mark similar to trade mark that has acquired a reputation in Australia

The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

(a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and

(b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

It follows that the issues for consideration in terms of section 60 are whether:

- the trade marks are substantially identical or deceptively similar;
- the reputation of the opponent's trade mark before the priority date of the opposed application; and,
- if because of the reputation of the opponent's trade mark, the use of the use of the applicant's trade mark would confuse or deceive.

For convenience and brevity, since the issue here is clear-cut, I will discuss only the reputation of the opponent's trade mark.

In *McCormick & Company Inc v McCormick* [2000] FCA 1335 (15 September 2000), at paragraph 81, Kenny J discussed the term 'reputation' thus:

What is intended by the word "reputation" in s 60? The word is defined in *The Macquarie Dictionary* as follows:

reputation ... 1. the estimation in which a person or thing is held, esp. by the community or the public generally; repute ... 2. favourable repute; good name ... 3. A favourable and publicly recognised name or standing for merit, achievement, etc. ... 4. The estimation or name of being, having done, etc, something specified.

Cf. The Oxford English Dictionary. In s 60, the word is, I think, apt to refer to "the recognition of the McCormick & Co marks by the public generally".

The date at which I am to consider the reputation of the opponent's trade mark is 24 January 2000, the date that this application was filed. It would seem, although the evidence is not explicit on this point, that the opponent uses, or intends to use, its trade mark in two forms: that in trade mark application 854408, above, and in the form MYDOCTOR, as used in the Internet domain name, mydoctor.com.au.

The evidence shows that Ms Hodge, on behalf of the opponent, had talks with a number of organizations about her company's website portal at about the time this opposed application was filed by the applicant. However, I do not consider that the evidence shows either that the negotiations resulted in "a recognition of the trade mark by the public generally" or that the discussions were earlier than the filing of this opposed trade mark. Neither are the other preparations of the opponent to use its trade mark, by registering a company name and domain name, activities that, in themselves, would, prima facie, result in a recognition of a trade mark by the public generally.

Accordingly, the opponent has not established this ground of opposition.

Section 41

Section 41 provides for the assessment of the inherent fitness of a trade mark for registration in terms of its capacity to distinguish the goods or services of the applicant from those of other traders. Subsection 41(3) of the Act describes the initial step in the assessment:

- (3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

In *Clark Equipment Co. v. Registrar of Trade Marks* (1964) 111 CLR 511, at 315, Kitto J observed of the expression 'adapted to distinguish':

In *Registrar of Trade Marks v. W. & G. Du Cros Ltd.* (1913) AC 624, at pp 634, 635 Lord Parker of Waddington, having remarked upon the difficulty of finding the right criterion by which to determine whether a proposed mark is or is not "adapted

to distinguish" the applicant's goods, defined the crucial question practically as I have stated it, and added two sentences which have often been quoted but to which it is well to return for an understanding of the problem in a case such as the present. His Lordship said: "The applicant's chance of success in this respect (i.e. in distinguishing his goods by means of the mark, apart from the effects of registration) must, I think, largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connexion with their own goods. It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Acts a monopoly in what others may legitimately desire to use."

Kitto J continued, at page 514, that:

... the question whether a mark is adapted to distinguish [should be] be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives - in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess - will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.

The opposed trade mark is the expression MY DR. The opponent argues that, "the word 'Doctor' and its abbreviation 'Dr' is a word which is legitimately required by other traders in respect of their similar services and the word 'My' does not add sufficiently to the abbreviation 'Dr' to render it a distinctive trade mark, particularly when no logo or device is attached to the words."

I do not agreed with this proposition for two reasons.

Firstly, the opposed trade mark ought to be considered as a whole. The form of analysis suggested by the opponent relies on an initial dissection of the trade mark which is artificial, arbitrary and does not allow consideration of the meaning of the expression MY DR as a whole. The investigation works backwards from conclusions based on assessments of the fitness of the individual components of the trade mark.

Secondly, the argument places the threshold for registration, under section 41, at a level that a trade mark be 'distinctive'. This threshold is not appropriate, however, as it is not essential in terms of section 41 that a trade mark be 'distinctive' of goods or services in order to be registered: it is, rather, required that a trade mark be 'capable of distinguishing' the goods or services.

I consider that the expression MY DR is not one that other traders would require to use, in respect of the services nominated on the opposed application, in the manner described, above, by Kitto J. There is no evidence that the opposed trade mark is in use by other traders as a description of the services that they perform or that the expression is in common usage in the performance of those services. Further, the opposed trade mark is not one which by the ordinary significations of the words lack inherent adaptation to distinguish the applicant's services.

Accordingly, the opponent has not established its ground in terms of section 41 of the Act.

Section 58

Section 58 of the Act provides:

58 Applicant not owner of trade mark

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Note: For *applicant* see section 6.

The word 'owner', in section 58 of the Act, has the same meaning as the word 'proprietor' in the *Trade Marks Act 1955*, and its predecessors.

In *Re Hicks's Trade Mark* (1897) 22 VLR 636, at 639, Holroyd J said during the course of submissions:

A person cannot be properly registered unless he is the proprietor. Proprietor is the person who at the moment he makes application to be registered is entitled to the exclusive use of the name, whether he then or before publicly adopted it. A man cannot be said to have adopted a name if someone else has done so before him. Section 19 merely says that the act of applying is to be deemed equivalent to public user. No one could otherwise be entitled to registration as proprietor unless he had publicly used the trade name before. The section does not affect the fact that another person used the name first. The difficulty here is that although Hicks may have by virtue of his application publicly used the name, someone else publicly used it before him.

In his judgment, at page 640, Holroyd J said:

For the reasons given by us in the course of the argument, we think this application to expunge Hicks's name from the register of trade marks as the proprietor of the word 'Empress' as a trade mark applied to stoves ought to be granted. In order to substantiate his application to be placed on the register for this word he must have claimed to be the proprietor, and the word 'proprietor' must be taken to mean the person entitled to the exclusive use of that name. If there is anyone else who would be interfered with by the registration of the word 'Empress' in the exercise of a right which such person has already acquired to use the same word in application to the

same kind of thing, then Hicks ought not to have been put on the register for that trade mark, and his name will be properly removed on the application of the person whose right of user was thereby disturbed.

The applicant's claim to ownership of the opposed trade mark is, if the trade mark was previously unused by the opponent, via its application to register the words as a trade mark. If the opponent can show use of the same words as a trade mark before the priority date, or any use by the applicant of the same words as a trade mark, it may displace the applicant's claims to ownership of the trade mark.

The expression 'the same words' means 'substantially identical words'. In *Carnival Cruiselines Inc v Sitmar Cruises Ltd* (1994) 120 ALR 495 at 513, Gummow J said this:

When the decision [a reference to *Shell Co of Australia Ltd v Rohm & Haas Co* (1949) 78 CLR 601 at 629] is understood in this way, it does not supply any general authority for the proposition that in the case of disputed claims to proprietorship under the present statute anything less than substantial identity between the two marks will suffice. The phrase "substantially identical" requires a total impression of similarity to emerge from a comparison between the two marks. In a real sense a claim to proprietorship of the one extends to the other. But to go beyond this is, in my view, not possible.

The opponent's evidence is not explicit, but I gather that the opponent states that it has used the trade marks MYDOCTOR and the device/word combination which I have reproduced under the heading **Evidence**, above, before the priority date or first use of the opposed application.

I do not consider that the evidence shows that preliminary preparations the opponent made to set up its Internet website portal constitute use of either the words MYDOCTOR or the device/word combination as a trade mark before the applicant filed for registration of, or first used, the trade mark MY DR. It is possible under some circumstances that preliminary preparations that do result in actual use of a trade mark for services will constitute use in a trade mark sense. In a decision of Deputy Registrar Hardie, relating to services, *Sizzler Restaurants International Inc v Sabra International Pty Ltd* (1990) 20 IPR 331, the Deputy Registrar said of the preparatory work for the use of the trade mark SIZZLER:

I distinguish this use from the use found short in the *Moorgate* case. There, the court found it was not established that at the critical date there was an existing intention to offer or supply the goods bearing the mark in trade. There was no more than preliminary discussions and most notably, the choice of a trade mark was not yet settled. Here, I do not find that there were services which had been offered under the trade mark, but I do find that there was a fixed and existing intention to use the mark SIZZLER, that the market research and negotiations were much more than the preliminary discussions undertaken in the *Moorgate* case, and

that by means of the market research and trade negotiations, the Sizzler Restaurants International had exposed its use of the trade mark SIZZLER to the public.

Here, the evidence of the opponent does not reveal any sense of immediacy concerning its use of the trade mark and the evidence is not precise. Moreover, the opponent's preparations are matched by the applicant's own preparations during the same period. The evidence shows that the trade marks occurred to the parties at very much the same time and preparations of the parties for use of their trade marks have occurred at the same time.

In addressing the similarity of the trade marks of the parties in the 'submission' part of its evidence, the opponent states that the trade marks are deceptively similar. However, as per *Sitmar*, above, the minimum degree of similarity between the trade marks of the parties for the opponent to establish this ground is a substantial identity.

Substantial identity is to be assessed according to the test set out in Windeyer J in *The Shell Co of Australia Limited v Esso Standard Oil (Australia) Limited* (1962) 109 CLR 407 at 414. His Honour described the test in the following terms:

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

The trade marks MY DR and MY DOCTOR, in a side by side comparison, do not give an impression of resemblance amounting to an identity. The test for substantial identity is an objective test and is not contextually based, as is the test for deceptive similarity. While it is true that the expression MY DR may be read as MY DOCTOR, such a reading is largely dependant on the context in which it is read. Thus, I do not consider the trade marks MY DR and MY DOCTOR to be substantially identical.

It follows that the device/word trade mark relied on by the opponent is also not substantially identical to the opposed trade mark.

Accordingly, the opponent has not established this ground of opposition.

Decision

Section 55 of the Act provides:

55 Decision

Unless the proceedings are discontinued or dismissed, the Registrar must, at the end, decide:

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark (with or without conditions or **Imitations**) in respect of the goods and/or services then specified in the application; having regard to the extent (if any) to which any ground on which the application was opposed has been established.

Note: For *limitations* see section 6.

The opponent has not established its grounds of opposition. The trade mark may therefore be registered if there is no appeal against this decision in the requisite period and if the applicant has paid the registration fees.

Costs

The applicant, in its written submissions, has requested its costs. Section 221 of the Act provides:

221 Costs awarded by Registrar

- (1) The Registrar may award costs in respect of the matters, and in the amounts, provided for in the regulations against any party to proceedings brought before him or her.
- (2) A party desiring to obtain costs must apply to the Registrar in accordance with the regulations.
- (3) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

The applicant has been successful in these proceedings. In accordance with section 221(1), I therefore order that the opponent pay the applicant's costs per the schedule to the regulations.

Ian Thompson
Hearing Officer

4 February 2002