TRADE MARKS ACT 1995

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

Re: Opposition by My Doctor Online Pty Limited to registration of trade mark application 852020(41, 42) - **MYDOCTOR** - filed in the name of MIMS Data Systems Pty Limited.

Background

MIMS Data Systems Pty Limited (the applicant) filed application number 852020 on 28 September 2000 in classes 41 and 42 of the *International Classification of Goods and Services* (the Nice classification). The trade mark comprises the single 'word' **MYDOCTOR** formed by a simple conjoining of the English words 'my' and 'doctor' represented in uppercase typescript. The services in respect of which the application was filed, and later accepted, are respectively, in class 41:

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

and in class 42:

> *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 advertised as accepted in the *Australian Official Journal of Trade Marks* (the Journal) of 1 February 2001. My Doctor Online Pty Limited (the opponent) filed a notice of opposition on 5 February 2001 which outlined grounds under ss.41 and 60 of the *Trade Marks Act 1995*. Both parties have now served and filed evidence to support their cases. Neither party has taken up the opportunity to be heard in the matter - relying instead on a decision based on the written record of material held in this Office. The applicant has tendered a supporting written statement to uphold its position through its legal representatives, Rohan Singh and Rebecca Ordish of Baker & McKenzie in Sydney.

The applicant here is a leading publisher of healthcare information in Australia. It produces the well-known *MIMS Annual* and *MIMS Bi-Monthly* publications that reach some 28 000 healthcare professionals throughout Australia. The *MIMS Bi-Monthly* was first published in 1963 and the applicant claims that it is used by 97% of general practitioners, on average, 30 times each week. The publication contains an abbreviated collection of information about drugs for healthcare professionals. Such information encompasses side effects, contraindications and product indications of specific drugs as well as Pharmaceutical Benefits Scheme listings at the point of prescription. The *MIMS Annual* was first published in 1976 and now enjoys an annual printing run of 25 000 copies. It is a more detailed encyclopedia of drug information. Since 1995 the applicant has also produced a publication known as the *Disease Index* which contains a summary of diseases by experts for use by healthcare professionals.

To date the applicant has not claimed any commercial use of the **MYDOCTOR** trade mark. Around 24 August 1999 the applicant sought to register two domain names for use in business by means of the Internet. It successfully registered "mydr.com.au" but was unable to register "mydoctor.com.au" in the face of a prior registration. This prior domain name registration was registered to Devoga Pty Limited (Devoga) from some date earlier than 24 August 1999. The evidence from both parties appears to indicate that Devoga is a forerunner of the present opponent company because the opponent claims a registration of the domain name "mydoctor.com.au" from May 1999. The applicant launched its **MY DR** Website on 3 February 2000. It also entered into a licence agreement with the Australian Medical Association (AMA) to use the AMA's Ampco database. This database contains lists of doctors, hospitals, pharmacies and other healthcare professionals. The applicant began using this database in July 2000. The applicant has made use of two trade marks in relation both to this Website, and to advertising in the medical journals *Medical Observer*, *Australian Dr* and *Medicine Today*. It has used the normal upper-case script of **MY DR** and it has used the logo mark shown below.

The applicant has also recently been involved in a vigorous advertising campaign under these two trade marks. The **MY DR** Website was a major sponsor of the *Adidas International 2001* tennis tournament held in Sydney in January 2001.

The opponent in this matter operates a health portal website. The opponent describes this business venture as an internet-based communications channel between consumers, doctors and the health care community in the areas of health, e-commerce, finance and communications. It claims registration of the business name "My Doctor Online" in New South Wales from March 1999 and also registration of the domain name "mydoctor.com.au" from May 1999. The business name became the company name in February 2000. According to the first Hodge declaration the opponent began to develop its business plan during 1999 and arranged to obtain a licence to use the AMA's Ampco database from January 2000. This is the same database used by the applicant. From as early as July 2000 both the applicant and the opponent have attended the same conferences and meetings dealing with establishing on-line health services. The opponent has claimed some level of confusion has occurred in the minds of potential business associates that they have met at these conferences and meetings, as a result of the use of similar trade marks.

The Evidence

The opponent's evidence in support of the opposition comprises a single declaration, with exhibits 'A' and 'B', dated 15 February 2001 from Angela Hodge (first Hodge declaration). Ms Hodge is a director of the opponent company.

The applicant's evidence in answer is a single declaration, with exhibits 'A' to 'L' inclusive, dated 28 September 2001 from Christopher Wills (Wills declaration). Mr Wills is the managing director of MediMedia Australia, a member of the Vivendi Universal group of companies of which the applicant company is also a member.

The opponent has responded with evidence in reply. Again this evidence consists of a single declaration but without exhibits and dated 25 October 2001 from Angela Hodge (second Hodge declaration).

Discussion

The opponent's notice of opposition claims two grounds of opposition. These two grounds are based on ss.41 and 60 of the *Trade Marks Act 1995*.

Before I begin a closer consideration of these two grounds, I must make some comment on aspects of the evidence that has been submitted. First, it is apparent that the opponent has included a good deal of opinion and some argument within the declaration that was filed as the evidence in support. I only intend to give these items the appropriate weight as evidence. I am prepared, however, to give the opponent's arguments the status of supporting written submissions in deciding this matter.

(a) Section 41 - Trade mark not distinguishing applicant's goods or services

Insofar as it is relevant here this section reads:

> **41.(1)** ....
> **(2)** An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (***designated goods or services***) from the goods or services of other persons.
> Note: For ***goods of a person*** and ***services of a person*** see section 6.
> **(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.

The opponent has challenged that the present trade mark, **MYDOCTOR**, is not capable of distinguishing the applicant's goods or services from those of other traders. The basic inquiry to be made to test this capability has been set down by Justice Kitto in *Clark Equipment Company v Registrar of Trade Marks* (1964) 111 CLR 511 at 513 (the **MICHIGAN** case). Justice Kitto has further summarised this test in *F. H. Faulding & Son Limited v Imperial Chemical Industries of Australia and New Zealand* (1965) 112 CLR 537 at 555 (the **BARRIER CREAM** case) in the words:

> ..... the question to be asked in order to test whether a word is adapted to distinguish one trader's goods from the goods of all others is whether the word is one which other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use upon or in connexion with their goods.

The services in respect of which the applicant seeks registration are respectively, in class 41:

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

and in class 42:

> *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 registrability of the trade mark must always be considered in relation to the goods or services for which registration is sought. The APPLE trade mark illustrates this point - while the mark may be registrable for computer apparatus it may well be unregistrable for certain well-known Tasmanian fruits.

The services described in the application could be useful for a variety of purposes. By means of them it may be possible to 'select a doctor', 'find a doctor' or 'locate a doctor'. The mark **MYDOCTOR**, while it may have some vague element of connection to these services is not one that other traders in similar services are likely to desire to use for the purpose of indicating those services. Nor do the applicant's services allow an online user to actually own or possess a doctor in any sense. Another manner in which the applicant's services could be viewed is that the information supplied via the website may serve as a 'substitute' doctor. An individual could perform a self-diagnosis by means of the information obtained online. In such a circumstance the user does not truly view the services provided as their own doctor - but merely as a source of information that doctors would normally supply. Whilst the word **MYDOCTOR** does have a tenuous descriptive link with the services claimed by the applicant, I believe that, despite this, the mark is capable of distinguishing the applicant's services from those similar services of other traders.

This being the case, I find that the s.41 ground of opposition is not successful.

(b) Section 60 - Trade mark similar to trade mark that has acquired a reputation in Australia

Here the legislation allows:

> **60.** 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.

There are three factors that an opponent needs to establish in order to succeed with an opposition under s.60. These are that:

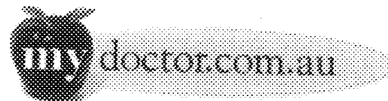
- the respective marks must be either substantially identical or deceptively similar,
- the mark relied on must have established a reputation as at the priority date of the application and

- because of that reputation use of the mark applied for would be likely to deceive or cause confusion.

To consider the degree of similarity of the respective trade marks I turn first to the test outlined for substantial identity of trade marks, as set out in *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* 109 CLR 407 at 414 where Windeyer J said:

> 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 mark applied for is simply the single 'word' in uppercase letters - **MYDOCTOR**. The mark on which the opponent seeks to rely is the composite trade mark as shown below:



When placed side by side for such a comparison the differences between these marks are many. The applicant's mark is in standard uppercase lettering and consists of an eight-letter 'word' not to be found in dictionaries. The opponent's mark contains a domain name address, the words 'my doctor' are in lower case and in contrasting colours of black and white and the device of an apple is also in the mark. I could expand this list of differences between these marks but suffice to say that these differences outweigh the similarities and I find that these marks are not substantially identical.

The test for deceptive similarity of two trade marks is not, however, a side by side comparison. Windeyer J states the test at 415 of *Shell v Esso*, supra, in the words:

> On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions.

I am not convinced that the marks would be taken one for the other visually. One has a device element, is scripted in lower-case lettering and consists of a domain name whilst the other is merely a standard upper-case script for a coined word. For the purposes of aural comparison the applied for mark would be referenced as 'my doctor'

whereas, in full, the opponent's mark would be quoted as 'my doctor dot com dot au'. There is an argument that the opponent's mark would not generally be quoted in full orally but would be abbreviated to 'my doctor'. The balance point of these two competing claims may be moot but I do not believe that I need to develop the matter further because a more compelling circumstance exists in this case.

This factor, I believe, concerns the issue of contextual confusion. On this matter Mr S. E. Chisholm, the Assistant-Comptroller, commented in *John Fitton & Co. Ltd's Application* 66 RPC 110 at 113:

> With reference to the nature of the confusion alleged the evidence furnished on behalf of the Opponents by their trade declarants is directed not so much towards showing that the two marks 'Jests' and 'Easyjests' might themselves be confused either visually or orally, as towards establishing that confusion would result, owing to the presence of the common element 'Jest' in each mark, in traders and the public being induced to believe that the two sets of goods sold under the marks emanated from one and the same trade source.

The heart of both of these trade marks is the phrase *'my doctor'* and I believe that the similarity between them is sufficient for a substantial number of people to believe that the marks identify the same trade source. For this reason I find that these marks are deceptively similar.

I turn next to the reputation that has been established in the opponent's mark as at the priority date for the present application. In this case, the priority date and the date of application are one and the same, being 28 September 2000. The evidence submitted by the opponent to establish a reputation of its trade mark is limited. The opponent claims registration of the domain name 'mydoctor.com.au'. The opponent, for the purposes of s.60, must be able to direct me to a trade mark that has acquired a reputation. To do so would require a demonstration of trade mark use of 'mydoctor.com.au' or of **MYDOCTOR**. The opponent has not provided a definite indication of any business operation by use of either of these possible trade marks. I simply have no facts before me concerning the actual use of the 'mydoctor.com.au' or **MYDOCTOR** marks by the opponent that would demonstrate a substantial reputation.

Such factors as duration, size and geographical distribution of sales and advertising would, at least, provide some sort of firm evidence on which to base such a claim. The opponent has set out, at clauses 14 and 15 of the first Hodge declaration, examples of confusion by prospective clients that it claims have already occurred. The specifics of the alleged confusion were not submitted. Again, even if I do consider such a claim of

confusion to have been shown, the real issue of the extent of the reputation of the opponent's mark, in Australia, by 28 September 2000, has not been addressed. For the foregoing reasons I find that the opponent's mark has not been shown to have established a reputation before the priority date of the present application.

Thus, the ground of opposition has not been established under s.60.

I note that the opponent has also claimed that it has sufficient 'honest concurrent use' of its mark to render the mark **MYDOCTOR** incapable of registration by the applicant. Honest concurrent use, however, is not an avenue for an opponent to prevent registration of a trade mark by an applicant - although it may be a possible avenue under the provisions of s.44(3) for the opponent to gain registration of its own mark concurrently with the earlier mark. I make no finding on that issue, however.

Conclusion

From the foregoing I have found that the opposition has not been established under either of the grounds claimed by the opponent in the notice of opposition. Thus, I dismiss this opposition and direct that subject to payment of the appropriate registration fee that this trade mark may proceed to registration 30 days from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been decided or discontinued.

Costs

In the supporting written submissions, the applicant requested its costs in the matter. Having been the successful party, the applicant is entitled to its costs insofar as Schedule 8 of the *Trade Marks Regulations 1995* allows and these I award against the opponent.

Don Nancarrow
Hearing Officer
Trade Marks Hearings
26 February 2002.