

**O-577-15**

**TRADE MARKS ACT 1994**

**TRADE MARK REGISTRATION 2431417**

**IN THE NAME OF SAMEDAYDOCTOR (LONDON) LIMITED**

**AND**

**APPLICATION 500692 BY HARLEY DOCTOR LIMITED**

**FOR A DECLARATION THAT REGISTRATION 2431417 IS INVALID**

**AND**

**TRADE MARK APPLICATION 3029193**

**BY SAMEDAYDOCTOR (LONDON) LIMITED**

**AND**

**OPPOSITION 403329 BY HARLEY DOCTOR LIMITED**

## Background and pleadings

1. Samedaydoctor (London) Limited (“SDD”) registered the trade mark shown below.



2. The application for registration was filed on 1<sup>st</sup> September 2006. The mark was entered in the register on 9<sup>th</sup> March 2007 under number 2431417.

3. On 4<sup>th</sup> November 2013, SDD applied under number 3029193 to register the series of three trade marks shown below.

SAMEDAYDOCTOR

**samedaydoctor**

**samedaydoctor**

4. The examiner provisionally rejected the application on the grounds that the marks were descriptive and/or non-distinctive and therefore excluded from registration by section 3(1)(b) and (c) of the Trade Marks Act (“the Act”) . The applicant subsequently filed evidence of use of the marks. This persuaded a Hearing Officer that the marks had acquired a distinctive character through use and that the marks therefore met the requirements for registration. Consequently, the application to register the marks was published on 12<sup>th</sup> September 2014.

5. All four marks are registered, or proposed to be registered, in class 44 of the register for:

Medical services; health screening services; sexual health services; medical and health counselling; occupational health (health and medical services); specialised medical services; medical analysis for the diagnosis and treatment of persons; advice, consultation and information services for all the aforesaid services.

6. On 2<sup>nd</sup> December 2014, Harley Doctor Limited (“Harley”) opposed application 3029193 and applied to invalidate registration 2431417.

7. Harley’s grounds for doing so are that the marks consist of signs that may serve, in trade, to designate a characteristic of the services and/or are devoid of any distinctive character. Although it was not made clear in the notice of

opposition/application for invalidation, the characteristic in question is the time of making available the services at issue (i.e. the same day as they are sought).

8. SDD filed counterstatements denying that the marks are descriptive and/or non-distinctive. In any event, SDD relies on the marks having acquired a distinctive character through use.

9. Both sides seek an award of costs.

10. The opposition and invalidation proceedings are consolidated.

### **The evidence**

11. SDD's evidence takes the form of two witness statements by Dr Lawrence Gerlis, who is its Chief Executive Officer, and one by Carissa Kendal-Parker, who is a solicitor employed by EIP Europe LLP, which represents SDD in these proceedings.

12. Dr Gerlis explains that SDD was incorporated in 2006. Prior to this, in 2003, he and his wife set up a walk-in clinic in Harley Street, London, which offered immediate appointments under the name 'SAME DAY DOCTOR'. In 2006, the clinic moved to Wimpole Street, London.

13. In 2007 the business started to expand. A further clinic was opened in the City of London. A franchise was opened in Manchester in 2007 (although this franchise was bought back by SDD in 2010). Further franchises took place in 2008 and 2009 and clinics were opened in North London, Basingstoke, Canary Wharf, New Malden and Edinburgh. A 9<sup>th</sup> clinic opened in Richmond in 2014.

14. Dr Gerlis says that his business's clients are busy working people who do not have the time to wait for an NHS appointment. By 2014, an average of 150 patients per day visited SDD's (then) 8 clinics and paid around £150 each. The company also has 31 corporate clients, many (but not all) of whom are based, or have headquarters, in London.

15. The services provided by SDD include screening and treatment for sexually transmitted diseases, provision of contraceptive devices, visa and pre-employment medicals, occupational health reports, health screening, vaccinations, drug testing, referrals for scans, pharmacy services, and treatment for minor ailments such as hay fever injections and ear syringing.

16. SDD's annual turnover was £1.15m in 2006, rising to £2.87m by 2008, to £3.3m by 2011, and to £3.7m by 2013.

17. SDD's main advertising tool for the services provided under SAMEDAYDOCTOR is Google Adwords. It has spent £2.3m on such promotion. It is currently spending about £350k per annum on this. Rather surprisingly, Dr Gerlis gives no evidence about the adwords SDD uses to generate enquiries to its clinics. He does, however, provide information about the number and geographical location of those internet users clicking through from the Google advertisements to SDD's website<sup>1</sup>. It appears from this information that the advertisements were seen by people in many places in the UK. I find some of the results hard to understand. For example, the only people in Wales who appear to have clicked through to SDD's website are from a small area called Blaenau Gwent in South East Wales. There were 58 click-throughs from this area, yet none from the cities of Cardiff or Swansea. By far the highest number of click-throughs came from Greater London and Greater Manchester (matching the areas where SDD's clinics are based).

18. Dr Gerlis states that SDD also advertises through conventional channels. He provides some examples of leaflets, guides, post cards etc. distributed at the clinics<sup>2</sup>. I note that some of these examples include the composite mark registered under number 2431417 as well as the marks covered by application 3029193. There is no evidence as to the extent of such use. The documents in evidence are unused and therefore more like samples than examples.

19. The SAMEDAYDOCTOR mark is also used on a sign outside the clinics and on SDD's website, samedaydoctor.co.uk, which has been in operation since 2003. SDD also promotes its clinics via email 'mailshots'. Dr Gerlis says that these were sent to 250 businesses in the vicinity of the clinics.

20. SDD also uses an advertising agency called Sense Advertising. The cost of their advertising and marketing services is around £20k per annum. They have arranged poster advertisements featuring the SAMEDAYDOCTOR mark on the London Underground, Manchester trams, advertising boards in London, Reading railway station, Hampshire, Manchester and Edinburgh. SDD's advertisements on tube carriages ran for two weeks. The poster advertisements ran for one month. Examples of such advertisements are in evidence<sup>3</sup>. Dr Gerlis states that advertisements featuring the SAMEDAYDOCTOR mark have appeared in publications such as Wimbledon tournament tennis magazine, The Lawyer, Metro and Cosmopolitan. However, he does not say when these advertisements appeared or provide examples showing how the mark was used.

21. The evidence which does show how the mark was used shows that most of the uses of SAMEDAYDOCTOR were, or at least arguably were, trade mark uses. Some

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<sup>1</sup> See exhibit LG-9

<sup>2</sup> See exhibit LG-2

<sup>3</sup> See exhibit LG-3

appear to be purely descriptive uses. For example, a promotional postcard<sup>4</sup> shows use of the phrase “*Same day Doctor. Timing is everything*”. I also note that one of the posters showing use of the mark also used the description expression “*same day GP services*”<sup>5</sup>. This particular poster was used in 2008 at Reading railway station, Basingstoke and in the City of London. Not surprisingly, the immediacy of the services is a recurring theme throughout the advertising.

22. Postcards and washroom posters bearing the SAMEDAYDOCTOR mark were displayed in Edinburgh in 2008. These appear to have promoted medical services provided by the Edinburgh clinic, mainly for the treatment of sexually transmitted diseases.

23. Flyers were given away at Boots stores in 2013 promoting the Wimpole Street clinic (the flyer refers to the clinic as being 5 minutes away, so this must have been distributed through local Boots stores).

24. Harley’s evidence consists of witness statements by Julius Stobbs and Harriet Berridge. Both are trade mark attorneys at Stobbs, which represents Harley in these proceedings.

25. Mr Stobbs’ evidence includes print-outs of current and historical web pages showing use of:

- i) “*Same Day Doctor (GP)*” and “*Same Day Doctor appointments*” in 2013 by a third party walk-in clinic in Harley Street;
- ii) “*Private Same Day Doctors*” on the UK website of Blossom’s Healthcare in 2015;
- iii) “*Same Day Doctor Medical Services*” on the UK website of 24 Hour Zahash Doctors in 2015;
- iv) “*Same Day Private GP*” on the UK website of HealthScreenPlus in 2013;
- v) “*Sameday (Walk-in) GP*” on the UK targeted website of IPSA, another private medical service provider, in 2015.

26. Ms Berridge’s evidence shows that total expenditure on private healthcare was £25.1 billion in 2013. Total expenditure on all healthcare in the UK amounted to £150 billion.

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<sup>4</sup> See the 6<sup>th</sup> and 7<sup>th</sup> pages of LG-3

<sup>5</sup> See the 14<sup>th</sup> page of LG-3

## The Hearings

24. The matter was scheduled to be heard on 2<sup>nd</sup> October 2015. However, it became clear shortly before the hearing that SDD intended to rely on the evidence provided to the examiner prior to the publication of application 3029193, despite not having served that evidence on Harley in these proceedings. The Hearing Officer allocated for this hearing agreed that SDD should be allowed to rely on this evidence, subject to 1) it being served on Harley, and 2) SDD bearing the cost of the adjournment of the hearing.

25. Consequently, the substance of the matter came before me at a re-convened hearing on 20<sup>th</sup> November 2015. SDD was represented by Ms Paula Flutter of EIP Europe LLP. Harley was represented by Mr Julius Stobbs.

## The law

26. Section 3(1) of the Act is as follows:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

27. Section 47(1) of the Act states that:

“47 (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

28. The relevant date for establishing the presence or absence of distinctive character of the trade marks covered by application 3029193 is the date of the application, i.e. 4<sup>th</sup> November 2013 (“the second relevant date”).

29. The relevant date for establishing the presence or absence of distinctive character of the trade mark covered by registration 2431417 is the date of the application for registration, i.e. 1<sup>st</sup> September 2006 (“the first relevant date”). However, in accordance with the proviso to section 47(1), the registration shall be saved if it has been shown that the mark had acquired a distinctive character by the date of the application for invalidation, i.e. 2<sup>nd</sup> December 2014 (“the third relevant date”).

30. The burden of proving that the composite mark registered under 2431417 does not meet the *prima facie* requirements of section 3(1) rests on Harley<sup>6</sup>.

31. There is no burden of proof as regards the question of whether the marks covered by application 3029193 meet the *prima facie* requirements for registration.

32. However, the burden of proving that the registered mark, and/or the marks covered by application 3029193, had acquired a distinctive character through use by the relevant dates rests on SDD<sup>7</sup>.

Does the mark SAMEDAYDOCTOR meet the *prima facie* requirements for registration?

33. The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) like this:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal*

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<sup>6</sup> See s.72 of the Act.

<sup>7</sup> See *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (Joined cases C-217 and 218/13) and *Dualit Ltd's Trade Mark* [1999] RPC 890

*Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).”

And

“50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis



of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

34. SDD accepts that ‘same day’ is descriptive of the services at issue. There can be no doubt that ‘doctor’ is also descriptive of a characteristic of medical services. SDD’s argument is that the mark consists of an unusual juxtaposition of these terms. This is said to be because ‘same day’ would usually be connected with a service, such as ‘delivery’, rather than the name of a person, such as ‘doctor’. Therefore the mark is distinctive in a similar way that the mark BABY-DRY was found by the CJEU to be distinctive for children’s nappies<sup>8</sup>. Ms Flutter submitted that the evidence showed little or no descriptive use of SAME DAY DOCTOR by third parties, at least prior to the relevant dates.

35. Harley says that the relevant average consumer would have no difficulty understanding SAMEDAYDOCTOR to describe the time of rendering of medical services. According to Harley, the mark is a very obvious contraction of ‘same day doctor’s appointment’. In this connection, Mr Stobbs reminded me of the decision of Mr Simon Thorley QC as the Appointed Person in *August Storck’s Application*<sup>9</sup>. The Appointed Person upheld the registrar’s decision to refuse to register WHERE ALL YOUR FAVOURITES COME TOGETHER as a trade mark for confectionery on the grounds that it was an obvious shortening of ‘This is where all your favourites come together in one box’. Mr Thorley agreed<sup>8</sup> that consumers would treat these terms as equivalent to one another. Consequently, the mark was excluded from registration by sections 3(1)(b) and (c) of the Act.

36. Ms Flutter accepted that the words ‘same day doctor’s appointment’ would be caught by section 3(1)(c) of the Act. Consequently, SDD’s argument depends in part on the distinction between the words making up the mark and the longer and undoubtedly descriptive expression ‘same day doctor’s appointment’. In *Baby-Dry* the CJEU stated that:

“39 The signs and indications referred to in Article 7(1)(c) of Regulation No. 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in

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<sup>8</sup> See Case C-383/99

<sup>9</sup> BL O/573/01

a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40 As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

37. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*<sup>10</sup> (Postkantoor) the CJEU considered a similar question as to whether a new word made up of elements each of which is descriptive of a characteristic of the goods/services is to be regarded as distinctive or non-distinctive. The court’s judgment stated that:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark”.

38. By comparing paragraph 40 of the judgment in *Baby-Dry* with paragraph 99 of the court’s later judgment in *Postkantoor*, it can be seen that the court adjusted the required difference between a descriptive term and a distinctive trade mark composed of individually descriptive elements, from “*any perceptible difference*” between the two signs, to a trade mark which creates “*an impression which is sufficiently far removed from that produced by the simple combination of those [descriptive] elements*”. The court has repeated that formulation of words in subsequent cases<sup>11</sup> and it must now be taken as settled law. Therefore the relevant questions are:

1) Is SAME DAY DOCTOR a syntactically unusual way of describing medical services provided by a doctor on the day they are requested?

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<sup>10</sup> Case C-363/99

<sup>11</sup> See, for example, *Campina Melkunie*, Case 265/00P

2) If it is not, is the difference between SAME DAY DOCTOR and SAME DAY DOCTOR'S APPOINTMENT enough for the former to create an impression on relevant consumers of the services which is sufficiently far removed from that produced by the descriptive term SAME DAY DOCTOR'S APPOINTMENT so that the words SAME DAY DOCTOR would be seen by them as distinctive and not descriptive?

39. The evidence shows a small level of use of 'Same Day Doctor' or 'Same Day GP' by third parties, mostly after the relevant dates. However, the case law indicates that it is not necessary for the words to have been used descriptively: it is sufficient that they are capable of being so used. The evidence showing that SDD has itself made some descriptive use of the words 'Same Day Doctor', and also the analogous term 'Same Day GP services'<sup>12</sup>, tends to suggest that the words at issue are capable of being used as a description of the time of rendering of medical services. Further, the application of section 3(1)(c) does not depend on whether there are more usual ways of designating the characteristic of the services in question. Therefore the limited evidence of actual descriptive use of the words at issue is not decisive.

40. Although a scholar of English might wince at the use of the phrase SAME DAY DOCTOR, I have no doubt that average consumers of medical services would immediately understand those words to describe the time of rendering of medical services in much the same way that 'headache tablets' would be understood as meaning 'headache relieving tablets'. Further, if such consumers thought about the meaning of the words any further, they would immediately realise that they are an obvious shortening of the (more grammatically correct) term 'Same Day Doctor's Appointment'. Either way the words are descriptive and may serve, in trade, to designate the time of rendering of medical services. I therefore find that the words SAME DAY DOCTOR are *prima facie* excluded from registration under section 3(1)(c).

41. I have not lost sight of the fact that the mark under consideration is SAMEDAYDOCTOR. However, that mark is obviously composed of the words SAME DAY DOCTOR. Eliminating the spaces between the words will not change the descriptive impression it creates on consumers, or change the way that the words sound when spoken<sup>13</sup>. I find that SAMEDAYDOCTOR is *prima facie* excluded from registration under section 3(1)(c) of the Act.

42. It follows that the mark is *prima facie* devoid of any distinctive character and therefore also excluded by section 3(1)(b) of the Act.

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<sup>12</sup> See paragraph 21 above

<sup>13</sup> See also Case T-184/07, *Avon Products Inc. v OHIM*, in which the Court of First Instance upheld OHIM's refusal of the mark ANEW ALTERNATIVE dismissing the distinctive significance of the conjoined letter A and word NEW.

43. Is SDD's mark **samedaydoctor** in any different position? Ms Flutter submitted that the font added some distinctiveness. However, it does not strike as a particularly unusual font. I cannot see why it is any more distinctive than any other font. I therefore find that this mark is also caught by the exclusions in section 3(1)(b) and (c) for the same reasons as SAMEDAYDOCTOR in block capitals.

44. I find that the same applies to **samedaydoctor**. The mark SAMEDAYDOCTOR naturally divides into 'sameday' and 'doctor'. Using contrasting colours simply highlights this fact.

Did the mark **samedaydoctor**  meet the *prima facie* requirements for registration at the first relevant date?

45. There is no evidence that 'Same Day Doctor' was in descriptive use in 2006. However, as I pointed out earlier, that is not a necessary condition for section 3(1)(c) to apply. The common meaning of the words in question has not changed since 2006. I therefore find that the word element of the mark was, in 2006, a sign that may serve, in trade, to designate the time of rendering of medical services.

46. The registered mark also includes the letters 'SDD' mounted on three dimensional looking background resembling a tablet. Ms Flutter submitted that the mark as a whole was distinctive, even if the word element alone was not.

47. Mr Stobbs drew my attention to the judgment of the CJEU in joined cases C-90/11 and C-91/11. The court was asked whether a descriptive term in combination with a letter sequence corresponding with the first letter of each of the descriptive words, was caught by the relevant provisions of the Trade Mark Directive. The court responded:

"The answer to the questions referred is therefore that Article 3(1)(b) and (c) of the directive must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character."

48. On the face of it, this judgment indicates that the composite mark at issue is not registrable *prima facie*. Ms Flutter submitted that the mark at issue in this case was not on all fours with the marks considered by the CJEU because it included colour, font and figurative elements that were not present in the other marks. I agree that it

is necessary to consider the mark as a whole, although I find that the particular font used for the letters making up the descriptive words in the mark is negligible in terms of its likely impact on consumers. It can therefore be effectively discounted. Further, I have already explained why I consider that the contrasting colours used for the words 'sameday' and 'doctor' do nothing to undermine or disturb the descriptive message conveyed by those words.

49. The parties agree that average consumers for medical services will pay an above average level of attention when selecting the services. However, the services covered by the trade marks include treatments for relatively minor medical problems. I therefore accept Mr Stobbs' qualification to the concession he made on the part of Harley, which is that the consumer's level of attention should not be assumed to be of the very highest level. I accept that average consumers of medical services are likely to notice that the letters SDD in the mark are mounted on a three dimensional looking background resembling a tablet. However, I do not think that this will change their impression of the letters SDD. These letters will still be recognised as an abbreviation for SAME DAY DOCTOR. The letters will therefore support the descriptive message conveyed by the words.

50. There remains the overall impact of the words, letters, the figurative background on which the letters SDD appears, and (to the extent that they individually or collectively have any distinctive impact) the font and colours used. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*<sup>14</sup>, Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

"116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place."

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<sup>14</sup> [2013] F.S.R. 29

51. A similar point arose in *Thomas Pink Ltd v Victoria's Secret UK Ltd*<sup>15</sup>, where Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink and in a unique form of script, all within a rectangular box, did not prevent the mark being *prima facie* unregistrable under s.3(1)(c). In the alternative, the mark was excluded by s.3(1)(b).

52. Similarly, I find that the visual aspects of the mark relied on in this case are insufficient to justify the conclusion that the mark consists of more than a sign which may serve, in trade, to designate the time of rendering of medical services. The composite trade mark was therefore registered at a time when it was *prima facie* excluded from registration by section 3(1)(c).

53. If I am wrong about that, then I find that the mark was excluded from *prima facie* registration by section 3(1)(b). This is because the additional elements of the mark (over and above the descriptive words and abbreviation of them in letters) are insufficient to enable the mark to perform its essential function of distinguishing the services of a particular undertaking to average consumers of medical services.

#### Acquired distinctiveness?

54. There is almost no evidence of use of the composite trade mark registered under 2431417. However, if the word element SAMEDAYDOCTOR had acquired a distinctive character through use by the second relevant date (November 2013) then it would follow that the registered mark had acquired a distinctive character by the third relevant date (in 2014). Such a finding would also mean that the marks covered by application 3029193 would also have acquired a distinctive character at the filing date of that application. In that event, the application for invalidation would have to be rejected because the proviso to section 47(1) would apply. Further, the opposition to application 3029193 would also have to be rejected because the proviso to section 3(1) would apply. Consequently, there is no point in considering whether the registered mark had acquired a distinctive character through use prior to the first relevant date. And it is only necessary to consider whether the registered mark had acquired a distinctive character at the third relevant date in 2014 if it had not done so by the second relevant date in 2013. I will therefore start by considering whether any of the marks had acquired a distinctive character through use by the second relevant date (November 2013).

55. The CJEU provided guidance in *Windsurfing Chiemsee*<sup>16</sup> about the correct approach to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

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<sup>15</sup> [2014] EWHC 2631 (Ch)

<sup>16</sup> Joined cases C-108 & C-109/97

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

56. SDD’s evidence shows use of SAMEDAYDOCTOR as a trade mark, as well as some other uses<sup>17</sup> which are descriptive, or are ambiguous in nature. For example, the use of the domain name ‘samedaydoctor.co.uk’ will not necessarily be taken by consumers as being trade mark use because domain names are frequently composed of descriptive terms. Further, the use of other marketing lines in SDD’s promotional materials emphasising the immediacy of the availability of its services may have blurred the distinctive impact of the words SAMEDAYDOCTOR in some of this material.

57. On the other hand, the SDD has not used the mark alongside another obviously distinctive name and it is therefore more likely to be taken as its trade mark. For example, the use of the word mark outside SDD’s clinics, and on internal signage in its clinics, appears to be the sort of uses one would normally associate with trade marks.

58. The length of the use of the mark is reasonable, but up until 2007 it appears to have been focused on just one clinic in London. SDD’s turnover under the mark appears significant, but placed in the context of the market for medical services it represents only a tiny share of the market, even if the market is limited to private

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<sup>17</sup> See paragraph 21 above

medical services. Similarly, the amount invested in promoting the trade mark is relatively modest in the context of the huge market for medical services.

59. SDD's clinics are geographically concentrated mainly in Greater London, Manchester and Edinburgh. Looked at like this the geographical spread of the use in the UK is also somewhat limited. In this connection, Mr Stobbs reminded me that in *Bovemij Verzekeringen NV v Benelux-Merkenbureau*<sup>18</sup>, the CJEU held that:

“..... Article 3(3) of the Directive must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal.”

60. SDD's answer to this criticism is threefold. Firstly, that the Google adwords advertising it undertakes would have brought its mark to the attention of potential customers throughout the UK. Secondly, that it also promotes its mark in places, such as on posters in central London and Reading railway station, that will be seen the travelling public. Thirdly, that it advertises in national publications, such as *The Lawyer* and *Cosmopolitan*.

61. As to the first point, it is true that the evidence shows that internet users in many (but by no means all) places in the UK have clicked-through to SDD's website after seeing advertisements in internet search results prompted by adwords. However, without knowing what adwords were being used it is difficult to decide what weight to give to this evidence. For example, if the searcher was searching on a generic term, such as 'walk-in clinic' the number of people reportedly clicking through to SDD's website is unlikely to bear any relation to the number of consumers who were actually looking for SDD's clinics. Further, without seeing the paid-for internet advertisements that prompted searchers to click through to the SDD website, it is not possible to know what proportion of them had the SAMEDAYDOCTOR mark in sight when they did so. Further still, those that had the mark in sight at this point may have clicked through in error, or quickly found that the website was of little use to them because of their location in relation to SDD's clinics. Consumers in this position would only have had the most fleeting of exposures to SDD's mark.

62. As to the second point, I accept that posters in central London and on Reading railway station would have been looked upon by thousands of people from all over the UK, but only those in the vicinity of SDD's clinics are likely to have had sufficient interest in them to retain a recollection of the trade mark. After all, the whole point of SDD's clinics is that they are walk-in clinics providing relatively routine medical treatments in a way that is convenient for busy consumers. They are not the sort of

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<sup>18</sup> Case C-108/05



specialist medical clinics that the public will travel any distance to visit. Therefore although the promotion of the mark via Google adwords, and on posters in busy places in South East England is, in one sense, national advertising, its main practical effect would have been to drive local business to its local clinics.

63. As to the third point, I am not inclined to attach much weight to this without evidence as to the timing, regularity of any national advertising in publications such as *Cosmopolitan*, or any examples showing how the mark was so used. Certainly, the amount spent on non-internet advertising does not suggest that national non-internet advertising has been conducted on any significant scale.

64. I do not therefore accept that SDD has established that a significant proportion of the relevant UK public for medical services (or private medical services) identified the services as originating from a particular undertaking at the second relevant date because of the use of the trade mark *SAMEDAYDOCTOR*. Further, to the extent that the CJEU's judgment in *Bovemij* additionally requires the mark to have acquired a distinctive character throughout the UK, I find that this requirement has not been satisfied in this case.

65. In principle, the position may have been different at the third relevant date. However, as this was only a year or so later and the nature and scale of SDD's use of the word mark had not changed significantly in this period, I find that the word mark still lacked the necessary distinctive character at the third relevant date.

66. There is evidence of use of the word mark in the font and colours shown in the registered mark and also the second and third marks in application 3029193. However, I do not understand SDD to rely on these features to show that these marks have acquired a distinctive character in these particular forms. In any event, there is no evidence that the marks have become distinctive because of these features. Therefore, for the same reasons I gave when considering the impact of these features on the *prima facie* case for registration, I find that they have not.

## **Outcome**

67. The opposition and the application for invalidation succeed. Subject to appeal, application 3029193 will be refused and registration 2431417 will be invalidated.

## **Costs**

68. Harley has been successful and is entitled to a contribution towards its costs. In addition to normal scale costs, Harley asks for compensatory costs for the first adjourned hearing on 2<sup>nd</sup> October. This is because it was SDD's very late application to rely on evidence that it had not served on Harley which led to the adjournment.

The wasted costs of that hearing date are put like this:

- 1) Research relating to the merits of the invalidity claim - £250
- 2) Preparing and submitting a skeleton argument - £750
- 3) Receiving and reviewing the other side's skeleton - £350
- 4) Receiving and reviewing the other side's evidence - £500
- 5) Preparation for the hearing - £500
- 6) Attendance at the hearing - £650

This comes to a total of £3000 plus VAT.

69. SDD responded to this request on 27<sup>th</sup> October. Essentially, SDD says that costs should be assessed on the normal scale, except for cost item 6 above and a small proportion of cost item 5. It accepts that costs should be awarded for these items on a compensatory (but not indemnity) basis. SDD points out that much of the work for the adjourned hearing covered by cost items 1-4, would also have served for the reconvened hearing. Therefore these were not wasted costs.

70. I accept SDD's argument as regards cost item 1. It is not clear to me why any research that was done would have had to be repeated for the reconvened hearing. I also accept SDD's argument as regards cost item 4. Costs for reviewing evidence are included in scale costs, irrespective of when it is filed. As regards cost items 2 and 3, I accept that some of the work that went in to preparing Harley's skeleton argument for the adjourned hearing would have served for the reconvened hearing. However, as the issues had widened by then to cover SDD's evidence that its marks had acquired distinctive characters through use, it was inevitable that Harley's skeleton would have to be re-written. For the same reason, Harley would have had to review SDD's skeleton again, although it does not appear to have changed all that much. I will therefore award Harley 50% of the cost of preparing the original skeleton and reviewing SDD's original skeleton, i.e. £550.

71. Some of Harley's preparation for the adjourned hearing will have had to be repeated for the reconvened hearing. I will therefore award Harley 50% of cost item 5, i.e. £250.

72. There is no dispute that Harley is entitled to all of cost item 6, i.e. £650.

73. I will therefore award Harley £1450 to compensate it for the wasted costs caused by the adjournment of the October hearing.

74. In terms of scale costs, Harley is entitled to:

£400 in official fees for filing a notice of opposition and an application for invalidation;

£200 for drawing up those documents;  
£1200 for reviewing Harley's evidence and filing evidence of its own;  
£ 500 for attending the reconvened hearing.

75. In deciding the appropriate sum of costs to award for the reconvened hearing, I have taken into account that Harley filed a very full 'skeleton' argument. The hearing should therefore have taken less time than it actually did. It is not appropriate to duplicate the costs awarded to Harley for unnecessary duplication of effort.

76. I order Samedaydoctor (London) Limited to pay Harley Doctor Limited the sum of £3750 towards the cost of these proceedings. This should be paid within 14 days of the expiry of the appeal period, or if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 7th day of December 2015**

**Allan James  
For the Registrar**