

**O-245-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF CONSOLIDATED PROCEEDINGS  
FOR CANCELLATION UNDER NOS 500828, 500829 AND 500830  
BY MY HEALTHCARE CLINIC LTD**

**OF REGISTRATION NO 2435997  
IN THE NAME OF INTEGRATED DENTAL HOLDINGS LIMITED**

**AND REGISTRATION NOS 2447125 AND 2425800  
IN THE NAME OF IDH LIMITED**

## Background

1. This decision concerns three registrations:

- i) Registration no 2435997 which was filed on 19 October 2006, was published on 16 November 2007 and completed its registration procedures on 22 February 2008. The registration stands in the name of Integrated Dental Holdings Limited. It is registered for the following mark:



in respect of "Private dentistry"

- ii) Registration no 2447125 which was filed on 19 February 2007, was published on 18 April 2008 and completed its registration procedures on 25 July 2008. The registration stood in the name of IDH Limited and was registered for the following mark:

MyGP

in respect of "Medical services; advisory and consultancy services relating thereto"

The registration was recorded as surrendered by the registered proprietor on 24 August 2015. I shall return to this shortly.

- iii) Registration no 2425800 which was filed on 29 June 2006, was published on 1 September 2006 and completed its registration procedures on 15 December 2006. The registration stands in the name of IDH Limited and is registered for the following mark:

MyDentists

in respect of the following goods and services:

Class 16

Printed matter; magazines and publications relating to dental matters.

Class 35

Advertising and publicity services; all included in Class 35, provision of advertising information and how to advertise relating to dental matters; conducting surveys; conducting of public opinion polls.

Class 38

Telecommunications services; telecommunication of information (including web pages), electronic mail services; provision of telecommunication access and links to computer databases and the Internet; telecommunication services providing access to financial and insurance information, services and transactions; telecommunications services relating to electronic commerce; Internet communication services; operating of chat rooms; transmission of written and digital communications; provision of news and news information via a computer network and/or the Internet; advisory and consultancy services relating to the aforesaid.

Class 41

Operation of a publishing website; electronic publishing of a magazine relating to dental matters.

Class 42

Dental care services and advice relating to dentistry and dental care services provided in personal and via the Internet.

Class 44

Internet services, namely provision of information relating to dentistry and dental care services on the Internet, the provision of information relating to the aforesaid services on-line from databases on the Internet.

2. In this decision, I will refer to both IDH Limited and/or Integrated Dental Holdings Limited as “the registered proprietor” unless the context requires otherwise.

3. Applications for the cancellation of each registration were filed by My Healthcare Clinic Ltd (“the applicant”). Cancellation is sought in each case under the provisions of sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”) on the grounds that the marks have not been put to genuine use within the relevant periods and there are no proper reasons for that non-use. Under section 46(1)(a), revocation is sought from 23 February 2013 (2435997), 26 July 2013 (2447125) and 16 December 2011 (2425800). Under section 46(1)(b) revocation of each of the registrations is sought from 20 April 2015. As noted above, registration no 2447125 has been recorded as surrendered, however, as the dates of revocation sought pre-date the date of surrender and the applicant has indicated that it does not withdraw it, the cancellation action remains to be determined. The applicant has also indicated that it notified the registered proprietor of its intention to seek cancellation of each of the registrations on 21 January 2015.

4. The registered proprietor filed identically worded counterstatements denying the grounds of revocation. These state:

“The Proprietor denies the claim made by the Applicant that there is no relevant use of the registered trade mark for the registered services within the relevant time frames. It is submitted and will be supported with evidence that prior to the three months before the application for cancellation was filed, the

proprietor had made extensive preparations to re-introduce the use of the Mark within the provisions of section 46(3) of the Act.

The Proprietor denies the claim made by the Applicant that there are no proper reasons for non-use of the relevant trade mark”.

5. All three matters were consolidated. The registered proprietor filed evidence in the form of witness statements from Dr Marcel Fung, who states he is the Principal Dentist at the MYDENTIST dental practices, and from Ms Annette Spindler, Chief Operating Officer of Turnstone Equityco 1 Limited, a holding company for a group of companies (“the Group”) which includes both of the registered proprietors in these proceedings. I will refer to this evidence as appropriate later in this decision. The applicant did not file evidence but did file submissions which, again, I will refer to as appropriate. The matter came before me for a hearing on 16 March 2016 when the registered proprietor was represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP. The applicant was represented by Mr Yoann Fouquet of Venner Shipley LLP.

## **Decision**

6. The relevant provisions of section 46 of the Act state:

“**46** (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)...

(d)...

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or

resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(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.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

7. Section 100 is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

8. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services

from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### **Registration No 2447125**

9. Despite the registered proprietor, in its counterstatement, denying the claim that there was no use made of the mark and further claiming that extensive preparations had been made to “re-introduce the use of the Mark” neither Dr Fung nor Ms Spindler give any evidence relating to the use, preparations for the use or proper reasons for the non-use of surrendered registration no 2447125. That being so, and

as Mr Fiddes accepted at the hearing, the application for cancellation of the registration succeeds under section 46(1)(a) of the Act.

### **Registration Nos 2425800 and 2435997**

10. Registration no 2425800 is registered for a wide range of goods and services but the registered proprietor makes reference only to dental services. I bear this in mind. In its counterstatements it claims to have made preparations to “re-introduce” the use of these marks, which implies it is claiming that the marks have been used previously. Mr Fiddes submitted that the evidence shows the marks have been used. His first submission was that the registered proprietor takes benefit of the use made by Dr Fung from 2004 by virtue of an assignment between Dr Fung and the registered proprietor.

11. In her witness statement, Ms Spindler refers to Dr Fung's business and an assignment of “the unregistered rights, the goodwill and the right to sue for past infringements in relation to the trading style MYDENTIST for dental services and the associated domain [www.mydentistuk.com](http://www.mydentistuk.com)” as previously owned by him. She exhibits a redacted copy of the assignment document at AS12. The document, dated 24 August 2015, refers to the domain name and the “trading name MYDENTIST together with other indications of origin” collectively entitled “the Brand”, but does not specify what these other “indications of origin” might be nor does the document refer to any specific trade marks which may have been the subject of the assignment.

12. In his witness statement, Dr Fung also refers to what he calls his unregistered rights. He provides evidence, at MF1, in the form of a copy of a letter dated 30 September 2004 which shows the General Dental Council had no objection to his proposed business name “My Dentist”. Within the same exhibit is a letter dated 15 February 2006 from Wandsworth Teaching Primary Care Trust addressed to him at “Mydentist” and which refers to a proposed contract for dental services.

13. Dr Fung states that he opened his first practice, in Earlsfield, in 2004 and a second, in Wandsworth in 2011 and that between them he treats (presumably at the date of his witness statement, 22 September 2015) over 7000 patients. At MF3, he exhibits a “whois” document showing registration details of the website mentioned in paragraph 11 above. It shows it not be registered to Dr Fung at either of his practice addresses but to someone called Nigel Reece at an address in Poole in Dorset. No explanation is provided to explain this apparent discrepancy. The screenshot said to be taken from the website, which is exhibited at MF2, provides the facility to enter the websites of the separate Earlsfield and Wandsworth Town practices which are said to be operated by Dr Fung. The page does not show either of the marks as registered. There is an indication on the page showing it was last updated in August 2015 (after the relevant periods) but no indication of what it may have shown at any period before the assignment took place.

14. None of the documents provided by either Dr Fung or Ms Spindler assist in determining what unregistered trade mark rights Mr Fung may have had nor what trade mark rights may have been the subject of the assignment and I do not consider this material assists the registered proprietor in defending its registrations.

15. Mr Fiddes did not direct me to any specific evidence which shows use of the marks as registered, nor have I been able to identify any such evidence. In its counterstatement, however, the registered proprietor indicated that it relied on the provisions of section 46(3) of the Act, set out above and, in respect of that claimed use, Mr Fiddes submitted that what use had been made was use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. I go on to consider the evidence filed in more detail.

16. In her witness statement, Ms Spindler states that the Group is Europe's largest dental chain with a network of over 650 dental practices throughout the UK serving over 10 million patients and gives details of the Group's turnover for 2013 and 2014. She gives no specific details of either Integrated Dental Holdings Limited's or IDH Limited's individual businesses or their use of any specific trade marks.

17. Ms Spindler states that another of the companies within the Group is MyDentist Limited. This company was the original registered proprietor of registration 2435997 and was incorporated in May 2006. She states the company was "originally intended to be a vehicle for use of the original MYDENTIST brands" though does not say what, specifically, these "original" brands might have been and adds that this company "has been dormant for some time". She does not provide any evidence to show this company made any use of, or made preparations to use, any particular marks.

18. Ms Spindler refers to the "preparation for the relaunch of MYDENTIST" and states that given "the scale of the Group's activities and the importance of a complete rebranding of our business there were months of preparation work within the company in addition to using outside consultants, before a final decision was made on the form of the MYDENTIST rebrand. At AS9, she exhibits a copy of a document which, she states, was produced by "an Independent Creative Marketing Consultancy, Caramba, in May 2014" and which "represents the culmination of the design development stage for the recommencement of the MYDENTIST brand, work on which first started in April 2014". On the first page of the document are the words: "IDH Re-brand". Many of the pages show "POS RE-BRAND" at the bottom of the page and also have "Caramba" on them. Having set out the 'Current Logo' which comprises the letters IDH and words Integrated Dental Holdings with what I shall describe as a multi-coloured swoosh-type device and giving details of "Current Campaigns" and "Current Clinic Information", it goes on, at page 5, to refer to the "idh rebrand". The graphic prominently shows a pair of teal-coloured curly brackets superimposed over the picture on the page.

19. The "new logo" is shown on page 7. It appears in this form (which includes the colours teal and grey):



I will refer to this as the **{my} dentist** mark. The subsequent pages set out some brand guidelines along with examples of posters and leaflets. At page 13 are shown posters on which the **{my} dentist** mark can be seen. The posters also refer to



various teeth whitening services which are listed within the same brackets device. At page 52, other posters are shown. They are identical to those shown at page 13 except that the word and brackets **{my} dentist** is replaced with **{idh} dental** (with the words 'helping the nation smile' appearing under the word 'dental'). I will refer to this as the **{idh} dental** mark.

20. Page 32 refers to a "Brand overview..." and the subsequent pages (pages 33 to 59) also show the **{idh} dental** mark. Page 48 shows what is said to be a "family generic wall graphic" where two adults and a child appear within the brackets device. Pages 84 and 85 contain photographs of buildings with signs or flags bearing the **{idh} dental** mark.

21. Also within AS9 is a copy of an invoice from Caramba Marketing Limited in relation to what it refers to as "IDH Brand Development". The invoice is dated 1 July 2014 and lists various items of work done including: "logo options, with in-situ visuals" and "Example applications of the brand within IDH practices".

22. At AS4, Ms Spindler exhibits "a document produced by the Group entitled "Brand Update"" which she states was issued to the rest of the Group in November 2014, though I note the document refers to the "proposed" rebrand of the Group's support centre in October. Several of the pages within the exhibit are duplicated. Ms Spindler states that the document shows that on 17 October 2014, there was an "Operational Conference to launch the brand to the operations side of the business". Certainly, one of the pages does have "Operational Conference" as a heading and shows this date. The document also gives examples of the proposed rebranding some of which show the **{my} dentist** mark whilst others show the **{idh} dental** mark. On other pages, there is similarly stylised use of the brackets device e.g. **{thank} you** (see page 74).

23. Ms Spindler draws attention to a copy of the Group's Annual Review and Report for 2013/2014, which she has exhibited at AS2 and in particular, to page 8. The text on this page includes the following:

"Finally, I am sure you will all have noticed the change in this year's Annual Review. I am proud to introduce our new brand, mydentist. Over the next few months we plan to roll this out across our estate, changing the look and feel of all our practices. We believe the renewed focus on practices and on who we are and what we believe in is an important next step in the development of our business. {My}Dentist will put the patient at the heart of everything we do."

Underneath this text appears the **{my} dentist** mark. Ms Spindler states that this document was issued to the public on 11 December 2014 though she gives no indication of where or how many copies were distributed or to whom, specifically, they may have been issued.

24. At AS6, Ms Spindler exhibits what she refers to as "a further document issued by the Group". Again, she does not say to whom it was issued but it is entitled "Welcome to our new brand Launched November 2014". The document, which contains a limited amount of text, shows interior and exterior shots of buildings which show the **{my} dentist** mark although there are some in which only the **{my}**

element can be seen (see page 18). Again, there is also use of the brackets device with other matter i.e. various teeth straightening options are listed and presented within brackets (see page 7).

25. At AS7 is exhibited a document entitled “Brand Roll out” which Ms Spindler states was issued by the Group in November 2014 and shows the “plan for the roll out and [includes] examples of the new branding in a number of locations”. The document appears to be a PowerPoint presentation. The content of some of this document is a duplicate of that included within AS6 and most pages show the **{my} dentist** mark though on page 3 is a picture of a door above which is shown **{idh}**.

26. At AS8, Ms Spindler exhibits a copy of a Style Guide which she states was issued by the group in March 2015. Again, some of the material has been included within other exhibits. She states the guide details the way the brand is to be used throughout the Group together with various examples of changes which were made to the first pilot practices which were rebranded in November and December 2014. From page 31 of the exhibit are guidelines for the brand (presented as “{brand} guidelines”). The **{my} dentist** mark appears throughout the document. The use of the bracket with other words are also shown e.g. again, various teeth straightening options are listed and presented in the bracket device (see page 14) along with {what is the purpose of this brand book} (see page 32) and {Air Polish/Safe Whitening} (see pages 43 and 53).

27. Ms Spindler states that since October 2014, the Group has been “rolling out the rebrand across all of our practices which the Group operates across the United Kingdom”. At AS10 she exhibits a list of practices along with what I take to be the various stages of the rebrand.

28. At AS11 Ms Spindler exhibits “extracts from investor presentations and reports”. The exhibit consists of 8 pages. The first two comprise a presentation to investors given on 29 May 2015, by Integrated Dental Holdings. The second two are entitled IDH Finance plc and show an annual report for the year ending 31 March 2015. The third two comprise a presentation to investors given on 4 August 2015 by Integrated Dental Holdings. The final two are an IDH Finance plc quarterly financial report for the 3 months ending 30 June 2015. All of these documents show the **{idh} dental** mark.

29. Mr Fouquet submitted that what evidence has been filed, are documents prepared by a marketing company showing options for rebranding. Contrary to Mr Fiddes’ interpretation, Mr Fouquet submitted that he was not suggesting the evidence had been falsified, but instead, was pointing out that some, at least, of the photographs within the documents were not true photographs but, instead, were mock-ups as they are “pictures created by the marketing agency [which was] hired to present a visual proposal showing how the IDH brand would be applied”. Mr Fiddes did not dispute this. Much of the documentation Ms Spindler has exhibited, is created from material supplied by the company employed to design proposals for the new branding or are internal documents which appear to be for use in presentations to staff. Both the **{my} dentist** and the **{idh} dental** marks appear in the documentation, although only the former appears in the Annual Review at AS2.

30. At the hearing, Mr Fiddes submitted that the rebranding has revolved around the **{my} dentist** mark. He submitted that the evidence filed is sufficient to show that preparations to use this mark have been made. For his part, Mr Fouquet accepted that the evidence provided showed this mark was included within documentation provided by a design company but submitted that all of this was internal documentation and did not show genuine use as is required when relying on a defence of a registration under section 46(3) of the Act.

31. I have set out above a summary of the evidence filed by the registered proprietor. There is no evidence in the form of e.g. turnover or marketing under the **{my} dentist** mark. The list of dental practices provided at AS10 shows that none of them have all of the rebranding stages marked as complete. Five of those listed show the “main contractor” stage to be complete on site but there is no evidence as to what this means and none of the practices are listed as having reached the stage of completion of external signage. There is no evidence to show how, specifically, any particular practice has been rebranded. Whilst there is some evidence of the **{my} dentist** mark being included in various documentation, the vast majority of it is clearly for internal use, whether as part of a presentation given by the design company commissioned to provide branding options or as material for use in providing information to employees once the new branding had been agreed. The Annual Review and Report exhibited at AS2 is said to have been made available to the public but, as set out above, there is no evidence of where this was published and who, outside the business, may have seen it.

32. In short, I do not consider the registered proprietor has shown that it has made genuine use of the **{my} dentist** mark it relies upon in any of the relevant periods. The period under section 46(1) ends of 19 April 2015. Clearly, preparations have been made to trade under the mark relied upon (from the end of 2014) but there is no objective evidence of actual use for the purpose of creating an outlet for the services. Whilst, in some cases, the advertising of a service for something which is about to be marketed may assist, there is no objective evidence that this has occurred. Reference has been made to section 46(3) of the Act, however, this is not applicable as it would only be operative if use had commenced before the filing of the application for revocation on 20 April, thus the proprietor is in no better position. The reference to preparations for the commencement of use in section 46(3) is not a self-standing defence. It is only a safeguard to allow a proprietor’s use not to be disregarded but then only if use has commenced or resumed before the application date of revocation.

33. In case I am found to be wrong in my finding that no use has been made of the mark relied upon, I go on to consider Mr Fiddes’s further submission that the **{my} dentist** mark is in a form which differs in elements which do not alter the distinctive character of the mark in the form in which it was registered. In *Bud/Budweiser Budbrau* [2003] RPC 25, Lord Walker of Gestingthorpe stated:

“43...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? –registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgment of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

34. Also of relevance are the comments of Sir Martin Nourse who stated, at paragraph 12:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements..."



35. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person undertook a thorough analysis of the relevant case law, including judgments of the CJEU and the General Court. He then put forward the following questions which assist in determining whether a variant form of use represents an acceptable variant. He stated:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period..."

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive

character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

36. For ease of reference, the respective marks are as follows:

Mark relied upon	Marks as registered
	2435997 
	2425800 MyDentists

37. Mr Fiddes referred to the fact that Integrated Dental Holdings Ltd has applied for, and gained registration of, a series of two marks: MY DENTIST and MYDENTIST on a prima facie basis and without having to file evidence of acquired distinctiveness. As per *Formula One Licensing BV v OHIM, Global Sports Media Ltd* the fact that a mark is registered means that it must be considered to have at least some degree of distinctive character, however, I do not consider the registration referred to by Mr Fiddes assists the registered proprietor. I have to consider the marks as registered and this is not a case whether the registered marks are being jointly used with other matter. Registration 2425800 is for a mark made up of the two words 'My' and 'Dentists' (plural) conjoined. Both words are ordinary dictionary words and, in respect of dental services, the mark is of limited distinctive character, the distinctiveness resting in its whole. The mark of registration 2435997 is made up of the words 'My' and 'Dentist' (singular) conjoined with the tittle of the letter 'i' replaced by a flower device. The flower device will not be overlooked but the words have dominance within the mark. It is also a mark with limited distinctive character.

38. The mark relied upon by the registered proprietor is made up of a number of elements. There is the word 'my' which is presented within curly brackets alongside the word 'dentist'. Underneath the word 'dentist' are the words 'making the nation smile'. Marks weak in distinctive character are more influenced by changes to them than marks of strong distinctiveness. In my view, the inclusion and the positioning of the brackets within the mark relied upon are not a negligible element within the mark and would not be overlooked. Indeed, they are a distinctive and somewhat striking element and serve to separate the word within it from the other elements of the mark. The fact that, as shown in the evidence, the registered proprietor has employed the same bracket device with other words and in other contexts, simply highlights the distinctiveness this element has in its own right and supports my view that even if the registered proprietor had shown genuine use of this mark, the inclusion of the brackets would lead me to find that the differences identified alter the distinctive character of the marks as registered.

39. Taking all matters into account, the registered proprietor has failed to show that it has made genuine use of either of the marks as registered and failed to show that it has made preparations to use those marks. It has also failed in its alternative claim founded on section 46(2) of the Act that there has been use of a mark in a form differing in elements which do not alter their distinctive character. For completeness,

I should also state that despite the registered proprietor denying, in its counterstatements, the applicant's claim that there are no proper reasons for the non-use of the marks as registered, it made no submissions and filed no evidence in this regard and I dismiss any such defence.

## Summary

40. The application to cancel all three of the registrations succeeds in full. They will be revoked as follows:

Registration No 2447125 will be revoked in its entirety with effect from 26 July 2013;

Registration No 2425800 will be revoked in its entirety with effect from 16 December 2011;

Registration No 2435997 will be revoked in its entirety with effect from 23 February 2013.

## Costs

41. The applicant, having succeeded, is entitled to an award of costs in its favour. Whilst three separate applications and defences were filed, they were essentially identical and not lengthy and the proceedings were consolidated at an early stage. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Fees: (3 x £200)	£600
Preparing written submissions and considering the other side's evidence:	£600
Preparation for and attending the hearing:	£600
<b>Total:</b>	<b>£2100</b>

42. I order IDH Limited and Integrated Dental Holdings Limited, being jointly and severally liable, to pay to My Healthcare Clinic Limited the sum of **£2100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of May 2016**

**Ann Corbett  
For the Registrar  
The Comptroller-General**