

O/046/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO. 3253269
FOR THE TRADE MARK:**

DIGITAL SURGERY

IN THE NAME OF DIGITAL SURGERY LIMITED

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 502835 BY RAVEN TOR LTD**

BACKGROUND AND PLEADINGS

1. Digital Surgery Limited (“the proprietor”) applied to register the trade mark **DIGITAL SURGERY** (“the contested mark”) in the UK on 29 August 2017. The contested mark was registered on 24 November 2017 in respect of the following goods and services:

Class 9: Software; application software; software applications (apps) delivered online or as downloadable applications; educational software and/or software applications (apps); software and/or software applications (apps) for medical and/or surgical teaching and training; software and/or software applications (apps) for medical and/or surgical applications; medical and/or surgical simulation software and/or software applications (apps); teaching apparatus and instruments; medical simulators (teaching aids); surgical simulators (teaching aids); electronic publications; electronic publications relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; audio, visual, audio-visual and/or video recordings; audio, visual, audio-visual and/or video recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; data carriers, discs, CD-ROMs, DVDs, laser discs, mini discs, tapes and/or other data storage media, all for recordal, storage and/or transmission of audio, visual and/or audio-visual data.

Class 41: Education services; teaching services; training services; education, teaching and/or training services provided online, via a downloadable software application (app) and/or via the Internet; education, teaching and/or training services relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; educational and/or academic research; educational and/or academic research relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; providing, arranging, organising and/or conducting courses, lectures, seminars, working groups, research groups and/or workshops; providing, arranging, organising and/or conducting courses,

lectures, seminars, working groups, research groups and/or workshops relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; provision of educational exams and/or tests; provision of educational exams and/or tests relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; arranging, organising and/or conducting conventions, congresses, conferences and/or exhibitions; arranging, organising and/or conducting conventions, congresses, conferences and/or exhibitions relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; news reporting services; news reporting services relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; provision of electronic publications; provision of electronic publications relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; publishing services; publication of printed matter, educational materials, teaching materials, training materials, texts, books, magazines, newspapers, journals, manuals, handbooks, periodicals, newsletters, calendars, programmes, leaflets, pamphlets and/or brochures; publication of printed matter, educational materials, teaching materials, training materials, texts, books, magazines, newspapers, journals, manuals, handbooks, periodicals, newsletters, calendars, programmes, leaflets, pamphlets and/or brochures relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; production of video and/or audio recordings; production of video and/or audio recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; production of video and/or audio recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; live action production; animation services; production and presentation of television

programmes, films, videos, DVDs, digital media (excluding digital radio) and media products; production and presentation of television, cable and satellite programmes; production, presentation, distribution, syndication, networking and rental of television, cable and satellite programmes and of films, sound recordings (excluding recordings of radio programmes), video recordings and DVDs; publishing; audio and video recording services; organisation, production and presentation of events, lectures, seminars, debates, conferences and meetings for educational, cultural, sporting or entertainment purposes; consultancy, advisory and information services relating to or connected with all the aforementioned services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; medical and/or surgical research; design, research, development, configuration, adaptation and/or customisation of software, application software, software applications (apps) delivered online or as downloadable applications, educational software and/or software applications (apps), software and/or software applications (apps) for medical and/or surgical teaching and training, software and/or software applications (apps) for medical and/or surgical applications, and/or medical and/or surgical simulation software and/or software applications (apps); consultancy, advisory and information services relating to or connected with software, application software, software applications (apps) delivered online or as downloadable applications, educational software and/or software applications (apps), software and/or software applications (apps) for medical and/or surgical teaching and training, software and/or software applications (apps) for medical and/or surgical applications, and/or medical and/or surgical simulation software and/or software applications (apps); technical support, maintenance and/or repair services for software, application software, software applications (apps) delivered online or as downloadable applications, educational software and/or software applications (apps), software and/or software applications (apps) for medical and/or surgical teaching and training, software and/or software applications (apps) for medical and/or surgical applications, and/or medical and/or surgical simulation software and/or

software applications (apps); consultancy, advisory and information services relating to or connected with all the aforementioned services.

2. On 4 October 2019, Raven Tor Ltd (“the applicant”) applied to have the contested mark declared invalid pursuant to section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 3(1)(b) and 3(1)(c) of the Act and is directed against all the goods and services listed above.

3. Under section 3(1)(c) of the Act, the applicant argues that the contested mark simply describes the kind and/or intended purpose of the goods and services for which it is registered. In its statement of grounds, the applicant states as follows:

“The Proprietor’s mark DIGITAL SURGERY consists of the adjective ‘DIGITAL’, meaning *“involving or relating to the use of computer technology”*, and the noun ‘SURGERY’ meaning *“the treatment of injuries or disorders of the body by incision or manipulation, especially with instruments”*. As a result, there is no doubt that the relevant public would understand the term ‘DIGITAL SURGERY’ as a meaningful expression, namely: *“the use of computer technology in relation to or in connection with the treatment of injuries or disorders of the body by incision or manipulation”*. The message conveyed by the Proprietor’s mark DIGITAL SURGERY is clear, direct and immediate to the relevant public and relates directly to the goods and services claimed in the Registration...”

4. As for the section 3(1)(b) claim, the applicant continues:

“Given that the sign has a clear descriptive meaning, it is also devoid of distinctive character, as it is incapable of performing the essential function of a trade mark, which is to distinguish the goods or services of one undertaking from those of other undertakings. Furthermore, signs that are commonly used in connection with the goods and services concerned are devoid of distinctive character. In the present case, an internet search dated 30 September 2019, has revealed that the term ‘DIGITAL SURGERY’ has been commonly used in the relevant market for a number of years.”

5. According to the applicant, the grounds of the application are also supported by prior decisions of the European Union Intellectual Property Office (“EUIPO”) and US Patent and Trade Mark Office (“USPTO”); the applicant highlights that the EU and US designations of the proprietor’s international registration – which is based upon the UK registration at issue in these proceedings – were refused by these respective bodies. Moreover, the applicant accentuates past decisions of the UKIPO and EUIPO in which other signs were found to be descriptive; the applicant considers these other signs to be similar to the contested mark.

6. The proprietor filed a counterstatement denying the grounds of the application. The proprietor also claims that, in addition to its mark possessing the requisite level of inherent distinctive character, it has acquired distinctiveness through use.

7. On 11 August 2020, the proprietor surrendered its registration in full by means of Form TM22. With effect from 24 August 2020, the proprietor’s rights in the registration lapsed with an *ex nunc* effect. The applicant was informed by the Tribunal on 2 September 2020 that, unless the application for invalidation was withdrawn, the proceedings would continue. No response was received from the applicant. On 14 October 2020, the proprietor was provided an opportunity to withdraw its defence which would, in turn, allow the proceedings to be terminated. However, no response was forthcoming. Accordingly, as neither the application nor the defence have been withdrawn, these proceedings are now subject to a final determination.

8. The proprietor is professionally represented by Taylor Wessing LLP, whereas the applicant represents itself. Only the applicant filed evidence in these proceedings, which will be summarised to the extent that is considered necessary. Both parties were given the option of an oral hearing. Neither party asked to be heard on this matter, nor did they elect to file written submissions in lieu of a hearing. The applicant did, however, file written submissions during the evidence rounds. I do not intend to summarise these but will refer to them throughout this decision, as and where appropriate. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

EVIDENCE

9. The applicant's evidence consists of a witness statement dated 25 February 2020 of Thomas Rory St. John Meadows, together with Exhibits TM1 to TM16. Mr Meadows is the Director of the applicant company, a position he has held since June 2019.

10. Mr Meadows reiterates the applicant's argument that the contested mark consists of the adjective 'DIGITAL' and the noun 'SURGERY', meaning 'involving or relating to the use of computer technology' and 'the treatment of injuries or disorders of the body by incision or manipulation, especially with instruments', respectively.¹ Mr Meadows provides excerpts obtained on 30 September 2019 from the online dictionary 'Lexico', which confirm the foregoing definitions for the two words.²

11. Mr Meadows continues by explaining that an internet search conducted on 30 September 2019 revealed descriptive uses of the term 'DIGITAL SURGERY'.³ Sample uses of the term are evidenced and consist of the following:

- An extract of a schedule for the '6th Annual Academic Congress of Chinese Society of Digital Medicine & Founding Conference of the International Society of Digital Medicine & 1st International Conference on Digital Medicine and Medical 3D Printing' which took place from 16 June – 19 June 2016 in Nanjing, China.⁴ References to 'digital orthopaedic surgery' and 'digital surgery' can be seen in the schedule of events;
- An article by 'Ampronix' dated 21 June 2016 and titled 'Virtual Reality Gains in Surgical and Diagnostic Applications'.⁵ The article discusses ways in which technology can be used to assist surgeons, physicians and other medical professionals, and contains a reference to 'digital surgery tools'. The date format and references to institutions in the US are indicative of a non-UK readership;

¹ Witness statement of Thomas Rory St. John Meadows, §6

² Exhibit TM1

³ Meadows, §9

⁴ Exhibit TM2

⁵ Exhibit TM3

- An abstract of a paper by Xing Wang, Rui Song, et al. titled 'System design for orthognathic aided robot' which was published in 2015.⁶ The abstract contains a reference to 'virtual digital surgery design' and how this can assist medical professionals. The print suggests that the paper was presented at the IEEE International Conference on Cyber Technology in Automation, Control, and Intelligent Systems which took place from 8 June – 12 June 2015 in Shenyang, China;
- An article by S. Atallah of Florida Hospital titled 'The dawn of the digital operating theatre and the rise of the digital surgeon'.⁷ The article was published on 17 June 2015 by Springer-Verlag and includes references to 'digital surgery' in the context of minimally invasive surgery;
- An article by Rensselaer Polytechnic Institute dated 13 August 2006, accessed via Science Daily on 30 September 2019.⁸ The article is titled 'Digital Surgery With Touch Feedback Could Improve Medical Training' and discusses how surgeons could be trained using technology by analogy to how pilots learn to fly using flight simulators. References in the article to US institutions are indicative of a non-UK readership;
- An abstract from an article dated 1 October 2001 by Rony Abovitz titled 'Digital surgery: the future of medicine and human-robot symbiotic interaction'.⁹ The abstract outlines that the full article discusses the role of technology in surgical operations.

12. Mr Meadows states that the EUIPO and USPTO have refused the EU and US designations of the proprietor's international registration based upon the contested mark, the former being upheld by the Board of Appeal.¹⁰ In this connection, Mr Meadows exhibits the decisions of the EUIPO and USPTO, as well as the decision to

⁶ Exhibit TM4

⁷ Exhibit TM5

⁸ Exhibit TM6

⁹ Exhibit TM7

¹⁰ Meadows, §10

dismiss an appeal against the decision of the EUIPO.¹¹ The evidenced decisions confirm the refusals as described by Mr Meadows.

13. Moreover, Mr Meadows lists other trade marks which he feels are similar to the contested mark; these, Mr Meadows explains, have all been refused by the UKIPO and EUIPO.¹² The corresponding decisions are evidenced and confirm that marks including, *inter alia*, 'DIGITAL VACCINES', 'DIGITAL THERAPEUTICS' and 'MAGNETIC SURGERY' have faced objections or refusals at examination and appeal stages.¹³

PRELIMINARY ISSUES

14. In its evidence and submissions, the applicant refers to previous decisions of the EUIPO and USPTO, highlighting that the proprietor's EU and US designations of its international registration based upon the contested mark have been refused. While I have read the decisions and note the findings therein, it suffices to say that they will be of little import to the present proceedings. It is well established that previous decisions, whether that be of this Tribunal, the EUIPO, or any other national office, are not binding. Each case must be assessed on its own merits and I do not consider it appropriate to derive my conclusions wholly from the decisions to which the applicant refers.

15. Similarly, the applicant makes reference to a number of other trade marks which have been refused in the UK and EU on the grounds that they were considered descriptive and non-distinctive. In the applicant's submission, the contested mark is adequately similar to these marks and it should, therefore, follow that it offends sections 3(1)(b) and 3(1)(c) of the Act. I note these trade marks and have read the corresponding decisions, though I must clarify at this early stage that the fact that other marks have been denied registration will have no bearing on the outcome of this application for invalidation. The refusal of other marks is simply not relevant for the purposes of my assessment. As previously outlined, each case must be assessed on

¹¹ Exhibits TM8 – TM10

¹² Meadows, §11

¹³ Exhibits TM11 – TM16

its own merits; whether or not the contested mark is valid will not be predetermined by decisions concerning different trade marks with different specifications. My assessment later in this decision must take into account only the contested mark, its specification and all the relevant factors.

DECISION

16. In invalidation proceedings, section 3 of the Act has application because of the provisions of section 47(1), which stipulates:

“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.”

17. Sections 3(1)(b) and 3(1)(c) of the Act read as follows:

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

(a) [...]

(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) [...]

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.”

18. The relevant date for determining whether the mark is objectionable under the above provisions is the filing date of the contested mark i.e. 29 August 2017.

19. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).¹⁴

20. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.¹⁵ The relevant public will vary depending on the particular goods and services concerned. However, in this case, the relevant public will consist of both members of the general public and professional users. At least a medium degree of attention will be paid for all of the goods and services for which the contested mark is registered as various factors will be taken into account during the purchasing process. For example, in the case of software the relevant public will consider suitability, functionality and product specifications, while in the case of education services will consider quality as well as the performance and outcomes of previous students. I recognise that a higher degree of attention will be paid by professional users, such as medical professionals looking to purchase software for their practice.

Section 3(1)(c)

21. I consider it prudent to begin with the application under section 3(1)(c). This provision prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the

¹⁴ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, paragraph 25

¹⁵ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“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 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

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

22. In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the Court of Justice of the European Union (“CJEU”) stated that:

“39. As a general rule, the 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 within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. 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.

40. However, such a combination may not be descriptive within the meaning of Art.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 will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of

which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

23. The applicant has argued that, based upon the dictionary meanings of the words ‘DIGITAL’ and ‘SURGERY’, the contested mark would be immediately perceived by consumers as providing information that the relevant goods and services are digital products or technologies connected with surgery and related fields i.e. describing the kind and/or intended purpose of the goods and services. The applicant has contended that there is nothing vague or allusive about the contested mark. Rather, the message conveyed by the contested mark, according to the applicant, is clear and direct. For its part, the proprietor denies that consumers would understand the contested mark in the manner submitted by the applicant.

24. The Oxford English Dictionary defines the word “digital” as, *inter alia*, ‘involving or relating to the use of computer technology’,¹⁶ while the word “surgery” is defined as ‘the branch of medical practice that treats injuries, diseases, and deformities by the physical removal, repair, or readjustment of organs and tissues, often involving cutting into the body’.¹⁷ There is no dispute as to the meaning of these words.

25. I consider that these would be the meanings ascribed to the words by the average consumer, being both members of the general public and professional users. The bringing together of the two words does not, in my view, introduce any perceptible difference between the resulting combination and the two individual words. The combination is not unusual and neither does it create an impression which is sufficiently far removed from that produced by the combination of meanings lent by

¹⁶ <https://www.lexico.com/definition/digital>

¹⁷ <https://www.lexico.com/definition/surgery>

the two words. On the contrary, the word 'SURGERY' is preceded by the adjective 'DIGITAL', the latter qualifying the former. The combination of the two words in the mark results in a grammatically correct term, which would be immediately understood by the average consumer as referring to the medical treatment of injuries, diseases, and deformities by the physical removal, repair, or readjustment of organs and tissues involving the use of computer technology. The applicant's evidence incorporates examples from the internet of use of the term 'DIGITAL SURGERY'. In my view, these do not assist the applicant as there is nothing to suggest that they are targeted at consumers in the UK. Moreover, the examples provided do not demonstrate descriptive use of the term 'DIGITAL SURGERY' in relation to the trade of any goods or services. Nevertheless, as set out in the case law above, it is not necessary that the sign in question is actually used in a way that is descriptive for it to fall foul of section 3(1)(c). It is sufficient, by virtue of the wording of the provision, if the sign could be used for such purposes. Furthermore, it is considered reasonably foreseeable that the contested mark could be used descriptively in the future due to the exponential growth of computer technologies and their ever-increasing scope of application. I am of the view that surgery, which requires a high level of precision, is one such domain which could be increasingly realised with the use of computer technologies.

Class 9

'Software; application software; software applications (apps) delivered online or as downloadable applications; educational software and/or software applications (apps); software and/or software applications (apps) for medical and/or surgical teaching and training; software and/or software applications (apps) for medical and/or surgical applications; medical and/or surgical simulation software and/or software applications (apps); teaching apparatus and instruments; medical simulators (teaching aids); surgical simulators (teaching aids); data carriers, discs, CD-ROMs, DVDs, laser discs, mini discs, tapes and/or other data storage media, all for recordal, storage and/or transmission of audio, visual and/or audio-visual data'

26. It is important to bear in mind the principle behind section 3(1)(c), which is to keep descriptive signs relating to one or more characteristics of the goods or services free to use by all traders offering such goods and services. It is, in my view, entirely likely

that traders who sell software and hardware may wish to use the term 'DIGITAL SURGERY' to describe a characteristic of the goods they sell. That is, to convey the intended purpose of the goods, namely, software and hardware that is to be used to perform surgeries with the use of computer technology. To my mind, the same also applies to teaching apparatus and aids; consumers will perceive the mark as an indication that these goods are for equipping individuals with the skills to perform such surgeries.

'Electronic publications; electronic publications relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; audio, visual, audio-visual and/or video recordings; audio, visual, audio-visual and/or video recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training'

27. When the mark is used in conjunction with the above goods, the mark will be perceived as informing consumers that the publications or recordings provide insights and knowledge for the purpose of performing surgeries with the use of computer technology. In addition, or in the alternative, the mark will be seen as describing the subject matter of the goods, namely, publications or recordings containing information about surgeries involving the use of computer technology. In accordance with *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch), these goods are apt to convey information about subject matter and it is reasonable that consumers would recognise the mark as designating the same. Further, 'DIGITAL SURGERY' is not, in my view, a subject matter that consumers would assume is controlled by a single economic undertaking. Rather, it is a subject that consumers would expect to be written about by a number of different undertakings, including medical professionals, institutions, educators and researchers.

Class 41

'Education services; teaching services; training services; education, teaching and/or training services provided online, via a downloadable software application (app) and/or

via the Internet; education, teaching and/or training services relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; educational and/or academic research; educational and/or academic research relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; providing, arranging, organising and/or conducting courses, lectures, seminars, working groups, research groups and/or workshops; providing, arranging, organising and/or conducting courses, lectures, seminars, working groups, research groups and/or workshops relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; provision of educational exams and/or tests; provision of educational exams and/or tests relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; arranging, organising and/or conducting conventions, congresses, conferences and/or exhibitions; arranging, organising and/or conducting conventions, congresses, conferences and/or exhibitions relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; organisation, production and presentation of events, lectures, seminars, debates, conferences and meetings for educational, cultural, sporting or entertainment purposes; consultancy, advisory and information services relating to or connected with all the aforementioned services'

28. It is considered that, broadly, the above terms all refer to educational services. Some of the terms specify that the services are for application in a medical context, whereas others are more general. To my mind, the latter will still incorporate educational services connected to medicine and surgery. Therefore, when used in relation to all of the above educational services, the mark will be perceived by consumers as describing the kind and intended purpose of the services, for instance, training relating to surgeries involving the use of computer technology and educational services which provide individuals with the skills and knowledge to perform such surgeries.

'News reporting services; news reporting services relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; provision of electronic publications; provision of electronic publications relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; publishing services; publication of printed matter, educational materials, teaching materials, training materials, texts, books, magazines, newspapers, journals, manuals, handbooks, periodicals, newsletters, calendars, programmes, leaflets, pamphlets and/or brochures; publication of printed matter, educational materials, teaching materials, training materials, texts, books, magazines, newspapers, journals, manuals, handbooks, periodicals, newsletters, calendars, programmes, leaflets, pamphlets and/or brochures relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; production of video and/or audio recordings; production of video and/or audio recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; production of video and/or audio recordings; production of video and/or audio recordings relating to or connected with medicine, medical procedures, medical practice, medical training, surgery, surgical procedures, surgical practice and/or surgical training; live action production; animation services; production and presentation of television programmes, films, videos, DVDs, digital media (excluding digital radio) and media products; production and presentation of television, cable and satellite programmes; production, presentation, distribution, syndication, networking and rental of television, cable and satellite programmes and of films, sound recordings (excluding recordings of radio programmes), video recordings and DVDs; publishing; audio and video recording services; consultancy, advisory and information services relating to or connected with all the aforementioned services.'

29. In my judgement, it is entirely likely that undertakings who provide the above services may wish to use the term 'DIGITAL SURGERY' to describe a characteristic of the services they provide, that being the intended purpose of the services; the providers of these services may wish to inform consumers that they produce or supply

news reports, journals or audio-visual recordings to disseminate information, or impart knowledge, about performing surgeries with the use of computer technology.

Class 42

30. The services in class 42 essentially consist of scientific, technological and medical research as well as the design, development and maintenance of computer technology. It is considered that, when used in relation to these services, the term 'DIGITAL SURGERY' will be perceived by consumers as describing a characteristic of the services, namely, the intended purpose; the mark will be seen as informing consumers that the services are to provide research, development and maintenance of technology that will be used in surgical procedures.

Section 3(1)(b)

31. I now turn to the application under section 3(1)(b) of the Act. This provision prohibits the registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product

in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

32. From the applicant's evidence and submissions, it appears that the application under section 3(1)(b) is inextricably linked to its claim under section 3(1)(c) i.e. that the contested mark is descriptive of the goods and services. There does not seem to be any separate basis for the applicant's argument that the mark is non-distinctive. Moreover, for reasons previously outlined, I am not convinced by the applicant's evidence that the term 'DIGITAL SURGERY' is commonly used in trade. Nevertheless, where a mark is descriptive for certain goods or services, it necessarily lacks the

required distinctiveness to avoid objection under section 3(1)(b). Consequently, the contested mark will be prima facie devoid of distinctive character under section 3(1)(b) for all the goods and services for which it has been registered.

Acquired distinctiveness

33. I now turn to consider whether the proprietor has established acquired distinctiveness for its goods and services in classes 9, 41 and 42. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“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).”

34. Although the proprietor has claimed that the contested mark has acquired distinctiveness through use, there is no evidence before me to substantiate such a claim. Accordingly, I am unable to conclude that the proprietor has demonstrated acquired distinctiveness for any of its goods and services.

CONCLUSION

35. The application for invalidation under sections 3(1)(b) and 3(1)(c) of the Act has succeeded in its entirety. Subject to any successful appeal against my decision, under section 47(6) of the Act the registration is deemed never to have been made.

COSTS

36. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. This decision has been taken from the papers without an oral hearing. The opponent filed evidence and written submissions in these proceedings. In the circumstances I award the opponent the sum of **£1,600** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the proprietor’s counterstatement	£400
Preparing evidence and written submissions	£1,000
Official fee	£200
Total	£1,600

37. I therefore order Digital Surgery Limited to pay Raven Tor Ltd the sum of **£1,600**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of January 2021

**James Hopkins
For the Registrar,
The Comptroller General**