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## Primary Health Care is not registrable as a trade mark

Posted on [20 April 2016](#)

You will probably not be surprised to discover that PRIMARY HEALTH CARE is not registrable as a trade mark. You may, however, be surprised that the successful challenger was the Commonwealth of Australia.

Primary Health Care Limited (PHC) applied to register PRIMARY HEALTH CARE and



Primary Health Care logo

in class 35 for:[\[1\]](#)

Medical centre business management; medical centre business administration; service provider to medical professionals, namely provider of: administrative support services, billing and invoicing services, reception and telephone answering services, patient booking services, patient file management services including management of access to patient files, typing services, account-keeping and book-keeping services, preparation of business reports, systemisation of information into computer databases, professional business consultancy, computerised file management, business and information management services, ordering services, processing of purchase orders.

What PHC did was it bought or built a building for use as a medical practice. It set up the rooms and facilities and provided the staff such as receptionists, book keepers etc. Then it contracted with medical practitioners (mostly GPs) to work from the medical centre, using the staff and facilities PHC made available to provide their services. PHC argued that it used its trade marks only in providing those services to the medical practitioners and the trade marks were not used by it in providing medical services to the medical practitioners' patients. Thus, it said, it was not using the trade marks for medical services, only for business management and administration services – services for which the expression PRIMARY HEALTH CARE was *not* an apt description. At [53]:

The applicant's case is that the Services are all to be provided to health care professionals and are not to include clinical or medical care by those professionals to patients.

This argument was predicated on PHC's clinics/centres *not* being called or promoted to the public as PRIMARY HEALTH CARE centres.[\[2\]](#)

Jagot J rejected PHC's contention. Her Honour accepted that PHC's marketing was directed to health care professionals rather than the public. Her Honour also accepted that the health care professionals provided the health care services to the patient and jealously guarded their clinical independence in deciding what clinical care to provide to the patient. So PHC was not actually providing medical or health care services to the patients *per se*. However, it was unrealistic to treat the services PHC provided as being services provided only to the health care professionals. They were also provided to the public. Jagot J explained what her Honour had in mind by reference to the medical centre's receptionist – who was employed by PHC. For example at [55] – [59]:

.... the person paying for the services, the medical professional, is not the only person who receives the services or, at the least, is not the only person *concerned with* the services. The Services include reception and telephone answering services, patient booking services, patient file management services, information management services, billing and invoicing services, computerised file management, and ordering services, all said to be “to medical professionals”. (emphasis supplied)

Assume then a member of the public who wishes to see a GP who is contracted to and has a practice located in one of the applicant's medical centres (leaving aside, for the moment, the issue about Idameneo and how the marks have in fact been used). The patient calls the centre and speaks to a receptionist. On the applicant's case, in answering the call, the receptionist is providing a service only to the GP the patient might wish to see and not to the patient. This is untenable. The GP who ultimately sees the patient pays for the service but the service cannot be said to be a service to the GP only. It is also a service to the patient, the cost of which is borne by the GP, at least insofar as the GP does not seek to recoup those costs in the consultation fee. ....

As a consequence, Jagot J found:

[64] As such, the focus of the applicant's case is off target and at odds with the evidence. The consequences of this disconnect run through every aspect of the case. First, the Services cannot be considered as if they exist in isolation because that is not how the Services are provided. Second, no matter how often the applicant repeats it, I am unable to accept that the Services are directed only to GPs and health professionals; the public and other participants in the health care sector are provided with some of the Services and are potentially concerned with all of the Services. ....

[65] ... the reality is that, at least insofar as the Services are concerned, the applicant is providing services to medical professionals within its centres, to patients of those centres, and to all other participants in health care who interact with any medical professional in one of its centres. The fact that the applicant (or Idameneo) receives payment for the provision of the Services directly from the medical professional does not mean that the Services are provided only to the medical professional. Nor does the fact that medical professionals understand that they alone provide clinical or medical services to patients mean that the Services are not provided to patients. The reasoning involved seems to involve a false syllogism: (i) only medical professionals provide clinical services to patients, (ii) the Services are not clinical services, (iii) therefore,

the Services are necessarily not services to patients. Propositions (i) and (ii) may be accepted, but they do not lead to proposition (iii).

Therefore, when deciding what the ordinary signification of the words PRIMARY HEALTH CARE was, the relevant public was not just the health care professionals to whom the services were promoted but all other participants in the health care system including patients and potential patients.

For the public so defined, Jagot J then went on to find that the expression PRIMARY HEALTH CARE was directly descriptive and so not inherently adapted to distinguish at all under the old form of [s 41\(3\)](#) or capable of distinguishing under [s 41\(5\)](#) or in fact distinctive under [s 41\(6\)](#).[\[3\]](#)

At first blush her Honour's ruling that the Services were being provided to the public (other than the medical practitioners) might seem questionable because, so far as I can make out from the judgment, no member of the public (apart from the medical practitioners of course) actually sees the sign PRIMARY HEALTH CARE being used as a trade mark. For example, patients were not given bills or receipts or prescriptions with PRIMARY HEALTH CARE emblazoned on them. Nor does it seem that the receptionist (or other ancillary staff) wore uniforms with the sign on them. If keywords are [not used as a trade mark](#) because they are "invisible", one might think that the unseen expression PRIMARY HEALTH CARE was also not being used as a trade mark for the services provided to the public. As the Commonwealth pointed out, however, PRIMARY HEALTH CARE *could* be used on, for example, the uniforms if the trade mark were registered. So, taking into account fair notional use renders the "invisibility" argument untenable.[\[4\]](#)

Perhaps the crucial consideration is that the services being provided by the receptionist and the other "ancillary" staff are just so closely bound up with the health care services being provided by the medical practitioner to be part of those services or taking their character from the primary services being offered at the clinic. This indeed appears to be what her Honour had in mind. So for example, her Honour said at [119]:

there is an unreal distinction at the heart of the applicant's case between the provision of the Services and the provision of clinical or medical care. The distinction is unreal because the Services are part of the overall service a patient receives when attending a medical centre and, to some extent, are also part of the medical or clinical care a patient receives. It is part of medical care that a GP be able to access clinical records for a patient. It is part of medical care to ensure new records are accessible in the future. It is part of medical care for a patient's referral to be properly recorded, stored and managed. It is part of medical care for the centre to have available necessary medical supplies. ....

and at [121]:

in the real world context in Australia (at least) the Services are inextricably bound up with the provision of medical and clinical services by general practitioners and allied healthcare professionals, including through medical centres and medical practices – they are 'part and parcel' of the practice of general medicine and allied healthcare in the community, of primary health care.

That way of looking at things, with respect, seems in accord with the reasons why the Full Court in the [Chifley Tower](#) case rejected the argument that an hotel was engaged in providing property management services.

Jagot J went on to find that an additional ground for refusing registration was that the trade marks were deceptive or confusing. They were deceptive or confusing because, although they were so

closely bound up with the provision of medical services, the specification of services did not include medical services. On the other hand, use of the trade marks would be contrary to law in contravention of [s 18](#) of the Australian Consumer Law because use of the mark misrepresented that PHC provided medical services and further that PHC was responsible for the medical services provided by the medical practitioners at the centres.

### [Primary Health Care Limited v Commonwealth of Australia](#) [2016] FCA 313 (Jagot J)

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1. The “Services”. In the course of the proceeding the specification of services went through a number of revisions. This is just the starting one, but it indicates the nature of what PHC wanted registration for. [?](#)
2. There was a factual dispute whether PHC used PRIMARY HEALTH CARE as the name of 3 or 7 of its medical centres, but this seems to have been regarded as essentially *de minimis*. [?](#)
3. Putting a simple box around the words didn’t improve matters. [?](#)
4. This led PHC in one of its revised specifications of services to seek to “disclaim” such use under [s33\(2\)](#) and [s 55\(1\)\(b\)](#). [?](#)

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