

O-429-99

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO 2164706
BY PET CARE TRUST TO REGISTER
A TRADE MARK IN CLASS 42**

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DECISION

1. This is an appeal against the decision of the Registrar dated 27th January 1999, by which he refused an application by the appellants, PET CARE TRUST, to register a mark consisting of a drawing of five pedigree dogs and the words PUPPY INDEX (the whole being contained in a square border), the words PUPPY and INDEX appearing in different typescripts, all as appears below:



2. Registration was sought in respect of Class 42 in relation to an amended specification in the following terms: “Provision of information relating to dog breeders and to the breeding of dogs by access through a computer database or to printed information derived therefrom”. The application was refused under Section 3(1)(b) of the Trade Marks Act 1994 on the basis that, in the absence of evidence that the mark had acquired a distinctive character, by reason of the use made of it, it was devoid of any distinctive character.

3. The Hearing Officer, Miss Janet Folwell, as is recorded in her decision, was asked by Mr Gregory for the applicants to hold that the mark was distinctive, having regard to its two components taken together. In the first place he said that the device of five dogs, as presented in the application, was in itself unique and distinctive and that the registration of the mark would not prevent others from using a device with different breeds of dogs. In the second place he contended that the words “PUPPY INDEX” were not totally non-distinctive for the services claimed. The Hearing Officer went on to refer to the definition of “PUPPY” in the Collins English Dictionary (3rd Edition, 1994) which includes: “a systematic list of book titles or author’s names giving cross-references and the location of each book: catalogue”. The crux of the Hearing Officer’s reasoning in refusing this application, is to be found in the following passage from her decision where she said:

“It is apparent from the meaning of both words that when used in relation to the services claimed they would indicate to the public that the service offers a printed or computerised index which receives details of pedigree puppies from breeders and supplies this information to potential buyers. This is further endorsed by the presence

in the mark of a drawing of pedigree dogs which are not presented in any special or fanciful manner. They serve only to compliment (sic) the words “PUPPY INDEX” and show the public that the services relate to all breeds of dog. I have the view that the mark as a whole is devoid of distinctive character.”

4. At a hearing before me, held on 5th July 1999, Mr T. Gregory of Messrs T.M Gregory, on behalf of the appellants, explained that the service in question would work as follows. It would be operated by certain pet shops. Members of the public interested in purchasing a dog of a particular breed would be able to go to such shops and have access to such database which would list the names of reputable breeders of such dogs. The compilation of the database would be the responsibility of the applicants who are a registered charity.

5. Mr Gregory went on to contend that the Hearing Officer had erred in her approach in that she had dissected the mark into its components and had considered these individually without having proper regard to the mark’s overall appearance. Secondly, he contended that the word “INDEX” was not descriptive of the service or services which the mark was going to be used in respect of. Mr Morgan, who appeared on behalf of the registrar before me, in reply, contended that the words “PUPPY INDEX” could be regarded as descriptive of the services to be provided, even as explained and described by Mr Gregory in his submissions. I agree with that. It appears to me that the listing of the names of breeders of certain kinds of dog, according to categories of breeds, and, perhaps, sub-categories of breeds, where the breeders would be in a position to provide puppies of the required breed and type, in a database to which members of the public would have access, might well be appropriately described by the words “PUPPY INDEX”. That being so, as Mr Morgan contended, the question is whether the addition of the depiction of five dogs transforms the mark into one which is distinctive.

6. Mr Morgan’s response to that question was that the consumer would see the depiction of the dogs as a typical get-up in relation to any services concerned with puppies and as such would not be seen as any badge or origin. Any depiction of a combination of dogs for such services, he submitted, would not be registerable unless highly stylised. In this connection he made reference to the as yet unreported decision of the Court of Appeal in the case of **Proctor & Gamble Limited v Registrar of Trade Marks** 29th January 1999. In that case, which was concerned with an application for registration of three-dimensional bottles as a mark in Class 3 (Polishing, scouring and abrasive preparations; detergents and soaps; bleaching preparations) the Court of Appeal had to decide whether or not the Registrar’s refusal to register these marks was justified in relation to the provisions of Section 3(1)(b) of the 1994 Act. In his judgement Robert Walker L J at page 12 said:

“Despite the fairly strong language of Section 3(1)(b), “devoid of any distinctive character” – and Mr Morcom emphasised the word “any” – that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product – in this case an ordinary, inexpensive household product – from that of another competing trader. Product A and product B may be different in their outward appearance in packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive (unless, of course, one constitutes an unlawful infringement of some existing registered trade mark). An objection on those grounds cannot in my judgement be treated (in the words of Young J in the **Standard Woven Fabric** case

(1918) 35 RPC 53, 58) as being on “grounds which were fanciful and which, in a business sense, were insubstantial”. On the contrary any objection on those grounds would be a practical and businesslike objection”.

7. Relying on that passage Mr Morgan submitted that the depiction, in the present case of the five dogs of different breeds, chosen at random, in neither a stylised nor fanciful manner did not serve to distinguish the applicant’s services which, in a general sense, related to dogs and services of others which in some way related to dogs. I agree with that submission. I, moreover, consider that the Hearing Officer was correct in considering that the following dictum from the decision of Mr Hugh Laddie QC in the case of The PROFITMAKER Trade Mark [1994] RPC 17 was apposite to the present case. In the last-mentioned case Mr Laddie said as follows:-

“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all those other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the Register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others”.

8. In my view the ordinary depiction of a selection of five dogs of different types should not, in my view, without evidence of distinctiveness acquired by reason of use, be declared to confer on the applicants a monopoly of such a depiction against other honest traders who may legitimately alight on such a depiction as being appropriate for the description of the services they provide.

9. In the result I am not persuaded that the arguments put forward on behalf of the appellants have revealed any error of approach by the Hearing Officer and I accordingly refuse the appeal.

M.G. CLARKE QC
5th August 1999