

TRADE MARKS ACT 1994

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

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DECISION AND GROUNDS OF DECISION

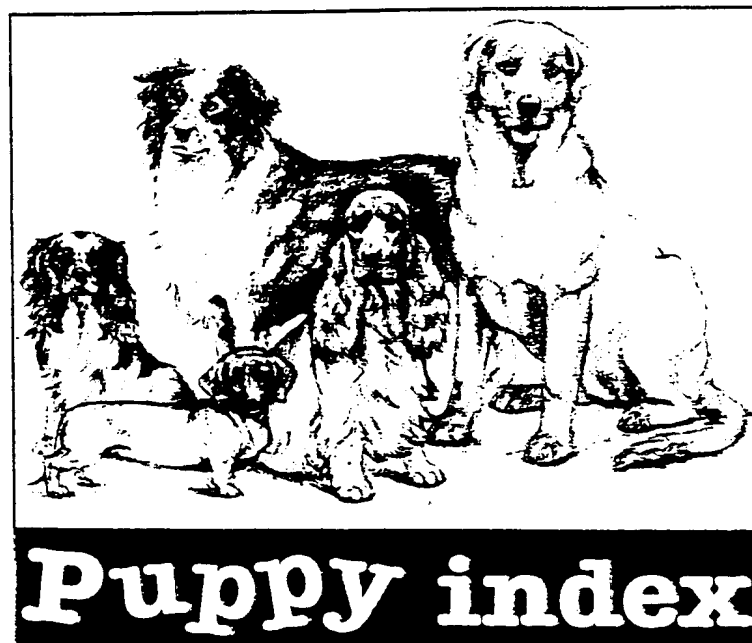
10 On 23 April 1998 Pet Care Trust of Bedford Business Centre, 170 Miles Road, Bedford, applied to register the mark shown below:

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in Class 42 of the register in respect of:

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“Provision of databases; registration services of dogs and relating to the pedigree of dogs; arranging of introductions between breeders and purchasers of puppies; publication of texts relating to the above services.”

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An objection to the application was taken under Section 3(1)(b) of the Act on the grounds that the mark consisted of the words “PUPPY INDEX” and an ordinary drawing of pedigree dogs, the whole being devoid of any distinctive character.

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An objection to the application was also taken under Section 5(2) of the Act in respect of an earlier registered trade mark. This objection was subsequently waived and so I need not address that issue any further.

An enquiry was made concerning the specification of services in Class 42, as the term “provision of databases” is not understood. Also the term “publication of texts” is proper to Class 41. The applicants were invited to clarify the coverage of services intended and did so by offering the following amended specification which is acceptable to the Registrar:

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“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.”

10 At a Hearing at which the applicants were represented by Mr Gregory of T M Gregory & Co, their trade mark agents, the objection under Section 3(1)(b) was maintained, and following refusal of this application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to provide a statement of the reasons for my decision. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

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At the Hearing and in correspondence, Mr Gregory put forward his arguments for acceptance of the mark as follows:

20 i That the device of five dogs, as presented in this application, is in itself unique and distinctive and that registration of the mark would not prevent others from using a device with different breeds of dog;

25 ii That the words “PUPPY INDEX” are not totally non-distinctive for the services claimed.

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These arguments did not persuade me that the mark was not devoid of any distinctive character.

The mark consists of the words “PUPPY INDEX” together with a drawing of five pedigree dogs, the whole being contained in a square border.

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Collins English Dictionary (Third Edition 1994) defines “Puppy”, inter alia, as:

“A young dog”.

35 In the same dictionary, included in the definition of “Index” is:

“A systematic list of book titles of authors names giving cross references and the location of each book; catalogue.”

40 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 the words
45 “PUPPY INDEX” and show the public that the services relate to all breeds of dog.

I have considered the individual elements of the mark, and even when taken in combination, I take

the view that the mark as a whole is devoid of distinctive character.

5 The fact that the words “PUPPY INDEX” appear in the mark in differing typescript does not affect the question of distinctiveness. In *British Sugar plc and James Robertson and Sons Ltd* decision [1996] RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said:

10 “I am, of course, aware that the words “Toffee Treat” are written in a fancy way. But then so are many other mere descriptors. One only has to look at how British Sugar write such words as “meringue mix” or “golden syrup” to see parallel sorts of use. I do not think this affects the matter one way or the other.”

With regard to the drawing of a group of dogs, again Mr Justice Jacob commented in the TREAT decision:

15 “Next, is “TREAT” within 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common
20 laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act *inherently* but the idea is much the same) devoid of any distinctive character.”

25 Although Mr Justice Jacob was specifically referring to a word mark, he makes it clear that the same considerations apply to other signs. In my view the applicants’ mark is the type of sign falling within the category of marks which have to acquire a distinctive character before being able to function as an indication of origin.

30 Furthermore, I do not accept the argument that I should accept the application because registration of the mark would not prevent others from using the words “PUPPY” or “INDEX” or any other device featuring a group of dogs.

Mr Hugh Laddie said in the PROFITMAKER trade mark [1994] RPC 17:

35 “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
40 laudatory words, or not unusual combinations of them, have been monopolised by others.”

In my view Mr Laddie’s remarks apply equally to combinations of devices and words such as in the applicants’ mark.

Moreover, in the AD200 trade mark [1997] RPC 168, Mr Geoffrey Hobbs QC said:

45 “Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration

of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd’s Trade Mark Application* (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

In conclusion, in the absence of evidence that the mark has acquired a distinctive character by reason of the use made of it, it is debarred from registration under Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application, and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 27 day of January 1999

JANET FOLWELL
For the Registrar
The Comptroller General