TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2164709
BY PET CARE TRUST
TO REGISTER A TRADE MARK IN CLASS 16

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2164709
BY PET CARE TRUST
TO REGISTER A TRADE MARK IN CLASS 16

DECISION AND GROUNDS OF DECISION

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

in Class 16 of the register in respect of:-

> "Printed matter and publications; books, magazines and periodicals; instructional and teaching material; maps; educational materials; photographs; calendars; greeting cards; cards; stationery."

An objection to the application was taken under Section 3(1)(b) of the Act on the grounds that the mark consisted of the word "PETCARE" and a drawing of ordinary domestic animals, the whole being devoid of any distinctive character.

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 the 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.

At the Hearing, Mr Gregory put forward the argument in support of acceptance of the mark that the drawing of domestic animals does possess a distinctive character. Any other honest trader, he submitted, would not wish to use a drawing presented in such a way as in this application. He made no submissions in respect of the word "PETCARE".

This argument did not persuade me that the mark was not devoid of any distinctive character.

The relevant part of Section 3(1) of the Act reads as follows:

> "The following shall not be registered -
>
> (b) trade marks which are devoid of any distinctive character,"

The mark consists of the word "PETCARE" together with the drawing of domestic animals, ("pets"), this comprising the faces of a dog, cat, rabbit, guinea pig and the whole body of a budgerigar.

Collins English Dictionary (Third Edition 1994) defines "Pet", inter alia, as:

> "A tame animal kept in a household for companionship, amusement, etc".

In the same dictionary, included in the definition of "Care" is:

> "To provide physical needs, help or comfort".

It is apparent from the meaning of both words that when used together in relation to the goods claimed, they would indicate that the products either relate to, or are concerned with, the care of domestic pets. This is further endorsed by the presence in the mark of a drawing of domestic pets which are not presented in any special or fanciful manner. They serve only to compliment the word "PETCARE" and show the public that the goods relate to the care of a variety of different pets.

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 any distinctive character.

The fact that the word "PETCARE" appears in the mark in differing typescript does not affect the question of distinctiveness. In British Sugar plc and James Robertson & Sons Ltd decision [1996] RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said:

> "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 ordinary domestic pets, again, Mr Justice Jacob commented in the TREAT decision:

> "Next, is "TREAT" within Section 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 further 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 laudatory word such as "TREAT" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character".

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.

Furthermore, I do not accept the argument that I should accept the application because registration of the mark would not prevent others from using any other drawing featuring domestic animals.

Mr Hugh Laddie said in the PROFITMAKER trade mark (1994) RPC 17:

> "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 alternative ways could, on the same argument, also be the subject of registered 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."

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:

> "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 Mr Robin Jacob QC in his decision on behalf of the Secretary of State in the COLORCOAT trade mark [1990] RPC 551 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