

O-428-99

TRADE MARKS ACT 1994

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

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IN THE MATTER OF Trade Mark Application No. 2164709 by PET CARE TRUST to register a Trade Mark in Class 16.

DECISION:

1. In this appeal the applicants appealed against a Decision of the registrar, dated 27th January 1999 refusing to register the mark shown below:



2. Shown in Class 16 of the register in respect of:- "Printed matter and publications; books, magazines and periodicals; instructional and teaching material; educational materials; photographs; calendars; greetings cards; cards; stationary". The ground for refusing the application, as set out by the Hearing Officer, Miss Janet Folwell, was that the mark failed to qualify for registration by reason of the provisions of Section 3(1)(b) of the 1994 Act. There was no evidence of use, so the Hearing Officer was simply deciding the *prima facie* case.

3. The Hearing Officer, at page 2 of her decision, after referring to the fact that 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", went on to refer to the dictionary definitions of the words "PET" and "CARE" provided by the Collins English Dictionary (3rd Edition, 1994). The definition of "PET", given in that dictionary, includes the following: "a tame animal kept in a household for companionship, amusement etc." And the definition of "CARE" is given as "to provide physical needs, help or comfort".

4. The key passage in the Hearing Officer's Decision is then set out in the following terms:-

"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 (sic) the word "PETCARE" and show the public that the goods relate to the care of a variety of different pets. I take the view that the mark as a whole is devoid of any distinctive character."

5. I heard submissions, in this appeal, at a hearing before me held on 5th July 1999, from Mr Gregory of messrs T.M. Gregory, for the appellants, and Mr D. Morgan for the Registrar.

6. Mr Gregory conceded that the word “PETCARE” on its own would not be registerable. The short point, therefore, was whether the drawing or picture of the animals made the mark distinctive. Mr Gregory maintained that distinctiveness came from the particular selection of the pets, in question, and the particular arrangement of these pets in the picture. He explained that at least initially, the mark was being used in relation to a magazine, and possibly related publications published by the appellants, relating to their activities, which are concerned with the welfare of domestic animals.

7. Mr Morgan for the register relied, in supporting the Hearing Officer’s reasoning, on the recent decision of the court of appeal in the case of **Proctor & Gamble Limited v Registrar of Trade Marks**, as yet unreported, 29th January 1999. In that case, which was concerned with an application for registration of three-dimensional bottles as a mark, 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, having regard 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 difference becomes 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 younger 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.”

8. Relying on that decision, and , in particular, the passage just cited therefrom, Mr Morgan contended that the depiction of the domestic pets would be seen by consumers simply as a normal get-up in relation to books, and other publications, concerned with, or relating to, the welfare of pets. Such a depiction could not be regarded as a badge of origin or distinctive in any way unless they appeared in an extremely stylised form. I agree with that submission. Moreover it seems to me that the hearing officer was well-founded in her rejection of an argument, made on behalf

of the applicants, and repeated before me by Mr Gregory that the application should be allowed because registration of the mark would not prevent others from using any other drawing featuring domestic animals. In this respect the words of Mr Hugh Laddie QC in The PROFITMAKER trade mark case (1994) RPC 17 are particularly apt, where he said:

“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 the common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others.”

9. For the foregoing reasons I have been unable to identify any error in the approach of the Hearing Officer and, accordingly, refuse this appeal.

M.G.CLARKE QC
5th August 1999