

# O-106-16

**TRADE MARKS ACT 1994  
IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3069768  
BY DOGS TRUST  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 3, 14, 18, 20, 21, 24, 25, 28, 31, 39, 41, 42 43:**

## **A DOG IS FOR LIFE NOT JUST FOR CHRISTMAS**

### **Background**

1. Trade mark application 3069768 was filed on 22 August 2014 in the name of Dogs Trust ('the applicant', 'the charity' or 'the Trust'). The relevant mark (I shall refer to it as a, or the, 'mark', or 'slogan', but nothing should be inferred from this), is as follows:

A Dog is For Life not Just for Christmas

2. The goods and services for which registration was sought are annexed to this decision.
3. By letter dated 15 September 2014, the registry ('IPO') raised an objection against the application as follows:

#### **Section 3(1)(b)**

*The application is not acceptable in All Classes. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the term "a dog is for life not just for Christmas" would be seen as a non-distinctive inspirational and promotional strap line. The phrase would be immediately perceived as a phrase inspiring an individual to ensure they realise that owning a dog is a life-long commitment, as opposed to a short term pastime or a gift, like that of a present given at Christmas.*

*As such the term does not possess the required level of distinctive character that will convert it into a distinctive trade mark for a single undertaking.*

4. In a letter dated 23 September 2014, the applicant indicated a wish to submit evidence of acquired distinctiveness showing its use of the slogan over 30 years. It also said the mark had been already registered and the earlier registration had been accepted on the basis of acquired distinctiveness. An extension was requested for the purpose of collating such evidence and this request was allowed by the examiner.
5. Accompanying a letter dated 4 November 2014, a statutory declaration by Ms Clarissa Baldwin was filed. This was said to have been declared on 31 October 2014 but in fact was dated 25 June 2001 and had been used to support an earlier registration, 2264463 ('463).

6. The examiner nonetheless assessed the evidence and wrote to the applicant on 25 November 2014 as follows:

*“I have reviewed the evidence in line with the goods and services included in the application and regrettably I am unable to waive the section 3 objection at this stage, based on the use that has been demonstrated.*

*There are some examples of the mark being used with the ® symbol, indicating the brand usage that has been granted in connection with the slogan previously and this naturally reflects in a good light when considering the mark.*

*However, the other uses of the mark where it is not displayed with the ® symbol fail to provide a brand link that would enable the relevant consumer to identify the mark being used as a brand name, and these instances demonstrate use of the mark as a general promotional slogan.*

*When reviewing the evidence I took particular note of the dictionaries, however, although these references are an official source, they attribute the term as being a slogan of the “NCDL” interchangeable in my view with “Dog’s Trust”, but do not emphasise enough that the term is a brand of the organisation, rather simply a slogan, which could serve as a general promotional statement or potentially a brand.*

*I also took into account the annual reviews and other articles where the mark had been used either discreetly within text or in some cases as a larger more prominent text block across or down the page. In all instances these uses were accompanied by the brand of the organisation, namely, NCDL or Dog’s Trust, and therefore appeared again to be a slogan of a general promotional nature, rather than indicating brand origin when viewed alone.*

*Other uses of the mark appeared to be promotional matter and therefore not essentially denote brand origin, but to inform the reader that the term was intended to convey meaning, namely that it is important to recognise that ‘a dog is for life, not just for Christmas’.*

*I feel in conclusion that the evidence, while well founded and presented, is not capable of showing that the mark is purely to be seen as a distinctive brand, and therefore not capable of convincing me of distinctiveness acquired through use of the mark. In light of my decision, I would recommend a hearing with a senior officer, who may be able to consider your mark in more detail.”*

7. A further statutory declaration (undated and unsigned) by Ms Baldwin was filed on 10 December 2014 and in an accompanying letter the applicant asked that this declaration constituted the evidence Ms Baldwin had declared on 31 October 2014.

8. In addition, further time was requested to submit more evidence of acquired distinctiveness and this was filed on 26 March 2015 in the form of a witness statement of the same date, together with exhibits from Mr Adrian Burder.
9. At the same time, by letter dated 21 January 2015, the applicant made a number of submissions regarding the prima facie case and also, that of acquired distinctiveness. The applicant said, in reliance on the well-known *Audi AG v OHIM* (Case C-398/08 P) (*'Audi'*) case, that signs can send objective messages and still function as trade marks. Applying that guidance, the examiner ought to have considered the impact of the sign in relation to the specific goods and services. In that regard, and for example, goods such as bags or figurines are not linked in any way to responsible dog ownership. Specifically, the applicant cited goods of classes 3, 18, 20, 31, 41 and 43 as comprising goods or services in respect of which the sign would not be 'promotional' or 'inspirational' and, to make any kind of link with those goods would require, what was termed an 'additional mental step'. This additional mental step would mean that the consumer would not immediately perceive the sign as being devoid of distinctive character. Likewise, as regards certain services, such as 'research in the field of animal and pet welfare' or even 'boarding kennels', the applicant submitted, similarly, would not involve responsible dog ownership, *per se*.
10. As regards the question of acquired distinctiveness, the applicant said it had been using the mark since 1978 and it has been exclusively associated with the applicant since that time. It is noted that the mark had been accepted for registration under number '463 in respect of, inter alia, fundraising and charitable services, all relating to the care and welfare of dogs and also for veterinary services. In principle the applicant says that that earlier acceptance shows that an extension to those services must therefore be possible.
11. The applicant acknowledges that much of the use is in conjunction with other trade marks such as 'The National Canine Defence League', or 'NCDL' up to 2003 and 'Dogs Trust' thereafter. That said, and in reliance of the well-known *HAVE A BREAK* case (Case C-353/03 *Societe des Produits Nestle SA v Mars UK Ltd* [2005] ECR I-6135), the applicant's use with other trade marks would not act as a barrier to demonstrating acquired distinctiveness. Moreover, the fact that certain use may be seen in a promotional context is inevitable given the applicant's charitable status and activities and would not, in any event, act as barrier, either, to showing acquired distinctiveness
12. As I have said, a request was made to file further evidence to satisfy the examiner and this was allowed. The further evidence, alongside the submissions as above, was assessed and the examiner wrote as follows on 1 April 2015:

***"Use of the mark***

*I am inclined to agree that the relevant consumer (the public in this case) would not view, for example "bags" as being linked to responsible dog*

*ownership, however, I do feel that this may stretch how much emphasis the relevant consumer would place on a message seen on the side of a bag.*

*In the current climate of advertising it is often the case that promotional strap lines, slogans and phrases are seen on multiple products as purely a means of promoting the goods and services of an organisation, however, the terms seen on such materials can vary from distinctive brands, to completely non-distinctive or descriptive terms.*

*In the case of “A dog is for life not just for Christmas” I feel that the term serves more as a promotional message, that remains to be seen as a term informing individuals that a dog is to be kept for life and not just owned for a short period as a Christmas present.*

*In this context as a promotional message I feel it could function as a non-distinctive statement when seen anywhere, and the link of ‘responsible dog ownership’ is therefore not required when assessing how the mark is used for such goods. The “Feedback Matters” case (BL 0/185/12) refers in the following paragraph:*

*“In relation to the comments at paragraph 21 about “office functions”, I would not have separated these services out from the rest of the specification as giving the Mark more chance of being accepted. The power of the Mark to individualise office functions, even if restricted to something like photocopying services or phone answering services, as suggested by the hearing officer, seems to me to be no greater than for the other services. Although the Mark is less obviously potentially descriptive of what the services entail, it nevertheless remains lacking in the ability to denote origin without first being used in a way that would educate business people that this is its purpose.”*

*In the same light as the above, I feel that a phrase such as “A dog is for life not just for Christmas” would not be required to be linked definitively to the notion of responsible dog ownership being specifically linked to the bag one acquires, but rather that it could be used anywhere as a term that nevertheless remains lacking in the ability to denote origin without first being used in a way that would educate business people that this is its purpose. – and the education in this case would be required to show the mark solus, used as a brand in its own right.*

*The evidence submitted is mainly seen on promotional goods such as stickers, tee-shirts, in shop windows and on carrier bags, leaving the relevant consumer to appreciate the mark in a promotional context, as these types of channels are often used to advertise or present advertising slogans. Other advertisements are seen in the Dog’s Trust magazine “Wag”, which is circulated to it’s 34,000 members throughout the UK. Although this is representative of the charity’s customers, it would do little to educate members of the general public (who we agree is the relevant consumer here)*

and rather would reinforce the promotional message in a campaign amongst the charity's members.

When the slogan is presented on the "street art" it is mostly seen in a stylised font and with an image of a dog, thus an additional level of context and stylisation is provided. Nevertheless, I feel that when seen in this light I would merely perceive the message to be a slogan that informs the relevant consumer that a dog is for life and not just for Christmas, rather than attributing a brand ownership to it that supplies me with a badge of origin. In this light I feel the relevant consumer would be left searching for a trade mark alongside the mark to allow the consumer to apportion a brand to the term.

Where the term is used in conjunction with the "Dog's Trust" branding I feel that it is this branding with either the words "Dog's Trust" or the stylised dog logo that adds the distinctive brand element and allows the consumer to relate to the slogan as coming from that source.

Referring to your argument in relation to the above issue, i.e. that the "slogan like phrase, associated with a trade mark can, by repetition over time, create a separate and independent impression", I feel that although the slogan may have gained an association with the house mark in this case, it is incapable of functioning as a badge of origin without the aforesaid house mark, and I therefore do not feel that it represents a case on all fours with the KitKat decision.

In the Kit Kat decision the term "Have a Break" was an integral part of the overall composite term "Have a Break ... Have a KitKat" and therefore a comparable mark in relation to this application would be something like "A dog is for life ... Dog's Trust" to argue that the house mark "A dog is for life" has the same level of impact.

### **Earlier right**

In considering the earlier right owned by the same applicant I appreciate that this was accepted in 2001 but feel that it was based on a different set of evidence at a different time, and that at the time the examiner considered the evidence to be sufficient to allow acceptance of the mark. However, although the distinctiveness of the mark was fulfilled at the time (13 years prior to this case) for the goods and services that were the subject of that application, practice has evolved in relation to the assessment of evidence since this time.

The "Treat" decision gives further support to the registry in respect of this stance:

*"The individual circumstances surrounding each application are paramount. 'Precedents' cannot be decisive.*

*The comments made in the MADAME case (1966) RPC page 545 were re-stated by Mr Justice Jacob in the TREAT trade mark case (1996) RPC page 25:*

*“In particular the state of the Register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. Madame TM and the same must be true under the 1994 Act.”*

### **Conclusion**

*In conclusion, I feel that the mark is used mainly in a promotional context whether seen with or without the house mark, and the earlier trade mark owned by the same organisation was accepted based on evidence that was submitted at a time prior to that of our current practice, and at a time when continued exposure of the mark was able to render it a functional trade mark for the goods and services that were the subject of that application. When used in conjunction with the house mark I feel that the house mark is prominent and that the term “A dog is for life not just for Christmas” is a non-distinctive promotional phrase that remains, in my opinion, incapable of denoting brand origin.”*

13. Following this, the applicant requested to be heard and this took place before me on 6 July 2015 at which the applicant was represented by Ms Alaina Newnes of Counsel, instructed by Charles Russell Speechlys ('CRS'). Also in attendance at the hearing were Kate O'Rourke of CRS, Chrissie Paphiti of Dogs Trust and Jason Aghatise of CRS.
14. It is necessary to summarise the evidence filed in this case and which gave rise to the previous correspondence referred to and quoted from, above.
15. The applicants rely on three witness statements, two by Ms Clarissa Baldwin dated 25 June 2001, in respect of the earlier registration '463, as well as the later declaration dated 31 October 2014, updating the evidence filed in respect of '463, and one witness statement by Mr Adrian Burder dated 26 March 2015. I should explain that Clarissa Baldwin is, or was, the Chief Executive and Secretary of Dogs Trust and is also responsible for devising the mark and Mr Adrian Burder is the current Chief Executive of Dogs Trust.
16. Ms Baldwin said in support of the '463 registration which had been filed in the name of National Canine Defence League '(NCDL'), the former name of Dogs Trust and which changed in 2003, that she had devised the slogan in 1978, and since 1979 the mark had been extensively throughout the UK and had been totally associated with the charity for the past 22 years. She goes on to list the goods and services on which the sign had been used and these include: newsletters, advertising literature,

posters, photographs and publications for fundraising, all in Class 16. The mark was used in relation to the applicant's core charitable and fundraising activities in Class 36 and its re-homing centres, veterinary and legal services as well as computer programming in Class 42.

17. Exhibit CB1 shows the applicants printed NCDL newsletter from the years 1979 through to 1996 which is circulated to members as well as the general public. The numbers printed vary from 20,000 in 1979, rising to 80,000 in 1989. The printed numbers peak in the Spring of 1993 with 120,000 and fall back to 100,000 for the years 1993-1996. The printed newsletter was then replaced by the applicant's "WAG" magazine in 1998 (Exhibit CB2). The printed numbers for this start at 200,000 in the Winter of 1998 and by the Spring of 2001 had risen to 340,210, of which 269,318 were mailed, including 707 abroad.
18. Exhibit CB3 comprises Annual Reports for the years 1990-1996, excluding 1994 and these were distributed to members as well as the general public with print runs varying from 30,000 in 1990 to 40,000 in 1996.
19. Exhibit CB4 is the NCDL centenary book celebrating 100 years existence of the charity in 1990. 5000 copies of this book were printed in the UK.
20. Exhibit CB5 is a copy from the Collins Dictionary of Slogans 1997 which refers to the slogan as being that of the applicant.
21. Exhibit CB6 is a copy from the Oxford Dictionary of Phrase, saying and quotation 1997 which also refers to the slogan as being that of the applicant
22. Exhibit CB7 shows an extract from the Oxford Dictionary of Quotations 1999 edition. Number 11 in the list on page 58 shows the mark as filed attributed as the slogan of the applicant.
23. Exhibit CB8 is a Christmas card produced by the applicant which displays the mark as filed. 12,600 were printed but they are not dated.
24. Exhibit CB09 shows use of the sign on Christmas cards produced by the applicant in 1999/2000, 20,000 of these were printed per year.
25. Exhibit CB10 shows a poster with the mark shown as a slogan. This is not dated.
26. Exhibit CB11 comprises a paper folder with the mark printed on it.
27. Exhibit CB12 comprises a car window sticker with the mark displayed – dated 1995
28. Exhibit CB13 also comprises a car window sticker. The applicant states that some 2.5 million of these stickers with the mark displayed were distributed across the UK between 1995 and January 2001.

29. Exhibit CB14 comprises a Christmas catalogue from the year 2000. 443,000 of these were printed and distributed, showing several merchandising items, none of which appear to have the entire mark on them. Often the mark is split into two elements e.g. 'A dog is for Life' or 'Not just for Christmas'.
30. Exhibit CB15 comprises a photograph of the NCDL Head office building. The mark is displayed outside, prominently and without additional material.
31. Exhibit CB16 comprises a photograph of 3 dogs with the mark displayed on a banner in the picture.
32. Exhibit CB17 comprises a photograph of the applicant's mobile educational unit, a vehicle used at shows and country fairs, to promote the applicant's services and educate the public about the care of dogs generally. The sign is presented on the side of the vehicle but not in isolation, in combination with the applicant's NCDL logo.
33. Exhibit CB18 is a T-shirt with the sign on the front and back, split into two parts. On the front of the shirt the words 'A Dog is For Life' and on the back 'Not Just for Christmas'. There are no indication of numbers produced or sold/distributed and no idea of costs or date.
34. Exhibit CB19 is a yellow tea towel which is pre-1995, as the address shown is the applicant's old address. The mark is printed on the towel.
35. Exhibit CB20 comprises the applicant's raffle tickets from 1997-2000. There is some minimal use of the mark but this seems secondary to the main use of the NCDL logo.
36. Exhibit CB21 comprises children's school posters from 1997-2000, 'search for smudge' is the campaign message but the mark applied for is displayed.
37. Exhibit CB22 is a photograph of a billboard from the year 2000 Christmas campaign. This shows the mark clearly – in conjunction with the main NCDL logo however, although the mark applied for is the most prominent element on the billboard.
38. Ms Baldwin's witness statement from 2001 also sets out the amount spent on promotional materials, arranged by the various classes of goods and services as follows:
39. Within the scope of Class 16, the applicant paid for printed materials and miscellaneous promotional products. The costs of this were:
  - 1996 - £12,761.96
  - 1997 - £10,515.79
  - 1998 - £13,536.69
  - 1999 - £48,501.21
  - 2000 - £150,922.29

2001 - £87,514.62

40. The applicant spent money on promotional materials that promoted its activities in Class 36:

1997 - £27,009  
 1998 - £36,970  
 1999 - £55,467.83  
 2000 - £152,925.07

41. The applicant spent money on promotional materials that promoted its activities in Class 42:

1997 - £4,515  
 1998 - £1,085  
 1999 - £130,712.16 & £35,506.56  
 2000 - £375,237.54

42. The applicant also spent money advertising and promoting itself and the services it provided:

1996 - £12,761.96  
 1997 - £10,515.79 Advertising & £27,009 Marketing  
 1998 - £13,536.69 Advertising & £36,970 Marketing  
 1999 - £115,020.89 Advertising & £64,373.99 Marketing  
 2000 - £390,241.80 Advertising & £151,728.56 Marketing  
 2001 - £16,840.62 Advertising & £70,674 Marketing

43. Ms Baldwin's second statutory declaration, dated 31 October 2014, seeks to fill in the gaps between the years 2001 and 2014, both in terms of the use of the mark and also to justify the extension of the rights to the additional goods and services listed in the current application over and above those for which the mark is already protected in relation to registration '463. The various exhibits are listed as follows:

44. Exhibit CB1 is a copy of the Statutory Declaration filed by Ms Baldwin in 2001

45. Exhibit CB2 comprises examples of the applicant's magazine 'Dog Tales' 2010 and 2014. This is a printed newsletter which depicts the mark "A Dog is for Life not Just for Christmas". There is an estimated distribution of the newsletter throughout Dublin through circulation to supporters and ordinary members of the public. It describes use of the sign since 1978.

Page 1&3 Winter 2010, with a printed estimate of 12,000.

Page 1 Spring 2014, with a printed estimate of 20,000. The mark "A Dog is for Life not Just for Christmas" is depicted on the plastic water bottle at the bottom of the page.

Page 1 Summer 2014, with a printed estimate of 20,000. The mark “A Dog is for Life not Just for Christmas” is depicted on a school book featured on the right hand side of the page.

46. Exhibit CB3 is Dogs Trust Dog Manifesto. The publication was distributed to Members of Parliament, their advisors, policy makers, local authorities and other animal organisations in the run up to the 2010 general election. The mark “A Dog is for Life not Just for Christmas” is depicted on the front page and there is an estimated distribution of the publication of 1000.
47. Exhibit CB4 is a copy of the Scoop magazine cover from Autumn 2010. The publication sets out the recent work and campaigns and introduces the work of the applicant and the mark to celebrities who had no former connection to the charity. The publication shows how other high profile supporters have got involved with the charity and highlighted future campaigns and encourages their involvement. There is an estimated distribution of the publication of 200.
48. Exhibit CB5 comprises copies of Wag magazine from 2010 and 2013. This is a printed magazine that goes out to all members, distributed throughout 21 re-homing centres nationwide, at public events and abroad. The estimated distribution of the publication is given as follows:
- Autumn 2010 with a printed estimate of 708,000 and was posted to approximately 700,000 supporters. The mark “A Dog is for Life not Just for Christmas” is depicted at the bottom of the page.
- Spring 2013 with a printed estimate of 780,000.00 and was posted to approximately 700,000 supporters. The mark “A Dog is for Life not Just for Christmas” is depicted on the right hand side of the page.
49. Exhibit CB6 comprises the Annual Review of Dogs Trust 2013 and this shows an explanation of the mark applied for and states ‘Definition: English Phrase, in common usage since 1978’. The question as to what exactly ‘common usage’ meant was raised by me at the hearing and the answer is recorded below.
50. Exhibit CB7 comprises a print out from Dogs Trust website which depicts the sign “A Dog is for Life not Just for Christmas” on its home page. The website has “users” who are unique people that visit the website numerous times and visits to the website otherwise known as “sessions”. There are currently 511,293 users and 860,191 sessions. This exhibit is dated 28 October 2014 and so is, technically, out of scope but I have nonetheless taken notice of it, in terms of what it may indicate or suggest prior to the date of filing.
51. Exhibit CB8 is a car window sticker depicting the mark “A Dog is for Life not Just for Christmas”. We are told that window stickers are, however, apparently used on houses as well as cars. The applicant printed 1,854,000 stickers for use in cold mailings. In 2013 they sent 2,211,099 cold mailings with the window stickers enclosed and this breaks down as follows. In January 2013 they mailed 400,746 and

in July 2013 they mailed 332,225. In September 2013 they mailed 357,737 and in November/December 2013 they mailed 1,120,391. All examples show the mark in combination with Dogs Trust logo.

52. Exhibit CB9 comprises T-shirts for volunteers, depicting the mark “A Dog is for Life not Just for Christmas”. In 2014, the applicant had 100 printed and plan to print more for volunteers and staff. All examples show the mark in combination with the Dogs Trust logo.
53. Additionally, Ms Baldwin provides further information regarding promotional and marketing expenditure between 2009 and 2014 as follows:

2009 £ 1138  
 2010 £4717.63  
 2012 £2086.50  
 2013 £159,863.89  
 2014 £8731.03

54. Mr Burder’s witness statement starts by giving some background to the history of the mark. This is set out in para [6] which reads as follows:

*The Trade Mark was created by our former CEO, Clarissa Baldwin, in 1978 when she held the position of Head of Public Relations at the Trust. The Trust wanted a campaign slogan due to the number of dogs which were bought as Christmas presents which was very commonplace at the time. At the time the NCDL was struggling to cope with the high numbers of stray dogs and we wanted to launch a new campaign to highlight the callous way in which puppies and other dogs were being bought on a whim only to be abandoned, in a similar style to how other presents are discarded, both at Christmas and all year round. The new campaign was also to educate people that a dog should be part of its owner’s life, for life.*

55. He says that the mark has become an integral and synonymous part of the Trust’s charitable activities. In 1974 the Trust had an income of approx £750k and now it is one of the largest dog charities in the UK, having an income of £84 million.
56. The Queen has been the official patron of the Trust since 1990 and opened the first Trust re-homing centre in Scotland in 1994. There have been many other famous/celebrity patrons, including: Eamonn Holmes, Jilly Cooper and Keith Floyd.
57. The Trust has a network of 20 re-homing centres across the UK and Ireland.
58. In 2013, Mr Burder says the applicant micro-chipped 90,968 dogs and gave away 35,000 microchips. The applicant also spent £5 million as part of their neutering campaign.

59. The Trust has donated £37,960 to an emergency help fund for veterinary services and it has worked with the Greyhound Forum to work on providing better lives for greyhounds.
60. As part of their ongoing research programmes the Trust has given away more than £1 million in the past 10 years.
61. The Trust's website received over 5.3 million unique visitors in 2013 and they have more than 590,000 Facebook followers and 118,000 on Twitter. Membership of the Trust costs £25 per year and the applicant currently has 34,000 members. The following exhibits are filed.
62. Exhibit AJB 01 comprises basic information referring to the applicant's earlier trade mark registrations, namely:
- 2041757 18 October 1995 "A Dog is for Life" Class 36 'Charitable services included in Class 36'.
- 2107302 09 August 1996 "A Dog is for Life" Class 42 'Charitable services included in Class 42.
- 2264463 17 March 2001 "A Dog is For Life not Just for Christmas"
63. Exhibit AJB 02 is a copy of the letter from the applicant dated 21 January 2015 responding to the examiner's objection in the matter at hand (3069768).
64. Exhibit AJB 03 comprises copies from the applicant's newsletter 'Wag!' which is published 3 times a year and has been in existence since 1995. Exhibited are pages from the Autumn 2013 edition, celebrating the 35 year anniversary of the trade mark "A Dog is For Life not Just for Christmas". Also provided are earlier editions showing the mark in use and the 1995 edition showing the mark on Christmas billboards.
65. Exhibit AJB 04 shows that the Trust sends out mailings, warm and cold, to existing or potential supporters. Since 2010 the applicant has sent more than 12 million mailings at a cost of £5,902,466. With every mailing the applicant includes a car window sticker that displays the mark applied for. As a result the applicant estimates that more than 3 million cars in the UK currently display the Trust's window sticker.
66. Exhibit AJB 05 shows an example of a cold mailing. The mark is shown on the back of an envelope, combined with the Dogs Trust logo.
67. Exhibit AJB 06 comprises the 'Canine Care Card' ('CCC') scheme. This is a free scheme where dog owners can register for the Trust to take their dog into care if anything happens to the owner. This exhibit shows the mailing information that is sent out in respect of the CCC. The mark does not appear on the card itself, only the literature explaining the scheme.

68. Exhibit AJB 07 comprises photographs of the applicant's charity shops. The applicant runs 19 such outlets across the UK. The mark applied for is displayed in the shop front windows but is used in conjunction with the main Dogs Trust logo.
69. Exhibit AJB 08 comprises a spreadsheet showing investment in producing materials for fundraisers to hand out. From 2009 to 2015 this is over £82,000; however, when considering the filing date of 22 August 2014, the true figure is £73,284.
70. Exhibit AJB 09 comprises a photograph of the applicant's stand at the famous UK dog show, 'Crufts'. The mark applied for is shown on a banner on the stand.
71. Exhibit AJB 10 comprises a yellow bag with the mark shown on the side in basic print. These bags were given out at Crufts and the mark is shown in 30 languages with English at the top of the list. The applicant then refers to the line of merchandise items that it provides to help promote its activities. The applicant states that the continued extension of the range of products is one of the main reasons behind filing the application to extend protection.
72. The applicant lists examples of the goods it currently provides:

Exhibit AJB 11 – being mousemats, with an invoice from 2007 for 1000 mats.

Exhibit AJB 12 – being fridge magnets, an example of one is provided showing the mark.

Exhibit AJB 13 – being cotton tea towels which have been available since 2001 and an invoice is shown for an order of 1000 towels in March 2007, with a cost of £1,742.50.

Exhibit AJB 14 - being T-shirts, available since 2001. An example is provided from 2011. The mark is split into two, half on the front and half on the back.

Exhibit AJB 15 - being a standard yellow coffee mug with the mark applied for displayed in plain type face on one side, with a device element on the other side, showing a dog's head in black, together with the applicants name Dogs Trust.

73. Exhibit AJB 16 is a list of purchase orders for merchandise products in 2011. The total cost to the applicant was £12,923.09. The list relates specifically to:

420 shopping bags, 250 umbrellas, 500 rucksacks, 600 bandanas, 559 T-shirts,

150 baseball caps, 150 rope toys, 150 tea towels, 300 dog food bowls and 200 plastic mugs.

These goods are covered under the specification of the current application.

The list also relates to:

136 stationery sets, 420 parker pens, 150 mouse mats. These goods are outside the scope of the current application.

I would just observe at this point that the issue of exactly what the applicant is selling (or giving away for free) with the mark applied to it, is slightly complicated because on some of the products the mark is split up, on some the NCDL or Dogs Trust logo is included and on much of it, there is no indication from the applicant that the mark is applied to the products.

74. Exhibit AJB 17 shows that the applicant operates a website where the public can buy merchandise items. This is one way the applicant raises funds for its activities.

The applicant states that *“currently, the items for sale which are branded with the Trade Mark are tea towels, mugs, dog bowls, dog car safety harnesses, collars and leads.”*

75. Exhibit AJB 18 indicates that in 2014 the applicant ran a campaign which involved producing 12 murals in 12 cities across the UK over a 12 day period. All 12 murals are shown and it can be seen that the mark is presented at the bottom of each one. These murals are dated as at Christmas 2014. It can be concluded that, based on the dating of evidence on exhibits AJB 19, 20 and AJB 21, the murals were probably created in each city after the date of filing of this application (22 August 2014), nearer to Christmas, if not in the month of December itself, but for the sake of completeness I have recorded the exhibit and will not dismiss its significance out of hand.
76. Exhibit AJB 19 comprises a memory stick which shows two news items on the applicant’s campaign from BBC Look North from 1 December 2014 and ITV Meridian from 6 December 2014. As both items are, strictly speaking, dated after the date of filing of the application, this information is not material to these proceedings but I have nonetheless recorded it in the same way as the mural campaign above and will not dismiss its significance out of hand.
77. Exhibit AJB 20 comprises a selection of invoices relating to the creative design and photography elements of the mural campaign. The 7 invoices total £24,022.95. They are dated from 6 November 2014 to 17 December 2014 and are therefore later than the filing date of the application and, again strictly speaking, cannot form a part of these proceedings but I have nonetheless recorded the exhibit and will not dismiss its significance out of hand.
78. Exhibit AJB 21 comprises online articles featuring pictures of the murals. The applicant points out that only the mark as filed is presented on the murals and not the usual Dogs Trust logo or a combination of other elements. However the mural campaign appears to be the 2014 Christmas campaign and as such is not, I repeat, and strictly speaking, material to these proceedings as the mark was filed on 22 August 2014. That said, I picked up at the hearing that the article refers to the mark

as being 'reclaimed' by the applicant. The response is recorded below at paras [90] and [91].

79. Exhibit AJB 22 attests to the fact that in 2013 the applicant collaborated with the cosmetics company, Models Own, to create a limited edition nail varnish to celebrate the 35<sup>th</sup> anniversary of the sign. The bottle cap of the varnish displays the mark and the applicant retailed this product on its website. Some blog articles and a Daily Mail article are shown to highlight this project. No sales figures are given.
80. Exhibit AJB 23 comprises photos of the applicant's fleet of cars, vans and animal ambulances as well as two mobile "Dogmobiles" that travel the country visiting county shows, town centres and supermarkets educating people. The mark applied for is only partially displayed on the vehicles.
81. Exhibit AJB 24 comprises examples of third party references to the mark applied for. These are dated 2008-2013.
82. Exhibit AJB 25 comprises examples of authorised use of the mark by others, which shows the widespread recognition and respect of the mark and the applicant. These are dated 2004-2014. By way of example only, authorised uses listed (totalling 13) include, in 2004 by TESCO, 'A customer is for life, not just for Christmas', in 2009 by Marks & Spencer, 'A bag is for life, not just for Christmas', in 2014 by The Gloucestershire Historic Churches Trust, 'A church is forever, not just for Christmas'.
83. Exhibit AJB 26 comprises examples of unauthorised use of the mark by others. By way of example only, unauthorised uses (totalling 6) listed include, in 2004 by Ann Summers, 'A rabbit is for life, not just for Christmas', in 2014 by Mulberry, 'A bag is for life, not just for Christmas'. At the hearing I picked up on the examples of authorised and unauthorised use to better understand the applicant's response to such use. The response is recorded below at paras [90] and [91].
84. Prior to the hearing a very helpful skeleton argument had been filed and which covered Ms Newnes' key submissions which I need to record in summary and which built upon the submissions already made in correspondence. As regards the prima facie case, Ms Newnes' submissions were that:
  - The mark is original, memorable and neither laudatory nor descriptive of the goods or services;
  - In any event, being original or having resonance were not requirements for a sign to be able to function as a trade mark (see, e.g. the recent case of *Go Outdoors Ltd v Sketchers USA Inc* 11 [2015] EWHC 1405 (Ch) at para [24]);
  - The mark required a degree of 'mental agility or unpacking' in order for its meaning to be discerned;
  - In any event, a mark with a clear meaning could nonetheless function, and be recognised, as a trade mark as in e.g. EVERY LITTLE HELPS or JUST DO IT;
  - The goods and services can be divided into three categories: firstly, those in relation to which there is no connection with responsible dog ownership and these included e.g. key fobs, bags, baskets, textiles, clothing and toys; secondly,

those in relation to which may have some connection with dogs and these included, e.g. shampoos for animals, toys for animals and food for animals; and lastly, those which may be said to concern responsible dog ownership and these included, e.g. education in the field of animal welfare and boarding kennels. It was Ms Newnes' contention that the mark was not laudatory or descriptive of any of the goods or services. Or, at the very least it was only indirectly so. At the hearing I should record that, in response to my question, she was not submitting that for a sign to be considered devoid of distinctive character, there had to be a literal link between the goods and services and the sign. In other words she conceded that a sign submitted for registration need not be 'informative' in some way of the goods or services for it to be considered 'origin neutral' by the relevant public;

85. I should also record the response to my question at the hearing as to why the applicant had not argued the prima facie case (and instead, had immediately submitted evidence of acquired distinctiveness) in relation to its earlier registration(s), thus appearing, at least tacitly, to have resiled from its previous position in relation to the prima facie case. Ms Newnes responded by saying that no explicit concessions in relation to the prima facie case had been made in relation to its earlier registration(s) and that at the time of filing the applicant was without the benefit of legal advice and this may have explained the earlier position.
86. I should also record that Ms Newnes disputed my characterisation of the mark at the hearing, along the lines of the mark being 'a narrative exhortation to responsible dog ownership and giving'. I had characterised the mark in this way, specifically to avoid labelling the sign as being 'promotional' or 'inspirational', terms which had been used by the examiner in his correspondence. I said such terms were, or could be, unhelpful in my analysis, as indeed, could be categorising the sign as a slogan at all, when, in the prima facie and abstract at least, it may not be the case. In Ms Newnes' submission the mark was not a simple narrative.
87. Although no decision on the prima facie case was given at the hearing, lest I was against her in that regard, we went on to discuss the evidence of acquired distinctiveness.
88. Ms Newnes asked me to take special note of the use in relation to stickers and the mail outs which included the sign on the envelope as well as inside on the letter itself. She also asked me to take note of the amount spent by the applicant on its promotional material. In view of the case law, to which I shall refer below, she had helpfully indicated in her skeleton argument evidence which showed use of the sign, *solus*, and without any other indicia, such as Dogs Trust. This included in relation to Christmas cards at CB1, although these also have NCDL in small font, printed between 1999-2000; on the front of the applicant's office, in or before 2001 CB1; the 1994 poster campaign used in over 280 sites in London and every veterinary practice, AJB3 and the 2013 street art campaign, AJB 21.
89. As regards the evidence that showed 'combined use', that is, alongside or in conjunction with Dogs Trust or NCDL, Ms Newnes submitted that such use would

not, having regard to the case law referred to below (*HAVE A BREAK*) act as barrier to registration on the basis of acquired distinctiveness. Even in the context of what may be regarded as clarification of the '*HAVE A BREAK*' case by the later, and very recent Advocate General's Opinion in Case C-215/14 *Societe des Produits Nestle SA v Cadbury UK Ltd* (see paras [43] – [53] on combined use)<sup>1</sup>, she said the evidence met the required standard in this case. That is to say, although much of the use may be characterised as 'combined use', the sign stood out as a separate, complete and independent sign in its own right and apart from 'NCDL' or 'Dogs Trust'. It was clear from our discussion at the hearing that Ms Newnes was very familiar with the recent AG Opinion in Case C-215/14 and this is unsurprising given the extensive coverage it has received.

90. I should also record the answers to three questions I posed at the hearing in relation to three exhibits which appeared, at first sight, either to act against the applicant or that I felt required clarification. Firstly, as regards Exhibit CB6 to Ms Baldwin's witness statement of October 2014 which, taken from the applicant's own Annual Review, gives a definition of the mark and which says the mark is 'in common use'. Ms Newnes explained that that definition referred to the applicant's own use and that explanation was consistent given that the mark would hardly have been likely to have been in use by others from the date of its inception. Secondly, I asked about the word 'reclaim' in Exhibit AJB 21 which appears, again at first sight, to amount to a concession that the sign was, in fact, or had been up to that point, in general use by many undertakings. The response was that the word 'reclaim' was not one the applicant had chosen itself; the author of the article in PR Week had used the term and it should not be held against the applicant.
91. Finally, I asked about the action taken by the applicant in relation to unauthorised use by others of the mark itself, or more likely, an adaptation of it. Ms Newnes said that, howsoever such use came to the applicant's attention, the applicant would take action by means of a 'cease and desist' letter and matters may ultimately be resolved by a retrospective license which may entail a donation to the charity and/or some form of acknowledgement of the applicant's rights to the mark.
92. At the hearing I reserved my decision, both in the prima facie and on the basis of acquired distinctiveness.
93. Finally I should record that Ms Newnes offered at the conclusion of the hearing to file any supplementary evidence I may deem necessary to make good any shortcomings I felt existed in the case for acquired distinctiveness.

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<sup>1</sup> At the time the hearing took place, the Advocate General had given his opinion in Case C-215/14, being a reference from the UK High Court on the question, inter alia, of acquired distinctiveness. Although the question was posed in the context of shapes ('KIT KAT'), its relevance for other types of marks was, at least at the hearing, not disputed. At the time of finalising this statement of grounds and full decision, events have moved on as far as Case C-215/14 is concerned. The CJEU has given its answer and this answer has been applied ('adapted', may be a better term) by the High Court in *Societe des Produits Nestle SA v Cadbury UK Ltd* [2016] EWHC 50 (Ch). It is, however, important in this case to note that, notwithstanding, the developments or clarifications in the KIT KAT case, I would have refused this application, based on known and established principles at the date of filing and the hearing.

94. Following the hearing, on 21 July 2015, I formally refused the application and am now required to provide a full statement of reasons for my decision.

## Decision

### The prima facie case: section 3(1)(b) legal principles

95. As the applicant has not conceded the prima facie case, I am required to deal with that as a first step and it helps to set out the legal principles.
96. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94) in light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph [59] and the case law cited there, and e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).
97. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that "*...the public interest... is, manifestly, indissociable from the essential function of a trade mark*" (Case C-329/02P '*SAT.1*' *Satelliten Fernsehen GmbH v OHIM*). The essential function, thus referred to, is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see para [23] of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of' from the perspective of the average consumer.
98. It follows from the above that the application of section 3(1)(b) and (c) is not necessarily co-extensive; it may be, but not in all cases. A sign may both designate a characteristic of the goods or services and for that reason alone be devoid of distinctive character, but it may also be devoid of distinctive character notwithstanding that a characteristic of the goods or services is not designated – see, e.g. BL O/313/11 *Flying Scotsman*, a decision of the Appointed Person at para [19].
99. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Para [34] of the CJEU Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('*Postkantoor*') reads as follows:

*"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services*

*and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75)."*

100. So, the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer for those goods or services.
101. It is also a well established principle these days that the registrar's role is to engage in a full and stringent examination of the facts, underling the registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541. Whilst that case was, technically speaking, in relation only to section 3(1)(c), or its equivalent in European law, the principle about the 'prevention of undue monopolies' must hold good whether section 3(1)(b) and/or (c) applies.
102. In applying these principles to this case, it is nonetheless important I am convinced that the objection applies to *all* the goods and services applied for. If there are goods or services specified which are free of objection under section 3(1)(b) then they must be allowed to proceed. In the CJEU case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the question being referred to the Court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The Court answered, and in para [38] said that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the Court also confirmed that the competent authority may use only general reasoning for all the goods and services concerned. It is plain from this judgment that the Court had in mind purely practical considerations which had to be balanced against a legal provision in the Trade Marks Directive which allows for refusal only in relation to goods and services where objections apply.
103. The above principles have, in the UK at least and in essence, helpfully been synthesised into a single test, as expressed in the case, e.g. BL O/561/01 '*Cycling is...*' which, at para [69], identifies the relevant question as being whether the perceptions and recollections the mark would trigger in the mind of the relevant consumer would be 'origin specific' or 'origin neutral'. This distillation of the relevant question has been consistently and uniformly applied over the years, in the UK at least.
104. Perhaps the only points to add to this distillation is that the test appears to be one that needs to be applied in the context of 'immediate impression' (see e.g. Case C-136/02 *Mag Instrument* at para [50]). Finally, and by way only of clarification, that in making the assessment in the *prima facie*, it is not about whether consumers will

have seen the mark before, or never seen the mark at all; it is about whether consumers will see the mark as denoting origin and without the need to be educated that it is a trade mark.

105. I do not understand Ms Newnes to take any issue with such a statement of legal principles as she herself referred in her submissions to the notions of origin neutrality and specificity, as expressed in the '*Cycling is ....*' case.

### **Application of the legal principles in the prima facie**

106. The relevant consumer in this case is likely to be the general public who is deemed to be reasonably circumspect. For certain goods it may be said that the relevant public would be likely to be animal owners or, specifically, dog owners or lovers, but nothing turns on this in terms of such consumers being especially discerning as far as any trade mark messages may be concerned. As far as the services are concerned, some, such as boarding kennels will also be accessed by dog owning members of the public but other services, such as research, may involve other customers like veterinary or other researchers.
107. The mark comprises the words 'A dog is for life not just for Christmas'.
108. As I said at the hearing there is much in the previous correspondence about the mark being 'promotional' or 'inspirational'. I think these words could be misconstrued and could, at worst, be said to be infelicitous and I prefer not to use them. It is difficult, for example, to say that the sign is 'promotional' in the sense, e.g. of expressing something positive about the goods or services and neither is the mark 'inspirational' in the normal meaning of the term. Moreover, and quite rightly, such labels or descriptions will not, in and of themselves, inevitably lead to the legal conclusion a mark must by definition, be devoid of distinctive character. As the case law rightly states, marks that are promotional or inspirational, even those that are unoriginal can function as trade marks and be registered accordingly.
109. I do not consider it wrong, however, to characterise the sign as comprising a grammatically correct, narrative exhortation towards responsible dog ownership and responsible dog-giving. The specific problems associated with abandoned puppies and dogs at the time the mark was first devised, and up to the present, are what gave rise to the mark in the first place and the mark, very neatly, draws attention to those problems and urges responsible ownership of sentient domestic animals. Without question, the mark carries a punchy and effective narrative message; the tone is admonishing if not censorious.
110. Needless to say I have carefully considered the goods and services applied for, as I must. I regard all the goods and services, in whatever category Ms Newnes has adopted in her submissions, recorded at para [84] above, as being capable of carrying such a message in normal and fair use. So, for example, even in what may be called the 'remote' category of goods (as in 'remote' from dog ownership or responsibility) such as key fobs and other such items; all are capable of bearing a message such as the mark; that much is proven in the evidence.

111. As far as the services are concerned some of these are, and as conceded, potentially and directly related to responsible dog ownership. As such, and even if the degree of literal connection between the services as specified and the mark may vary, such services can all be said to be susceptible to having such a mark used in connection with their provision. But being used in connection with such services in no way suggests that such a mark would perform the essential function of a trade mark to guarantee the origin of such goods or services.
112. Given my linguistic analysis of the mark in para [109] above. I have concluded that, in relation to all the goods and services, the perceptions and recollections amongst consumers would be 'origin neutral'. Notwithstanding that the message conveyed is not as simple or direct as 'Look after your dogs', and there is, then, a degree of mental effort in unpacking the message, such unpacking in this case cannot be said to convert the narrative into what would, in normal use and given a normal contextual understanding on the part of the relevant consumer in relation to the goods and services, result in a mark which conveys origin.
113. For these reasons the objection in the prima facie is maintained, across the board, for all goods and services

#### **Acquired distinctiveness: the legal principles**

114. The key legal principles may be stated as follows:

The proviso to section 3 based on acquired distinctiveness does not establish a separate right to have a trade mark registered. It allows an exception to, or derogation from, the grounds of refusal listed in section 3(1)(a)- (d) and as such, its scope must therefore be interpreted in light of those grounds of refusal – see, e.g case T-359/12 *Louis Vuitton Malletier v OHIM* and case law referred to at para [83].

Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness.

A significant proportion of the relevant consumers need to be educated that the sign has acquired distinctiveness.

If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee.<sup>2</sup>

It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or

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<sup>2</sup> Both the second and third two principles are stated in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513, paras [49] and [45] respectively.

service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression ‘use of the mark as a trade mark’ in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking;<sup>3</sup>

Acquired distinctiveness cannot be shown by reference only to general, abstract data such as predetermined percentages (see also *Windsurfing* (para [52]) case and others);

The mark must have acquired distinctiveness through use throughout the territory of the UK;

In assessing whether a trade mark has acquired a distinctive character, the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include: (i) the market share held by goods bearing the mark; (ii) how intensive, geographically widespread and long-standing the use of the mark has been; (iii) the amount invested by the proprietor in promoting the mark; (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor; (v) evidence from trade and professional associations; and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character;<sup>4</sup>

The position must be assessed at the date of application, being 22 August 2014.

It is also recognised, of course, that acquired distinctiveness may arise as a result of the use of a sign as part, or a component of, another sign or in conjunction with another sign, but this is not inevitably the case and the evidence must be capable of supporting such a conclusion.<sup>5</sup>

115. Further, and for the sake of completeness, and as mentioned at the hearing, in a then recent opinion in Case C-215/14 *Societe des Produits Nestle Sa v Cadbury UK Ltd* (*‘Kit Kat’*), Advocate General (‘AG’) Wathelet has expressed the following view on reference from the UK High Court:

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<sup>3</sup> See e.g. *Societe des produits Nestlé SA v Mars UK Ltd*, (C-353/03 (*‘Nestlé’*)); *Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99); *Henkel KGaA v Deutsches Patent – und Markenamt* (C-218/01) and also see Case BL O/166/08 *Vibe Technologies* to which I drew attention at the hearing (Para 60 onwards).

<sup>4</sup> *Windsurfing*; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-1318 at [23], *Philips v Remington* at [60]-[62], *Libertel v Benelux-Merkenbureau* at [67], *Nestlé v Mars* at [31] and C-25/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck II)* [2006] ECR I-5719 at [75].

<sup>5</sup> See e.g. Case C353/03 *Nestle* [2005] ECR I-6135 para 30 and others

*55. Consequently, in view of the foregoing, I consider that the answer to the first question referred for a preliminary ruling should be that it is not sufficient for the applicant for registration to prove that the relevant class of persons recognises the trade mark in respect of which registration is sought and associates it with the applicant's goods or services. He must prove that only the trade mark in respect of which registration is sought, as opposed to any other trade marks which may also be present, indicates, without any possibility of confusion, the exclusive origin of the goods or services concerned.*

115. The opinion also deals, at paras [43] - [52], with the question of combined use of a sign, that is to say, in conjunction with, or as part of another sign. As I understand it, the AG rejects the submission that such combined use of a sign, in and of itself, will result in acquired distinctiveness being shown, see paras [43] and [44], and instead stresses that the element applied for, *in and of itself*, must be shown to function as a guarantee of origin. As I mention above, in my footnote to para [89], events in this case have substantially moved on, with the CJEU issuing its full answer and that answer being adapted to the facts of the case in the High Court. In the High Court judgment, the CJEU's answer is adapted by Arnold J as follows:

*"in order to demonstrate that a sign has acquired distinctive character, the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question (as opposed to any other trade mark which may also be present)." (para 57)*

The above is provided for the sake of completeness only, since, as I have said in my footnote to para [89], and regardless of the 'because of' test above, this application would have been refused by me on the basis of long established principles. That is to say, and specifically, that even on the (now rejected) assumption that to demonstrate that a mark has acquired distinctiveness, all that the applicant need show is that the mark in question may be 'associated' with a particular undertaking, this case would not even pass that test on the evidence provided and neither could it be inferred.

### **Application of the legal principles to the evidence**

116. In my assessment of the prima facie case I was required to reduce the sign to its inherent linguistic essence in order to discern whether the relevant consumer's perceptions and recollections were going to be 'origin neutral' or 'origin specific'. I chose in this case to conduct that exercise, unencumbered by certain preconceptions such as labelling the sign as being 'promotional' or 'inspirational', or even labelling the sign a 'slogan' necessarily. Inevitably, in my analysis of the case for acquired distinctiveness, I am not constrained by the same reductionist approach and am able, or even obliged, to consider the context and effect of the applicant's use to discern whether the evidence takes me to the point where I can conclude that a significant proportion of the relevant public regard the mark, in and of itself, as a trade mark.

117. This is an especially stern test, in my opinion, where, as in this case, the slogan has been in use for over 35 years and has achieved such exposure and success, not just in a trading context but in its adoption as part of the common language as well, that its capacity to guarantee origin must, by definition, have lessened over time. Whether one regards it as being fair or not, this is truly a case where the slogan's fame, as shown by its spawned variants, has conspired, over time, to diminish its prospects of guaranteeing origin.
118. The fame of the slogan and its recognition amongst the public is not something I need to prove in this case; judicial notice in my opinion suffices. I would add, though, that this is backed up by the evidence itself, in terms, for example, of the lists of authorised and unauthorised users, exhibited to Mr Burder's witness statement at AJB 25 and 26 – see paras [82] and [83] above. The very fact other unrelated traders or undertakings have adopted and, significantly, adapted the mark illustrates that it is, in fact and at the material date of filing, very much embedded in the UK public's wider consciousness; it is a phrase which is, to coin another phrase, is very much 'in the common'.
119. As regards dictionary references, attributing the mark as the applicant's own slogan, such evidence cannot in any way be dismissed out of hand in terms of its value as evidence, but the ultimate and determinative guide for me is the extent to which that dictionary recognition is, in turn, recognised and confirmed by the perception of the relevant public. By 'recognised', I mean specifically that, for the legal standard to be met and shown, a significant proportion of relevant consumers must see the mark as denominative of, or guaranteeing, the origin of the goods and services in relation to which the mark is used.
120. As a recent demonstration of the pre-eminence of public perception I need look no further than the case of *Canary Wharf Group PLC v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch) at para [18] where the Judge specifically approves the right legal question to have been posed in that case as being, "how then does the public, at the material date of filing, perceive the area known as Canary Wharf – as an estate/development or as a business district'.
121. Dictionaries aside, at the hearing Ms Newnes drew attention to certain aspects of the evidence she felt represented her client's best case. Inevitably the exposure through, especially, the cold and hot mailings, the car stickers, the amount spent on promotional and the various marketing activities is all material that must be factored into my overall analysis. The evidence certainly demonstrates the applicant's use of the mark but in the last analysis this evidence must take me to the point that I can realistically infer, that a significant proportion of relevant consumers regard the mark, in and of itself, as guaranteeing origin.
122. In that last analysis of this case I am asked to make the relevant inference based on the evidence, only, of two people, both of whom are intimately connected with the applicant and one of whom devised the slogan.

123. In this case, it would be fair to say, in my opinion, the vast bulk of the evidence displays combined use, that is, use of the mark with other indicators or origin. Ms Newnes' list of use *solus* is, by comparison with the rest of the evidence, small and even then, includes material such as the Christmas cards which is acknowledged to contain the letters 'NCDL', although these are said to be *de minimis* in comparison with the mark itself. To me, and without wishing to be in any way prescriptive about this, it is sometimes a useful measure (though not, of course, determinative) in a case such as this, to view use, *solus*, as a litmus test almost as to the level of confidence the applicant itself puts in the sign as guaranteeing origin. I should say in this case, lest I be accused of setting the bar too high by seemingly insisting on *solus* use, in this case I am not sure that, even if *solus* use can be shown, as in, for example, certain of the murals, comprising the street art campaign, it is hard to see how such use would necessarily be seen as performing the essential function of a trade mark, as distinct from simply reinforcing the underlying core message I have discussed in para [109].
124. To remind myself of the various 'yardsticks' (not criteria as such) by which acquired distinctiveness may be assessed and as identified in the *Windsurfing* case: (i) the market share held by goods bearing the mark; (ii) how intensive, geographically widespread and long-standing the use of the mark has been; (iii) the amount invested by the proprietor in promoting the mark; (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor; (v) evidence from trade and professional associations; and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.
125. As regards (i) above, I would say the evidence contains little or no data on market share but frankly, in light of my overall assessment and the more fundamental obstacles encountered, as mere abstract data this is unlikely to have counted for much in any event. As regards (ii), the evidence appears to have addressed these matters. As regards (iii), the evidence also addresses these matters, though it is sometimes hard to link the specific goods or services to the amount spent on promotion of the same. This is not, however, an uncommon occurrence in these cases. As regards (iv) and, to my mind, the most critical yardstick, the evidence relies only upon the people providing the witness statements; no member of the relevant public has given evidence of *their* perception of the mark. An opinion poll is not necessarily the only means of garnering such evidence; in cases where clearly other traders are using the mark (authorised or unauthorised) it is perhaps a little surprising that no actual instances of confusion, in whatever form, are highlighted by the evidence. Similarly, as regards (v) and (vi), there is simply no evidence at all.
126. In short, the evidence leaves me in no doubt about either the worthiness of the charity or how much importance it places upon what it considers to be its unique slogan, but it leaves me with way too much to infer, in terms of the slogan serving

the essential purpose of a trade mark, to guarantee the origin of the goods and services specified.

127. I should also record that my consideration of the evidence in this case includes also the applicant's own prior registrations, accepted for registration by the registry and on the basis of acquired distinctiveness. I think the examiner's reflection on this particular aspect of the case is correct. Namely, that prior acceptance for registration, and on the basis of acquired distinctiveness, creates no binding imperative as regards subsequent applications.
128. I have, then, given very careful consideration to all the evidence in this case and arrived at the conclusion that, cumulatively, it does not take me to the required point that I can safely conclude or infer that a significant proportion of relevant consumers regard the sign as guaranteeing the origin of the relevant goods or services.
129. I should say, finally, that I carefully considered Ms Newnes' request at the end of the hearing that if I felt that additional evidence could assist the applicant's case that I notify the applicant of my concerns to allow them to remedy any shortcomings. This is sometimes a difficult request to accede to. On the one hand there is an inevitable imperative and urgency to resolve matters as far as third parties and uncertainty are concerned (see, e.g. BL O/166/08 *Vibe Technologies Application* – a decision of the Appointed Person at paras [15] – [16]) and on the other, there is an inevitable desire to do justice to the applicant, especially where it can be seen that shortcomings in the evidence are such as may be easily remedied and without undesirable impact on third parties. In this case, it is my view that the interests of resolution outweigh the realistic prospect that the shortcomings in the evidence can be put right and for that reason I refused the application.
130. In this decision I have considered all the submissions and evidence filed and put to me at the hearing and the application is refused for the reasons given.

**Dated this 2<sup>nd</sup> day of March 2016**

**Edward Smith  
For the Registrar, the Comptroller General**

**Annex****Goods and services for which application is made****Class 3**

Shampoos for animals, dentifrices for animals.

**Class 14**

Key fobs.

**Class 18**

Bags, backpacks, luggage; collars, leads, dog harnesses, muzzles; dog coats; clothing for pets; umbrellas; key fobs; goods made of leather and imitations of leather.

**Class 20**

Baskets; pet beds; pillows, cushions and pet bedding.

**Class 21**

Cages and boxes for household pets; combs, brushes and toothbrushes for pets; mugs, cups, glasses, drinking vessels; glassware; tableware; pottery; containers for household use; bottle openers, corkscrews; coasters; feed bowls for animals; litter trays; figurines of glass, porcelain or terracotta.

**Class 24**

Textiles, bed covers, sofa throws.

**Class 25**

Clothing, footwear, headgear.

**Class 28**

Toys for animals; toys, games and playthings; Christmas tree decorations.

**Class 31**

Food for animals; animal litter; foodstuffs and additives for dogs; edible treats for dogs; dog biscuits and chews.

**Class 39**

Transportation of animals for animal welfare purposes.

**Class 41**

Education in the field of animal welfare, dog care and responsible dog ownership; organising competitions and other entertainments in relation to animal and pet welfare.

**Class 42**

Research in the field of animal and pet welfare.

**Class 43**

Boarding kennels; provision of long and short-term accommodation for animals; re-housing animals.