

## TRADE MARKS ACT, 1963

### Decision in Hearing under Section 26

IN THE MATTER OF an application for registration of Trade Mark No. 164164 and in the matter of an Opposition thereto.

MASTERFOODS LIMITED

Applicant

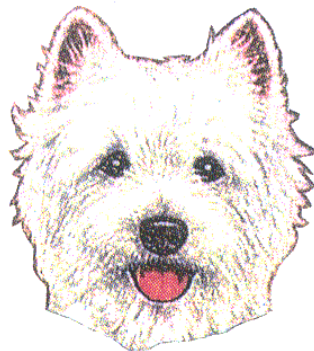
NESTLÉ PURINA PETCARE (UK) LIMITED

Opponent

### **The application**

1. On 16 May, 1994, MASTER FOODS LIMITED, an Irish company, of 7/8 Harcourt Street, Dublin 2, Ireland, Manufacturers and Merchants (now MASTERFOODS LIMITED of Burton Court, Burton Hall Road, Sandyford, Dublin 18) made application (No. 94/2988) to register the device of a dog's head, as shown below, as a Trade Mark in Part A of the Register in Class 31 in respect of the following specification of goods:

“Agricultural, horticultural and forestry products, grains and seeds, all included in Class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in Class 31 for use as additives to such foodstuffs; cuttlefish bone; bones for dogs; litter for animals; fresh fruit and fresh vegetables.”



2. The Application was subsequently advertised as accepted for registration in Part A of the Register under No. 164164 in Journal No. 1772 on 1 November, 1995. The

advertisement carried a noting to the effect that the use of the mark would be limited to the colours red, white and black as shown in the representations accompanying the application.

3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 30 January, 1996 by DALGETY SPILLERS FOODS LIMITED (now NESTLÉ PURINA PETCARE (UK) LIMITED) of 100 George Street, London W1H 5RH, England. The Applicant filed a counter-statement on 1 April, 1996 and evidence was, in due course, filed by the parties under Rules 37, 38 and 39 of the Trade Mark Rules, 1963.
4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 7 May, 2003. The parties were notified on 1 July, 2003 that I had decided to uphold the opposition and refuse registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

### **Notice of Opposition**

5. In its Notice of Opposition the Opponent stated as follows:
  - (i) The Opponent is engaged in trade, inter alia, in the manufacture and sale of foodstuffs for dogs.
  - (ii) The Opponent is the proprietor of numerous trade marks which Opponent uses in connection with foodstuffs for dogs. Opponent and other traders use pictures of dogs to promote their sales of foodstuffs for dogs.
  - (iii) The registration by the Applicant of the representation of a dog, as shown in Application No. 164164 and hereinafter referred to as the said mark, would seriously interfere with the legitimate rights of other traders to use pictures of dogs to promote sales of their foodstuffs for dogs.
  - (iv) The said mark would be disentitled to protection in a Court of Justice and registration thereof would offend against the provisions of Section 19 of the Trade Marks Act, 1963.
  - (v) The Applicant is not the proprietor of the said mark and did not have at the date of application a present and definite intention of using the said mark

in the Republic of Ireland as required by Section 25 of the Trade Marks Act, 1963.

- (vi) The said mark is not a Trade Mark within the definition contained in Section 2 of the Trade Marks Act, 1963 and is not intended to be used as a Trade Mark.
- (vii) The said mark is not qualified for registration under either of Sections 17 or 18 of the Trade Marks Act, 1963.
- (viii) Registration of the said mark would be contrary to the provisions of the EC Harmonisation Directive (Council Directive 89/104/EEC).
- (ix) The Opponent accordingly requests that registration of the said mark be refused in the exercise of the Controller's discretion. An award of costs in Opponent's favour is also requested.

### **Counter-Statement**

6. In its Counter-Statement the Applicant stated as follows:

- (i) The Applicant has no knowledge of the statements contained in paragraphs (i) and (ii) of the Notice of Opposition.
- (ii) Paragraphs (iii) – (viii) of the Notice of Opposition are denied as if the same were herein set forth and traversed ad seriatem.
- (iii) The Applicant has used the Mark applied for in Ireland since at least 1988 and such use has not interfered with the use by other traders of pictures of dogs to promote sales of dog food.
- (iv) The Trade Mark which the Applicant has applied to register is inherently and in fact adapted to distinguish the Applicant's goods from those of other traders.
- (v) The Trade Mark applied for complies with the relevant provisions of the Trade Marks Act, 1963 and in particular with the provisions of Sections 2, 17, 18, 19 and 25 and the Trade Mark is in all respects a distinctive Trade Mark adapted to distinguish the Applicant's goods from those of other traders.
- (vi) The Notice of Opposition filed on behalf of the Opponent is vexatious and ought to be dismissed by the Controller and costs awarded to the Applicant.

## **The evidence**

### *Rule 37*

7. Evidence submitted by the Opponent under Rule 37 consisted of –
- a Statutory Declaration (and Exhibits NM1 and NM2) dated 4 October, 1996 of Norman MacLachlan, Partner in the firm of MacLachlan & Donaldson, Trade Mark Agents, and
  - a Statutory Declaration (and Exhibits DSF1 and DSF2) dated 14 November, 1996 of Brian Edgar Gandy, Director of Dalgety Spillers Foods Limited.
8. In his Declaration, Mr. MacLachlan states that he arranged for containers of food for dogs to be purchased in Quinnsworth Supermarket, Baggot Street, Dublin 2 and that each of the containers in question carried at least one representation of a dog. He exhibits the labels taken from the containers; these include a label bearing the name “Cesar” and carrying the picture of a dog’s head that is the subject of the present application for registration surrounded at the bottom and sides by what might be described as a wreath or garland. The other 8 labels exhibited all carry pictures of one or more dogs or dogs’ heads and bear various names by which the respective products are known, including “Pedigree Chum”, “Bounce”, “Winalot”, “Pal”, “Butcher’s”, “Max”, “Chappie” and “Spillers”.

Mr. MacLachlan also states that he caused a search to be made through the records of registered trade marks and pending applications in Class 31 in respect of foodstuffs for dogs, from which were extracted marks containing representations of dogs. He exhibits copies of the Journal notices advertising acceptance of the applications in question together with summary details of those applications awaiting acceptance. Several of the marks accepted for registration are subject to disclaimers of exclusive rights in the device of a dog or dogs. Among the accepted marks is No. 118900 in the name of the present Applicant, which contains the word “Cesar” and the device of a dog’s head surrounded by a wreath similar to that referred to in the previous paragraph; the dog’s head device is not the same as that contained on the “Cesar” label already exhibited and referred to and which is propounded for registration in the present application. Among the marks awaiting acceptance is No. 96/1386, which is the same device

of a dog's head as contained in the present application but which also includes the wreath together with infill colouring in the background. This mark has since been registered under No. 176679, which registration covers the same specification of goods as the present application and is subject to a disclaimer of exclusive rights in the device of a dog.

Mr. MacLachlan ends his Declaration by stating that the representation of a dog is not inherently capable of distinguishing foodstuffs for dogs.

9. In his Statutory Declaration, Mr. Gandy, Director of Dalgety Spillers Foods Limited, states that the mark propounded for registration in this case is simply the head of a particular breed of dog and that it is the common and long-standing practice of pet food manufacturers to use representations of dogs on containers in which foodstuffs for dogs are sold. In support of this latter assertion, he exhibits samples of labels for the products "Spillers Top Dog", "Beta Digestive Terrier Wholewheat Biscuit Mixer", "Beta Assorted Terrier Wholewheat Biscuit Mixer" and "Spillers mini Winalot", which, Mr. Gandy states, include representations that are virtually identical to the mark of the present application. Mr. Gandy goes on to state that his company and other manufacturers of pet foods would be significantly embarrassed and hampered by the registration of this mark and that the plain representation of a dog's head, as shown in the present application, should be free for use by all other traders. He also asserts that the representation in question is simply part of a composite trade mark which includes the word "CESAR" and which is the subject of Application No. 95/7401 (now registered under No. 176893), a copy of which mark Mr. Gandy exhibits.

*Rule 38*

10. Evidence submitted by the Applicant under Rule 38 consisted of –
  - a Statutory Declaration (and Exhibit BOR1) dated 29 September, 1998 of Brenda O'Regan, Partner in the firm of F.R. Kelly & Co., Trade Mark Agents, and
  - a Statutory Declaration (and Exhibit JH1) dated 6 October, 1998 of James Holahan, General Manager of Master Foods Limited.

11. In her Declaration, Ms. O'Regan refers to the Statutory Declaration of Norman MacLachlan filed as Opponent's evidence under Rule 37, and states that she does not agree with the assertion therein that the representation of a dog is not inherently capable of distinguishing foodstuffs for dogs. She states that the Opponent's own evidence shows that it is normal for manufacturers of dog foods to use differing representations of a dog to distinguish their products from those of competitors and that such representations are commonly adopted as Trade Marks by dog food manufacturers and have long been accepted for registration by the Irish Patents Office. She exhibits a sample label showing how the mark that is the subject of the present application is used. The label bears a representation of a dog above the word "Cesar" with the wreath device partially encircling those two elements. In addition to the dog's head, a part of its body is also evident and its right foreleg rests on top of the "e" in "Cesar". The symbol ® appears beside the "r" in "Cesar". The label includes the words "© Pedigree Petfoods" and "® Registered Trademarks" and Ms. O'Regan explains the corporate relationship between the company referred to on the label, i.e. Pedigree Petfoods, and the present Applicant, presumably lest any question may be raised as to the Applicant's proprietorship of the mark.

12. In his Statutory Declaration, Mr. Holahan states that his company, Master Foods Limited, has been using the present mark in the Republic of Ireland in relation to foodstuffs for dogs since 1988. He exhibits 3 sample labels showing use of the mark, each of which bears the composite mark consisting of the dog and wreath devices together with the word "Cesar" as described in the immediately preceding paragraph. Mr. Holohan gives details of turnover in goods sold under the mark for the years 1990-1998 totalling approximately €5.25 millions. He states that there is nationwide use of the mark and goods sold under it may be found in major retail outlets such as Dunne's Stores, Quinnsworth and Superquinn.

Referring to the Statutory Declaration of Norman MacLachlan, filed as Opponent's evidence under Rule 37, Mr. Holahan agrees with the former's statement to the effect that manufacturers of pet food commonly use representations of dogs in relation to those products but he claims that such use

constitutes trade mark use and is for the purpose of differentiating between the products of different competitors in the market. He further claims that the scope of protection that would ensue from registration of the present mark will extend only to marks that are identical or confusingly similar to it or that draw an association with his company's trade mark. In this regard, he states that there are an infinite number of strikingly different ways in which a dog's head can be represented and he accepts that the representation of a dog's head *per se* is free for use by all traders but contends that his company's device is distinctive and has served as a trade mark for a long number of years. As to the fact that his company uses the mark in conjunction with other marks such as the word "CESAR" and different colours and get-ups of packaging, Mr. Holahan states that it is his company's policy to register its important trade marks separately because these are capable, individually, of distinguishing its goods from those of competitors.

*Rule 39*

13. Evidence submitted by the Opponent under Rule 39 consisted of a Statutory Declaration dated 11 October, 1999 of Peter Farrand, European Marketing Director of FRISKIES PETCARE (UK) LIMITED (formerly known as DALGETY SPILLERS FOODS LIMITED). Mr. Farrand refers to the Statutory Declaration of James Holahan, filed as Applicant's evidence under Rule 38, and states that the latter's evidence makes it clear that his company has used a composite trade mark incorporating a number of elements, only one of which is the device now propounded for registration and that that device on its own cannot serve to distinguish the Applicant's goods from those of other traders. As to the Applicant's assertion that there are many different ways of representing a dog's head, Mr. Farrand agrees that an unusual representation of a dog may function as a trade mark but he contends that an ordinary representation of an ordinary breed of dog or of the head of such an ordinary breed of dog is inherently incapable of distinguishing one dog food product from the next. In this regard, he refers to the fact that evidence has been presented showing use on competing products of virtually identical representations to that which the Applicant seeks to register.

In response to the Statutory Declaration of Brenda O'Regan filed under Rule 38, Mr. Farrand disputes that deponent's apparent contention that all of the representations of dogs used by pet food manufacturers are trade marks. He says that there is no evidence to support that assertion; rather, the evidence shows that manufacturers use pictures of dogs to inform consumers that the relevant product is suitable for dogs and for particular breeds of dogs and to distinguish food prepared especially for dogs from foods prepared for other pets, such as cats. Mr. Farrand claims that no trader should be allowed to monopolise an ordinary representation of an ordinary breed of dog unless it is established that consumers unequivocally associate that representation with the product on which it is used. He remarks that, in the case of the registered marks that contain representations of dogs, as exhibited with the Statutory Declaration of Norman MacLachlan under Rule 37, each one also contains some additional feature or features other than the representation of a dog.

### **The hearing**

14. At the Hearing the Opponent was represented by Mr. Paul Coughlan, BL instructed by MacLachlan & Donaldson and the Applicant by Mr. Brian O'Moore, SC instructed by F.R. Kelly & Co.

15. In his submissions in support of the opposition, Mr. Coughlan argued that,

- (i) a picture of an ordinary breed of dog or, as in this case, the head of such an ordinary breed is neither inherently adapted to distinguish nor capable of distinguishing one undertaking's dog food products from those of others,
- (ii) the use made by the Applicant of the image propounded for registration is not such as to have made it factually distinctive and,
- (iii) the inconvenience and embarrassment that would be caused to other traders by the registration of the mark justified refusal of the application in exercise of the Controller's discretion under Section 25.



(He also contended that the application for registration was wrongly made insofar as the Applicant did not appear to be the proprietor of the mark, which question is addressed at paragraph 19 below).

On the question of whether the mark is adapted to distinguish or capable of distinguishing, Mr. Coughlan stated that manufacturers of dog food use pictures of dogs on containers of their products in order to indicate to consumers what the contents of those containers are, i.e. dog food. Such use is descriptive of the product and, in the context of the relevant trade, a picture of a dog, *per se*, is not capable of distinguishing one brand of dog food from another. As to the use that the Applicant has claimed to have made of the mark, Mr. Coughlan pointed out that the mark propounded for registration formed only a part (and, in his submission, a small part) of a larger composite mark containing the word “CEASR” and a wreath device. The present mark has never been used on its own or separate from the other components in this composite mark and cannot, therefore, have achieved distinctiveness in its own right. As to the consequences of registration of the mark, Mr. Coughlan held that these would be to seriously inconvenience other traders who use similar pictures of dogs to that propounded for registration, to expose such traders to potential litigation for trade mark infringement and to allow the appropriation by the Applicant of the image of a particular breed of dog and its removal from use by other traders who have, heretofore, been at liberty to use (and have in fact used) such an image.

16. Mr. O’Moore, for the Applicant, argued firstly that the Opponent’s contention that registration of this mark would seriously embarrass other traders was without any foundation. It would be preposterous to suggest that the Applicant was seeking, or would obtain by registration, exclusive rights in the use of an image of a dog, *per se*, in relation to dog food products. Rather, what is sought to be protected is the specific image propounded for registration and this is an image that the Applicant has used and is entitled to have protected unto itself through its registration as a trade mark. As to the question of distinctiveness, Mr. O’Moore pointed out that there were numerous registrations of trade marks in Class 31 containing pictures of dogs and that many of these contained a minimum of other matter that might be said to make them distinctive. He concluded that pictures of

dogs must be capable of distinguishing dog food products, otherwise all of these existing registrations would be invalid. Nor did he accept that the fact that the Applicant has used the mark propounded for registration in conjunction with other trade marks in any way undermined its claim for acquired distinctiveness; the present mark is a central and significant element of the composite mark that has been used on containers of the Applicant's product and the very significant sales of that product must have resulted in the mark having become recognised and associated with the product. Referring to the Opponent's submission that the Controller's discretion should be exercised to refuse registration of the mark, Mr. O'Moore stated that there could be no justification for such an adverse exercise of discretion against the Applicant if the opposition under the specific sections of the Act cited by the Opponent was found to be without substance.

### **Preliminary issue**

17. An issue arose at the hearing that requires mention prior to my consideration of the substantive issue between the parties. Mr. O'Moore sought to introduce copies of extracts from the Irish Trade Marks Register and the European Community Trade Marks Register, which had not already been put in evidence nor furnished to the other party or to me. This attracted a formal objection from Mr. Coughlan on the ground that evidence could not be introduced at the hearing and without notice. I declined to rule on the matter at the hearing but stated that I would allow Mr. O'Moore to introduce the disputed material while reserving my position as to whether or not to consider it in reaching my decision. Mr. Coughlan's subsequent rebuttal of the arguments made by Mr. O'Moore based on this material were without prejudice to his denial of their admissibility. I think, perhaps, that a better approach would have been to adjourn the hearing to allow consideration by the Opponent and by me of the content of the material put forward on behalf of the Applicant, following which a decision acceptable to both parties might have been reached. In the event, nothing turns on this as, having looked at the register extracts in question, I am not altered in any way in my opinion on the merits of the opposition. In the circumstances and while I may be held to have, *de facto*, admitted these documents, I do not consider it necessary to rule definitively on the question of their admissibility. In passing, I would say that the general rule of procedure prohibiting the presentation of "surprise" evidence

must be observed in proceedings of this nature, a fact acknowledged by Mr. O'Moore who explained that the material he sought to introduce had come to hand too late to be disclosed prior to the hearing.

### **The substantive issues**

18. Of the grounds of opposition stated in the Notice of Opposition filed on behalf of the Opponent, only those under Sections 2 and 25, Section 17 and Section 18 were canvassed at the hearing. I am satisfied that my consideration of the matter may be confined to these sections. While a decision one way or the other under one of these sections may be determinative of the matter and may obviate the need for consideration of the case under the other sections, I have treated each separately so that, in the event of a possible appeal, any matter that could have been considered at this stage will have been.

#### *Sections 2 and 25 – was the application validly made?*

19. The first question I have considered is whether the Applicant was, at the time that the application was made, the proprietor of the mark as required by Sections 2 and 25 of the Act. The relevant parts of those two Sections read as follows:

##### Section 2

“trade mark” means ..... a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark .....

##### Section 25

“(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or Part B of the register.”

The Notice of Opposition included, at paragraphs (v) and (vi), standard claims that the application did not comply with these provisions and these were met with standard denials in the Counter-Statement, at paragraphs (ii) and (v). No

evidence in support of these grounds of opposition was presented by the Opponent and the matter only came to be argued at the hearing on foot of a statement contained in the Statutory Declaration of Brenda O'Regan submitted as Applicant's evidence under Rule 38 and referred to at paragraph 11 above. In an apparent explanation of why a sample label (exhibited as evidence of how the Applicant had used the mark) bears the name of another entity, Pedigree Petfoods, Ms. O'Regan outlines the corporate relationship between that entity and the Applicant; essentially, both are wholly owned subsidiaries of the same entity, Mars Inc. In furnishing this explanation, Ms. O'Regan states that, "*It is the policy of Mars Inc. to register their petfood trade marks in the name of the local company*". Mr. Coughlan argued that this amounts to an admission that the mark that is the subject of the present application is, in fact, the property of Mars Inc. and not the Applicant and that the application was made in the name of a company that is not the proprietor of the mark. Mr. O'Moore denied this and stated that Ms. O'Regan was merely explaining the close corporate relationship between the Applicant and the entity referred to on the label exhibited, which close corporate relationship should be sufficient for me to accept that the Applicant had an entitlement to make the application in its name. In any event, he argued, it is not clear that the reference, on the label exhibited, to "*® Registered Trademarks*" necessarily governs the mark of the present application and it might relate instead to the word mark "CESAR", which also appears on the label.

20. As I have indicated, the Opponent did not present any evidence on this point and its reliance on the statement contained in the Applicant's evidence may be seen as somewhat opportunistic, though not invalid for that reason alone. The fact is that I cannot determine as a matter of certainty whether the Applicant was the proprietor of the mark as of the date of application because there is no useful evidence before me on the question. The statement in Ms. O'Regan's Statutory Declaration casts doubt on the Applicant's proprietorship of the mark but it does not prove conclusively that the mark is owned by another entity. It is a statement of the general trade mark protection policy of Mars Inc., which is not a party to these proceedings, and it does not, in my view, amount to a statement that the present application has been made in pursuance of that general policy. The words

and symbols appearing on the controversial label may be interpreted to mean that the copyright in the design and content of the label is owned by Pedigree Petfoods and that the marks appearing on the label are registered trade marks but this does not, of itself, establish that the marks are also the property of Pedigree Petfoods, let alone Mars Inc., which is not referred to at all. In the absence of any concrete evidence to support the assertion that the Applicant is not the proprietor of the mark, I think it is proper that I should give the benefit of the doubt to the Applicant and find that the opposition on this ground has not been proven. Accordingly, I dismiss the opposition under Sections 2 and 25 of the Act insofar as it relates to the Applicant's proprietorship of the mark.

*Sections 17 and 18 – is the mark distinctive?*

21. Sections 17 and 18 of the Act specify the requirements for registrability in Parts A and B, respectively, of the Register. Insofar as the present application is concerned, the relevant parts of those sections are as follows:

*Section 17*

“(1) In order for a trade mark ..... to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-  
.....

(e) any ..... distinctive mark .....

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is ..... proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists .....

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the ..... Controller ..... may have regard to the extent to which –

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.”

*Section 18*

“(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is ..... proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists .....

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the .... Controller .... may have regard to the extent to which –

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.”

22. While the present application was accepted for registration in Part A of the Register and was opposed on this basis, it is necessary at this stage to consider also its suitability for registration in Part B, which may arise even if it is found to be ineligible for registration in Part A. The legislative history of the division of the Register into two parts is traced by O’Higgins C.J. in the decision of the Supreme Court in WATERFORD [1984] FSR 390 and I do not need to go over that here; suffice to say that, while registration in Part A is reserved for marks that are “adapted to distinguish” and registration in Part B is available to marks that are merely “capable of distinguishing”, the fundamental question in each case concerns the degree of distinctiveness (whether inherent or acquired), or lack of it, of the mark in question. Given that the factors to be considered in determining the merits of the application for registration under both Section 17 and Section 18 are essentially the same, I have treated the two sections jointly for the purposes of setting out the reasons for my decision.

23. The question of whether the present mark is inherently adapted to distinguish or capable of distinguishing the Applicant’s goods from those of other traders must, I think, be considered by reference to the context in which those goods are traded and the established practices of petfood manufacturers as regards the design of labels of their products. The evidence shows that such traders commonly use

pictures of dogs on containers of their products and this is not disputed between the parties and is, of course, a practice that is very familiar to the relevant class of consumers. The Opponent states that this practice renders the image of a dog, *per se*, as inherently non-distinctive in relation to dog food while the Applicant states that the different pictures of dogs used by various manufacturers serve to distinguish their respective products one from the next and are, therefore, adapted to this purpose (and, by definition, capable of fulfilling it).

24. I am inclined to the former opinion. In my view, traders use pictures of dogs on containers of dog food in an essentially descriptive manner. The picture tells the consumer that the container contains dog food and functions in the same way as a picture of a peach on a can of peaches or a picture of a scone on a packet of scone mix. In making these comparisons, I have to have regard to the fact that, while a peach is a peach and a scone is a scone, there is considerably more individuality about dogs. There is no doubt that dog owners, to whom the relevant marks are addressed, are inclined to regard dogs as individuals and the way in which a dog owner comprehends a picture of a dog is likely to be different from the way in which a person with no particular interest in dogs regards such an image. The latter is likely to think, “there is a picture of a dog” while the former will probably perceive the individuality of the particular dog and make subconscious assumptions about its character or nature. Nevertheless, in the absence of specific knowledge of an individual dog, I think that even dog owners will comprehend a picture of a given dog as signifying a terrier, spaniel or collie, etc., as the case may be, i.e., the message conveyed remains generic rather than specific. I consider, therefore, that even in the case of dogs and dog food, our familiarity as consumers with the practice of manufacturers of using images on containers for the purpose of designating the contents thereof detracts from the capacity of images that fulfil this function to serve, in trade, anything other than a descriptive purpose.

25. The foregoing is, of course, a general observation and cannot, of itself, be determinative of the merits of any specific application. It is necessary to look at the present mark and ask whether, notwithstanding the widespread descriptive use of images of dogs in relation to dog food, there is anything about this particular image that renders it apt to distinguish in a trade mark sense. In this regard, the

Opponent drew attention at the hearing to the fact that previous registrations of marks containing or consisting of images of dogs all appear to have had an additional element that rendered them distinctive as trade marks. The Applicant countered that several of the registrations in question had only a very minimal additional content over and above the simple representation of a dog. Indeed, both sides drew considerable attention on this point to the exhibits in evidence, which were examined in detail at the hearing. My own assessment of this matter is that, in the context of an application for registration of a mark in respect of goods that include dog food, a mark that consists only of a representation of a dog and no other feature must have about it some quality or characteristic that makes it distinctive in a trade mark sense, i.e., either adapted to distinguish or capable of distinguishing in the terms of the Act. There must be something that sets it apart in the eyes of the consumer, who is well used to seeing pictures of dogs on containers of dog food, and conveys to the consumer a trade mark message as to the origin of the particular product as opposed to a merely descriptive one as to its nature. It may be argued that the degree or extent of additional content, over and above the simple representation of a dog, need not be particularly significant in order for the mark to be distinctive. The Applicant has correctly pointed out that a number of existing registrations contain a minimum of such additional elements. So, for example, the dog pictured need not be smoking a pipe and riding a bicycle in order for the mark to qualify for registration but it must, in my view, display some characteristic or quality that sets it apart.

26. Looking at the mark in question here, I can find no such characteristic or quality in it. While the mark is not an actual photograph of a dog's head, it is an almost photographic image of an entirely typical, alert expression of an individual of the particular breed, the West Highland White Terrier. It is in the nature of pure breeds of dog that individuals display the features that are common to, and typical of, the breed and so an image of a pure-bred dog suffers the added difficulty (insofar as its suitability to distinguish in a trade mark sense is concerned) of looking just like any other individual of that breed. The present image consists only of the head of a dog and this limits further its capacity to display distinguishing features that might arise from, say, the representation of the dog in an unusual or eye-catching pose. In short, there is nothing about this image that



displays the type of individual character required to make it distinctive in the context of the relevant goods. I think that any consumer who was shown a container (whether it be a can, bag or packet) bearing the picture that the Applicant has put forward for registration and was asked what the picture meant, would answer that it meant that the contents of the container were some form of dogfood. If asked whether the picture could indicate a particular brand of dogfood, then I think that the only reasonable answer could be that it could only do so if, (i) the particular brand was already known to the person in question and, (ii) he or she associated the picture with that brand exclusively. For these reasons, I find that the mark propounded for registration is not inherently adapted, in relation to the relevant goods, to distinguish the goods of the Applicant from those of other traders and nor is it inherently capable of so distinguishing.

27. I turn now to the second consideration under Sections 17 and 18, viz., whether the mark is, by virtue of the use that has been made of it, in fact adapted to distinguish or capable of distinguishing as aforesaid. The first thing to be said in relation to this question is that the Applicant's evidence is limited to evidence of *use* and does not include any evidence of *factual distinctiveness*, by way of, for example, survey evidence or statutory declarations from persons in the trade. The Applicant says that the extensive sales of its "Cesar" product must have resulted in the present mark having become distinctive of that product but there is no third party or independent evidence before me as to this fact. I am asked, rather, to accept the Applicant's opinion in the matter. The question must, therefore, be addressed in the abstract as to what is likely to have been the result of the Applicant's use of its mark rather than what has been established in the evidence to have been the factual outcome.

28. A key consideration in this regard, and one that was disputed between the parties at the hearing, is the question of whether the use that has been made by the Applicant of the image carried on its "Cesar" product constitutes use of the mark propounded for registration here. The Opponent says "no" to this question, arguing that the mark applied for differs significantly from the image used on the "Cesar" containers, which also includes the word "CESAR" and the wreath device and which is described in paragraph 11 above. The Applicant says that the

present mark is an integral and significant element of that composite image and has, of itself, become distinctive through its use as part of that image. I think the question turns, in large part, on the degree of significance of the mark as an element of the composite image that the Applicant has used on its “Cesar” product. If the mark is the predominant feature of the composite image that has been used and the other elements are merely incidental or of little significance, then it is reasonable to assume that whatever factual distinctiveness attaches to the image may be ascribed to the mark. If, on the other hand, the mark may be regarded as a relatively minor element of the composite image, then the assignation to the mark on its own of the reputation acquired by the composite image would not be justified.

29. Looking again at the composite image that the Applicant has used on its “Cesar” product, I consider that, of the three elements that it contains, the word element, “Cesar” is the most significant, primarily because it is the name by which the product is known; the dog device is the next most significant element as it is centrally placed and because of the quirky pose adopted by the dog, whose right foreleg rests on the “e” in “Cesar”; and the wreath device is the least significant as it serves primarily to frame the central elements of the image while not, to my mind, making in itself a striking impression on the viewer. It will be evident from the foregoing that I consider the pose adopted by the dog as important in determining the extent of its significance as an element of the composite image appearing on the “Cesar” label. The fact that the dog’s right foreleg rests on the word “Cesar” creates an attractive interaction between those two elements of the composite image and imbues the dog with more individual character than it might possess if pictured in a less striking pose, say, simply sitting or standing.

30. When the mark propounded for registration is compared with the picture contained in the composite image, I think that the difference between them is significant. The mark consists of the image of a dog’s head only whereas the representation contained within the composite image used on the “Cesar” labels exhibited by the Applicant shows the dog in the pose just described. It should be noted that the representation of a dog that forms part of the composite image on the “Cesar” labels exhibited with the Statutory Declaration of Norman

MacLachlan as part of the Opponent's evidence under Rule 37 is not the same as that exhibited by the Applicant; in the former case, the representation of the dog's head that is included in the composite image appears to be identical to the mark that is the subject of the present application. The evidence shows, therefore, that there have in fact been at least two different images used on the labels of "Cesar" dogfood and these two images have included slightly different pictures of a West Highland White Terrier. Given that I do not know the extent to which each of these two different labels has been used, I must rely on the Applicant's evidence in the matter and that evidence is that the use has been of the more distinctive picture showing a portion of the dog's body and front legs; however, it is the other picture, which shows the head only, that is propounded for registration.

31. In view of the foregoing, the question of whether the present mark has acquired distinctiveness through use may be formulated as follows: "Is it reasonable to assume that, by virtue of the very significant sales over a number of years of the "Cesar" dogfood product bearing an image of a dog resembling the present mark, together with other elements, the mark has come to distinguish that product from other similar products and is used by consumers for this purpose?" For this question to be answered in the affirmative, I think that it must be supposed that a substantial number of the relevant consumers, on finding in the dogfood section of a retail outlet containers bearing the present mark and no other indication of brand identity, would take the product so marked to be "Cesar" or some related product, i.e., as emanating from the Applicant. I am not satisfied that this has been proven. To my mind, the name of the product is the primary identifier and I am not convinced that the mark propounded for registration does in fact function to distinguish it, particularly having regard to the fact that the image carried on the product is actually different from the mark. The evidence shows that the Applicant, in common with its competitors, uses attractive images of dogs on its products but there is no evidence that the consumer relies on these images to distinguish the different products. It seems far more likely that the relevant public identify and distinguish between such products by reference to their different names. This is all the more likely when one considers that the pictures of dogs used on different dogfood products can be quite similar to each other, a fact that is evident from the various exhibits filed with the Opponent's evidence under Rule

37. Indeed, the labels from Spillers' "Top Dog" and "mini Winalot" exhibited by Mr. Gandy for the Opponent bear pictures of a West Highland White Terrier that look very similar to that used on the Applicant's "Cesar". In such circumstances, I am not inclined to accept the Applicant's assertion, unsupported by any independent evidence, that the present mark serves to distinguish its goods from those of its competitors and has, therefore, acquired factual distinctiveness. I find, therefore, that the mark is neither factually adapted to distinguish nor capable of distinguishing the Applicant's goods and I refuse registration in either Part A or Part B of the Register.

*Section 25 – discretionary refusal of registration*

32. Subsection (2) of Section 25 of the Act reads as follows:

"Subject to this Act, the Controller may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right."

It was noted by Geoghegan J. in the Supreme Court in the DIESEL case that,

*"..even if registration of the trade mark is not prohibited by s. 19 or by any other sections in the Act of a prohibitory nature, the Controller, under s. 25(2) cited above, has a discretion to refuse the application. That discretion must be exercised properly and the reasons for it must be clear."*

33. In addition to the grounds of opposition that I have already considered, the Opponent invited me to refuse registration of the mark in exercise of the Controller's discretion under Section 25. Its argument on this point was to the effect that, given the widespread use in the pet food trade of pictures of dogs, registration of the present mark in the name of the Applicant would cause embarrassment to other traders who would be forced to take pains to avoid using a picture of a small white dog on their products lest it attract an action for trade mark infringement by the Applicant (or Proprietor, as it would then be). The Opponent argued that the evidence showed that the Applicant's competitors currently use pictures of this nature and that it would be inequitable to effectively

constrain them from doing so in the future. In response, the Applicant suggested that this was something of a red herring and that it claimed rights only in the specific image propounded for registration, which rights could not be invoked to prevent other traders from using pictures of dogs, *per se*, on their products, provided that use was in accordance with honest practices in trade. There was considerable debate at the hearing on the question of whether, and to what extent, any potential infringement action based on a registration of the present mark might succeed and each of the learned counsel found himself in the unusual position of having to advocate the position that the other would be likely to adopt if their roles were reversed in the course of any such proceedings in the future.

34. The first thing that I would say on this issue is that I do not consider it necessary or appropriate, in the context of considering an application for registration of a mark, for me to purport to adjudicate on the merits or otherwise of a possible future case for trade mark infringement. Any such case would be a matter for the Court to decide and would fall outside of the Controller's statutory remit. The Controller must, of course, have regard to the likely or potential consequences of his decisions to accept or refuse applications for registration but the scope of that consideration is defined by the specific provisions of the Act governing registration and it is only where reasons exist for the refusal of registration that do not fall within those specific provisions that the question of discretionary refusal arises. In the present case, the Opponent's argument in favour of discretionary refusal is grounded on essentially the same basis as its argument for refusal of the application as not meeting the requirements of Sections 17 and 18, viz., that the mark is of a type that is commonly used in the relevant trade and is, therefore, incapable of distinguishing the Applicant's goods. It seems to me that the assertion that registration of the mark will cause embarrassment to other traders who habitually use similar marks is simply a restatement, from a different perspective, of the argument that the mark, being no more than a picture of the head of an ordinary breed of dog, is incapable of distinguishing by reason of the common use of such pictures in the relevant trade. I agree with the point made by Mr. O'Moore for the Applicant that I should not exercise the Controller's discretion to refuse registration in this case if I find that the other grounds of opposition are unsupported as the argument in each case is essentially the same.

In the event, I have concluded that the mark is not registrable under Section 17 or 18 and discretionary refusal does not arise. However, the point I make here is that, if the other grounds of opposition had failed, I have not found sufficient merit in the case made by the Opponent as would have led me to exercise the discretionary power conferred by Section 25(2) to refuse registration. The Applicant did not, for example, make the application for registration in bad faith and nor would registration of the mark lead to potentially harmful confusion from, say, a public health aspect.

35. In conclusion, I have found that the application for registration was validly made and complied with the requirements of Sections 2 and 25 of the Act but that the mark was ineligible for registration under either Section 17 or Section 18. Accordingly I have upheld the opposition and refused registration of the mark.

Tim Cleary  
Acting for the Controller

September, 2003