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A DOG IS FOR LIFE, NOT JUST FOR CHRISTMAS: Distinctive brand or mere promotional slogan?

Julius Stobbs (Stobbs IP) · Wednesday, October 5th, 2016

In March 2016, the UKIPO refused registration of the mark A DOG IS FOR LIFE NOT JUST FOR CHRISTMAS in its entirety on the grounds that it would merely be seen as a non-distinctive inspirational and promotional strap line. The applicant (the Dogs Trust charity) argued that the mark had already been successfully registered in the UK in respect of a range of other goods and services and they produced evidence to show that the slogan had been used extensively in the course of trade since 1978. However, much to the surprise of many, this evidence failed to persuade the Hearing Officer that the mark had acquired the required level of distinctive character.

The evidence of use produced showed some examples of the mark being used in conjunction with the ® symbol, thereby strongly indicating brand usage. However, the UKIPO nonetheless found that the majority of uses appeared to be of such a nature so as to convey meaning with the purpose of simply encouraging responsible dog ownership, rather than being used to denote brand origin.

On the issue of the section 3(1)(b) inherently registrability of this mark, views were divided in relation to its varied specification. Some took the view that whilst it is grammatically correct, it is neither laudatory nor descriptive of the goods or services applied for, many of which have no obvious connection with responsible dog ownership in order for the slogan to function in a merely promotional capacity.

Others took the stance that the mark is devoid of distinctive character notwithstanding that a characteristic of the goods or services is not designated; rather it is simply incapable of guaranteeing the identity of a single trade origin.

Of course, the question of distinctiveness should be answered by reference to the perception of the average consumer of the goods and services applied for. The UKIPO regarded all the goods as being capable of bearing a slogan such as this, which conveys a meaningful narrative, in normal and fair use, and notably that such use

would be regarded as being entirely origin neutral by the relevant consumer.

On the issue of acquired distinctiveness, naturally, it is difficult for us to divorce ourselves from our own exposure to, and recognition of, this slogan, resulting from its years of use in the marketplace in the UK. It is insufficient in any case to simply demonstrate that the relevant class of persons recognise the mark; an applicant must also prove that the relevant persons associate it with the applicant's goods only, without any possibility of confusion, and that they regard the mark, in and of itself, as a trade mark.

In this case, the UKIPO found that, whether one regards it as fair or not, the fame of the slogan and its adoption as part of the common language, spawning numerous variants by other traders, had conspired over time to diminish its capacity to indicate and guarantee a single source of trade origin. It was also held that the prior acceptance of identical registrations creates no binding imperative as regards subsequent corresponding applications, not least because examination practices change.

The applicant appealed to the Appointed Person (AP), Thomas Mitcheson QC, who issued his [decision](#) recently on 26 September 2016. He found that the Hearing Officer had erred in failing to correctly apply the ruling of the CJEU in [Audi AG v OHIM \(Case-398/08P\)](#). This being the case, it was open to the AP to apply the Audi principles and reach his own conclusion. In doing so, the AP concluded that the mark would be perceived as imaginative, surprising and unexpected by the average consumer, and as such, these qualities endow the mark with a distinctive character. The AP also found that the widespread imitation of the mark by others supports the notion that it is striking and more than a merely origin-neutral narrative.

The AP did not find any material error of law in relation to the Hearing Officer's assessment of the legal principles relating to acquired distinctiveness, but the appeal had already succeeded nonetheless. The application has now been returned to the UKIPO for further processing.

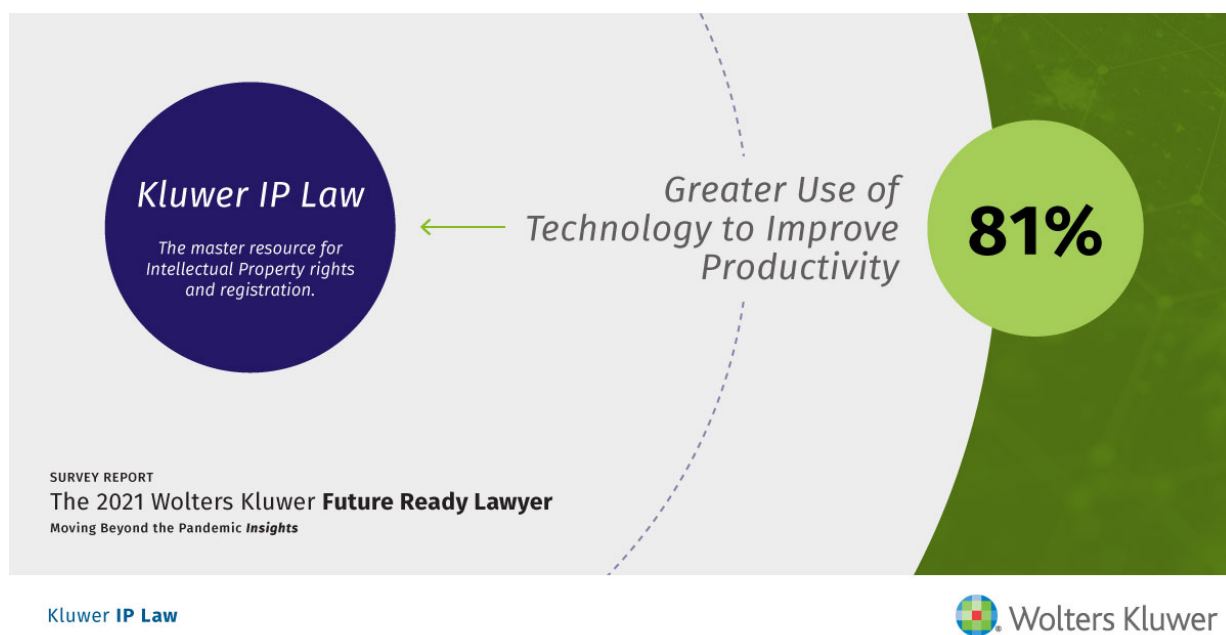
This has been an interesting case for practitioners to follow; the comment from the AP that imitations of the mark support the argument that it is distinctive is one that no doubt will ring true with many aggrieved brand owners. However, exactly how that third party use would play into an acquired distinctiveness argument is as yet undecided – does it confuse the market and make it difficult to show that the mark indicates one origin, or do the imitations simply reinforce distinctive character, as if the mark was not distinctive it would not be worth copying?

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