

Kluwer Trademark Blog

SHOULD'VE been in the news

Julius Stobbs (Stobbs IP) · Wednesday, September 7th, 2016

UK trade mark applications encountering no conflict with a third party rarely make mainstream news. However, last month the application to register the mark “SHOULD’VE” in the name of Specsavers B.V. at the UK Intellectual Property Office (UKIPO) roused significant interest in the media, including in The Times. The fact that this made the news of course says something about the power of advertising but also speaks volumes about the sophistication of the average consumer’s interest in brands and in particular in non-traditional marks, such as slogans, that is in my view ahead of how the courts see things.

The application in question was a series application for the word marks SHOULD’VE and SHOULDVE in classes 9, 10, 16, 35 and 44. At the time of media interest the application was under examination at the UKIPO and the comment was that that this was a shortened version of the full slogan SHOULD’VE GONE TO SPECSAVERS (which has been registered since 2007 as an EU TM and which UK readers cannot have missed due to the very significant advertising featuring this slogan). Commentators asked *could* this be registrable and *should* it be registrable? The “could” was of course because as we know slogans can be difficult to register inherently and the “should” was whether “Joe Public” thought it right that a company could “own” such a simple term.

At the time of writing, the application has been accepted and published for opposition purposes. Whilst we are not privy to the examiner’s view, the dates in question suggest this mark was accepted inherently with no evidence of acquired distinctiveness necessary.

What I find particularly interesting about this case is not so much the acceptance of the mark (i.e. that the UK office found this word on its own has inherent distinctive character with respect to Specsavers’ broad range of services), as the UKIPO has long made a distinction between a mark that is abstract on its own but could be descriptive when used as part of a phrase. Rather, it is the fact that this made it into the headlines at all.

I think this tells us something interesting about the issue of consumer perception and distinctive character. Consumers are increasingly sophisticated when it comes to understanding brands and particularly in their understanding of non-standard marks (shape, colour, slogans, etc.) as functioning as trade marks. By contrast, courts and tribunals frequently appear to lag behind in what they think consumers will accept and rely on as trade marks and therefore what is deemed registrable. The fact that this trade mark application for SHOULD'VE, which was neither controversial (the word is not offensive) nor under challenge (unlike, for example, the various Nestle v Cadbury spats over registrations) nor being used as part of a newsworthy dispute (e.g. big company enforcing against small party), made the news I think shows a sophisticated consumer understanding of brand.

The coverage contained (limited) discussion of the issue that this was a contraction of the more famous long form of the slogan SHOULD'VE GONE TO SPECSAVERS but might still be recognised as that brand, as well as discussion of issues such as whether or not someone should “own” a word like this. It shows engagement with the relevance and functions of brand and legal rights. It certainly shows something about the power of slogans to capture our imagination. It also confirms what we in the profession already know is true, namely that most people do have an opinion on whether or not someone should own a brand or whether or not something is confusing or reminds them of a company or not.

Of course the press coverage misses some of the key substantive issues. This is acceptance of protection for SHOULD'VE and not SHOULD'VE GONE TO... and whilst the former may be a shortening of the latter it is not what the UKIPO was considering. Their assessment was not about the recognition of this word by the public but about its inherent ability to function as a trade mark. I can see that SHOULD'VE would be an odd name for a shop or for an optical product but the granting of this right does not mean that Specsavers now owns all usages of this word. Indeed it does not even mean they could stop Asda saying “Should've gone to Asda” – although I am also sure that this would not be a sensible choice for Asda (given previous encounters) and Specsavers have other registrations better suited to tackling that! However, whilst these points are important it is still good to see these sorts of issues aired in the public media and awareness raised.

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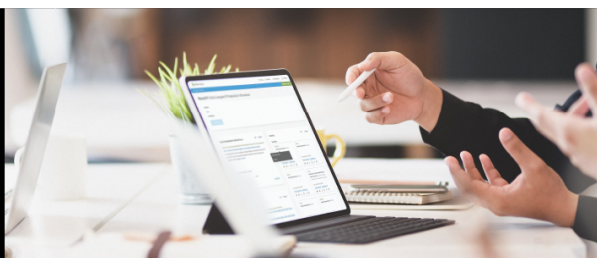


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