



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION
of the Fourth Board of Appeal
of 23 September 2008**

In Case R 543/2008-4

Mars, Incorporated

6885 Elm Street
McLean, Virginia 22101-3883
United States of America

Applicant/Appellant

represented by CLIFFORD CHANCE LLP MARS CO-ORDINATION TEAM,
10 Upper Bank Street, London E14 5JJ, United Kingdom

APPEAL relating to Community trade mark application No 6 112 171

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman), A. Szanyi Felkl (Rapporteur) and
I. Mayer (Member)

Registrar: J. Pinkowski

gives the following

Decision

Summary of the facts

- 1 On 18 July 2007 the appellant applied to register the word mark:

THE PEDIGREE ADOPTION DRIVE

as a Community trade mark ('CTM').

- 2 On 30 January 2008 the examiner notified the appellant of his decision ('the contested decision') that the trade mark was not eligible for registration under Article 7(1)(b) and (c) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR') (OJ EC 1994 No L 11, p. 1; OJ OHIM 1/95, p. 52) for the following goods and services listed in the application:

Class 31 – Live animals, birds and fish.

Class 35 – Advertising; promotion of public awareness about the need for adopting animals, responsible pet ownership and the proper care and treatment of pets.

Class 44 – Veterinary services; animal hospitals; hygienic and beauty care for animals; charitable services, namely providing care and treatment for animals; consulting services in relation to the aforesaid; breeding services relating to animals.

- 3 The examiner divided the sign into individual words and cited the relevant definition in each case from the *Chambers 21st Century Dictionary* (2001 edition): 'pedigree' was an '(adjective) said of an animal: pure-bred; descended from a long line of known ancestors of the same breed'; 'adoption' was a noun relating to the verb adopt, meaning '(transitive & intransitive) to take (a child of other parents) into one's own family, becoming its legal parent; to take up (a habit, position, policy, *etc.*)' and 'drive' meant 'an organised campaign; a group effort *e.g.* an economy drive'. He stated that the overall expression conformed to the rules of English grammar. The examiner considered that the relevant consumer would not perceive it as unusual but as a meaningful expression: 'the campaign to adopt pedigree animals'. He concluded that the term THE PEDIGREE ADOPTION DRIVE taken as a whole immediately informed consumers without further reflection that the goods and services in question concerned a campaign to adopt pedigree animals. Therefore, the expression contained obvious and direct information on the kind, quality, intended purpose of those goods and services. In response to the appellant's citation of several of its PEDIGREE marks which had been accepted for registration by the Office, the examiner stated that the previous practice of the Office was irrelevant in determining the registrability of a sign. He nevertheless noted that the mark THE PEDIGREE ADOPTION DRIVE differed significantly in its 'material particulars' from the appellant's earlier registered marks, which comprised PEDIGREE alone. The examiner waived his original objection to the remainder of the goods listed in the application, namely:

Class 25 – Clothing, footwear, headgear.

Class 31 – Agricultural, horticultural and forestry products, grains and seeds, all included in class 31; foodstuffs for animals, birds and for fish and preparations included in class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs; litter for animals; fresh fruit and fresh vegetables; but excluding foodstuffs for livestock, including foods for bovines, ovines and pigs, foodstuffs for equines, foodstuffs for poultry, birds and game birds.

- 4 By letter of 27 March 2008 the appellant made a request to the Office to divide its application, pursuant to Articles 44a and 48a CTMR. A divided application was created as CTM No 6 828 065 in respect of the goods listed above which had been accepted by the examiner.

Grounds of appeal

- 5 The appellant filed a notice of appeal against the contested decision and a statement of the grounds within the due time.
- 6 The appellant requests the Board to annul the contested decision in relation to those goods and services for which the application was rejected. It essentially argues that consumers will recognise the appellant's PEDIGREE brand name as a part of the sign applied for and, due to its notoriety and reputation, will immediately and automatically know that the goods and services in question emanate from the appellant. It states that the PEDIGREE trade mark has and continues to be the leading sponsored brand of the 'Crufts' international championship show for dogs, which is the largest annual dog show in the world. Therefore, the relevant consumer would instantly identify the commercial origin of the goods and services to which the objection relates as emanating from the applicant. Given the nature of the goods and services in question, the appellant submits that although the dictionary defines 'pedigree' as referring to a pure bred animal which has descended from a long line of known ancestors of the same breed, the average consumer coming across the goods and services in question would not view the mark as having the same meaning. It is an unusual choice of words to choose to describe an adoption drive for pedigree animals. If the mark were descriptive, a clearer and more grammatically correct way to describe the goods and services would be to use the expression 'The Adoption Drive for Pedigree Animals'. The appellant argues that the fact that the well-known PEDIGREE trade mark appears at the beginning of the mark applied for emphasises that the adoption drive initiative is PEDIGREE® inspired and related.
- 7 The appellant has submitted various surveys, articles, trade journal extracts, advertisements, leaflets and brochures to attest to the notoriety of its PEDIGREE mark.

Reasons

- 8 The appeal is well founded and will be upheld since the sign is not directly descriptive and non-distinctive in respect of the goods and services in question.

Article 7(1)(c)CTMR

- 9 Pursuant to Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services are to be refused registration.
- 10 According to settled case-law, the signs and indications referred to in Article 7(1)(c) CTMR are those which, for at least one of their possible meanings, could be used to describe the goods or services in respect of which registration is sought, or the characteristics of the same. Such signs and indications cannot be reserved to one undertaking alone and, because they are unable to fulfil the indication of origin function of a trade mark, should be excluded from registration (see judgment of the Court of 23 October 2003 in Case-191/01 P *OHIM v Wm. Wrigley Jr. Company* ('Doublemint') [2003] ECR I- 12447, at paragraphs 30-32). Moreover, the assessment of whether a sign is descriptive should be made in relation to the goods or services concerned and in relation to the understanding of the target public (see judgment of the Court of First Instance of 27 February 2002 in Case T-34/00 *Eurocool Logistik GmbH v OHIM* ('Eurocool') [2002] ECR II-683, at paragraph 38).
- 11 For the purposes of Article 7(1)(c) CTMR it is necessary to consider, on the basis of a given meaning of the sign in question, whether the relevant public will immediately and without reflection perceive a direct and specific link between the sign and the categories of goods or services in respect of which registration is sought ('Carcard', at paragraph 28, and judgment of the Court of First Instance of 20 March 2002 in Case T-355/00 *DaimlerChrysler AG v OHIM* ('Tele Aid') [2002] ECR II-1939, at paragraph 28).
- 12 The sign is the slogan THE PEDIGREE ADOPTION DRIVE. The slogan will not be viewed in the abstract by consumers but in the context of a charitable campaign aimed at the welfare of dogs and, in particular, finding responsible, loving owners for abandoned and ill treated dogs.
- 13 The Board confirms the definitions provided by the examiner. The word 'pedigree' in relation to dogs refers to purebred dogs which have an established lineage. If the lineage is not recorded they cannot be referred to as pedigree dogs. Such dogs, which are the product of careful selective breeding, are sold for considerable amounts of money. For this reason, they are not the subject of adoption or rescue programmes.
- 14 The Board notes the evidence provided by the appellant regarding the reputation of the PEDIGREE mark, especially in relation to dog food, and accepts that the sign is a well-known brand, with trade mark registrations throughout the European Union. However, the appellant has not provided evidence to demonstrate that the sign THE PEDIGREE ADOPTION DRIVE has acquired distinctiveness or enhanced distinctiveness.
- 15 Nevertheless, the Board considers that it is probable that the relevant consumer,

who is likely to be enthusiastic about dogs and sympathetic to their plight, will perceive the sign as indicating that the appellant company sponsors and supports the project through the sale of its goods and services, rather than understanding the campaign to be in relation to pedigree dogs. It is reasonable to assume, since the appellant has satisfactorily demonstrated the reputation of its PEDIGREE mark in connection with related products such as dog food, that the consumer will view the sign as a whole as indicating that the goods and services in question, marketed and provided in connection with the adoption campaign, emanate from the appellant. This is especially so given the fact that the relevant consumer will be aware that pedigree dogs are not put up for adoption but rather, are sold for tidy sums of money.

- 16 Taking this into account, the overall impression of the sign is not descriptive. In the Board's opinion, the meaning of the words, when combined, will inform the consumer about the commercial origin of the goods and services rather than be perceived by the relevant public as primarily informing them that the goods and services directly relate to a campaign promoting and arranging the adoption of pedigree dogs.

Article 7(1)(b) CTMR

- 17 According to the case-law of the Court, a word mark which is descriptive of the purpose or essential characteristics of goods or services under Article 7(1)(c) CTMR will, on that account, also be devoid of any distinctive character with regard to those same goods for the purposes of Article 7(1)(b) CTMR (see by analogy as regards the identical provisions of Article 3(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ('TMD') (OJ EC 1989 No L 40, p. 1; OJ OHIM 4/95, p. 510, 'Postkantoor', cited above, at paragraph 86). Thus, if Article 7(1)(c) CTMR applies, Article 7(1)(b) CTMR will also apply.
- 18 Given that the Article 7(1)(c) CTMR objection no longer holds in this case and given that it provided the sole basis for an objection under Article 7(1)(b) CTMR, the latter can also be dispensed with as a basis for refusing the registration of the sign.
- 19 By reason of the foregoing the appeal is upheld.

Order

On those grounds,

THE BOARD

hereby:

Annuls the contested decision.

D. Schennen

A. Szanyi-Felkl

I. Mayer

Registrar:

J. Pinkowski