

**TRADE MARKS ACT 1994**

**AND**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 724668  
AND THE REQUEST BY BOSE B.V.  
TO PROTECT A TRADE MARK IN CLASS 9**

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TO PROTECT A TRADE MARK IN CLASS 9**

1. On 4 November 1999, Bose B.V. of 8, Nijverheidstraat, NL-1135 GE EDAM, Netherlands, on the basis of international registration no. 724668, requested protection in the United Kingdom, for the mark “Personal” under the provisions of the Madrid Protocol. Protection is sought in respect of :

Apparatus for recording, transmission or reproduction of sound and/or images; magnetic data carriers; sound carriers, including recording discs; loudspeakers; loudspeaker systems; software for recording, transmission or reproduction of sound and/or images; parts and accessories for the aforementioned goods, not included in other classes.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because it consists exclusively of the word “Personal”, being a sign which may serve in trade to designate the kind and intended purpose of the goods.

3. The holder’s representatives, Stevens Hewlett & Perkins, responded in a letter of 1 September 2000 and submitted that “The goods are not, themselves, personal goods and it is unlikely that others in the trade would wish to use this word in order to describe these goods”. The letter went on to say that the proprietor of the International Registration was prepared to limit the goods to “remote controllers, in particular sound system remote controllers for controlling and displaying information about a loudspeaker system and one or more of a radio tuner and CD player” which it was contended “are even further removed from being personal goods as such and in the circumstances we are of the view that in relation to these goods the trade mark PERSONAL is capable of distinguishing the applicant’s goods from those of other traders”.

4. The examiner was not persuaded by these submissions and in a letter to the holder’s representative of 7 September 2000, the objections were maintained.

5. At a hearing, at which the holder was represented by Mr Mike Needleman of the trade mark attorneys referred to above, the objection was maintained and notice of final refusal was issued on 3 October 2001.

6. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

8. Section 3(1)(b) and (c) of the Act read as follows :

3(1) The following shall not be registered -

(b) trade marks which are devoid of any distinctive character,

(c) 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, the time of production of goods or of rendering of services, or other characteristics of goods or services.

9. The mark consists exclusively of the word “Personal”. There are several definitions for this word in the Collins English Dictionary (5<sup>th</sup> Edition), the most pertinent being :

“belonging to or intended for a particular person and no-one else.....e.g. for your personal use”.

10. I understand from Mr Needleman that the mark is to be used in relation to a remote control which enables the user, from any part of the home, to control a single sound system that is able to simultaneously output radio programmes and music from compact discs in several different rooms through loudspeakers located in those rooms. The user can use the remote control to instruct the system to play, for example, the music from a compact disc in one room whilst playing music from another compact disc in a different room and at the same time to output a radio programme in another room. Further, the remote control gives the user information on, for example, what is being played in each room, again from any part of the home.

11. At the hearing, and in subsequent correspondence, I took the view that “Personal” would be a word which may serve, in trade, to designate remote controls for personal use, particularly given that such goods may be adapted by the user to his or her own personal requirements.

12. However, The European Court of Justice has recently given further guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1) of the Trade Marks Act) in the “Baby-Dry” case C-383/99 P. I set out the guidance given at paragraph 37 of this judgement:

“It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function”.

And the guidance given at paragraph 39:

“The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

13. In my view, the word “Personal”, when used in relation to the goods listed in the restricted specification, would convey to the purchasing public that the goods are for personal use rather than being an indication of origin, particularly given that the goods are of the type that can be personalised and adapted by the user to his or her requirements.

14. I attach at annex “A” a printout from a web site referring to, what I believe to be, the holder’s goods. This site includes a picture of the goods and states at paragraph 6, “Commands are programmable to adapt to user preferences” which appears to confirm that the goods are, indeed, of the type that can be adapted as required by the user.

15. At annex “B” are printouts from web sites, again referring to what I believe to be the holder’s goods, which in my view, confirm that the word “Personal” is apt, and indeed is being used, to convey to the public that the goods are for personal use rather than being an indication of origin. It should be noted that in these web sites, the remote control is referred to as a “music centre”.

16. The use of “Personal” in relation to goods is not new and the public are, of course, already used to seeing the word used in relation to a wide range of goods, for example, personal computers, personal stereos, personal organisers etc. The word now appears to be used in relation to other products and at annex “C” are examples of this.

17. Copies of the printouts referred to in annexes “A” and “B” were sent to Mr Needleman on 19 July 2001 and examples at annex “C” on 11 September 2001 but no submissions have been received in response to them. In a letter of 25 September 2001, Mr Needleman requested that the designation be refused.

18. The guidance set out in the “Baby-Dry” case indicates that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). In my view, the word “Personal” would be regarded by the purchasing public as a normal way of designating that the goods are for personal use. ie a normal way of designating the kind and intended purpose of the goods.

19. Although I consider that the term could be used on the goods themselves, or on their packaging, it is perhaps more likely to be used in the promotion or advertising of the goods, as demonstrated in the annexes attached to this decision. In this regard, I have taken account of comments made in the unreported decision of Simon Thorley QC, as Appointed Person, in the “Day By Day” case in which he said:

“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising.....”

20. In this decision, I have considered all the documents filed by the holder and all the arguments submitted to me and, for the reasons given, the notice of refusal is upheld.

Dated this 8 day of January 2002

John Hamilton-Jones  
For the Registrar  
The Comptroller General

Annexes in order a copy