

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2192145 BY HARMAN-KARDON, INCORPORATED TO REGISTER A TRADE MARK IN CLASS 9

DECISION AND GROUNDS OF DECISION

On 17 March 1999 Harman-Kardon, Incorporated of 250 Crossways Park Drive, Woodbury, New York 11797, United States of America applied under the Trade Marks Act 1994 for registration of the mark TAKE CONTROL in respect of:

Class 09 Electrical and electronic devices and equipment; audio equipment; remote control devices for operating all of the aforesaid goods; parts and fittings for all of the aforesaid goods.

Objection was taken to the application under Section 3(1)(b) and (c) of the Act because the mark consists of the words "TAKE CONTROL" only, being a sign which may serve in trade to designate e.g. goods which allow the user to control electronic equipment.

Objection was also taken under Section 3(6) of the Act because the range of goods specified seemed so extensive as to call into question the statement of the form of application that the applicant had a bone fide intention to use the mark on all of them.

Further objections were taken under Section 5(2) of the Act in respect of the following marks:

Number	Mark	Class	Specification
2172837		09	Audio, video and audio recordings; transparencies for projection; pre-recorded discs and tapes.
		41	Educational services; provision of training; provision of conferences and seminars; all relating to business, commerce or personal development.
E194647	TAKECONTROL	09	Computer software and user manuals in electronic format distributed therewith, for use in accessing and automating consumer affairs records, marketing records, sales records, customer records and support records.

TAKECONTROL •

Printed user manuals for computer software for use in accessing and automating consumer affairs records, marketing records, sales records, customer records and support records.

At the hearing, at which the applicants were represented by Mr McCall of W P Thompson & Co, their trade mark agents, the objections were maintained. The applicants were allowed further time until 24 March 2000 in which to respond. However, on 20 March 2000 the registry was invited to refuse the application so that the applicants could request a written statement of the grounds of that decision.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56 of the Trade Mark Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

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

Firstly I turn to Sections 3(1)(b) and (c) of the Act which reads 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, geographic origin, the time of production of goods or rendering of services, or other characteristics of goods or services,

The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

The mark consists of two ordinary dictionary words. The Collins English Dictionary (Updated Edition), gives various meanings of these words. The most pertinent as numbered in the said dictionary are reproduced below:

TAKE 9. to assume the obligations of: *to take office*.

19. to make, do, or perform (an action):

21. to put into effect; adopt: *to take measures*.

- CONTROL** 1. to command, direct or rule: *to control a country*.
3. to regulate or operate (a machine).
6. power to direct or determine: *under control: out of control*.
7. a means of regulation or restraint; curb: *a frontier control*.

The words TAKE CONTROL are presented in an ordinary upper case typeface without any form of stylisation. In my view members of the public on seeing this mark in relation to the goods contained in the specification applied for, would interpret them in line with the dictionary definitions set out above. The specification applied for in Class 9 is very wide. There are many goods covered by the term “Electrical and electronic devices and equipment”, many of which may have a controlling function or capability. The specification goes on to include “Remote control devices” for the operation of such goods. These goods are, by definition, designed to perform a controlling function. Remote control devices are available for many goods e.g. televisions, video recorders, video cameras, audio equipment, digital video disc players and many other specific receivers and recorders. Such has been the proliferation of these devices in recent years that customers may now purchase a single remote control device which is capable of controlling most of, if not all, of the equipment listed above, all of which is commonly found in both personal and business premises. In my view the mark indicates the kind of goods and the intended purpose of the goods and is one which other traders should be free to use in their normal course of trade.

The mark is also one which other traders may wish to use when advertising the same or similar goods. Traders involved in the retail of e.g. remote control devices, may well wish to advertise such products as ones which “Allow you to take control” with one “master” controller. In this respect I have taken account of the comments in the, as yet unreported, decision on the DAY BY DAY decision in which Simon Thorley QC in his role as the appointed person commented:

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

I also bear in mind the comments of Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9 to 23:

“Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacobs Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Works Ltd’s*

Trade Mark Application (1954) lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

I therefore conclude that the mark TAKE CONTROL is devoid of any distinctive character and consists exclusively of a sign which may serve in trade to designate the intended purpose or other characteristic of the goods and services and is thus excluded from registration under Sections 3(1)(b) and (c) of the Act.

The application was objected to under Section 3(6) of the Act because the terms “Electrical and electronic devices and equipment” are so wide ranging that, prima facie, it appears that the applicant could not have had a bona fide intention to use the mark in relation to all of the goods covered by such terms.

Section 3(6) of the Act reads as follows:

3.-(6) “A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The Registrar’s practice of objecting under Section 3(6) of the Act in cases of overly wide specifications would seem to be supported by comments made by Mr Justice Laddie in the *Mercury Communications v Mercury Interactive (UK) Ltd* case and Mr Justice Walker in the *Road-Tech Computer Systems Limited v Unison Software (UK) Limited (Road-runner)* case.

In the *Road-Runner* case 1996 F.S.R. 818 Mr Justice Walker said:

“Counsel have not been able to refer me to any material which shows the legislative purpose behind the Directive’s reference to bad faith. The recitals to the Directive make clear that it is intended to achieve partial (not total) harmonisation of trademark law within the European Union. The recitals refer to it being essential to require “that the conditions for obtaining and continuing to hold a registered trade mark are, identical in all Member States” and to the need “to require that registered trade marks must actually be used or, if not used, be subject to revocation”.

I find it impossible to get any clear guidance from these general recitals. They do however provide some support for Laddie J’s observation in *Mercury*, which I have already cited, that unduly wide specifications may not be possible under the 1994 Act”.

The registrar does not, as a matter of course, consider that applications for a wide range of properly specified goods and services should be challenged. The application form contains a statement that the Trade Mark is being used by the applicant, or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used. Accordingly, applications for lists of goods and services will normally be accepted even if they cover many classes. However, in extreme cases, or where vague and very wide terminology is used, the Registrar will continue to object under Section 3(6) of the Act.

In this particular application the specification applied for includes the term “Electric and electronic devices and equipment” which encompasses all goods in Class 9 which are electric or electronic in operation. The breadth of this specification was discussed at the hearing and,

as indicated in the hearing report, a reduced specification was to be considered by the applicant as a possible way forward but no such proposals have been submitted for consideration. Consequently I conclude that this application is debarred from registration under Section 3(6) of the Act.

I now turn to the objections raised under Section 5(2) of the Act.

Section 5(2) of the Act reads as follows:-

5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The term “earlier trade mark” is itself defined in Section 6 of the Act as follows:

6.-(1) In this Act an “earlier trade mark” means -

- (b) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (c) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark (UK), or
- (d) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

Turning to the respective marks, since these are not identical, I must decide whether the mark of this application so nearly resembles the cited mark as to be likely to cause confusion on the part of the public, which includes the likelihood of association with the earlier mark. In doing so, I take account of the comments in the *Sabel v Puma* trade mark case in the European Court of Justice (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 which stated:

“..... In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive- “..... shows that the perception of marks in the minds of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public”.

In the subsequent case of *The European v The Economist Newspaper* before the Court of Appeal (1998) RPC 283 Lord Justice Millet noted that:

“.....the converse must also apply. The more descriptive and less distinctive the major feature of the earlier mark, the less the likelihood of confusion.”

I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C 39/97) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”

and

“It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the

goods or services covered, where the marks are very similar and the earlier mark, in particular it's reputation, is highly distinctive.”

Firstly I will address the issue of whether the mark applied for is confusingly similar to the earlier trade marks. In the case of registration 2172837 the trade mark consists of the words TAKE CONTROL, presented in a stylised form together with a device which bears some resemblance to a stylised representation of the sun (a representation of this mark is to found earlier in this decision). Community registration 194647 is for the trade mark TAKECONTROL which is simply the words TAKE and CONTROL conjoined. Taking into account the visual, aural and conceptual similarity of the trade marks in question I have no doubt that both marks are similar to the trade mark applied for. All marks will be referred to as TAKE CONTROL marks when used in relation to the ordering or purchasing of goods or services. In my view the addition of the device element in registration 2172837 and the conjoining of the words in Community registration 194647 is not sufficient to remove this similarity. It is common practice for devices to be added to word marks as mere embellishment and for words to be conjoined.

I am, of course, also required to consider the similarity of the goods or services before one may conclude that there is a likelihood of confusion between the marks. The Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer decision makes it clear that the degree of similarity between the trade marks in question is a vital factor in determining the similarity of the goods or services. Trade marks which have a greater degree of similarity may be offset by a lesser degree of similarity between the goods or services, and vice versa. In this case I am of the view that both of the earlier trade marks have a high degree of similarity with the trade mark applied for. Registration 2172837 incorporates the same words in a slightly stylised form whilst Community Registration 194647 consists of the same two words conjoined. Consequently there is less need for a high degree of similarity between the goods or services before there is a likelihood of confusion.

This application has a very wide specification and in my view, the term “Electrical and electronic devices and equipment” covers all devices and equipment which are electric or electronic in operation.

Registration 2172837 has protection for the following goods:

Class 09 Audio, video and audio video recordings; transparencies for projection; pre-recorded discs and tapes.

It is clear that the specification for this application covers audio, video and audio video equipment, projectors and parts and fittings for such equipment. The goods covered by the specification for Registration 2172837 include those which would be used in conjunction with such equipment. Audio and video tapes are often provided free with the purchase of audio and video equipment. Given the high degree of similarity between the marks in question I conclude that the goods are similar and that registration of the trade mark applied for would lead to a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

Community registration 194647 has protection for the following goods:

- Class 09 Computer software and user manuals in electronic format distributed therewith, for use in accessing and automating consumer affair records, marketing records, sales records, customer records and support records.
- Class 16 Printed user manuals for computer software for use in accessing and automating consumer affairs records, marketing records, sales records, customer records and support records.

It is clear that the specification for this application covers computer hardware and peripheral computer equipment. The goods covered by the specifications for Community registration 194647 comprise computer software together with user manuals in both electronic and printed form. Such goods are often provided free with the purchase of computer equipment. Given the high degree of similarity between the marks in question I conclude that the goods are similar and that registration of the trade mark applied for would lead to a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

I therefore consider the prior registrations to be fatal barriers to the progress of this application. This application is, therefore, debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application and, for the reasons given, it is refused under Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c), 3(6) and 5(2) of the Act.

Dated this 3 Day of August 2000.

**A J PIKE
For the Registrar
The Comptroller General**