

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2224156
BY KABUSHIKI KAISHA SONY COMPUTER ENTERTAINMENT
(ALSO TRADING AS SONY COMPUTER ENTERTAINMENT INC)
TO REGISTER A TRADE MARK IN CLASS 9**

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DECISION AND GROUNDS OF DECISION

1. On 1 March 2000, Kabushiki Kaisha Sony Computer Entertainment (also trading as Sony Computer Entertainment Inc) of 1-1, Aksaka 7-Chome, Minato-Ku, Tokyo, 107-0052 , Japan applied under the Trade Marks Act 1994 to register the following trade mark in class 9:

Tools & Middleware

2. The goods in class 9 claimed are as follows:

Amusement apparatus adapted for use with television receivers only; amusement machines, automatic and coin-operated; apparatus for games adapted for use with television receivers only; cassette players; cathodes; coin-operated mechanisms for television sets; compact discs players; computer keyboards; computer memories; computer mice; computer operating programs, recorded; computer peripheral devices; computers; conductors electric; connections for electric lines; connections, electric; contact lenses; contacts, electric; contacts, electric, of precious metal; controller for games adapted for use with television receivers only; demagnetizing apparatus for magnetic tapes; digital versatile disc roms; electro-dynamic apparatus for the remote control of railway points; electro-dynamic apparatus for the remote control of signals; encoded cards, magnetic; floppy disks; integrated circuits; intercommunication apparatus; joysticks for games adapted for use with television receivers only; loudspeakers; magic lanterns; magnetic data media; magnetic encoders; magnetic tapes; magnetic wires; magnets; microprocessors; mouse for games adapted for use with television receivers only; notebook computers; optical data media; optical discs; printed circuits; printers for use with computers; record players; semi-

conductors; softwares for games adapted for use with television receivers only; sound recording apparatus; sound recording carriers; sound recording discs; sound recording strips; sound reproduction apparatus; sound transmitting apparatus; sounding apparatus and machines; sounding leads; sounding lines; tape recorders; telephone apparatus; telephone receivers; telephone transmitters; telephone wires; teleprinters; television apparatus; video cassettes; video game cartridges; video recorders; video screens; video telephones; videotapes

3. Objection was taken under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that the mark is a sign which may serve in trade to designate e.g. goods incorporating or consisting of software tools and middleware products. Reference was made to the Oxford Dictionary of Computing, which separately lists the terms "software tool" and "middleware".

4. At the hearing at which the applicants were represented by Ms J Rowley of A A Thornton & Co, their trade mark agents, the objections under Section 3(1)(b) and (c) of the Act were maintained. Following refusal of the application under Section 37(4) of the Act, 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 decision and the materials used in arriving at it.

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

6. Section 3(1)(b) and (c) of the Act reads as follows:

"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".

7. The mark consists essentially of two words that are meaningful in the field of computers and computer related goods. The Oxford Dictionary of Computing gives references as follows:

"**tool** See software tool.

software tool A program that is employed in the development, repair, or enhancement of other programs or of hardware. Traditionally a set of software tools addressed only the essential needs during program development: a typical set might consist of a *test editor, *compiler, *link loader, and some form of *debug tool. Such a set concentrates solely on the program production phase and is that normally provided by a *program development system.

It is now recognized that software tools can assist in all activities of all phases of the

*software life cycle, including management and quality-assurance activities. Thus a comprehensive set would address such issues as requirements specification, design, validation, configuration control, and project management. Such tools would frequently form part of an integrated *software engineering environment.

Middleware 1.(firmware) Products that in some sense occupy a position between hardware and software. It is usually system software held in a *ROM. In particular where microcoded systems are used, the actual microcode is sometimes spoken of as middleware.

2. Software that occupies a position between the *operating system and *applications programs, particularly in a distributed system."

8. The term "Tools and Middleware" as a totality, in my view, is therefore likely to convey the meaning to the purchasing public that, when applied to computers and computer related goods, the products either consist of or incorporate software tools and middleware products.

9. The agent argued at the hearing that the mark forms a distinctive whole. She disputed that the term "Tools" clearly meant "Software Tools" in this context, and she further pointed to the stylised font used in the mark. I rejected these arguments at the hearing. In relation to relevant goods, "Tools" means "Software Tools". The presentation of the words in the non-distinctive font used is neither here nor there.

10. I indicated at the hearing that the mark may be acceptable if an amended specification of goods is offered which removes relevant goods. The agent sought an acceptable restricted specification, and the letter to the registrar dated 5 July 2001 offered the final limitation as follows:

"Amusement apparatus adapted for use with television receivers only, none being computer based; amusement machines, automatic and coin-operated; apparatus for games adapted for use with television receivers only, none being computer based; cassette players; cathodes; coin operated mechanisms for television sets; compact disc players; conductors electric; connections for electric lines; connections, electric; controllers for games adapted for use with television receivers only, none being computer based; demagnetising apparatus for magnetic tapes; electrodynamic apparatus for the remote control of railway points; electrodynamic apparatus for the remote control of signals; integrated circuits; intercommunication apparatus; joysticks for games adapted for use with television receivers only; loudspeakers; magic lanterns; magnetic data media; magnetic encoders; magnetic tapes; magnetic wires; magnets; mouse for games adapted for use with television receivers only; optical data media; optical discs; printed circuits; record players; semiconductors; sound recording apparatus; sound recording carriers; sound recording discs; sound recording strips; sound reproduction apparatus; sound transmitting apparatus; sound apparatus and machines; sounding leads; sounding lines; tape recorders; telephone apparatus; telephone receivers; telephone transmitters; telephone wires; teleprinters; television apparatus; video cassettes; video game cartridges; video recorders; video screens; video telephones; video tapes; but not including any goods containing a chip or memory of any kind".

11. This specification was rejected despite the exclusion at the end because it still contains goods that do, or could, contain software tools and/or middleware products, such as "magnetic data media", and so the term "Tools and Middleware" would merely be taken to be an indication of the kind of goods on offer. I had indicated to the agent at the hearing and in later correspondence that a positive limitation of the goods in class 9 would be the best way to overcome the objection. It was only after the application had been formally refused that the agent proposed the following restricted specification of goods.

"Magnetic data media; magnetic tapes; optical data media; optical discs; sound recording discs; sound recording strips; video tapes".

12. Even though the time for negotiation over a possible restricted specification has passed, I remain of the view that coverage is sought for products, such as "magnetic data media" that may be concerned with software tools and middleware such as systems software held in read only memory (ROM). I would go on to say that a specification covering software alone or middleware alone would still not overcome the objection as the mark as a whole conveys the message that the products are a combination of the both and registration of the mark for either would be contrary to Section 3(1)(c).

13. Since I made the decision to refuse this application, the European Court of Justice has 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). This is in "BABY-DRY" Case C-383/99 P. I give below the guidance issued 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 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."

14. This 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). I had already taken the view in this decision that "Tools and Middleware" is regarded as a normal way of designating software tools and middleware.

15. In this decision I have considered all documents filed by the agent and, for the reasons given it is refused under the terms of Section 37(4) of the Act because it is debarred from registration under Section 3(1)(b) and (c) of the Act.

Dated this 8TH day of November 2001.

JANET FOLWELL
for the Registrar
the Comptroller General