

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO. 2180156**  
**BY ADVANCED MICRO DEVICES, INC**  
**TO REGISTER A TRADE MARK IN CLASS 9**

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**DECISION AND GROUNDS OF DECISION**

10 On 21 October 1998, Advanced Micro Devices, Inc of One AMD Place, Sunnyvale, California 94088, United States of America, applied to register the trade mark 3DNOW! in respect of:

Class 9           Semi-conductor devices; computer hardware and microprocessors;  
                      programming language compilers and interpreters; application  
                      programming interface(s) and computer software.

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Objection was taken under Sections 3(1)(b) and (c) of the Act on the grounds that the mark consists of the term "3DNOW!" being devoid of distinctive character and a term others may legitimately wish to use for e.g. goods relating to 3-dimensional programming.

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At a hearing, at which the applicants were represented by Mr I Bartlett of W H Beck Greener & Co, their trade mark agents, the objections 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 56(2) of the Trade Marks Rules 1994 (as amended) to state in writing the grounds of my decision and the materials used in arriving at it.

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At the hearing, Mr Bartlett put forward various arguments in support of acceptance of the mark in totality. No claim was made that the numeral and letter "3D" is distinctive per se. The case for registration may be summarised as follows:

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- It is not a relevant consideration that others will wish to use the term ""3D".

- The mark, in totality, performs the function of a trade mark.

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- Sample trade literature was produced to me at the hearing showing the mark applied for in use on the goods claimed. A selection of some of the literature provided, showing the more prominent use of the mark applied for is attached at Annex A.

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- The mark applied for cannot readily be used in a descriptive sense for the products claimed other than in a manner that is badly stilted or ungrammatical.

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- The *Lake Chiemsee* case (*Windsurfing Chiemsee Produktions - und - Vertriebs GmbH, and Boots - und - Segelzubehor Walter Huber and Franz Attenberger ref: C-108/97 and C-109/97 4 May 1997*) supports Mr Bartlett's view that the availability of signs (other than geographical indicators) for honest descriptive use is guaranteed by Article 6(1)(b), the equivalent provision to our Section 11(2)(b) and therefore the principal question to be asked in relation to

distinctiveness is whether the sign may serve, in addition to any descriptive application that it might have, to denote trade origin. Mr Bartlett is firmly of the view that in this case, the mark applied for has the capacity to denote trade origin.

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- In the *Phillips -v- Remington* case (*Philips Electronics NV v. Remington Consumer Products Ltd* [1999] RPC 809), the Judge, Aldous LJ, who gave the leading judgement of the Court said that cases decided under the old law are no longer authoritative. Consequently, the comments of Mr Hobbs QC in the AD2000 decision [1997] RPC168 to the effect that the "savings" provisions are not to be taken into account in deciding questions of registrability, are no longer applicable.

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These arguments did not persuade me that the mark is not devoid of any distinctive character.

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The relevant part of the Act under which objection was taken is as follows:

Section 3(1):

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"3(1) The following shall not be registered -

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

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(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,

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Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

No evidence of use before the date of the application has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

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The mark consists of the well known abbreviation of the term "3-dimensional" (i.e. 3D) conjoined with the word "NOW" with an exclamation mark at the end. The term "3-dimensional" is given in the Collins English Dictionary (Millennium Edition) as meaning:

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1.- Of, having, or relating to 3 dimensions: *3-dimensional space*.

2. - (of a film, transparency, etc) simulating the effect of depth by presenting slightly different views of a scene to each eye.

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3.- Having volume.

4.- Life like or real.

5 In Macmillan's Dictionary of Information Technology, "3-dimensional graphics" is given as follows:

"In computer graphics, the representation of a 3-dimensional image on a cathode ray tube (CRT) screen in a form which gives an impression of 3-dimensional imagery".

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The word "NOW" is an ordinary word which is so well known that I believe I do not need to set out any dictionary reference. The exclamation mark appearing at the end of the whole term is a common punctuation mark.

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From my own knowledge, the whole term "3DNOW!" is not invented and seems, to my mind, apt for use in advertising to draw attention to the 3-dimensional programming now on offer at retail outlets. In the fast developing market for technologically advanced products, my view is that 3D graphics applications would be seen as at the cutting edge. Consequently, "3D" is a pure description of the product and the word "NOW!" merely serves to emphasise that those

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As such it seems to me that the mark applied for is not badly stilted or ungrammatical, it is an apt advertising "strap line" which does not possess the necessary ability to identify goods or services from a single trade source. The trade literature provided at the hearing does show in some instances, that the applicant is attempting to use the term as a trade mark, but I am not convinced that it will be perceived as such without first having acquired a distinctive character through repetitive use. See Annex B for an example of the mark in use on the applicant's trade literature which comes across as purely descriptive use.

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In the course of this decision, I have also borne in mind the comments of Mr Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9-23:

"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 Mr Robin Jacob QC in his decision on behalf of the Secretary of State in the *Colorcoat trade mark* (1990) RPC 511 at 517 in the following terms:

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"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 Work Ltd's Trade Mark Application* (1954) RPC 150 at 154 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". "

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Mr Bartlett respectfully submitted that the approach taken by Mr Hobbs QC has been superceded by the decision of the ECJ in the *Lake Chiemsee* and *Phillips -v- Remington* judgements. In the *Phillips -v- Remington* judgement, the Judge, Aldous LJ, made the statement that cases decided under the old law are no longer authoritative. Mr Bartlett  
5 considers this statement significant in that the new UK law, based upon the European directive, has quite different considerations than that of the old 1938 Act. Accordingly, the old law which has been developed around the 1938 Act, including the *Colorcoat* and *Yorkshire Copper Works Ltd* decisions quoted with approval by Mr Hobbs QC in the AD2000 case cannot represent the law on an Act with a quite different history and schema. Bearing  
10 this in mind, the *Lake Chiemsee* judgement, in Mr Bartlett's submission, requires the UK Registrar to change the emphasis of the way in which she examines marks under Section 3(1) and should replace the guidance given by Mr Hobbs QC in the AD2000 decision. He submitted that although the *Lake Chiemsee* case was concerned in particular about the registration of geographical terms as trade marks, it has general application to all signs which  
15 might be considered capable of being used descriptively. He singled out Paragraph 28 of the Judgement where the ECJ states:

"Indeed, Article 6(1)(b) of the Directive [Section 11(2)(b) of the UK Act] which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or  
20 partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters."

And then at paragraph 35:

"It follows from the foregoing that the application of Article 3(1)(c) of the Directive [the equivalent of Section 3(1)(c) in the UK Act] does not depend on there being a  
30 real, current or serious need to leave a sign or indication free."

He submitted that the reason the ECJ was able to say this is that the availability of signs for honest descriptive use is guaranteed by Article 6(1)(b), the equivalent provision to our Section 11(2)(b). Thus, the principle question to be asked, in relation to distinctiveness, is whether the sign may serve, in addition to any descriptive use it might have, to denote trade origin.  
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Paragraphs 28 and 35 must be taken in the context of the whole Judgement.

Paragraph 25 of the Judgement states as follows:

"However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks."  
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Article 3(1)(c), specifically states that any sign that may serve in trade to designate characteristics of the goods or services should not be registered as an unused mark. Indeed, if it is the case that Section 11(2)(b) provides sufficient protection for honest traders by enabling  
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5 them to use descriptive signs in the course of trade without any concern for registered trade marks, then Article 3(1)(c) would have no 'public interest' role as described in para 25 of the ECJ's judgement. The use of the word "may" in Section 3(1)(c), in my view, means that objection must go wider than simply to such words as "3D" alone for computer software or "cotton" for clothing. These are words that must be used in trade because they are unavoidable if one wishes to describe certain characteristics of the product.

10 I therefore am of the view that the comments of Mr Hobbs QC in the *AD2000* case continue to be valid. The *Lake Chiemsee* judgement does no more than make clear that signs that may serve in trade as geographical indicators (or any word falling foul of Section 3(1)(c)) face serious obstacles to registration in the prima facie, although there may be circumstances where they may be registered. There is therefore a judgement to be made as regards the mark applied for and the meaning of Section 3(1)(c) as clarified by the ECJ in the *Lake Chiemsee* case.

15 I acknowledge the dictum of Aldous LJ in the *Phillips -v- Remington* case where he said that cases decided under the old law are no longer authoritative. But *AD2000* was decided by the Appointed Person in accordance with the 1994 Trade Marks Act. My understanding of Mr Hobb's statement is that whether it is the old law or the new law, the principle is the same, in that primary legislation needs to ensure that honest traders should not need to look over their  
20 shoulders in case ordinary descriptive words have been monopolised by others.

25 Despite my interpretation of the *Lake Chiemsee* and *Phillips -v- Remington* judgements, and on further consideration of the mark in question, I concede that the Section 3(1)(c) objection may be waived. This is because the totality of the mark is such that it combines the descriptive term "3D" with another (albeit non distinctive) element i.e. "NOW!". The word "NOW!" in this context probably does not designate characteristics of the goods so much as their immediate availability for sale. Consequently, I acknowledge that it is not a term that may be used in trade to designate the kind of goods. But I am firmly of the view that the mark, in  
30 totality, is devoid of distinctive character for the goods claimed within the meaning of Section 3(1)(b). It seems to me to be self evident that, in the context of computer graphics software, the words "3D now on sale!" should be regarded as devoid of any distinctive character because the sign is incapable of performing the essential function of a trade mark, which is to guarantee the trade origin of the goods. In my view the mark "3DNOW!" suffers from the same defects. Although the term 3D and the word "Now!" are conjoined, the capital letter  
35 "N" serves to create a similar impression as if the mark was "3D NOW!" In my view the average consumer would understand this to mean "now available" or "now for sale".

40 In this decision I have also taken account of the comments in the unreported decision on the DAY BY DAY case (Application no. 2068646 dated 12 April 1994). In that appeal, Mr Simon Thorley QC in his role as the Appointed Person 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 ....."

45 In conclusion, and in the absence of evidence that the mark has acquired a distinctive character by reason of the use made of it, it is debarred from registration under Section 3(1)(b) of the Act. In this decision, I have considered all the documents filed by the applicant and all the

arguments submitted to me in relation to this application, and for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

5     **Dated this    21    day of                    June 2000**

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**JANET FOLWELL (MS)**  
**For the Registrar**  
15     **The Comptroller General**

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(Nb annexe only available as a paper copy)