

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2221625

BY SONY KABUSHIKI KAISHA (T/A SONY CORPORATION)

TO REGISTER A TRADE MARK IN CLASS 9

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DECISION AND GROUNDS OF DECISION

1. On 7 February 2000 Sony Kabushiki Kaisha (T/a Sony Corporation) of 6-7-35 Kitashinagawa, Shinagawa-ku, Tokyo 141, Japan applied under the Trade Marks Act 1994 to register the mark "Music Clip" in respect of:

Class 9: Audio players/recorders that use integrated circuits as recording media; audio tape players/ recorders; audio disc players/recorders; headphones; earphones; and personal computers.

2. Objection was taken under paragraphs (b) and (c) of Section 3(1) of the Act because the mark consists exclusively of the words MUSIC CLIP being a sign which may serve in trade to designate the kind of goods (those for use in playing music clips).

3. At a 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.

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

5. 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".

6. The mark consists of the words MUSIC CLIP. Both these words are ordinary dictionary words.

Collins English Dictionary (Third Edition updated 1994) provides several meanings of these words the most relevant being:-

MUSIC - an art form consisting of sequences of sounds in time, esp. tones of definite pitch, organised melodically, harmonically, rhythmically and according to tone colour

CLIP - an extract from a film, newspaper, etc.

7. The term "Music Clip", as a totality, is therefore likely to convey the meaning, to the general public of an extract of music.
8. On 22 August 2000 examples of the term "music clip" in use were forwarded to the agent for information. A copy of this information is at Annex A of this decision.
9. In my view the term "Music Clip", when used on the goods covered by the specification filed with this application does no more than indicate the kind and intended purpose of the goods. They inform the prospective purchaser that the goods in question will enable them to play and listen to music clips. The goods are in effect music clip players.
10. This point is substantiated by reference to the applicants own website. A copy of the relevant information is at Annex B of this decision.
11. In this decision I have taken into account the guidance provided by the European Court of Justice in the "BABY-DRY" Case C-383/99P on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulations (equivalent of Section 3(1) of the Trade Marks Act).
12. Paragraphs 37, 39 and 40 of the judgement are reproduced below:-

"37. 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."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 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 or designating the goods or services concerned or their essential

characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

13. These paragraphs indicate 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).

14. I conclude that the relevant public would see the term MUSIC CLIP, on first impression, as an indication of the kind and intended purpose of the goods covered by the application. It would be the normal way of designating audio players etc for playing music clips.

15. Therefore, I consider the mark applied for consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods and therefore, excluded from registration by Section 3(1)(c) of the Act. For the same reasons I consider the mark to be devoid of any distinctive character and therefore not acceptable for registration under Section 3(1)(b) of the Act.

16. 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 Sections 3(1)(b) and (c) of the Act.

Dated this 29th day of April 2002.

Ian Peggie
For the Registrar
The Comptroller General

Annex in paper copy