

1 THE APPOINTED PERSON: On the 1st March 2000 Sony Computer
2 Entertainment Inc applied to register the designation **Tools &**
3 **Middleware** as a trade mark for use in relation to a wide
4 specification of goods in Class 9.

5 I should say at the outset that the words "tools" and
6 "middleware" appear to be meaningful in the context of the
7 application for registration on the basis of the meanings
8 ascribed to them in the Oxford Dictionary of Computing:

9 **"Tool** See software tool.

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

19 It is now recognized that software tools can assist in
20 all activities of all phases of the *software life
21 cycle, including management and quality-assurance
22 activities. Thus a comprehensive set would address
23 such issues as requirements specification, design,
24 validation, configuration control, and project

25 management. Such tools would frequently form part of

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1 an integrated *software engineering environment.

2 Middleware 1.(firmware) Products that in some sense

3 occupy a position between hardware and software. It

4 is usually system software held in a *ROM. In

5 particular where microcoded systems are used, the

6 actual microcode is sometimes spoken of as middleware.

7 2. Software that occupies a position between the

8 *operating system and *applications programs,

9 particularly in a distributed system."

10 The Registry raised objections to registration under

11 sections 3(1)(c) and 3(1)(b) of the Trade Marks Act 1994 on

12 the basis that the designation in question was descriptive

13 and, in the absence of any claim to distinctiveness acquired

14 through use in the United Kingdom prior to the date of the

15 application for registration, non-distinctive of the goods of

16 interest to the Applicant.

17 The Applicant sought to overcome these objections by

18 offering amendments to the specification of goods set out in

19 the application. The amendments were framed with a view to

20 defining the relevant goods in a way that might be said to

21 render the designation Tools & Middleware less obviously apt

22 to describe the nature or characteristics of the goods thus

23 defined.

24 Successive amendments were offered by the Applicant and
25 rejected by the Registry over a period of 10 months or so

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1 between October 2000 and August 2001. The application was
2 ultimately refused for the reasons given in a Decision issued
3 by Ms. Janet Folwell on behalf of the Registrar of Trade
4 Marks on 8th November 2001.

5 In essence, the Hearing Officer considered that the
6 designation in issue possessed a meaning and significance
7 which could not be regarded as anything other than
8 descriptive in the field of computer technology.

9 The Applicant gave Notice of Appeal to the Appointed
10 Person on the 20th November 2001 contending that registration
11 of the designation Tools & Middleware should have been
12 allowed, consistently with the guidance provided by the
13 European Court of Justice Case C - 383/99 P Procter & Gamble
14 v OHIM ("Baby Dry") 20th September 2001, for "magnetic data
15 media; magnetic tapes; optical data media; optical discs;
16 sound recording discs; sound recording strips; video tapes."

17 In paragraphs 39 to 42 of its judgment in the BABY DRY
18 case the European Court of Justice held that the exclusion
19 from registration contained in section 3(1)(c) of the 1994
20 Act is applicable to signs and indications which consist
21 simply and solely of designations "which may serve in normal
22 usage from a consumer's point of view to designate, either

23 directly or by reference to one of their essential
24 characteristics, goods or services such as those in respect
25 of which registration is sought" (paragraph 39) and which may

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1 therefore be viewed as a normal way of referring to the goods
2 or service or of representing their essential characteristics
3 in common parlance (paragraph 42).

4 In paragraphs 43 to 46 of its judgment the Court held
5 that the exclusion did not apply to signs or indications
6 identifiable as "syntactically unusual juxtapositions" of
7 words in the nature of "lexical inventions" (in that case
8 BABY DRY for disposable diapers made out of paper or
9 cellulose and diapers made out of textile).

10 For the reasons I gave at greater length in my decision
11 in CYCLING IS, T.M. 29th November 2001, I consider that the
12 BABY DRY judgment addresses the scope of the objection
13 prescribed by section 3(1)(c) of the Act and does so without
14 laying down any general rule to the effect that signs which
15 are not wholly descriptive should, for that reason, be
16 regarded as distinctive and therefore free of objection under
17 section 3(1)(b) of the Act.

18 I believe that similar views have been expressed by
19 Advocate General Colomer in his Opinion delivered on 31st
20 January 2002 in Case C - 363/99 Koninklijke KPN Nederland NV
21 v Benelux-Merkenbureau (Postkantoor) although I have not yet

22 seen the official English translation of that Opinion.

23 As indicated in the CYCLING IS decision, I consider
24 that section 3(1)(b) contains an independently available
25 objection to registration of somewhat broader scope than that

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1 prescribed by section 3(1)(c) and that the test of
2 registrability under section 3(1)(b) resides in the question
3 whether the perceptions and recollections that the sign in
4 issue would trigger in the mind of the average consumer of
5 the specified goods or services are likely to be
6 origin-specific or origin-neutral.

7 Reverting to the present case it appears to me that the
8 designation in issue combines the two words "Tools" and
9 "Middleware" in a non-distinctive way for use in a context
10 and manner that is likely to lead to them being perceived and
11 remembered simply as indications of the kind or character of
12 the goods concerned.

13 The Oxford Dictionary of Computing definitions indicate
14 that in the field of computer technology the expression
15 "Tools & Middleware" can be likened to the expression "nuts
16 and bolts" as used metaphorically to describe the elements of
17 an assembled product in the field of mechanical engineering.

18 There is no material which is before me to suggest that the
19 Dictionary meanings are obscure or of such specialised
20 significance as to render the words Tools & Middleware

21 cryptic or idiosyncratic in the context of their proposed use
22 by the Applicant.

23 I am left with the impression that they amount to an
24 ordinary way of designating the general nature of the goods
25 of interest to the Applicant and are not likely to trigger

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1 origin-specific perceptions and recollections in the mind of
2 the average consumer of the goods concerned.

3 For these reasons, shortly stated, I consider that the
4 Hearing Officer was right to reach the decision she did. The
5 Appeal therefore stands dismissed.

6 Does anyone want to address me on the question of
7 costs?

8 MS. HAVARD: No, I do not.

9 THE APPOINTED PERSON: Normal practice, Mr. Rowan? Treating the
10 appeal as effectively a continuation of the ex parte
11 procedure in the Registry there will be no order for costs on
12 this Appeal.

13 MS. HAVARD: Thank you.

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