

**IN THE MATTER OF
APPLICATION No 2297609
BY KABUSHIKI KAISHA SONY COMPUTER ENTERTAINMENT
TO REGISTER A TRADE MARK
IN CLASS 9**

DECISION AND GROUNDS OF DECISION

Background

1. On 10 April 2002 Kabushiki Kaisha Sony Computer Entertainment of 1-1 Akasaka 7-chome, Minato-ku, Tokyo 107-0052, Japan applied to register the following trade mark in Class 9.



2. The application was made in respect of the following goods:

Class 9. Mouse pads for computers; Mouse for computers; Electronic circuits, magnetic discs and magnetic tapes, encoding computer programs for encrypting or decrypting information data; Information proving devices, encrypting and micro programming devices for information processing machines; Straps for cellular phones; Instant cameras with films; Machines and instruments for amusement parks; Slot machines; Downloadable computer programs; Downloadable electronic publications; Downloadable video game software; Electronic circuits, magnetic discs, magnetic tapes, optical discs, CD-ROMs, magnetic cards, and other memory media encoding assemblers, compilers, and computer programs for software development and computer programming; Encryption devices used for scrambling in telecommunication; Electronic circuits, magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc ROMs), magnetic tapes and Digital Versatile Disc ROMs encoding video game programs for personal use; Electronic circuits, magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc

Roms), magnetic tapes and Digital Versatile Disc ROMs encoding video game programs for business use; Controllers, joysticks, memory cards, volume controllers, mouse and other parts and accessories for Video games adapted for use with television receiver only; Magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc Roms), magnetic tapes and Digital Versatile Disc ROMs encoding magazines, books, news papers, maps, pictures, images and literal information; Apparatus and instruments for scientific research in laboratories; Educational models and specimens; Measuring apparatus by standard measuring units; Measuring apparatus by derived measuring units; Precision measuring machines and instrument; Automatic control machines and instruments; Material testing machines and instruments; Surveying machines and instruments; Astronomic measuring machines and instruments; Hiding-charts for identifying hiding power of paint; Thermosensitive sheets for temperature indication; Steel pieces for testing rust formation; Power distribution and/or control apparatus; Rotary converters; Phase modifiers; Dry cells; Wet cells; Accumulators and batteries; Photovoltaic cells; Electric or magnetic meters and testers; Electric wires; Electric cables; Photographic apparatus and instruments; Cinematographic apparatus and instruments; Telescopes; Microscopes; Eyeglasses and goggles; Parts and accessories for eyeglasses and goggles; Processed glass (not for use in building); Life nets; Lifebelts; Lifejackets; Life-buoys; Telephone apparatus; Wire communication apparatus; Frequency-carrier apparatus; Broadcasting apparatus; Radio communication apparatus; Radio application apparatus; Remote control telemetering apparatus; Audio frequency apparatus; Video frequency apparatus; Parts and accessories for electric communication apparatus and instruments; Phonograph records; Metronomes; Recoded Compact Discs; Computers; Electron microscopes ; Electronic desk calculators ; Word processors ; X-ray tubes (not for medical use) ; Photo-sensitive tubes ; Vacuum tubes ; Rectifier tubes ; Cathode ray tubes ; Discharge tubes ; Thermistors ; Diodes ; Transistors ; Electron tubes; Semi-conductor elements (Semi-conductor devices); Integrated circuits; Large scale integrated circuits; Semiconductor; Video Random Access Memory; Electric flat irons for household use; Electric hair-curlers for household use; electric buzzers for household use; Exposed cinematographic films; Exposed slide films; Transparencies; Slide film mounts; Encoded video discs and tapes; Vending machines (Automatic distribution machines); Video games adapted for use with television receiver only.

3. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the letters **GS** being an acronym of the conjoined words **GraphicsSynthesizer**, the whole being a sign which may serve in trade to designate the kind and intended purpose of the goods, e.g. Graphics Synthesizers or computer software for producing synthesized visual effects.

4. At a hearing, at which the applicants were represented by Ms Havard of A A Thornton & Co, their trade mark attorneys, the objection was maintained.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

The Law

7. Section 3(1)(b) and (c) of the Act 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, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

The Decision

8. At the hearing Ms Havard explained that the trade mark applied for is used in relation to the Playstation 2 game system and, more specifically, to a computer chip contained within it. Ms Havard provided me with detailed documentation with the view to providing me with further information regarding the goods on which the trade mark is used together with examples of the trade mark in use. Copies of these are attached at Annex A. The purpose of this was to persuade me that images are not synthesised and that the objection should be waived.

9. Because of the complexity of these documents I did not issue a decision at the hearing but advised Ms Havard that I would issue it in writing after considering the matter in detail. On 15 January 2003 I issued my decision which was to maintain the objection.

10. In a letter from A A Thornton & Co dated 14 April 2003 it was indicated that the specification of goods in Class 9 may be limited to:

“Large scale integrated circuits.”

11. Although no final decision to formally limit the specification has been made, this letter contained a request that the submissions made in support of this application should be considered on the basis that the specification is to be so limited.

12. Collins English Dictionary (3rd Edition Updated 1994) defines the word SYNTHESIZER as:

“n. 1. An electrophonic instrument, usually operated by means of a keyboard and pedals, in which sounds are produced by voltage-controlled oscillators, filters and

amplifiers, with an envelope generator module that controls attack, decay, sustain, and release. 2. a person or thing that synthesizes.”

13. The same dictionary defines the word SYNTHESIZE inter alia as:

“vb. 1. To combine or cause to combine into a whole.”

14. Synthesizers have been well known in relation to musical instruments since the 1980s when they were commonly used by performing artists and groups. They allow a keyboard to be used in order to create different sounds such as those usually associated with guitars or violins. They generate sounds. In my view they have been in use for many years and the word is now well known by the general public.

15. This application is for a specification limited to “Large scale integrated circuits” and the trade mark in question is used upon a circuit contained within a games system known as Playstation 2. I am aware that the display of graphics is an important element of such games and may be an important consideration in the mind of prospective purchasers who, in relation to these goods, are the general public. I am aware that the specification is now limited to integrated circuits but information on file makes it clear that such circuits are part of the electronic game known as Playstation 2 and the purchasers of these games and, by extension the integrated circuits, are the general public. The evidence on file makes it clear that the integrated circuits are not sold separately but as part of the Playstation 2 game. In the same way that a synthesizer combines sounds to produce a different sound then it may perform the same function in relation to graphics. The following information is provided in the documentation introduced by Ms Havard (Annex A):

“The “Emotion Engine” CPU performs calculations and instructions, while the “Graphics Synthesizer” handles the task of coordinating and displaying graphics and the Sound Chip (SPU2) converts data to sounds and plays them. In a game, the CPU handles most of the calculations required to move objects. The Graphics Chip draws and moves the objects according to the CPU’s instructions.”

and:

“The original PlayStation introduced the concept of Graphics Synthesizer via the real-time calculation and rendering of a 3-D object. The new GS rendering processor is the ultimate incarnation of this concept-delivering unrivaled graphics performance and capability. The rendering function was enhanced to generate image data that supports NTSC/PAL television. The quality of the resulting screen image is comparable to movie 3D graphics in real time.”

16. The extracts set out above make it clear that the words GRAPHICS SYNTHESIZER is used by the applicant in relation to a graphics processor which processes graphics and displays them. I note from the extract set out above that the synthesizer functions by “*coordinating and displaying graphics*” which, in my view, is very similar in meaning to the dictionary definition of the word SYNTHESIZE which is “*To combine.....into a whole*” (see paragraph 13).

Although it is proposed that the specification should be limited to “Large scale integrated circuits” it would appear that this does not assist when assessing the validity of the objection.

17. I consider the words GRAPHICS SYNTHESIZER to be directly descriptive of integrated circuits which facilitate the synthesis of graphics. However that in itself is not enough because the trade mark applied for consists of these words together with the letters GS. As far as I am aware the letters GS are not a known acronym for the words GRAPHICS SYNTHESIZER and if viewed in isolation they may not be seen as standing for the words GRAPHICS SYNTHESIZER. However, in the trade mark applied for, they are placed directly above the words and follow the same order as the initial letters of those words. In this context they will only be seen as the initial letters of the words GRAPHICS SYNTHESIZER and will send no other message to the relevant consumer of these goods. I note that the letters GS are noticeably larger than the words GRAPHICS SYNTHESIZER but I am not of the opinion that this is sufficient to bestow trade mark character on the sign. I also note that the words are conjoined but with capitalised letters G and S, the words can only be seen as GRAPHICS SYNTHESIZER. I must, of course, consider the trade mark in its entirety and not simply consider individual elements. In my view the combination of letters and words as presented in this sign does not remove the descriptiveness of it. The word SYNTHESIZE means “*To combine into a whole*” (see paragraph 13) and in my view the sign in question simply indicates that the goods in question provide the ability for graphics to be synthesized in that they are combined through the synthesizer to form new combined graphics. I do not consider that the relevant consumer, who in this case I have found to be the general public, will place any trade mark significance upon it. To the contrary they will, in my view, see it as being descriptive of a characteristic of the goods.

18. In a judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act).

19. 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 sign or indications and

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.”

“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 or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

20. And as Simon Thorley QC said when acting in his capacity as the Appointed Person in the FOIA Centre decision:

“10. It is also plain from a recent decision of the Court of Justice (see Case C-53/01 Linde A.G. v. Rado Uhrn A.G. (8th April 2003) and a recent opinion of Advocate General Jacobs (see Case C-191/01P OHIM v. Wm. Wrigley Jr. Company) that the concept of keeping signs free for descriptive use is a consideration which continues to apply in assessing registrability under Section 3.

11. In my judgment therefore Mr James’ submissions to the applicable law under Section 3(1)(c) are correct. It is not sufficient merely to take a snap shot of the appreciation of the relevant consumer as at the date of application. It is necessary, following the guidance in the Windsurfing case, to look ahead and look around in order to ensure that trade mark protection is not being given to a sign which may, (in the sense of being reasonably likely to), serve in trade to designate one of the descriptive aspects referred to in section 3(1)(c).”

21. When considering this matter through the eyes of the relevant consumer of the goods in question I am of the view that they will not place any trade mark significance on this mark but will perceive it as a sign which does no more than describe a characteristic of the goods applied for.

22. In the circumstances I have concluded that the trade mark at issue comprises a word which, prima facie, cannot distinguish the applicants’ goods from those of other undertakings and is therefore debarred from registration by Section 3(1)(c) of the Act.

23. For the same reasons I consider the trade mark to be devoid of any distinctive character and therefore not acceptable under section 3(1)(b) of the Act.

Conclusion

24. In this decision I have considered all the documents filed by the applicants 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 22nd day of October 2003.

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

ANNEX A