

BL O/376/21

**TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL  
REGISTRATION) ORDER 2008 (as amended)**

**IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001554268  
BY SONY INTERACTIVE ENTERTAINMENT LLC  
TO PROTECT THE FOLLOWING MARK IN CLASS 28:  
HEIGHTEN YOUR SENSES**

**TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 (as amended) ('the International Order')**

**IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001554268  
BY Sony Interactive Entertainment LLC  
TO PROTECT THE FOLLOWING TRADE MARK IN CLASS 28:**

**HEIGHTEN YOUR SENSES**

**Background**

1. On 08 October 2020, Sony Interactive Entertainment LLC ('the holder') requested protection in the United Kingdom under the provisions of the Madrid Protocol for the Trade Mark 'HEIGHTEN YOUR SENSES'.

2. Protection was sought in class 28 for the following goods:

Controllers for game consoles; game controllers for computer games.

3. On 10 November 2020 the Intellectual Property Office ('IPO') issued notification of a provisional total refusal of protection in response to the designation. In that notification the following objection was raised under Section 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') "*The designation is not acceptable in Class 28 as there is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of the words HEIGHTEN YOUR SENSES, being a sign which may serve in trade to designate the intended purpose of the goods e.g. goods such as games controllers which have been designed to heighten the senses of the user by way, for example, as using interactive elements which heighten the experience of touch/feel, sound or vision*". A deadline for the response was set as 10 January 2021.

4. The examination report confirmed that the holder was entitled to correspond with the examiner regarding the objection under section 3(1)(b) and (c) either by phone or in writing, as well as confirming the holder's entitlement to a hearing with a senior officer.

The examination report also explained that because the holder's address was outside the European Community, the Isle of Man or the European Economic Area, that a contact address in one of the above areas must be provided by filing a form TM33 'Appointment of change of Representative (for Trade Mark owners or holders).'

Finally, the examination report confirmed that, in accordance with standard procedure, failure to reply within the stipulated response period would result in the designation being refused under section 37(4) of the Act.

5. On 22 December 2020 the representative appointed by the holder, Boulton, Wade, Tennant ('the agent') requested a hearing. At the hearing Ms Hide, of the agent, submitted the following arguments for acceptance of the mark:

- The specification is very limited, and the goods do not contain interactive elements which could heighten your senses.
- The goods are not the same as virtual reality headsets as one is always going to have to look at a screen when using the goods, the goods in question are not multisensorial, relying on only one sense; one has a number of senses and touch is just one of them.
- The mark is evocative of a positive experience, but it is not descriptive and is not a term that has been used by others in the trade.
- Slogans can function as trade marks, as per guidance given in the manual of trade mark practice, where marks such as ‘NATURAL JUST GOT SEXY’ and ‘YOUR LIFE YOUR WAY’ are deemed to be acceptable.
- Ms Hide referred to the recent decision of ‘*ITS LIKE MILK BUT MADE FOR HUMANS*’ (T-253/20) where the General Court held that because the mark would set off a cognitive process in the minds of the relevant public the mark should be registered as it has the minimum degree of distinctive character necessary for acceptance.

6. I maintained the objection at the hearing and gave details of Internet references which supported my case for maintaining the objection. As Ms Hide had not had chance to consider these references prior to the hearing, I allowed two months from the date of the hearing report for her to consider the references.

7. Although the designation had not been formally refused, on 1 April 2021, the agent filed a form TM5 requesting a full statement for the reasons for the Registrar’s decision. Although the form TM5 was filed prematurely I am now required to set out the reasons for refusal. No formal evidence has been put before me for the purpose of demonstrating acquired distinctiveness. Therefore, I only have the *prima facie* case to consider.

8. Since reviewing the designation, following the request for a Statement of Grounds for my decision, I have come to the conclusion that an objection under Section 3(1)(c) of the Act is not appropriate. For an objection under Section 3(1)(c) to apply there must be a direct and specific link made by the average consumer between a characteristic of the goods and the sign applied for. On reconsideration I consider the sign too vague to designate such a characteristic. However, this does not mean that I consider the mark to be capable of indicating the trade origin of the goods for the purposes, only, of section 3(1)(b) of the Act, as applied by ‘The International Order’. As the Appointed Person stated in the *cycling is...* decision (BL O/561/01):

*“moreover, to hold that a sign or indication must be regarded as distinctive for the purpose of registration if it is not wholly descriptive of the relevant goods or services would be to ignore the reality of everyday experience; distinctiveness is a matter of fact and degree and signs which are not wholly descriptive do not always or necessarily possess a distinctive character ..”*

## Decision

9. Section 3(1) of the Act reads as follows:

*3.-(1) The following shall not be registered –*

*(a) ...*

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

*(c) ...*

*(d) ...*

*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.”*

### **The relevant legal principles – section 3(1)(b)**

10. The CJEU has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, para 59 and the case law cited there and, e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).

11. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that “...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*” (Case C-329/02P *Satelliten Fernsehen GmbH v OHIM 'SAT.1'*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of' from the perspective of the average consumer.

12. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux- Merkenbureau (Postkantoor)* C-363/99 where, at paragraph 34, it stated:

*“A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of*

*average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others 5 [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75)."*

13. So the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for and the perception of the average consumer for those goods. I should add also that being 'devoid of distinctive character' does not represent an objective standard but is based on an assessment which concludes that the sign presented for registration is 'unpossessed' of distinctive character from the perspective of the average consumer. Since, in the relevant authorities' assessment, the sign is unpossessed of distinctive character (this has been, in turn, paraphrased as being 'origin-neutral' as distinct from 'origin-specific'), the sign is not considered capable of performing the essential function of a trade mark.

14. In the light of the submissions made I have to treat the mark as a slogan, however I must stress that slogans can function as trade marks and I have not applied a different standard of assessment here, as it is clear from the Audi decision (ECJ -C-398/08 Audi AG v Office for the Harmonisation in the Internal Market) that slogans can be both promotional and function as a trade mark. That decision explained that marks that are also used as advertising slogans were still registrable and that stricter criteria should not be applied to the registration of such marks, however:

*"it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories."*

At paragraph 47 the Court went on to say:

*As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark 'Vorsprung durch Technik' can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.*

And at paragraph 57 the Court stated:

*"advertising slogans can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public".*

15. Given such guidance, I intend to approach this matter from a primarily semantic perspective in order to assess whether or not the phrase is capable of performing the essential function of a trade mark, and whether or not it should therefore be free from objection under section 3(1)(b).

### **Application of legal principles- section 3(1)(b)**

16. One must be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM* (2002 ECT II-5179 *Real People Real Solutions*) referred to above, which stated the following:

*"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."*

17. I have to consider what the relevant consumer's first impression would be on seeing this sign and who that relevant consumer is. The specification is limited to controllers for games consoles and game controllers for computer games. I believe the relevant consumer to be the general public and, in particular, those who are interested in playing electronic games. The goods in question are not particularly high cost goods but I consider it reasonable to assume that the users of these goods would apply at least a moderate level of attention at the point of considering a purchase, as those who play electronic games often have a great interest in this pastime. I believe their first impression would be that this is a plain statement in instantly recognisable, grammatically correct (if slightly elliptical) injunctive English, highlighting a positive aspect of the goods and they would not give the sign any trade mark significance. That is, in the sense that the term could equally be deployed by other providers in a purely promotional manner.

18. Given that the objection has been maintained under section 3(1)(b), the issue here is whether the sign applied for when used in relation to the goods claimed would be perceived as one which simply lacks any capacity *prima facie* to distinguish the products of one trader from those of another. I must then consider the effect upon the perceptions of the average consumer on seeing the words 'HEIGHTEN YOUR SENSES' in normal and fair use in relation to the goods of the designation. To do so I must start with a linguistic analysis of the words within the mark. Although it is paramount that any assessment of distinctiveness takes into account the mark's totality, it is also useful to first analyse the mark by reference to its constituent parts.

19. The mark consist of the statement 'HEIGHTEN YOUR SENSES' and the individual words within the mark are defined in the Oxford English Dictionary as:

**Heighten** – make or become more intense

**Your** - 1. Belonging to or associated with the person or people that the speaker is addressing. 2 – Belonging to or associated with any person in general

**Sense** – A faculty by which the body perceives an external stimulus; one of the faculties of sight, smell, hearing taste and touch,

20. The sign does not possess any stylisation or device elements; it consists of words only. When considered as a whole, I believe consumers, as stated above, would not see these words as an indicator of trade origin but merely see these words as an indication of a positive aspect of the goods i.e. that the goods in question can 'heighten your senses', that the users sense of e.g. touch becomes heightened and more intense when using these goods. The following are third party Internet references, included with the hearing report, that refer to the applicant's own controllers:

In Internet articles regarding Sony's controllers there are comments such as '*Nishino said that the adaptive triggers of the L2 and R2 buttons would allow players to "feel the tension of your actions, like when drawing a bow to shoot an arrow" and "This is why we adopted haptic feedback, which adds a variety of powerful sensations you'll feel when you play, such as the slow grittiness of driving a car through mud."* <https://comicbook.com/gaming/news/playstation-5-dualsense-trademark-slogan/>)

And

*"According to a new trademark filed by Sony on June 12, 2020, a day after the PS5 revealed, DualSense got its own slogan "Heighten Your Senses." If you don't know, DualSense comes with some really interesting features including haptic feedback, adaptive triggers, USB Type-C port, motion sensor, headset jack, and many more."* <https://www.thegamepost.com/2020/06/18/sonytrademarked-slogan-ps5-dualsense-controller/>

21. The articles refer to the adoption of 'haptic feedback' and possibly other features which stimulate, for example, the sense of touch. 'Haptic' relates '*to the sense of touch, in particular relating to the perception and manipulation of objects using the senses of touch and proprioception*' (Oxford English Dictionary). This is aimed at heightening the user's senses, allowing them to feel more physically connected to what they are doing as they play, i.e. allowing their senses to become stimulated towards a heightened state. It seems to me the combination of words therefore merely express in an origin-neutral fashion, a desirable feature of the goods. I would add perhaps that the term 'heighten your senses' is not necessarily one which would be unfamiliar to relevant consumers or indeed others. I believe I can take on judicial notice that, in addition to the definitions of each word referred to above, the overall term would be taken to mean that either one or more than one of our natural senses can be stimulated or otherwise enhanced by whatever means.

The following are references to haptic feedback specifically in relation to games controllers

<https://www.gamesradar.com/uk/haptic-feedback-explained/>

*While we may not immediately see the fruits of some of the visual enhancements coming with PS5 and Xbox Series X – like 8K for example – the benefits of haptic technology will be immediate. It's aimed at heightening your immersion, allowing you to feel more physically connected to what you're doing as you play.*

<https://www.psfanatic.com/sony-trademarks-heighten-your-senses-slogan-dualsense-controller/>

*The new DualSense controller's Haptic Feedback will let you feel things like rain when playing games and the sluggishness of moving through water or quicksand for example. And the adaptive triggers will simulate the tension of pulling a bowstring back.*

22. The agent argued that one has a number of senses and touch is just one of them. However, I think this is splitting hairs as far as the consumer is concerned. Whether use of the controller is apt to heighten one sense in particular, or several at the same time, will not alter the plain meaning of the term. Although the sense referred to in the extracts may primarily be the sense of touch, as indicated in the above references to haptic feedback, the controllers nonetheless allow the user to have a more fully immersive experience, including sensations such as moving through water or the tension of pulling a bowstring back, for example. The consumers first impression will in my opinion will merely be a positive message that the goods in question will simply heighten your senses. As I have said, I regard the term as being purely promotional and it could equally apply to other providers promoting similar products in a positive way, the end result being an origin neutral sign.

23. Having considered all factors, I maintain that the phrase would be perceived as nothing more than a non-distinctive sign, which merely highlights positive qualities about the applicant's goods. I therefore have no hesitation in refusing the designation.

24. Having given due care and attention to all of the arguments put forward during the proceedings, the designation is refused under Section 3(1)(b) of the Act for the goods applied for.

**Dated this 20<sup>th</sup> day of May 2021**

**Linda Smith  
For the Registrar  
Comptroller-General**