

O-373-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION NO 2419092**

**TO REGISTER A TRADE MARK**

**BY GAMING ALERTS LIMITED**

**IN CLASS 41**

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#### **DECISION AND GROUNDS OF DECISION**

##### **Background**

1. On 10 April 2006 Gaming Alerts Limited of Adams Hill, Breinton, Hereford, HR4 7PB applied under the Trade Marks Act 1994 to register the following trade mark:

#### **CASINO ALERTS**

2. Registration is sought for the following services:

Class 41

Gambling, gaming and betting services; on-line and telephone gambling, gaming and betting services, lottery services; tipping services; providing on-line news, information, publications and content relating to gambling, gaming and betting; information and advisory services relating to the aforesaid services.

3. Objection was taken against the application under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words CASINO ALERTS, being a sign which may serve in trade to designate the kind or intended purpose of the services e.g. providing on-line news that alerts the consumer to casinos and casino events etc..

4. Objection was also taken under Section 5(2) of the Act but as this objection was subsequently waived I will make no further mention of it in this decision.

5. A hearing was held on 24 July 2006 at which the applicant was represented by Mr Wilkes of Groom Wilkes & Wright LLP, their trade mark attorneys. At the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

6. 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.

7. For the sake of completeness I draw attention to the fact that at the hearing on this application I also maintained objections under Section 3(1)(b) and (c) of the Act in respect of the following trade marks:

2419082 - SPORTS BETTING ALERTS

2419090 - POKER ALERTS  
2419091 - GAMING ALERTS  
2419093 - BOOKIE ALERTS  
2419094 - BINGO ALERTS

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

### **The Law**

9. 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 case for registration**

10. At the hearing Mr Wilkes accepted that this is a borderline decision but sought to persuade me that the mark applied for is “on the right side of the line” and that the objection should therefore be waived in relation to all services for which registration is sought. In support of this submission Mr Wilkes referred me to nine earlier registered marks, all of which contain the words ALERT or ALERTS. Details of these registrations are at Annex A.

11. Subsequent to the hearing Mr Wilkes made further submissions in writing in which he clarified the submissions he made at the hearing. In his letter of 25 July 2006 Mr Wilkes said:

“...whilst these marks are of a nature that they *allude* to the service that will be provided, none of them is so specific as to make it clear to the potential customer what the exact nature of the service will be ....It seems to me that when a potential customer has to stop and think “now, what service are these people providing?” the mark can’t be devoid of distinctive character and should be accepted for registration.

I know that your Office is never bound by the previous acceptance of marks that bear comparison with that which is presently under consideration, but the acceptance of *so many* “ALERT” marks in Class 41 would surely make it inequitable to maintain the objections against these applications. Certainly I can’t see how, in particular, TUBEALERT for travel information, INVESTOR ALERT for magazines relating to investment information and (particularly) TICKET ALERT for information relating to ticketed events can all be registered if the present marks can’t”.

## Decision

12. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, (the DOUBLEMINT 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). Paragraphs 28 - 32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.
31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).
32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way

that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

13. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question.

14. Internet reports which were considered to support the objection under Section 3(1)(b) and (c) of the Act were forwarded with the examination report. Copies of these are at Annex B. I note that Mr Wilkes has made no comment regarding the relevance of these, either at the hearing or in correspondence.

15. Firstly, I acknowledge that none of these documents contain any reference to the trade mark applied for. They do, however, show descriptive use of the word ALERT in relation to downloadable alert systems which send information directly to a computer. Additionally, the article setting out the Terms and Conditions regarding “I-Play” and the article on Sky Sports News Alerts makes it clear that alerts may also be sent direct to a mobile telephone. I also note that the documents relating to “Virgin Bingo” and “Sky Sports News” both pre-date the filing date of this application. The remaining two documents appear to be undated but are the results of a Google search conducted on 19 May 2005.

16. The specification of services applied for contain a wide ranging list of services relating to gambling gaming and betting. As far as I am aware all of these services are provided by casinos. As the Internet reports indicate, alerts are commonly used today, and in recent years, to provide consumers with the latest news and information relating to the goods and services to which the alert relates. The Internet reports indicate that alerts cover many fields of activity and I see no reason why they are not a suitable vehicle for the provision of information emanating from or relating to the services provided by a casino. The gambling, gaming and betting services provided by casinos are numerous, ranging from card games and machine games to roulette and dice and other gaming services.

17. It is common marketing practice for the providers of such services to provide their members or subscribers with information detailing their latest news or developments. It is these members and subscribers who are the relevant consumer of the services applied for and they will consist of all classes of the general public. The information provided may relate to new gambling facilities, new games, new restaurant services, revised opening hours or even revised gambling limits. When so many people today

have regular access to E-Mail facilities and mobile phones, the easiest and most efficient method of delivering such information is to send it electronically, as an alert. If this alert emanates from a casino and provides information about that casino, or other casinos which are commercially linked to it, then it appears appropriate for such services to be described as the provision of casino alerts.

18. The specification of services is wide ranging but in my view the objection is equally valid in respect of all services applied for as each of them could easily be the subject of an alert. An alert is simply a notification to a user providing them with up to date information and this can apply to any of the services for which registration is sought. Furthermore, I see no reason why such alerts may not emanate from, or relate to services offered by, a casino

19. Mr Wilkes has referred me to nine registered mark which incorporate the words ALERT or ALERTS and has suggested that these should influence the outcome of this application. I do not accept this.

20. I am unaware of the circumstances surrounding the acceptance of these marks and they are of little if any assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

21. It is clear that the meaning and usage of words change over time. It appears that the practice of using the word ALERTS as a descriptive term in relation to the services applied for is relatively recent. This may well have been a contributory factor in the decisions to allow the nine marks referred to be allowed to proceed to registration.

22. I am aware that the mark applied for is a combination of the two dictionary words CASINO and ALERTS. In the context of the services applied for the meaning of each word will be clearly understood by the relevant consumer and their combination CASINO ALERTS would be perceived as a combination of words indicating that the services relate to alerts emanating from or relating to services provided by a casino.

23. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

24. Having found that this marks is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

25. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

26. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

27. For the same reasons that I found this trade mark is to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the services in question would not consider this mark to denote trade origin. The average consumer of these services will, upon encountering the words CASINO ALERTS, perceive them as no more than an indication that they relate to an alert emanating from or relating to the services provided by a casino. That is why it will not be seen as a badge of origin. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

28. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

### **Conclusion**

29. 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 3(1)(c) of the Act.

**Dated this 21st day of December 2006**

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

## ANNEX A

## **ANNEX B**