

**IN THE MATTER OF AN APPLICATION NO 2419092
TO REGISTER A TRADE MARK
BY GAMING ALERTS LIMITED
IN CLASS 41**

DECISION

Background

1. This is an appeal against a decision of Mr. A. J. Pike dated 21 December 2006, refusing the registration of the mark CASINO ALERTS. At the hearing of the appeal before me on 21 May 2007, the appellant was represented by Mr Wilkes of Groom Wilkes & Wright LLP, and Mr Allan James appeared on behalf of the Registrar.

2. On 10 April 2006 Gaming Alerts Limited of Adams Hill, Breinton, Hereford, HR4 7PB applied under the Trade Marks Act 1994 to register the trade mark CASINO ALERTS for the following services in Class 41:
“Gambling, gaming and betting services; on-line and telephone gambling, gaming and betting services, lottery services; tipping services; providing online news, information, publications and content relating to gambling, gaming and betting; information and advisory services relating to the aforesaid services.”

Objection was taken against the application under sub-sections 3(1)(b) and (c) of the Trade Marks Act 1994. After a hearing held on 24 July 2006, Mr A. J. Pike refused the application for the reasons set out in his decision (O/373/06).

3. At the hearing, Mr Pike also maintained objections under sub-sections 3(1)(b) and (c) in respect of a number of other trade mark applications made by Gaming Alerts Limited for registration of the following trade marks for the same or similar services in Class 41:

2419082 - SPORTS BETTING ALERTS
2419090 - POKER ALERTS
2419091 - GAMING ALERTS
2419093 - BOOKIE ALERTS
2419094 - BINGO ALERTS

Following the Hearing Officer's refusal to register those marks, it was agreed that those applications would be suspended whilst Gaming

Alerts Limited pursued an appeal to the Appointed Person pursuant to section 76 of the Act in respect of application 2419092 alone. At the hearing of this appeal, I was told by Mr Wilkes that the applicant hoped that the decision in this appeal might be of assistance in resolving his client's five other trade mark applications.

4. There were two limbs to the appeal. First, that Mr Pike wrongly applied the law and did not reflect accepted practice in deciding that CASINO ALERTS was unregistrable by reason of section 3(1)(b) and (c). Secondly, that in the light of a number of other "ALERTS" marks already on the Register it was inequitable to refuse the applicant's marks. Details of the earlier marks are found at Annex A of Mr Pike's decision and I do not think it necessary to reproduce them here.

The Hearing Officer's decision

5. Objection was taken to the mark applied for, CASINO ALERTS, on the basis of both sub-sections 3(1)(b) and (c) of the Act, which read 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,"

6. At the hearing before Mr Pike, and indeed at the hearing of this appeal, it was argued by Mr Wilkes that the mark applied for is "on the right side of the line" in relation to all the services for which registration is sought. Mr Wilkes argued that the mark is "allusive" rather than descriptive, and more particularly that the mark is essentially meaningless, rather than properly descriptive of any of the services for which registration is sought.
7. No evidence was put before Mr Pike, although he did have regard to a number of print-outs from the internet which were considered to support the objection under Section 3(1)(b) and (c) of the Act, and which had been forwarded with the examination report. Copies of those print-outs formed Annex B to his decision. Again, I do not think it necessary to reproduce them here.
8. Mr Pike first of all cited the judgment of the European Court of Justice in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, (the DOUBLEMINT case), as giving 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). He set out paragraphs 28 - 32 of the European Court of Justice's judgement:

“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.”

9.

Then, Mr Pike went on at paragraph 12:

“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.”

10. After reference to the Internet reports at Annex B, he continued: “15 ... 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 “IPlay” 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.”

11. Mr Pike then turned to the relevance of the earlier registered ALERTS marks:

“19. Mr Wilkes has referred me to nine registered marks 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 mark 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* (8th 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 caselaw, 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.”

Standard of review

12. This appeal is a review of the Hearing Officer’s decision. That decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

“In such circumstances an appellate court should in my view show a

real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

A decision does not contain an error of principle merely because it could have been better expressed.”

Merits of the appeal

13. Mr Wilkes did not criticise the legal principles applied by the Hearing Officer, save that the Grounds of Appeal indicated that in addition to the cases to which he referred Mr Pike ought also to have considered the judgment of the European Court of Justice in *Proctor & Gamble Company v OHIM ‘BABY-DRY’* Case C 383/99 [2002] RPC 16 and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)*, Case C-363/99 [2006] Ch 1, [2005] 2 CMLR 10. He argued that the combined effect of these decisions was that CASINO

ALERTS would be registrable if it lacked a clear descriptive meaning in relation to the services for which registration was sought.

14. In my judgment, as Mr James submitted, the appellant has failed to identify any distinct or material error of principle in the Hearing Officer's judgment in applying the European Court of Justice's guidance on the interpretation of section 3 (1)(c) to the facts of this case.
15. In paragraphs 16 to 18 of his decision, the Hearing Officer considered carefully whether the mark applied for would be seen as descriptive of the services in the specification. He commented on the common use of the word 'alerts' in many fields of activity, and concluded that the mark would be seen as descriptive by the relevant consumers.
16. Mr Wilkes accepted on behalf of the applicant that each of the words "Casino" and "Alerts" could be used "generically." The thrust of Mr Wilkes' argument was that the particular combination of words found in this trade mark is not likely to be used generically and is not descriptive. He did not seek to argue that the word combination amounted to a "syntactically unusual juxtaposition" of words, sufficient to produce a distinctive mark according to the *BABY-DRY* decision. In the circumstances, I do not think that the Hearing Officer's reliance upon *DOUBLEMINT* rather than *BABY-DRY* can be deemed an error of principle.
17. However, Mr Wilkes submitted that as the particular combination of words was "essentially meaningless", it could not be descriptive or devoid of distinctive character. The Hearing Officer did not refer in his decision to the *POSTKANTOOR* case, in which the European Court of Justice again considered the registrability of combinations of descriptive words :
 - "96 If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.
 - 97 It is not necessary that the signs and indications composing the mark that are referred to in article 3(1)(c) of the Directive 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 those signs and indications could be used for such purposes. A word 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: see to that effect, in relation to the identical provisions of article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, Office for

Harmonisation in the Internal Market (Trade Marks and Designs) v Wm Wrigley Jr Co (Case C-191/01P) [2004] 1 WLR 1728, 1751-1752, para 32.

98 As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99 However, such a combination may be not descriptive within the meaning of article 3(1)(c) of the Directive, if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100 Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

18. It is true that the Hearing Officer did not specifically refer to *POSTKANTOOR* in his judgment. However, this does not appear to me to have caused him to make any error of principle in his assessment of the registrability of the mark. The Hearing Officer specifically considered the impact of this particular *combination* of two dictionary words in paragraph 22 of his decision, and concluded that the combination would be perceived as descriptive. Plainly, he found no ‘perceptible difference between the word and the mere sum of its parts’. As Mr Wilkes accepted, that is a subjective decision which the Hearing officer was entitled to reach on the information before him, and as such in my judgment the appeal cannot succeed on this point.
19. At the hearing before me, I queried whether there was some distinction to be drawn between the various services listed in the trade mark

specification in terms of the descriptiveness of the mark. It was common ground that the mark was less descriptive of, say, a casino, than of on-line betting services. However, Mr Wilkes indicated that his client's commercial interests related only to information services, and he did not wish to take a point distinguishing different elements of the specification.

20. As to the argument based upon section 3(1)(b) of the Act, again in my judgment the appellant has identified no error of principle in paragraphs 16 and 27 of the Hearing Officer's judgment. It was not suggested that the Hearing Officer had failed to apply the appropriate tests, but that he had erred in reaching his subjective conclusion that the mark is inherently devoid of distinctive character. In the circumstances, it seems to me that the appeal must fail on that ground also.
21. This leaves the point of the suggested unfairness of refusing to register the applicant's CASINO ALERTS mark whilst other ALERTS marks have previously been accepted on to the Register. Again, it seems to me that in paragraphs 20 and 21 of his decision the Hearing Officer correctly applied the principles set out by Jacob J (as he then was) in *British Sugar* [1996] R.P.C. 281 at 305.
22. Moreover, since the date of the Hearing Officer's decision, the Court of First Instance has considered and rejected an equivalent argument raised in relation to an application to register a Community Trade Mark, in Case T-230/05, *Golf USA Inc v OHIM* (6 March 2007). The CFI held:

“57. In the light of the arguments raised by the applicant in the context of the plea alleging infringement of Article 14 of the ECHR, the Court considers that the applicant is in fact relying on the general principle of equal treatment, which constitutes a general principle of Community law. Thus, the plea will be examined accordingly.

58 As regards the applicant's first argument that similar marks have been registered by OHIM, it is sufficient to observe that, whilst factual or legal grounds contained in an earlier decision may constitute arguments to support a plea alleging infringement of a provision of Regulation No 40/94, the legality of the decisions of Boards of Appeal must nevertheless be assessed solely on the basis of this regulation, as interpreted by the Community judicature, and not on the basis of a previous decision-making practice (*STREAMSERVE*, cited in paragraph 28 above, paragraph 66, and Case T-123/04 *Cargo Partner v OHIM (CARGO PARTNER)* [2005] ECR II-3979, paragraph 68).

59. Two hypotheses therefore exist in that regard. If, by accepting, in a previous case, the registrability of a sign as a Community mark, the Board of Appeal correctly applied the

relevant provisions of Regulation No 40/94 and, in a later case comparable to the previous one, the Board of Appeal adopted a contrary decision, the Community judicature will be required to annul the latter decision because of infringement of the relevant provisions of Regulation No 40/94. In this first hypothesis, the plea alleging breach of the principle of equal treatment is therefore ineffective (*STREAMSERVE*, cited above in paragraph 28, paragraph 67; Case T-323/00 *SAT.1 v OHIM (SAT.2)* [2002] ECR II-2839, paragraph 61; and *CARGOPARTNER*, cited in paragraph 58 above, paragraph 69).

60 On the other hand, if, by accepting, in a previous case, the registrability of a sign as a Community mark, the Board of Appeal erred in law and, in a later case, comparable to the previous one, the Board of Appeal adopted a contrary decision, the first decision cannot be successfully relied on to support an application for the annulment of the latter decision. It is clear from the case-law that observance of the principle of equal treatment must be reconciled with observance of the principle of legality, according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another. In this second hypothesis, the plea alleging breach of the principle of equal treatment is therefore also ineffective (*STREAMSERVE*, cited in paragraph 28 above, paragraph 67; *SAT.2*, cited in paragraph 59 above, paragraph 61; and *CARGO PARTNER*, cited in paragraph 58 above, paragraph 70).

61 The applicant's first argument must therefore be rejected. In those circumstances, it is no longer necessary to examine whether the earlier registrations of the Community trade marks pleaded by the applicant – most of which are disputed by OHIM – have identical characteristics to the mark applied for, as claimed by the applicant, or different ones, as claimed by OHIM.”

23. In the circumstances, in my judgment, the Hearing Officer was right to reject the appellant's argument that it is unfair or inequitable to refuse to register its ALERTS marks when other similar marks are already on the Register. Any applicable principal of equal treatment cannot avail an applicant in these circumstances.
24. For all these reasons, the appeal fails. In accordance with the usual practice, I make no order as to the costs of the appeal.

Amanda Michaels

5 June 2007