# **TRADE MARKS ACT 1994**

# IN THE MATTER OF APPLICATION NUMBER 2597324 BY GIGI LEVY WEISS TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 41:

iCasino.com

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# **Background**

- 1. On 10 October 2011, Gigi Levy Weiss ('the applicant') applied to register the trade marks shown above for the following services:
- Class 41: Entertainment services; arranging, organising and provision of gaming, amusement and entertainment services; arranging, organizing and conducting entertainment services in the form of online contests and games of chance; organising competitions; provision of the aforesaid services in electronic or computerised form; providing online computer games, lottery services and interactive games and gaming services, via a global communications network; provision of the aforesaid services on-line from a computer database or the Internet; provision of information relating to gaming services accessible via a global computer network; provision of information online from a computer database or from the Internet in relation to gaming, amusement and entertainment services; provision of interactive games, interactive entertainment and/or interactive competitions; interactive Internet services for the purposes of gaming, amusement and entertainment.
- 2. On 19 October 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of the term 'iCasion.com', being a sign which may serve in trade to designate the kind of the services e.g. services to facilitate interactive casino games, or casino games that can be played via the Internet.
- 3. The examiner stated that the letter 'i' placed before the word 'casino' would be perceived as denoting 'interactive' or 'internet'. The examiner also provided URL links showing third parties' use in trade of the term 'interactive casino'.
- 4. On 25 October 2011, Mr Shahab Hanif, acting on behalf of the applicant, submitted arguments in favour of accepting the mark. These included reliance on precedents, with reference to registration numbers 2581207 'ibet.tv', and 2585113 'iBet just football' (and device). Mr Hanif submitted that the marks applied for were unique, and that the Internet references referred to by the examiner related to URLs rather than 'domain brands'. He argued that the sign would *not* be perceived as an abbreviation for 'internet casino' or

'interactive casino' in the way that, for example, the letters 'TV' are known to be an abbreviation for 'television', and claimed that, even if consumers understood the term as an abbreviation for 'internet casino' or 'interactive casino', they would still be aware that the sign belonged to the applicant. Finally, Mr Hanif made reference to other precedents which he considered to be 'generic', including trade marks such as 'iPhone', 'iTunes', 'iMusic', 'iLaw', 'iPad', 'iPlay', 'iTV, iPlayer', 'iAuto', 'iTrain', and 'iGames' (which seemed to contradict his earlier submissions that the letter 'i' does not mean internet or interactive).

- 5. In a further email, dated 3 November 2011, Mr Hanif informed the examiner that a third party had already registered the sign 'iMusic' as a Community Trade Mark, in the face of a media company based in Los Angeles who owned the mark 'iMusic.Com'. Mr Hanif did not advise me whether the media company in Los Angeles owned a trade mark, or specifically indicate if he was referring to unregistered use of the sign. In his email, Mr Hanif stressed that IP theft is common and that he sought to register both marks filed in the application in order to prevent scenarios such as those which have arisen in respect of the term 'iMusic'.
- 6. In the official letter of 22 November 2011, the examiner maintained the objection and informed Mr Hanif that he was not persuaded by the acceptance of the earlier marks. An *ex parte* hearing was suggested as the most suitable way forward.
- 7. On 24 November 2011, a hearing was requested. At that hearing before me on 10 January 2012, attended by Mr Hanif, the objection was maintained and, in view of the fact that the applicant did not have any use of the mark, the application was refused. On 13 January 2012 a formal notice of refusal was issued, and one further month was granted to allow for the submission of a form TM5. This final period expired on 13 February 2012.
- 8. On 21 February 2012, Mr Hanif contacted the examiner to establish the progress of his application, and was told that the application had been refused. Mr Hanif was then advised that, should he wish to pursue his application, he would have to file a retrospective extension of time request to facilitate the submission of a form TM5. On 7 March 2012, a request for a retrospective extension was received .The reasons for this request were that Mr Hanif did not consider that he had received sufficient time after the notice of refusal was issued and advised the Registrar that he was confused about the time allowed. In view of this, an extension until 30 March was granted. On 28 March 2012, Mr Hanif duly filed a form TM5 seeking a statement of reasons for the Registrar's decision.
- 9. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

### The applicant's case for registration

10. Prior to setting out the law in relation to sections 3(1)(b) and (c) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. Prior to refusal of the application, the arguments put forward in support of *prima facie* acceptance were those made in writing via Mr Hanif's emails of 25 October 2011 and 3 November 2011, and those made orally at the

hearing, which centred around the acceptance of precedents and the fact that consumers would not perceive the letter 'i' as meaning 'internet'.

11. I have noted the fact that in his written submissions and at hearing, much of Mr Hanif's claims regarding alleged distinctiveness are based upon the principle of 'equal treatment' set by earlier acceptances. Whilst I acknowledge these submissions, I have assessed the mark on its own merits and therefore attach limited significance to the fact that other 'i' marks have been registered.

#### The Law

- 12. 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) 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,
  - (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 above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to section 3 is based on the equivalent provision of Article 3(3).

### **Decision - Section 3(1)(c)**

- 13. In JanSport Apparel Corp v Office for Harmonisation in the Internal Market (Case T-80/07) the General Court gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:
  - "18. Under Article 7(1)(c) of Regulation No 40/94, '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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.
  - 19. By prohibiting the registration of such signs, that article 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 (Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12447, paragraph 31).

- 20. Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos* v *OHIM* (*ELLOS*) [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick* v *OHIM* (*Quick*) [2003] ECR II-5071, paragraph 28).
- 21. The signs and indications referred to in Article 7(1)(c) of Regulation No 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 (see the judgment of 9 July 2008 in Case T-323/05 Coffee Store v OHIM (THE COFFEE STORE), not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 Telefon & Buch v OHIM— Herold Business Data (WEISSE SEITEN) [2006] ECR II-835, paragraph 90).
- 22. It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation* v *OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).
- 23. It must finally be pointed out that the criteria established by the case law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 RheinfelsQuellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN) [2007] ECR II- 4413, paragraph 21)."
- 14. Furthermore, in Case C-363/99 *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, C-363/99 (Postkantoor)*, the Court of Justice of the European Union stated:
  - "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...

. . .

- 102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially."
- 15. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of services or other characteristics of the services. The services at issue here are 'entertainment services; arranging, organising and provision of gaming, amusement and entertainment services; arranging, organizing and conducting entertainment services in the form of online contests and games of chance; organising competitions; provision of the aforesaid services in electronic or computerised form; providing online computer games, lottery services and interactive games and gaming services, via a global communications network; provision of the aforesaid services on-line from a computer database or the Internet; provision of information relating to gaming services accessible via a global computer network; provision of information online from a computer database or from the Internet in relation to gaming, amusement and entertainment services; provision of interactive games, interactive entertainment and/or interactive competitions; interactive Internet services for the purposes of gaming, amusement and entertainment' in class 41.
- 16. Having regard to the nature and characteristics of the entertainment, amusement and gaming-oriented services claimed in the application, these are not specialist services and I proceed on the basis that the average consumer will be no more than reasonably circumspect in their selection.

#### The Mark

- 17. 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.
- 18. The mark applied for consists of a series of two marks being the signs 'iCasino.com' and 'icasino.com', presented in a stylised font and in greyscale. The words 'casino' and '.com' mark are defined as meaning:

**Casino** noun 1. a public building or room in which gaming takes place, especially roulette and card games such as baccarat and chemin de fer. (as defined in Collins English Dictionary)

**.Com** On the Internet, a top-level domain name that is assigned to a corporation or business. Top-level domain names come last in a given Internet computer's domain name (such as www.apple.com). (as defined in Webster's New World™ Computer Dictionary)

The letter 'i' is listed as an acronym for 'internet' on the acronym dictionary resource found at www.acronymfinder.com, and this definition is reflected in guidance already published in IPO's published Addendum to the Trade Marks Examination Guide (Chapter 6) (formerly known as the 'Examination Work Manual') which states;

#### • I or i

The letter "i" is a generic abbreviation for Internet, for example, i-music and i-magazine. In addition, the letter "i" is also an abbreviation for "interactive".

An application for a word which describes the goods or services applied for and is prefixed with "i" may be objectionable under section 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or services. The Internet will be searched where necessary, but it should be remembered that the fact that a term is not already in descriptive use does not preclude an objection under section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.

- 19. Before considering the merits of the sign 'icasino.com' it is worth establishing that 'internet casinos' are commonplace. In support of this, I refer to the two Internet references which are attached as annexes to this decision showing use of the term 'Internet casino' in relation to services covered by the application. Internet casinos are online versions of traditional casinos, enabling gamblers to play and wager on casino games through an online virtual casino via the Internet. Given the extent and availability of virtual casinos, the average consumer is likely to see the letter 'i' as meaning 'Internet' in the context of the mark as a totality. Its meaning emerges firstly from the combination with the word 'casino (that is, a casino accessible over the internet); secondly, from the addition of the domain name '.com' (which emphasises and reinforces the fact that the letter 'i' would be perceived as meaning 'internet'); and thirdly, from the connection with the specific services contained in the application.
- 20. Use of the letter 'i' as an abbreviation for the word 'Internet' is not only customary, but is also reflected in the fact that the specification qualifies many of the services intended for coverage as being provided 'via a global computer network'. Reference need only be made to the variety of specialist terms in which the letter 'i' stands for 'Internet' including, for example, 'IA' (meaning 'Internet Application'), 'IP' (meaning 'Internet Protocol'), IMAP (meaning 'Internet Message Access Protocol'), and 'ISP' (meaning 'Internet Service Provider').
- 21. It is also settled law at European level to approach marks containing the letter 'I' alongside descriptive terms, as conveying to the average consumer that such services are available over the internet. Examples from the decisions of the Boards of Appeal at OHIM include 'i-vote' (R 931/2001-4, 26 March 2003); 'IPUBLISH' (438/2002-4, 9 July 2003); 'I-CARD' (R 682/2002-2, 18 July 2003); 'ITUNES' (R 758/2002-2. 19 April 2004); 'iDesigner (R 1494/2006-1, 15 May 2007; 'iCallCentre' (R 1732/2008-2, 20 March 2009); 'I-player' (R 660/2007-1, 14 February 2008); and 'ILINK' (R 1849/2007-4, 5 February 2009) and 'ITEST' (R 902/2008-2, 22 October 2008). Such case law, whilst not binding upon IPO, nevertheless ought to be taken into account in the context of harmonisation.

- 22. It follows as a matter of fact and law that consumers are likely to perceive the letters 'I' or 'I' as an abbreviation for 'Internet'. The question of whether, as is claimed by the applicant, the term *could* be subject to a different interpretation (including, in the example of Apple's products, as a trade mark given its long established usage), is not decisively relevant. According to section 3(1) (c) of the Act 1994, it is sufficient for one of the possible meanings to have an exclusively descriptive character (see judgment of 23 October 2003, C-191/01, *Doublemint* para. 32)
- 23. The word 'casino' is defined in virtually all English dictionaries as meaning 'a public building or room in which gaming takes place, especially roulette and card games such as baccarat and chemin de fer' (or something very similar). However, in the context of the services claimed, I consider that the term would be readily and equally understood to mean an online virtual casino accessed via the Internet. In the modern world, all manner of goods and services are now accessible via the Internet, many of which were only previously available through visiting physical and tangible environments such as shops, warehouses, libraries, galleries and, in the case of gaming, licensed casinos. Nearly all products once provided solely through those aforementioned 'physical' environments are now available online via virtual equivalents, and so more and more consumers are choosing to buy goods and services over the Internet as opposed to via the more traditional means. As such, the awareness of consumers in respect of the availability of any inconceivable type of product or services via the Internet *including* the provision of online gaming and betting services must be taken into account when assessing the distinctiveness of the mark.
- 24. With regard to the '.com' element, the following is an extract from the Trade Marks Examination Guide which provides some guidance on the registration of domain names:

"A domain name is a written representation of an Internet electronic address, e.g. www.patent.gov.uk, which is the Office's web site address. It is common-place for goods and services to be sold in the UK under such a name i.e. the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks. Elements of the domain name such as '.com or '.co.uk' are considered to be totally non-distinctive, much in the same way as 'Ltd' and 'Plc'. As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under section 3(1)(b) of the Act.

- 25. It is also common practice to seek protection for domain names as trade marks. At paragraph 11 of its decision on the mark 'SPORTSBETTING.COM' (R 338/2006-2), the Community Trade Mark Office's Board of Appeal stated that:
  - "11.The mark consists of a second-level Internet domain 'SPORTSBETTING' joined to a top-level domain '.COM', the latter being assigned to commercial users (see Webster's New Word Dictionary of Computer terms). A domain name is the address of an Internet site and, as such, is used to access the website so identified. Generic top level domains will be perceived by the average Internet user as an Internet address and not as a trade mark. In this instance the mark merely tells the interested customer that *inter alia* online 'gaming', 'sports' and 'betting' services are found at the site SPORTSBETTING.COM, because the words 'sports' and 'betting' are nothing

more than descriptive of the applicant's services. The interested public, on seeing the mark, will assume - correctly - that the website in question offers opportunities for winning money through gambling on sporting events. It is entirely lacking in any arbitrary or fanciful characteristics. The mark was rightly rejected under Art 7(1)(b) and (c) CTMR."

- 26. The same can be said in respect of the application in suit. The marks 'iCasino.com' and 'icasino.com' are no more than a domain name likely to perceived as leading to an Internet site which provides online casino services. I note that the second mark in the series consists of the mark 'icasino', where the letter 'c' is presented in lower case. Although the Registrar acknowledges that the second mark might be perceived as containing a neologism (i.e. the word 'icasino'), this is an unlikely scenario, and will not prevent the consumer from understanding the clear 'online casino website' message conveyed by the mark. As confirmed in case law, the average consumer naturally seeks to break down a mark into elements which, for him or her, suggest a concrete meaning and/or which resemble recognisable words (see, to that effect, Case T-256/04 Mundipharma v OHIM and Altana Pharma, RESPICUR [2007] ECR II-449, paragraph 57, and judgment of 13 February 2008 in Case T-146/06 Sanofi-Aventis v OHIM and GD Searle, ATURION, not published in the ECR, paragraph 58). The word 'casino' is a common word in the English vocabulary, and therefore one which would be readily understood by the relevant public. And as already stated, the letter 'i' is a common abbreviation used for the word 'Internet'. I therefore consider that the sign has a concrete meaning for the average consumer, and that the relevant public would immediately recognise the word 'icasino' as meaning 'Internet casino'.
- 27. Having assessed the individual elements which combine to form the mark, I now have to determine the extent to which that combination of elements creates a mark that would immediately be perceived by the average consumer as an indication of origin. Furthermore, in determining the mark's suitability for acceptance and registration under section 3(1)(c), the Registrar is obliged to consider the semantic content of the sign and consider, in the context of the services claimed, whether or not the relevant consumer is likely to perceive it as being a denotation of a particular characteristic. Taking into account the dictionary definitions presented at paragraph 18 above, the signs 'iCasino.com' and 'icasino.com' not only possess a consistent and recognisable meaning likely to be understood by the average English speaking consumer, but also are suitably apt to act as descriptor of the services covered by the application. I therefore find it likely that the relevant consumer would recognise the sign as designating the type of services on offer.
- 28. Having found that the marks are to be excluded from registration by section 3(1)(c) of the Act, that effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b)

# Section 3(1)(b)

29. In relation to section 3(1)(b) it was held in *Postkantoor* that:

"86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or

services within the meaning of Article 3(1)(b) of the Directive. A mark may nonetheless be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."

- 30. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:
  - an objection under section 3(1)(b) operates independently of objections under section 3(1)(c) (*Linde AG (and others) v Deutsches Patent-und Markenamt,* Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
  - for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
  - a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
  - a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
  - the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).
- 31. Section 3(1) (b) includes within its scope those marks which, whilst not designating a characteristic of the relevant goods, will nevertheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. I do not consider that an application may escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive.
- 32. Even if the mark falls short of conveying the requisite level of specificity to support an objection under section 3(1)(c), I would nevertheless hold that it would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, consumers would not consider the mark to be that of any particular provider of the services covered by the application. The mark is essentially origin neutral. In particular, addition of the '.com' element does not individualise the services towards a single undertaking.
- 33. As already noted in respect of section 3(1)(c), the specific services claimed in class 41 are 'entertainment services; arranging, organising and provision of gaming, amusement and entertainment services; arranging, organizing and conducting entertainment services in the form of online contests and games of chance; organising competitions; provision of the aforesaid services in electronic or computerised form; providing online computer games,

lottery services and interactive games and gaming services, via a global communications network; provision of the aforesaid services on-line from a computer database or the Internet; provision of information relating to gaming services accessible via a global computer network; provision of information online from a computer database or from the Internet in relation to gaming, amusement and entertainment services; provision of interactive games, interactive entertainment and/or interactive competitions; interactive Internet services for the purposes of gaming, amusement and entertainment.' Used in relation to these services, the mark conveys a direct message to the average consumer that the services relate to an internet casino. I do not feel that the mark possesses the inherent capability to distinguish one trader's services from another as required under section 3(1)(b) of the Act. The sign is unlikely to be perceived as originating from a single undertaking because of its direct association with the services being offered.

34. I have concluded that the trade mark applied for will not be identified as an indicator of trade origin without first educating the public to that effect. I therefore conclude that it is devoid of any distinctive character, and thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act.

#### Conclusion

35. In this decision, I have considered all documents filed by the applicant, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) and (c) of the Act.

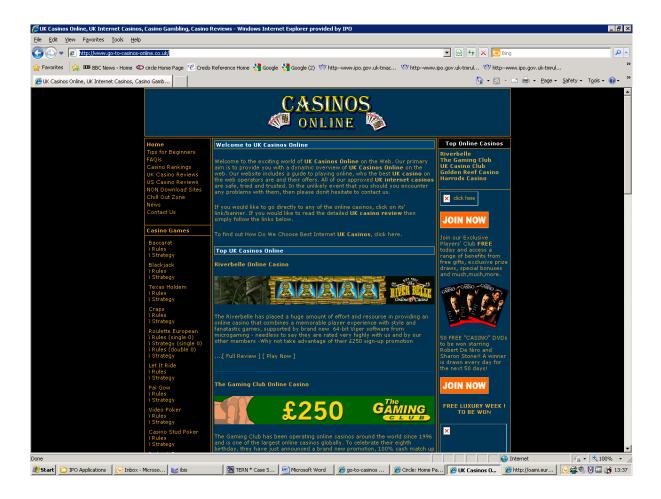
Dated this 8th day of October 2012

Bridget Whatmough
For the Registrar
The Comptroller-General

### **APPENDIX**

# Annex 1

Website found at www.go-to-casinos-online.co.uk



#### Annex 2

#### Website found at www.casinosure.com

