

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2052301 IN THE NAME OF DEREK JOHN WEBB TO REGISTER “THREE CARD POKER” AND DEVICE AS A TRADE MARK IN CLASS 41

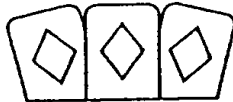
DECISION

On 19 January 1996 Derek John Webb of Farthings, 21 Elgin Avenue, Littleover, Derby, England applied to register the following series of three marks as trade marks in Class 41:-

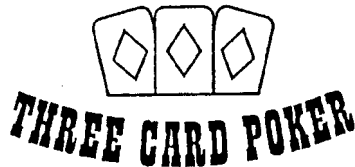
1. device only



2. device only



3. device and words “THREE CARD POKER”



The services for which registration was sought were as follows:-

“Casino services; provision of casino, gambling and gaming facilities; gaming services.”

Objection was taken to the application on the grounds that the three marks did not form a series within the meaning of Section 41 (2) and all three marks were debarred from acceptance under the terms of Section 3 (1) (b) and (c). Objection was also taken to the third mark under Section 3 (3) of the Act on the grounds that the mark would be deceptive if the services were other than those relating to three card poker. Due to a change in Registry practice, the Section 3 (3) objection was waived in correspondence prior to the hearing.

At a hearing before me on 18 November 1997, at which the applicant was represented by Mr Sales of Swindell & Pearson, the objections under Section 41 (2) and Section 3 (1) (b) and (c) were maintained and the application was subsequently refused.

I am now asked under Section 76 of the Act and Rule 56 (2) of the Trade Marks (Amendment) Rules 1998 to provide a statement of the reasons for my decision to refuse the application to register the three marks of the application.

The applicant has not claimed that the marks qualify under the proviso to Section 3 (1) as having, at the time of application, acquired a distinctive character as a result of the use made of them. I have therefore to consider whether the application should be accepted simply on the basis of the nature of the marks themselves.

At the hearing the agent Mr Sales submitted that the first mark was a stylised crown device, the second mark being the stylised crown device bearing diamond shapes, and the third mark being the stylised crown device bearing diamond shapes and also containing the additional words "Three Card Poker".

I will deal with the Section 3 (1) objection raised against each mark in turn.

The first mark consists of a device and can be seen in a number of ways, but it appears to me to be the outline of a fan of 3 playing cards not presented in an unusual manner. In that capacity it is hardly distinctive in relation to the casino, gambling and gaming services of this application.

The device of the second mark appears to me to be the outline of a fan of 3 playing cards bearing diamond shapes which to my mind reinforces the idea of playing cards. It is not unusual for the back of playing cards to bear a diamond as one of the four suits in a pack of cards.

The third mark appears to me to consist of the outline of a fan of 3 playing cards bearing diamond shapes and the words "Three Card Poker".

Section 3 (1) (c) of the Act says that the following shall not be registered:

"trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose..... or other characteristics of the goods"

The words "Three Card Poker" do in my view serve in trade to designate characteristics of the services claimed, that is casino, gambling and gaming services based on three card poker. The words are clearly descriptive of characteristics of such services and therefore debarred from registration under Section 3 (1) (c).

However, the third mark of this application does not consist exclusively of these words. There is also a device shaped like a fan of 3 playing cards. Is the mark as a whole devoid of any distinctive character?

It is of course true that innumerable permutations of combinations of words and devices are registered every year as trade marks. In all cases the Registry, in assessing the eligibility of these marks for registration, will have regard to:

- 1.) the degree to which the words may be descriptive, or otherwise objectionable,
- 2.) the degree of distinctiveness of the accompanying device and
- 3.) the size and position of these different elements as they appear in the mark.

The final decision will reflect whether the mark in its totality is likely, quoting Jacob J in TREAT 1996 RPC at lines 4 & 5, “to do the job of distinguishing without first educating the public that it is a trade mark”

Applying this test to the third mark of the present application I find that the words are highly descriptive of the applicant’s services and are therefore most unlikely to be able to do the job of a trade mark, and that the non distinctive device of a fan of 3 playing cards adds no measurable distinctiveness to the mark. I do not consider that the individual elements of the mark add up to a distinctive whole. When all the component parts are viewed as a totality, the mark is likely to convey to customers, that the services offered will be casino, gambling and gaming type services based on the game of three card poker. The third mark is therefore debarred from registration under Section 3 (1) (b) and Section 3 (1) (c) of the Act.

Although Jacob J in the TREAT decision was specifically referring to a word mark, he makes it clear that the same considerations apply to other signs:

“Next, is “Treat” within Section 3 (1) (b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”

In my view the applicant’s first and second marks are the type of signs falling within the category of marks which have to acquire a distinctive character before being able to function as an indication of origin.

In conclusion, in the absence of evidence that the marks have acquired a distinctive character by reason of the use made of them, all three marks are debarred from registration under Section 3 (1) (b) of the Act, and the third mark is further excluded by Section 3 (1) (c).

With regard to the series objection, Section 41 (2) of the Act states:-

“A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

I conclude that each mark is different visually. The first mark consists of the outline of a fan of 3 playing cards, the second mark consists of the outline of a fan of 3 playing cards bearing the shape of a diamond on each playing card, and the third mark consists of the outline of a fan of 3 playing cards bearing the shape of a diamond on each playing card and the additional words “Three Card Poker”. Although all the individual elements making up the marks are of a non distinctive character, when amalgamated in a combination of two or more of these elements, they serve to alter the identity of the trade marks one from another.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted 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 is debarred from registration by Sections 3 (1) (b) and (c) and 41 (2) of the Act.

Dated this 20th day of May 1998

ANGELA HALL

For the Registrar
The Comptroller General