

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION No 2271065  
BY VIS ENTERTAINMENT PLC  
TO REGISTER A TRADE MARK  
IN CLASSES 9, 28 AND 41**

**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 25 May 2001 Vis Entertainment plc of 130 St Vincent Street, Glasgow, G2 5HF applied to register the trade mark **I-RACE** in respect of the following goods and services:

- Class 9            Computer games entertainment software; computer games programs; computer games programs and software downloadable from a global communications network; computer games adapted for use with television receivers; computer software; computer programs; interactive computer software and computer programs; interactive entertainment software and computer games software for use with television receivers and apparatus; electronic publications, publications provided from a global communications network; CDs, CD-ROMs, interactive CD-ROMs; digital, electronic, optical and magnetic data storage means; digital electronic, optical and magnetic data recording means; data, sound, images, games, graphics, text, programs and information recordings; records, discs, tapes, cassettes, cartridges and cards, all bearing or for use in bearing data, sound, images, games, graphics, text, programs and information.
- Class 28           Games, toys and playthings; sporting articles; soft and plush toys; cuddly toys; dolls.
- Class 41           Entertainment services; betting services; provision of entertainment by means of television; provision of entertainment by means of interactive television; production of television programmes; production of interactive television programmes; electronic games services; electronic games services provided by means of global communications network or a computer-based system; entertainment services provided by means of a computer-generated horse-racing game; provision of information relating to entertainment and electronic games; provision of information relating to entertainment and electronic games services via a global communications network or a computer database; provision of information relating to horse racing.

2. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the letter **I** denoting “Internet” and the word **RACE** hyphenated, the whole being devoid of distinctive character and a term which may serve in trade to designate, e.g., goods and services related to information about racing and races provided through the Internet.

3. At a hearing, at which the applicants were represented by Mr Kennedy of Kennedys, their trade mark attorneys, the objection was maintained.

4. Following refusal of the application 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.

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

### **The Law**

6. 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**

7. At the hearing Mr Kennedy advised me that the goods and services in question are not provided via the Internet but via interactive television. In order to persuade me that the objection should be waived Mr Kennedy suggested that the specifications be limited and proposed the following alternative limitations:

1 “none being provided via the Internet” or-

2 “all provided via interactive television”

8. I did not issue a decision at the hearing. Instead, further research was conducted with the purpose of determining if the letter **I** would, in relation to the goods and services claimed in the specifications, be recognised in the United Kingdom as an abbreviation for the word **INTERACTIVE**. The results of that research were forwarded to Mr Kennedy on 14 May 2002 and the objection maintained. For ease of reference copies of those documents are attached at Annex A. Following a subsequent exchange of correspondence further research was conducted and the results of that were forwarded to Mr Kennedy on 17 September 2002

and the objection was again maintained..

9. The first two references attached at Annex A are copies of “The Online ITV Dictionary” which describes itself as “*the most comprehensive listing of worldwide interactive television businesses, products, services, terms, definitions & glossaries*”. In my view this dictionary reference confirms my view that the letter **I** is recognised as an abbreviation for the full word **INTERACTIVE**. Furthermore I consider that this dictionary also supports my view that the abbreviation **I** and the word **INTERACTIVE** are both in use as a means of describing interactive activities. The remaining references demonstrate that the word **INTERACTIVE** is in common use in relation to various types of sporting activities and associated wagering.

10. There is also guidance to be found in Practice Amendment Notice 9/02 which deals with E, I and M Prefixed marks and which was published by the Registry on 17 October 2002. This notice states at paragraph 4 that - “*In addition the letter “i” is also an abbreviation for “interactive”.*”

11. In a letter dated 17 June 2002 the trade mark attorneys acting for the applicants made the following statement:

*“It is denied that the word or letter “I” alone is automatically recognised by the public, without further education, as being a shortened form of “interactive”. “I”, as both a word and a letter, has numerous meanings, only one of which potentially relates to an abbreviated term for “interactive”.*”

12. It is clear from this extract that they accept that the letter **I** is an abbreviation for the word **INTERACTIVE** and appear to rely on the fact that the letter **I** may, in relation to some goods and services, be identified as an abbreviation for a different word. This is, in my view, confirmed by their letter of 4 October 2001 where they advised the Registry that one of the meanings that may be attributed to the letter **I** is “*Interactive (as in IV Interactive Video)*”. In this letter they go on to state that the goods and services contained within the specifications applied for are provided through the medium of television.

## **Decision**

13. In a judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY 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 37, 39 and 40 of the judgement are reproduced below:

*“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus*

*devoid of the distinctive character deeded for that function.”*

*“39. The signs and indications referred to in Article 7(1)(c) of Regulation 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.*

*Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other sign or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”*

*“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”*

14. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c) of the Act.

15. In my view the relevant consumer would see the term **I-RACE**, on first impression, as an abbreviation of the full expression **INTERACTIVE RACE** and consequently as a normal means of designating the nature of the goods and services for which registration is sought. The goods and services in question are interactive racing games and interactive betting services related to racing. When considered in relation to such goods and services any other meaning that may be attached to the letter **I** would not be apparent or relevant. The services provided through the medium of television have changed over the past few years and continue to develop at pace with interactive options being increasingly available to viewers who receive digital television broadcasts. Additionally, it is not necessary for the mark to consist of terms already in common usage before the mark is excluded under Section 3(1)(c) of the Act. The words “may serve” indicate that a degree of foreseeability is a part of the necessary inquiry.

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

17. Having found that this mark 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.

18. 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 46 to 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 must first of all be observed 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.”*

19. In my view the relevant public, bearing in mind that interactive services are in common supply via providers of digital television services, would not consider this mark to denote trade origin. I am not persuaded that the letter **I** in conjunction with the word **RACE** hyphenated 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 goods and services of the applicant from those of other traders. In my view 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**

20. 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 (c) of the Act.

**Dated this 23<sup>RD</sup> day of June 2003.**

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

## ANNEX A