

**TRADE MARKS ACT 1994**

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**IN THE MATTER OF APPLICATION  
NO. 2170934 BY CAMELOT GROUP PLC  
TO REGISTER A TRADE MARK  
IN CLASSES 9, 16, 28 & 41**

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**DECISION AND GROUNDS OF DECISION**

15 On 1 July 1998, Camelot Group Plc, of Tolpits Lane, Watford, WD1 8RN, England, applied under the Trade Marks Act 1994 to register the following:-

20 The marks consists of set of forty nine coloured lottery balls, each marked with a number 1 to 49 as follows: nine white balls marked with the numbers 1, 2, 3, 4, 5, 6, 7, 8 and 9; ten blue balls marked with the numbers 10, 11, 12, 13, 14, 15, 16, 17, 18 and 19; ten pink balls marked with the numbers 20, 21, 22, 23, 24, 25, 26, 27, 28 and 29; ten green balls marked with the numbers 30, 31, 32, 33, 34, 35, 36, 37, 38 and 39; and ten yellow balls marked with the numbers 40, 41, 42, 43, 44, 45, 46, 47, 48 and 49.

25 as a trade mark in Classes 9, 16, 28 and 41 of the Register in respect of :-

30 Class 9 Computer software; computer programmes; computer software and programmes for playing games; computer software and programmes for use on computer networks including the Internet; records; audio and video tapes; compact discs; non-printed publications; electronic publications; electronic number generators; calculators; credit cards; cards bearing magnetic data media; phone cards; sound and video recordings; mechanical signs; road signs; luminous signs; rulers; rules; scanners; bar code readers; fridge magnets; parts and fittings for all the aforesaid goods.

35 Class 16 Printed matter, printed publications; periodical publications; magazines; manuals; calendars; photographs; paper; stationery; tickets; printed cards; labels; tags; tokens; booklets; catalogues; pens; pencils; scratch cards; scratch card games; lottery tickets; game cards; signs; signs of card; signs of cardboard; signs of paper.

40 Class 28 Games, toys and playthings, playing balls, balloons, teddy bears.

45 Class 41 Entertainment by or relating to television and radio; production and presentation of television and radio programmes; entertainment by or relating to games, competitions, quizzes, television appearances and audience participation events; lottery services; gaming and gambling services; organisation and presentation of

competitions, games, quizzes, fun events and audience participation events; organisation, production and presentation of shows and live performances; information and advisory services related to all the aforesaid services; information relating to entertainment provided on-line from a computer database or network including the Internet, electronic game, quiz and competition services provided by means of the Internet or on-line from a computer network or database.

The application form did not indicate, at section 4, that the mark was 3-dimensional, though this was assumed to be the case from the detailed description of the mark filed, from subsequent correspondence, and for the purposes of this decision.

Objection was taken under Section 3(1)(a) of the Act on the grounds that the mark was not represented graphically, and under Section 3(1)(b) on the grounds that the mark was devoid of any distinctive character.

At a Hearing at which the applicants were represented by Mr A Gay of David Keltie Associates the objections were maintained and following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

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

Sections 3(1)(a) and (b) of the Act read as follows:-

**3(1) The following shall not be registered-**

**(a) signs which do not satisfy the requirements of Section 1(1),**

**(b) trade marks which are devoid of any distinctive character.**

Section 3(1)(a) bars registration of “signs which do not satisfy the requirements of Section 1(1)”, ie that “In this Act a trade mark means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

Section 3(1)(a) of the Act states that marks which do not meet the requirements of Section 1(1) shall not be registered. Section 37(1) of the Act requires the Registrar to examine applications and to determine whether they meet the requirements of the Act. The combined effect is that an applicant must demonstrate that the sign applied for is capable of being graphically represented by reference to the representation of the mark filed under Section 32(2)(d).

It is the Registrar’s view that a sign is graphically represented when:-

a) it is possible to determine from the graphical representation precisely what the sign is that the applicant uses or proposes to use without the need for supporting samples etc;

b) the graphical representation can stand in place of the sign used or proposed to be used by the applicant because it represents that sign and no other;

c) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.

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Having regard to the mark as applied for, firstly I do not believe it is defined with sufficient precision so that it is possible to determine precisely what the mark is. In particular, it is not clear:-

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1. whether the numbers appear in a contrasting colour on the lottery balls, or within a circle or other shape of contrasting colour on the balls;

2. what the size and appearance of the numbers on the lottery balls is, or whether the size and style of numbering is the same on each lottery ball;

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3. what the arrangement of the lottery balls is.

The description filed gives rise to an infinite variety of marks and is clearly not capable of precisely representing the applicant's mark.

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Nor do I consider that the description is capable of standing in place of the applicant's mark because it represents that sign and no other. On the contrary the description applied for could equally represent a significant number of other signs.

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Finally, I do not believe it is possible, let alone reasonably practicable, for anyone inspecting the register, or reading the Trade Marks Journal, to understand from the description exactly what the trade mark is. The description which constitutes the applicant's sign is an attempt to obtain registration for a sign which is open to endless permutations.

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I am fortified in this view by the comments of Mr Simon Thorley, QC, sitting as the Appointed Person in the case of an application for a 3-dimensional shape mark by Swizzels Matlow Limited (application no 2125372 - unreported at the time of writing), when he said:-

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"The first question that arises when infringement is in issue is whether or not the alleged infringing mark is identical to the trade mark registered. If it is, and is used in relation to the same goods, the trade mark proprietor has an absolute monopoly. Where, however, the mark is not identical but merely similar, the monopoly is restricted to uses which create the necessary likelihood of confusion on the part of the public.

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This is a fundamental aspect of the law and it is for this reason that the graphical representation, being the means by which the trade mark is defined, must be adequate to enable the public to determine precisely what the sign is that is the subject of the registration."

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and went on to conclude:-

“... it is unlikely that a mere description of a three-dimensional article would in practice ever be sufficiently precise to meet the needs of the Act (which are to enable traders to draw a distinction between a sign which is identical to the mark and one which is not)..... Accordingly I do not believe that the application before me is disqualified from registration merely because the representation of the mark consists of a description.”

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For all these reasons, I therefore conclude that the description of the representation of the mark as contained in the application form TM3 is inadequate to constitute a graphical representation for the purposes of satisfying Section 1(1) of the Act, and as a consequence it is therefore debarred from registration by Section 3(1)(a) of the Act.

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Because I have concluded that the representation of the mark is not adequate to comply with Section 1 of the Act, I am unable to assess whether that inadequately defined mark is devoid of any distinctive character under Section 3(1)(b).

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However, in case I am proved wrong in this matter, I believe there are no grounds for waiving the Section 3(1)(b) objection at this time and I reserve the right to revisit that objection at a later date should it prove necessary.

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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 is debarred from registration under Section 3(1)(a) of the Act.

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Dated this 8th day of April 1999.

**ROGER G EVANS**

For the Registrar  
The Comptroller General

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