

TRIPLE BONUS mark is out of luck at General Court European Union - Elkington & Fife LLP

Infringement

January 28 2016

In *Zitro IP Sàrl v Office for Harmonisation in the Internal Market (OHIM)* (Case T-318/15, January 14 2016), the General Court upheld OHIM's refusal on absolute grounds of a Community trademark (CTM) application for the stylised mark depicted below.



Facts

The application was filed in July 2013 for goods and services in Classes 9, 28 and 41 relating primarily to gaming and entertainment. In January 2014 OHIM raised an objection to the application on the basis of non-distinctiveness and descriptiveness. In essence, the examiner held that the mark consisted of an expression which would convey a clear and direct message to the consumer in relation to the nature and intended purpose of the goods and services, and was also devoid of distinctive character.

In March 2014 Zitro responded, claiming in particular that:

- the word 'bonus' does not mean 'winnings';
- the word has several meanings; and
- the mark had the minimum distinctive character to be registrable.

In an April 2014 decision the examiner rejected the application under Articles 7(1)(b) and (c) of the EU CTM Regulation for the reasons outlined above; and additionally because various English dictionaries define the word 'bonus' as meaning unexpected winnings received by someone and because this word refers to an additional sum of money.

In June 2014 Zitro appealed. In April 2015 the OHIM Fourth Board of Appeal rejected the appeal on the following basis:

- The mark consisted primarily of the words 'triple bonus', so the relevant public was the English-speaking public in the European Union; and because the goods and services related to games of chance, the relevant public would be the public at large and professionals.
- The words in the mark had a meaning for the English-speaking public – they would be perceived as an indication that the goods and services would facilitate the multiplication, by three, of winnings. The word 'bonus' means extraordinary winnings and the expression 'triple bonus' would facilitate the selection of a specific game of chance in which winnings could be tripled or the player could gain a triple advantage.
- The graphical elements of the mark – that is, the font and colours – would be perceived as purely decorative, making the verbal element of the mark dominant and leading the public to see the mark as descriptive rather than distinctive.

Zitro appealed to the General Court, claiming that the mark was evocative and not descriptive, being a complex mark with a highly distinctive stylisation; meaning that even if an English-speaking consumer analysed the mark, he or she would not conclude that it was descriptive of the goods and services. Zitro argued that for the same reasons, the mark did not lack distinctiveness.

Decision

The General Court essentially agreed with the Fourth Board of Appeal, concluding as follows:

- The relevant public was indeed the average and the professional English-speaking consumer in the European Union.
- Zitro's argument that the mark alluded only to the possibility that players could triple their winnings at a given point in the game and would not perceive the mark as a whole as descriptive, particularly in

view of the complex nature of the mark, was unconvincing in light of the board of appeal's analysis of the mark.

- The expression 'triple bonus' and the word 'bonus' could be interpreted only as stated by the board of appeal – that is, descriptively.
- The stylisation and colours in the mark would indeed be perceived as mere decoration, which would underline and reinforce the descriptiveness of the mark.
- Case law confirms that it is possible to refuse a figurative mark which contains descriptive and non-descriptive elements if the latter do not distract the public from the message which the descriptive elements convey. In this case, the stylisation and the graphical elements were insufficiently significant to require any effort to discern a connection between the word elements and the goods and services.
- As the mark was unregistrable due to descriptiveness, it was unnecessary to examine whether it was also devoid of distinctive character.

Comment

This decision is unsurprising, given the dominance of the word elements and their apparent descriptiveness in relation to gaming machines and the like. Interestingly, OHIM has previously rejected two CTM applications containing 'triple bonus', and Zitro is currently involved in opposition proceedings before OHIM involving marks containing 'triple bonus'.

Chris McLeod, Elkington & Fife LLP, London

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.