

EIP

ZYNGA hit triple word score as Mattel's Scrabble tile claim fails

[1] J.W. Spear & Sons Ltd [2] Mattel, Inc. & [3] Mattel UK Limited -and- ZYNGA, Inc. [2012] EWHC 3345 (Ch) – 28 November 2012.

Arnold J's summary dismissal of an infringement claim based on a UK trade mark registration of a 3D representation of the familiar Scrabble tiles should cause owners of older "trade dress" registrations for more unusual marks to review their portfolio.

Arnold J found that the Scrabble tile registration granted in 2000 (see [Fig 1.](#)) did not fulfil the conditions required under the UK Trade Marks Act 1994 for graphical representation or to form "a sign capable of distinguishing" in a trade mark sense. The broadly drafted registration fell foul of a body of subsequent European Court case law which requires more unusual trade dress applications to be precisely represented and defined on the register.

The Registration

The registration (the Scrabble Tile Mark) depicted a blank square tile (shown in 3D) along with an additional written description "The mark consists of a three-dimensional ivory coloured tile on the top surface of which is shown a letter of the roman alphabet and a numeral in the range 1 to 10";

Arguments

Although the Scrabble Tile Mark would include the familiar image of the Scrabble tile (large letter in the centre, small numeral in the corner) that has been marketed for many years, ZYNGA successfully argued that the description encompassed an almost limitless

range of different design presentations of the tile / number / letter combination, rendering the scope of the rights imprecise and granting a virtual monopoly in the concept rather than a particular expression of it (see Fig 2.). The developments in the law since the registration of the Scrabble Tile Mark make it clear that there is an overriding objective to enable those viewing trade mark registrations to be able to understand precisely what they can and cannot do.

Spear / Mattel argued that the fact that their registration had been accepted on the basis of acquired distinctiveness due to their long use of the mark avoided any doubt over whether the sign was functioning as a trade mark and went a long way to proving that all required conditions had been met. However, Arnold J confirmed that for the purposes of assessing the suitability of the sign and its representation, the only relevant points of reference were the abstract graphical representation on the register and the goods and services it was to be used upon. The fact that Spear / Mattel might be able to show that one version of the Scrabble Tile Mark was operating as a sign to indicate trade origin in the marketplace did not go any way to proving that the sign represented on the register and its many different possible iterations could do the same thing.

Key Case Law on Trade Dress Marks

The temptation has always been there for brand owners to seek to claim highly abstract rights in broadly defined colour schemes, shapes or feature combinations. If the mark can be broadly defined to cover a wide range of variations, the proprietor has a much better chance of showing that both the third party's mark and goods/services are identical to those of the registration, potentially leaving the other party without a defence. Equally, such a registration would provide considerable freedom to alter the particular design scheme over time and to adapt it for application to a whole range of different products. However, the following cases have defined the limits of what is possible when depicting and defining these marks.

- 2002 Sieckmann – confirmed that the mark itself did not have to be perceived visually, providing it could be graphically represented – sounds and smells thus have the potential to be registered as trade marks
- 2003 Libertel – colour per se can be a sign without spatial limitation. Marks consisting of a single colour applied to the goods or packaging are potentially acceptable. No need to represent the colour on specific items of goods, provided that the colour itself is clear (e.g. defined on the Pantone scale)
- 2004 Heidelberger Bauchemie – simple blocks of blue and yellow but mark covers “every conceivable form” of their combination: this is too imprecise. Unlike a simple colour, two or more colours combined will inherently import some form of

shape formed by their interface; this must be defined in the representation.

- 2007 Dyson – application for the “clear plastic bin” for vacuum cleaners. Again the attempt to claim the “absence of colour” on any shape of transparent bin as a trade mark went too far and did not define the mark sufficiently precisely.

Practice Point

Trade mark owners who secured registration of more unusual “trade dress” marks in the years immediately following the inception of the UK Trade Marks Act 1994 should review these registrations with their advisors to evaluate whether they remain valid under the current practice. It may be that new registered trade mark applications should be filed for more closely defined and represented marks to put the trade mark owners in a better position to enforce their rights and derive the full commercial benefit from them.

Wider Dispute

This is not the end of the road for the dispute between ZYNGA and Spear / Mattel. Mattel have cited three other registered trade marks in infringement claims against ZYNGA’s digital SCRAMBLE WITH FRIENDS game. However, the dismissal of the tile registration claim at this stage will impact on the overall costs liabilities in the dispute as Mattel will no longer go ahead with a planned evidence survey designed to show recognition of the tile trade mark.

By Simon Stanes