

# World Trademark Review Daily

**'32' marks held to have been infringed in battle of the casinos**  
**United Kingdom - McDermott Will & Emery UK LLP**

**Confusion**  
**Cancellation**

February 07 2011

*32Red Plc v WHG (International) Ltd* ([2011] EWHC 62 (Ch), January 21 2011) concerned a trademark dispute between *32Red Plc*, the owner and operator of the 32Red online casino, and *William Hill*, owner of the 21Nova (formerly 32Vegas) online casino. 32Red sued William Hill for infringement of its Community trademark (CTM) registrations for 32RED and its UK trademark 32. The signs to which 32Red objected were the words '32vegas.com', '32Vegas' and '32v' and three devices incorporating the numeral 32. In its counterclaim, William Hill asserted that 32Red's trademark registrations were invalid.

The Chancery Division of the High Court held that the CTMs were valid and that they had been infringed under Article 9(1)(b) and 9(1)(c) of the [Community Trademark Regulation \(40/94\)](#) (now [Regulation 207/2009](#)). It also found that the UK mark was valid, but that it had not been infringed by William Hill.

The court first considered whether the CTMs had been infringed under Article 9(1)(b). It acknowledged that the goods and services covered by William Hill's signs were "identical, or at any rate virtually identical, to those covered by the Community marks" and that, accordingly, a lesser degree of similarity between the marks would suffice to establish a likelihood of confusion.

Assessing the matter through the eyes of the average consumer of online gaming services, the court found that William Hill's signs were sufficiently similar to the CTMs to cause a likelihood of confusion among consumers insofar as they both commenced with the number 32 in the dominant position, followed by a single word (or a single letter which alluded to the word 'vegas') which had a gaming association. A natural conclusion to draw was that the 32Red and 32Vegas casinos were under common ownership or economic control. Additionally, the court stated that it would have found it surprising, given the highly specific nature of the number 32, for two unconnected casino operators to have hit on two such similar names independently.

The court noted that 32Red was a strong brand with an excellent reputation and that the 32Red marks were highly distinctive in character. Considering 32Red's case based on Article 9(1)(c), it held that William Hill's infringement caused detriment to the distinctive character and repute of 32Red's CTMs, noting that the detriment to the distinctive character of the marks "lay in the risk of a false association with 32Vegas, a brand with an inferior reputation which operated in the same market place". It found that there was evidence of changes in economic behaviour of online gamblers. The similarity of the casino names, as well as the fact that 32Vegas was always operated as one of a number of linked casinos on a carousel model, lead to the conclusion that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas or to play with 32Vegas in the first place, than he would have been in the absence of such similarity.

In its counterclaim, William Hill alleged that 32Red's CTMs and UK mark were invalid, among other things, because they were either non-distinctive or descriptive or had become generic. Further, William Hill challenged the validity of the CTMs on the basis that they were liable to mislead the public as a consequence of the use made, or consented to, by 32Red in respect of online casinos. William Hill also argued that the UK mark had been registered in bad faith. On the evidence, the court dismissed William Hill's challenge to the validity of 32Red's CTMs and UK mark on all counts.

With regard to the UK mark, the court confirmed that a trademark consisting of a two-digit number could be sufficiently distinctive to be registrable. However, on the basis that 32Red had not yet made any significant use of, or acquired a separate reputation in, the mark 32, it held that, unlike the CTMs for 32Red, the UK mark 32 had not been infringed.

*Rohan Massey and Désirée Fields, McDermott Will & Emery UK LLP, London*

McDermott Will & Emery UK LLP acted for 32Red plc

---

# World Trademark Review *Daily*

*World Trademark Review* ([www.worldtrademarkreview.com](http://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.