O-246-07

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 2323015 IN THE NAME OF TAOUFIK MATHLOUTHI TO REGISTER A TRADE MARK IN CLASSES 9, 28, 29, 30, 31, 32, AND 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 92543 IN THE NAME OF RANK LEISURE HOLDINGS LTD

Trade Marks Act 1994

IN THE MATTER OF trade mark application
No. 2323015 in the name of Taoufik Mathlouthi
to register a trade mark in classes 9, 28, 29, 30, 31, 32, and 35

And

IN THE MATTER OF opposition thereto
under no. 92543 in the name of
Rank Leisure Holdings Ltd

BACKGROUND

1. On 6 February 2003, Taoufik Mathlouthi made an application to register the trade mark MECCA in Classes 9, 28, 29, 30, 31, 32 and 35 in relation to the following specifications of goods and services:

Class 09	Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; parts and fittings for all the aforesaid goods.
Class 28	Games and playthings; gymnastic and sporting articles not included in other classes; parts and fittings for all the aforesaid goods.
Class 29	Meat other than meat derived from animals of the families Suidae and Tayassuidae, fish, poultry and game; meat extracts other than meat derived from animals of the families Suidae and Tayassuidae; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats other than those derived from animals of the families Suidae and Tayassuidae.
Class 30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals other than of the families Suidae and Tayassuidae; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.
Class 32	Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; drink other than alcoholic beverages.
Class 35	Advertising; business management; business

2. On 7 June 2004, Rank Leisure Holdings Plc filed notice of opposition to the application in respect of "Games and playthings and parts and fittings therefore" in Class 28, and all goods covered by Classes 29, 30 and 32. The grounds of opposition being as follows:

Under Section 5(2)(a)	because the mark applied for is identical to the opponents' earlier trade mark, and is sought to be registered in respect of goods that are identical and/or similar to the services, namely, betting and gaming facilities and services in Class 41, and Restaurants, self-service restaurants, café and bar services and catering services in Class 42 for which the trade mark is registered, such that, there exists a likelihood of confusion on the part of the public, especially bearing in mind the public's imperfect recollection, which includes a likelihood of association with the earlier mark.
Under Section 5(3)	because use of the mark applied for, in respect of the goods specified in Classes 28, 29, 30 and 32, would without due cause, take unfair advantage of, or be detrimental to the opponents' earlier mark by trading off the reputation, goodwill and distinctive character which the opponents have built up and acquired in the mark through use.

The opponents rely on one earlier mark, details of which are shown as an annex to this decision.

3. The applicant filed a counterstatement in which he disputes that the opponents are the proprietors of the earlier mark relied upon, and deny the claims and grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

4. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 17 October 2006, when the opponents were represented by Mr Simon Malynicz of Counsel, instructed by Wildbore & Gibbons, their trade mark attorneys. The applicant was not represented.

Opponents' evidence

5. This consists of a Statutory Declaration and a Witness Statements. The Statutory Declaration is dated 27 October 2005 and comes from Jacqueline Abraham, who since 2001 has been Head of Marketing for Rank Leisure Group Plc. Ms Abraham says that Mecca Bingo Limited is a wholly owned subsidiary of her company.

6. Ms Abraham gives details of her company's history and use of the trade mark MECCA, from its origins in relation to coffee houses, through to bingo clubs in 1961. Exhibit JA1 consists of a collection of prints from the MECCA BINGO website giving details of the services provided and announcing events to mark the company's 40th anniversary. Ms Abraham says that they currently operate 117 clubs which typically consist of a main bingo playing area flanked by a café/diner, licensed bar and a fruit machine foyer. Members must be over 18 years of age to register and play bingo, the membership details being held on a database, the details of which she shows as Exhibit JA2. This lists the locations of the clubs and membership numbers by club, Ms Abraham saying that these figures are accurate as of 18 October 2005 when the company had 5,622,044 registered members.

7. Exhibit JA3 consists of various promotional leaflets, menus, wine lists, etc, all bearing the mark MECCA BINGO, the lettering of MECCA being separated in different coloured squares with BINGO in an italicised text below, which, apart from the following, cannot be dated:

> Money off vouchers for drinks at a MECCA BINGO Club bar, valid to 24 January 2000. The mark shown is MECCA BINGO.
>
> A leaflet promoting the membership of MECCA BINGO CLUBS and giving new members the opportunity to be entered into a 40th Anniversary prize draw, winners to be notified by 30 September 2001. The mark shown is MECCA BINGO.
>
> Invitation to an open night at MECCA NOTTY ASH on 28 March 2001. The MECCA BINGO mark is also shown.
>
> Information guide dated 5 May to 1 June 2003, for ancillary games staff at MECCA BINGO clubs. The mark shown is MECCA.BINGO.
>
> Voucher enabling a winner to participate in an "All winners' game" on 1 September 2001.

8. Ms Abraham goes on to give details of the "approximate" annual turnover from the bar and catering side of the MECCA BINGO clubs between 1997 and 2004, which runs at between £11.8 - £13 million per annum for the bar, and £9.1 - £11.8 million for catering.

9. Ms Abraham says that MECCA BINGO has been extensively advertised since the deregulation of the industry in 1997, Exhibit JA4 consisting of promotion and marketing materials used from 1999 to date. The exhibit shows various masters for advertisements, nationally circulated advertising dating from 1997, a managers' brief dating from August 2001 outlining a promotional drive, and a closure report produced following the completion

of a "Mecca Bingo 40th Birthday Roadshow" also in 2001, in both cases supported by significant national press, television and radio advertising, features from the press. The exhibit also includes invoices for expenditure on television promotions in 2002 and 2003. The opponents' promotion and use is of the mark in the "coloured square" form described above, with references in the media being to MECCA BINGO. Ms Abraham gives the "approximate" annual marketing spend in promoting MECCA in the UK in the years 1997 to 2004 as being between £15.5 and £21.8 million. Ms Abraham says that her company initially conducted advertising trials in the Midlands and Scotland in 1997 and 1998, and thereafter on a nationwide basis spending some £2 million each year on television advertising. Ms Abraham refers to Exhibit JA5, which consists of a report into the bingo industry in the UK between 2000 and May 2005. A significant period covered by the report extends beyond the relevant date, the data cannot assist in establishing the position at that time. The opponents highlight a reference that states that, along with Gala Group, the Rank Group is long established in the UK Bingo market and is familiar to all players. The report recounts the history of MECCA BINGO, from its ownership by Grand Metropolitan in the 1980s, to it being acquired by and operated as a subsidiary of the Rank Organisation (now called the Rank Group) who, in the 1990s developed the brand for its bingo. The turnover of Mecca Bingo in the UK in the years 2000 to 2002 is stated to be of the order of £220 to £230 million.

10. Ms Abraham refers to Exhibit JA6, which consists of details taken from the MECCA GAMES.COM website, an online gaming/gambling website launched in February 2003. She concludes her Statement by giving details of the "approximate" total turnover for all business under MECCA in the UK for the years 1998 to 2004, which ranges from £230 million in 1998, rising year on year to £250 million in 2002, the last full year prior to the relevant date. For the record the following years show a continued increase.

11. The Witness Statement is dated 27 October 2005 and comes from Camilla Frances Sexton, a trade mark attorney with Wildbore & Gibbons, the opponents' representatives in these proceedings. Ms Sexton's Statement consists of submissions commenting on the contents of the applicants' Counterstatement. Being submissions I do not consider it to be necessary or appropriate that these be summarised. I will, of course take them fully into account in my determination of this case. Ms Sexton introduces three exhibits, as follows:

CFS1 prints from the Internet showing bingo sets, fruit/slot machine and gaming related board games, all of which come under the description toys and playthings.

CFS2 prints taken from the Internet that Ms Sexton says show that restaurants, cafes and fast-food outlets produce food and drink under their own brand name.

CFS3 Print-case details of the earlier mark relied upon by the opponents, and details from the Companies House website.

Applicants' evidence

12. This consists of a Witness Statement dated 30 January 2006, from Michael Lynd, a trade mark attorney with Marks & Clerk, the applicants' representatives in these proceedings. Mr Lynd's Statement consists of submissions on the substance of the proceedings, and comments on the contents of the opponents' evidence. Being submissions I do not consider it to be necessary or appropriate that I should summarise the Statement. I will, of course, take the submissions fully into account in my determination of this case. Mr Lynd provides one exhibit MAL1, which consists of an extract from the Registry's Guide to Cross Searching.

13. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

14. The opponents withdrew the ground under Section 5(3), so the opposition is founded on Section 5(2)(b), which reads as follows:

> **"5**.-(2) A trade mark shall not be registered if because -
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
> >
> > (b) …
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

15. An earlier trade mark is defined in Section 6 of the Act as follows:

> **"6.**- (1) In this Act an "earlier trade mark" means–
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark or International trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,"

16. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely

has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG & Adidas Benelux BV* paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

17. The opponents rely on one earlier registration for the mark MECCA, which is registered in Classes 41 in respect of "Betting and gaming facilities and services", and Class 42 in respect of "Restaurants, self-service restaurants, café and bar services and catering services." This achieved registration on 5 February 1999, just over five years prior to 5 March 2004, the date on which the application that is the subject of these proceedings was published for opposition. These proceedings are therefore also subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. Section 4 of those Regulations amend section 6 of the Act by the addition of the following:

“6A Raising of relative grounds in opposition proceedings in case of nonuse

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) …….

(7) …….”

18. Also of relevance is section 100 of the Act which states:

“**100**.- If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. The opponents claim to have used their mark on all of the services for which it is registered. Ms Abraham says that the opponents use MECCA primarily in relation to bingo clubs, and that this use dates back to 1961. She says that they also use MECCA in relation to Internet and electronic gaming and services ancillary to these. Exhibit JA1 consists of details from the MECCA BINGO website, announcing events to mark the company's 40th Anniversary, stating that they currently operate 117 clubs. The prints show the mark MECCA BINGO, the lettering of MECCA being separated in different shaded squares that from other exhibits can be seen to be colours, with BINGO in an italicised text below. Ms Abraham says that a typical club layout consists of a main bingo playing area flanked by a café/diner, licensed bar and a fruit machine foyer. Members must be over 18 years of age to register and play bingo. Exhibit JA2 shows the locations of the clubs and membership numbers by club as of 18 October 2005. At this point the company had 5,622,044 registered members. Whilst this is some time after the relevant date, given their size it seems reasonable to infer that the numbers would have been significant at that time. Exhibit JA3 consists of various promotional leaflets, menus, wine lists, etc, all bearing the MECCA BINGO mark as referred to above, but this time showing the colours. Part of the exhibit consists of money off vouchers for drinks at a MECCA BINGO Club bar, showing this to be valid up to 24 January 2000. A leaflet promoting the membership of MECCA BINGO CLUBS gives new members the opportunity to be entered into a 40th Anniversary prize draw, stating that the winners will be notified by 30 September 2001. This exhibit also includes an invitation to an open night at MECCA NOTTY ASH on 28 March 2001, an information guide dated 5 May to 1 June 2003 produced for ancillary games staff at MECCA BINGO clubs, and a voucher enabling a winner to participate in an "All winners' game" on 1 September 2001. All bear the MECCA BINGO mark as described earlier. In February 2003 the applicants launched MECCA GAMES.COM, an online gaming/gambling website.

20. Ms Abraham gives the "approximate" annual turnover from the bar and catering side of the MECCA BINGO clubs in the years 1997 and 2004 as being at between £11.8 - £13 million per annum for the bar, and £9.1 - £11.8 million for catering. The turnover of all Mecca Bingo businesses in the UK in the years 1998 to 2004 is stated to be of the order of £230 to £250 million.

21. Ms Abraham says that MECCA BINGO has been extensively advertised since the deregulation of the industry in 1997. Exhibit JA4 shows various nationally circulated advertising dating from 1997, a managers' brief dating from August 2001 outlining a promotional drive, and a closure report produced following the completion of a "Mecca Bingo 40th Birthday Roadshow" in 2001 supported by significant national press, television and radio advertising. Ms Abraham gives the "approximate" annual marketing spend in the UK in the years 1997 to 2004 as being between £15.5 and £21.8 million, earlier expenditure being centred on trials in the Midlands and Scotland in 1997 and 1998.

22. There can be little doubt that the applicants have used MECCA BINGO to a very significant extent in relation to their bingo clubs, betting and gaming services, part of which has included the operation of bar and café/restaurant services. They primarily use this mark in a composite form, the letters of MECCA being enclosed in separate coloured squares, with BINGO in an italicised script placed below. This emphasises that MECCA is the mark and BINGO is a description of the service provided, a distinction that will be plainly obvious to

the consumer. Their use of the same style for the MECCA online gaming further highlights that MECCA is the house mark, and what follows is a statement of the business. There is also limited evidence that shows the opponents are also known as MECCA *solus*. I therefore have little difficulty in reaching the position that the applicants have used their earlier mark (or a form not substantially different in its distinctive make-up) in relation to the services for which it is registered. I am also able to say that in respect of bingo, gambling and gaming services they undoubtedly have a substantial reputation in the MECCA name. This may well extend to café, bar and restaurant services that also form a part of the opponents business. However, these services are ancillary to the opponents' main activity of bingo clubs and gaming, in essence being provided to enhance the game players enjoyment. In such cases it is not clear to what extent any free-standing reputation will exist.

23. Self-evidently the respective trade marks are identical words, so there can be no argument that they look the same to the eye, would be aurally identical when spoken, and insofar as they send out any message, this would be the same. Their distinctiveness rests in the whole, there being no dominant element.

24. MECCA is an ordinary English word meaning a place to which people are attracted, presumably being derived from it being the name of a holy city to which pilgrimages are made. This may at first sight appear to give the word laudatory connotations but is an allusion rather than a description of the services for which the opponents have it registered as a trade mark. In relation to such services this is a mark with a strong distinctive character, a factor that Mr Malynicz correctly observed contributes to a greater likelihood of confusion (See *Sabel*). I have already given my assessment of the opponents' use of the word as a badge for their services, reaching the conclusion that they have made extensive use in relation to their bingo club services for which they have a significant reputation. I have no doubt that in relation to such services their use has added to the words distinctiveness. In relation to the café, bar and restaurant services , these have either been provided as an adjunct to the bingo activities, or are relatively new. I do not therefore consider that they have enhanced the already strong distinctive character of the mark.

25. I now turn to the question of whether the services of the opponents' earlier mark are similar to the goods in Classes 28, 29, 30 and 32 of the application. These are the classes on which the opponents specifically focus their objection. In his submissions Mr Malynicz referred me to something he said was sometimes called the "offset" principle. This is a reference to the *Canon* case in which it was stated that a lesser degree of similarity between the marks may be offset by a a greater degree of similarity between the goods, and *vice versa.* That is undoubtedly the case, but there still must be similarity in both respects. In considering the similarity of the respective goods and services I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

> "…the following factors must be relevant in considering whether there is or is not similarity:
>
> (a) the respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive.

This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors."

26. Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary."

(see paragraph 56 of Case T-169/03 explaining the change from "end consumers" to "intended purpose". This appears to have resulted from a mis-translation of the original text.)

27. Turning first to Class 28 of the application, which covers games, playthings, gymnastic and sporting articles, and parts and fittings for such goods. The specification also contains the expression "not included in other classes" which really adds nothing and takes nothing away. The opponents' objection relates to games, playthings and their parts which they submit are similar to their service related to the provision of betting and gaming facilities because "games and playthings cover gaming aparatus and gambling machines." On its usual and ordinary meaning the words "games" and "playthings" would cover "amusement machines" of the type found in the opponents' clubs. I would therefore conclude that they have the same uses, and in this respect, also the same users, although given the legal age restrictions on gambling, the user group would be narrower than for games and playthings at large.

28. The physical nature of a service must de different from goods; one is tangible, the other not, but if that were determinative there would never be a finding of similarity between goods and services. The sort of machines contained within the application that the opponents say they use in their club foyers are not of the type ordinarily purchased by the public, they are intended for use in commercial establishments such as pubs, clubs and amusement arcades.

As far as I am aware, and there is no evidence to the contrary, the provider of a gaming machine service will not also sell the gaming machines. Likewise there is no evidence that a manufacturer of gaming machines will also provide a service by which they may be used. They are not in competition, and are complementary only insofar as the maker of the goods may rent or sell them to the provider of the service. To my mind these are likely to be regarded as separate but allied markets, both by the relevant consumer and by the trade itself. That said this is not an area of trade of which I, or probably anyone outside of the amusement machine industry is likely to have much, if any experience. Balancing all of the factors for and against, I come to the view that the goods notionally covered by the opponents' specification in class 28 are similar to the services listed in Class 41 of the opponents' earlier mark.

29. The opponents also object to the application in respect of Classes 29, 30 and 32. They say that all of the goods applied for in these classes cover all manner of food and drink, including pre-prepared and packaged food where the trade channels can include bars, restaurants, cafes, etc. The objection is based on the assertion that it is not uncommon for such outlets to sell pre-packaged food under their own trade mark. The opponents contention is that if a consumer was offered the applicants' MECCA branded food or drink in their cafés or bars, there is a reasonable likelihood that they would believe it originated from the opponents or a linked business.

30. It would hardly be surprising if a consumer was sitting in a MECCA Bingo club eating a sandwich that came in a wrapper bearing the name MECCA were to reach the conclusion that it was food originating from that establishment. The question is whether that consumer would reach the same conclusion if they saw the sandwich in some unconnected environment such as a supermarket. The uses of a food and drink establishments appear to be the same as the food and drink *per se*; to satisfy hunger and thirst. However, the former is there to provide prepared food for immediate consumption as part of a social environment, whereas food and drink comes in many forms, both ready for use or requiring further processing or preparation.

31. I am aware of examples where a well-known restaurant has gone on to attach their name to a product for which they are known, but that is not something the consumer would expect of a café, restaurant or bar that is provided as a facility to enhance the enjoyment of a primary business activity. There is no evidence that clubs of whatever type trade in food and drink beyond the confines of their own premises. To my mind these are different market sectors and likely to be classified as such by industry and market research companies.

32. Apart from the fact that there is a legal age restriction of 18 on the consumers of the opponents' services, there appears to be no reason why the customers who use and purchase food and drink in the opponents' café's restaurants and bars should be any different to those who buy such goods for preparation and consumption at home. Insofar as a consumer may elect to eat-out rather than prepare food themselves, the respective goods and services are in competition, and otherwise are complementary.

33. Taking all of the factors into account, I find that the services of Class 42 of the opponents' earlier mark are neither the same or similar to the goods in Classes 29, 30 or 32 of the application.

34. Adopting the global approach advocated, I come to the view that given the strong distinctive character of the word MECCA and the opponents' substantial reputation in that word in respect of gaming and gambling, that should the consumer come into contact with the applicants' goods in Class 28, namely, games, playthings and parts for such goods, there is a likelihood of confusion, and in respect of that class the opposition under Section 5(2)(a) succeeds. Mr Malynicz observed that the applicants' specification "theoretically covers games and playthings that are not provided in a gaming or betting environment." He went on to argue that it was the specification in its current form that is objectionable and that it "is too late to restrict it now." That is the position. The finding against games and playthings at large requires that those terms be removed from the specification if the application is to proceed. Doing so also effectively removes parts and fittings for such goods. **In the event of there being no appeal, the application will be allowed to proceed for a specification in Class 28 reading as follows:**

> **Gymnastic and sporting articles not included in other classes; parts and fittings for all the aforesaid goods.**

35. In relation to the goods covered by Classes 29, 30 and 32 of the application, I take the view that should the applicant use MECCA in relation to the goods listed, this may well bring the opponents' earlier mark to mind, but that is not sufficient for the purposes of Section 5(2) (*Sabel BV v. Puma AG*, paragraph 26). Nor does the fact that they may have a reputation for MECCA in respect of gambling and gaming services, part of which involves the provision of food and drink. Having a reputation does not necessarily give grounds for presuming a likelihood of confusion simply because of a likelihood of any association by the consumer (*Marca Mode CV v. Adidas AG & Adidas Benelux BV* paragraph 41). For there to be a finding of a likelihood of confusion the association between the respective marks would have to cause the public to wrongly believe that the goods of the applicant are those of the opponents or some linked undertakings (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29). I do not see any reason why the consumer should draw that conclusion in respect of use by the applicants in relation to the goods in Classes 29, 30 or 32. The objection under Section 5(2)(a) in respect of these classes is dismissed accordingly.

36. The opposition has been successful, but only in respect of one of the four classes that were subject to the opponents' objection. Given this, I do not consider that an award of costs to either party is appropriate.

Dated this 24th day of August 2007

Mike Foley
for the Registrar
the Comptroller-General

Case details for Trade Mark 2125681

Mark

Mark Text: MECCA

Status: Registered

Classes: 41 42

List of goods and/or services

Class 41: Betting and gaming facilities and services; all included in Class 41.

Class 42: Restaurants, self-service restaurants, cafe and bar services; catering services, all included in Class 42.

Relevant Dates

Filing Date: 6 March 1997

Next Renewal Date: 6 March 2017

Registration Date: 5 February 1999

Publication in Trade Marks Journal

	Journal	Page	Publication Date
First Advert	6248	11869	21 October 1998
Registration	6267		10 March 1999
Renewal	6667		12 January 2007
Assignment	6247		14 October 1998

Names and Addresses

Proprietor:

Rank Leisure Holdings Limited
6 Connaught Place,London,W2 2EZ
Residence Country:
United Kingdom
Customer's Ref: SJB/SJ/2125681

Effective Assignment date: 2 July 1998
Assignment date: 2 July 1998
ADP Number: 0730248001

Agent:

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ADP Number: 0004382001

Service:

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