TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 84117
BY ASSOCIATED NEWSPAPERS FOR REVOCATION OF
REGISTRATION NO. 2301358 IN THE NAME OF
RAL LIMITED**

BACKGROUND

1.Registration No. 2301358 for the trade mark **METRO BINGO** was registered in the name of RAL Limited ("RAL"). The trade mark was applied for on 24 May 2002 and the registration procedure was completed on 15 August 2003. The trade mark was registered for the following services:

> **Class 41** - Provision of entertainment, amusement, leisure and recreational facilities; amusement centre and amusement arcade services; bingo halls and funfair services; gaming services; operating lotteries; arranging of recreational activities for groups of persons; organisation of games and competitions; all of the aforesaid services provided only in bingo halls/clubs.
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> **Class 43** - Restaurant, cafeteria, cafe, coffee shop, canteen, catering and bar services; all of the aforesaid services provided only in bingo halls/clubs.

2. On 21 July 2011, Associated Newspapers ("AN") applied for revocation of this registration under the provisions of sections 46(1)(a) & (b) of the Trade Marks Act 1994 ("the Act"). AN sought revocation in respect of all the services for which the trade mark was registered.

3. AN asks for the registration to be revoked with effect from 16 August 2008 under section 46(1)(a) and, under section 46(1)(b), either 28 July 2010 or 21 July 2011.

4. On 7 October 2011, RAL filed a form TM8 and counterstatement. In its counterstatement RAL said:

> "METRO BINGO is currently put to genuine use in relation to [RAL's] gaming business and specifically the classes stated in the registration. Even [if [AN] can establish that the trade mark was not put to genuine use in the 46(1)(a) period and that use had been suspended in the 46(1)(b) periods] the registration of the METRO BINGO trade mark may not be revoked as [RAL's] use of METRO BINGO commenced and/or resumed after 15 August 2008 and before this application was made. Preparations for the commencement/resumption of METRO BINGO began before [RAL] became aware that the application might be made."

5. On 31 May 2012, RAL's professional representatives filed a form TM22 to surrender its registration in full. In a letter to AN's professional representatives dated 9 July 2012 the Trade Marks Registry said:

> "As you have requested a date of revocation which is earlier than the date of the surrender, these proceedings will continue unless the application is withdrawn. You should notify the Registry if it is your intention to withdraw the application for revocation."

6. In a letter dated 23 July 2012, AN's representatives indicated that they would not be withdrawing the application.

7. Only RAL filed evidence. While neither party asked to be heard, both parties filed written submissions in lieu of attendance at a hearing. I will refer to these submissions as necessary below.

RAL's evidence

8. This consists of a witness statement, dated 13 February 2012, from Ian Johnson, RAL's Commercial Manager. The following facts emerge from Mr Johnson's witness statement:

- RAL was incorporated as a private limited company in August 1985. It was formerly known as Rank Amusement Limited and changed its name to RAL in December 1996;

- RAL is a wholly owned subsidiary of Talarius Limited. RAL, together with Talarius, operates around 168 adult gaming centres and around 8,000 gaming machines throughout the UK. Talarius is itself a wholly owned subsidiary of the Tatts Group which is one of the largest gaming companies in Australia;

- RAL had a turnover in excess of £42m for the financial year ending 2011;

- RAL and Talarius operate a number of brands in the UK, including QUICKSILVER, WINNERS, SILVERS AMUSEMENTS and METRO BINGO;

- Mr Johnson says:

  > "7...METRO BINGO brand was adopted with a view to RAL/Talarius growing revenue in the bingo club market as part of a commercial strategy of acquiring businesses which were suitably positioned to take advantage of growth opportunities within this market. In particular, in March 2006, Talarius acquired 12 prize bingo lounges from Leisurama Entertainments Limited, which brought the total number of prize bingo lounges to 21. Such acquisitions provided RAL with expertise in the high street prize bingo market, prompting RAL to explore its offering under the METRO BINGO brand in relation to bingo centres..."

- RAL/Talarius "currently operates" bingo gaming services at its premises at 2 Pasture Road using the METRO BINGO trade mark. Exhibit IJ1 consists of 3 undated photographs which Mr Johnson explains were taken of the Pasture Road premises and which shows "the METRO BINGO wording is displayed on the windows of 2 Pasture Road, and on the light panels above individual gaming machines..."; The first photograph is (I presume) the light panels on a gaming machine (although this is far from certain) above which appears the words METRO BINGO. The second photograph is of a part of a shop window which has the words METRO BINGO at the top of the window. The third photograph is of the front of the shop. Above the door appear the words SILVERS BINGO, the word SILVERS appears on both doors, on a display board in one of the

windows and on a display board at the entrance to the shop. The words METRO BINGO appear at the top of both windows (as in photograph 2);

- Mr Johnson goes on to say:

> "9. Whilst the METRO BINGO signage referred to above was installed relatively recently, preparations for the use of METRO BINGO at 2 Pasture Road were being made well before [AN] made its application to revoke METRO BINGO on 25 July 2011. In order to lawfully run commercial bingo gaming centres, businesses require both an operating licence from the Gambling Commission and a Premises Licence from the local licensing authority. In preparation for the use of METRO BINGO in relation to bingo centres, Talarius applied for, and was granted, an Operating Licence by the Gambling Commission in the name of METRO BINGO...";

- Exhibit IJ2 consists of a copy of a Combined Operating Licence issued by the Gambling Commission on (and valid from) 1 November 2010 to Talarius Limited trading as Winners Amusements, Silvers Amusements, Metro Bingo and Quicksilver and which authorises Talarius "to provide facilities for betting other than pool betting; to make gaming machines available for use in an adult gaming centre; to supply, install, adapt, maintain or repair (but not manufacture) a gaming machine or part of a gaming machine; to provide facilities for playing bingo";

- Exhibit IJ3 consists of a Bingo Premises Licence issued to Talarius Limited by the East Riding of Yorkshire Council which indicates that "Facilities for gambling may be provided in accordance with the licence on the following premises: Metro Bingo, 2 Pasture Road, Goole, East Riding of Yorkshire DN14 6EZ". The Licence came into effect on 14 October 2010 and (subject to conditions) is of unlimited duration.

- Mr Johnson concludes his statement in the following terms:

> "10. Given that preparations to use METRO BINGO to advertise RAL's bingo halls at 2 Pasture Road have been undertaken for a number of years, and that RAL currently uses and intends to continue to use METRO BINGO, I hereby request that the registrar dismisses the application to revoke..."

9. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The Law

10. Section 46 of the Act reads as follows:

> "46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) ….

(d) …..

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4)…..

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights

of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the Registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

11. Section 100 of the Act is also relevant and reads:

> "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."

The relevant five year periods

12. The application for revocation is based upon sections 46(1)(a) & (b) of the Act. AN asks for the registration to be revoked with effect from 16 August 2008 under section 46(1)(a) and, under section 46(1)(b), either 28 July 2010 or 21 July 2011. The relevant periods are therefore under section 46(1)(a) - 16 August 2003-15 August 2008 and under section 46(1)(b) - 28 July 2005-27 July 2010 and 21 July 2006-20 July 2011.

The authorities on genuine use

13. The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging* BV [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. The general principles were summarised by the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28 as follows:

> "(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: Ansul, [35] and [37].
>
> (2) The use must be more than merely "token", which means in this context that it must not serve solely to preserve the rights conferred by the registration: Ansul, [36].
>
> (3)The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: Ansul, [36]; Silberquelle, [17].
>
> (4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: Ansul, [37]-[38]; Silberquelle, [18].
>
> (a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: Ansul, [37].
>
> (b) Examples that do not meet this criterion: (i) internal use by the proprietor: Ansul, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: Ansul, [38] and [39]; La Mer, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: Ansul, [39]; La Mer, [21], [24] and [25]."

14. In approaching the issue of genuine use, I note the following comment which appears in RAL's written submissions:

"As you are aware, the proprietor has surrendered its rights to the trade mark which is the subject of these proceedings. As it has no further interest in the mark..."

15. In its written submissions AN say:

"5. Instead of taking the proportionate approach of consenting to the application for revocation, on 24 May 2012 RAL chose not to pay the renewal fee for the mark and on 30 May 2012 RAL filed a notice of surrender for the mark in its entirety. This approach leaves AN in the position of having to continue to pursue the revocation action for a mark that has been surrendered by the proprietor."

And:

"16. Mr Johnson's witness statement purports to provide evidence of use of the mark solely in relation for "bingo gaming services". Realistically, such services could conceivably fall [within the definitions "bingo halls and funfair services" and "gaming services"]. No evidence of genuine use has been proffered at all in relation to any of the other services..."

16. In his witness statement Mr Johnson says:

"8. RAL/Talarius currently operates bingo gaming services at its premises at 2 Pasture Road using the METRO BINGO trade mark..."

17. There is no suggestion (and certainly no evidence) which indicates that RAL has at any time commenced or resumed use of its METRO BINGO trade mark in relation to any of the services for which it was registered in class 43 i.e.

> Restaurant, cafeteria, cafe, coffee shop, canteen, catering and bar services; all of the aforesaid services provided only in bingo halls/clubs.

18. In those circumstances, AN's application for revocation based upon section 46(1)(a) of the Act must succeed, and the registration is hereby revoked in relation to these services under the provisions of section 46(6)(b) of the Act with effect from 16 August 2008.

19. That leaves RAL's services in class 41 i.e.

> Provision of entertainment, amusement, leisure and recreational facilities; amusement centre and amusement arcade services; bingo halls and funfair services; gaming services; operating lotteries; arranging of recreational activities for groups of persons; organisation of games and competitions; all of the aforesaid services provided only in bingo halls/clubs.

20. Once again, there is no suggestion (and no evidence) which indicates that RAL has at any time commenced or resumed use of its METRO BINGO trade mark in relation to:

> Operating lotteries; all of the aforesaid services provided only in bingo halls/clubs.

21. As, in my view, all of the services in class 41 which remain are broad enough to include the services upon which Mr Johnson claims the METRO BINGO trade mark has been used i.e. "bingo gaming services", it would be necessary (assuming RAL could satisfy the other genuine use criteria) for me to determine what constituted a fair specification applying the guidance in, inter alia, *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Animal Trade Mark* [2004] FSR 19 and *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03.

22. However, while it emerges from Mr Johnson's statement that having acquired 12 prize bingo lounges from Leisurama Entertainments Limited in March 2006 RAL was prompted to "explore its offering under the METRO BINGO brand in relation to bingo centres", it appears that nothing further happened until Talarius applied to the East Riding of Yorkshire Council and the Gambling Commission for Premises and Operating licences; licences which were subsequently granted and valid from 14 October and 1 November 2010 respectively. However, notwithstanding the existence of these licences (the former of which is limited to a single location in Goole), in his statement dated 13 February 2012, Mr Johnson states that the signage shown in exhibit IJ1 was "installed relatively recently". In response to this, in its written submissions, AN said:

> "19...Mr Johnson specifically omits whether the "recent" installation was even before the latest date on which RAL needed to show proof of use, being 20 July 2011. AN submits that this is unlikely as if this was the case, then surely Mr Johnson would have relied on that fact."

23. The evidence shows that RAL applied for the licences mentioned above before it became aware that this application was to be made (AN's application to revoke indicates that RAL was notified of its intention to revoke on 21 July 2011 i.e. the date the application was filed at the

Trade Marks Registry). However, irrespective of AN's submissions (by reference to, inter alia, the decision of the Court of Justice of the European Union (CJEU) in *Céline SARL v Céline* – case C17/06) regarding the use of the trade mark METRO BINGO shown in exhibit IJ1, having considered RAL's evidence as a totality, there is (despite the assertion in its counterstatement to the effect that its use of the METRO BINGO trade mark commenced or resumed before the application was made), nothing to indicate, for example, when the signage shown in exhibit IJ1 was installed or when RAL began using the trade mark the subject of these proceedings. This, together with the absence of any details relating to, inter alia, turnover generated by the use of the METRO BINGO trade mark and any indication of amounts spent on making the METRO BINGO trade mark known, leaves me unable to conclude that RAL has made any use of its METRO BINGO trade mark in relation to any of the remaining services in class 41 in any of the relevant periods. In those circumstances, AN's application for revocation based upon section 46(1)(a) of the Act succeeds, and the registration is hereby revoked under the provisions of section 46(6)(b) of the Act in relation to all of the services in class 41 with effect from 16 August 2008.

Overall conclusion

24. AN's application for revocation based upon section 46(1)(a) of the Act succeeds, and the registration is hereby revoked under the provisions of section 46(6)(b) of the Act in relation to all of the services for which it was registered, with effect from 16 August 2008.

Costs

25. AN has been successful and is, in principle, entitled to an award of costs. In its submissions AN said:

> "40. [AN] seeks the maximum award in costs in its favour in these proceedings."

26. In its submissions RAL said:

> "However, [RAL] does wish to object to [AN's] request that it be awarded its costs of the proceedings. [RAL's] objection to an award of costs is based partly upon the content of without prejudice discussions between the parties, the details of which cannot be disclosed to the examiner prior to the decision on substantive issues.
>
> We therefore request that following the decision on the substantive issues, the examiner reserves his/her consideration of the costs of the action and provides the parties with an opportunity to file written submissions on costs (which will allow for disclosure of the without prejudice discussions)..."

27. In view of the above, RAL are allowed 14 days from the date of this decision to file submissions on costs (and only on costs) and to copy these submissions to AN. AN will then have 14 days from receipt of these submissions to provide written submissions of their own on costs. At the conclusion of these periods I will issue a supplementary decision covering the costs of these proceedings.

28. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.

Dated this 16th day of October 2012

C J BOWEN
For the Registrar
the Comptroller-General