

O/0873/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004148944
BY CAKTUS LIMITED TO REGISTER THE TRADE MARK:



IN CLASSES 16 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 452298
BY PRICKLY CARDS LTD

BACKGROUND AND PLEADINGS

1. On 17 January 2025, Caktus Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 31 January 2025, and registration is sought for the goods set out in the Annex to this decision.

2. On 31 January 2025, Prickly Cards LTD (“the opponent”) partially opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ For the purposes of the opposition, the opponent relies upon the following trade mark:

Prickly Cards

United Kingdom Trade Mark: 3839492

Filing Date: 16 October 2022

Registration Date: 06 January 2023

Registered for goods in classes 16 and 21

(“The opponent’s mark”)

3. The opposition is directed against some of the goods in class 16 only, and the opponent relies upon some of the goods for which the earlier mark is registered. The relevant goods are set out in paragraph 15 of this decision.

4. The opponent’s mark qualifies as an ‘earlier mark’ in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of those goods without having to establish genuine use.

¹ The opposition was originally brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. However, as the opponent did not file any evidence, the grounds under sections 5(3) and 5(4)(a) were deemed withdrawn and the proceedings now continue under section 5(2)(b) only. This was communicated to the parties by official letter dated 5 January 2026.

5. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar and that the respective goods are identical or similar, such that there exists a likelihood of confusion on the part of the public.

6. The applicant filed a counterstatement in which it admits that the marks are similar but submits that the word 'prickly' is "too generic a word to gate-keep for a single use". The applicant further admits that the respective goods are similar but submits that "there are many others selling similar products elsewhere".

7. As the applicant has admitted that the marks are similar and that the respective goods are similar, those issues are no longer in dispute between the parties. However, I will nevertheless address them to determine the level of similarity before considering whether there is a likelihood of confusion for the purposes of section 5(2)(b). I further note the applicant's submissions regarding the purported generic nature of one of the shared words in the marks and the existence of other similar products on the market. I will address those matters in turn throughout this decision.

8. Both parties are unrepresented. During the evidence rounds, neither party filed evidence or submissions. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary issues

Third-party use in the marketplace

10. The applicant has submitted that “there are many others selling similar products elsewhere”.² I consider this submission to concern the alleged presence of other similar signs and/or products in the marketplace.

11. No evidence has been filed concerning the use of third-party trade marks or products in the marketplace. Consequently, I am unable to place any weight on the applicant's unsupported assertion in this regard. I will therefore determine the opposition on the basis of the material before me.

DECISION

12. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because –

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

² Form TM8, page 2, question 8.

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

15. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 16</u> Greeting cards; Printed cards.	<u>Class 16</u> Greeting cards; Printed cards.

16. The opponent relies upon "greeting cards" and "printed cards" in its earlier registration, and the opposition is directed against "greeting cards" and "printed cards" in the application. The respective goods are therefore self-evidently identical.

The average consumer and the purchasing act

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

18. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

19. The average consumer for the goods is likely to be a member of the general public. The goods are likely to be obtained by self-selection from retail outlets or their online equivalents. Visual considerations are therefore likely to dominate the selection process. However, I do not discount the role of aural considerations, for example, where the goods are purchased following interactions with sales assistants. The goods are likely to be inexpensive and purchased relatively frequently. In assessing the goods, the average consumer is likely to consider factors such as the design of the cards, their suitability for the intended recipient and/or occasion and, where relevant, reviews from other customers. Given the ordinary nature of the purchasing considerations involved, I find that the average consumer is likely to pay a low to medium degree of attention during the purchasing process.

Comparison of the marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

21. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

23. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
Prickly Cards	

Overall impression

24. The opponent's mark is a word-only mark consisting of the words 'prickly' and 'cards' presented in title case. The opponent submits that the word 'prickly' is distinctive,³ while the applicant argues that it is "generic."⁴ Considering the nature of the goods, it is my view that the average consumer will perceive the word 'cards' as purely descriptive of the goods. The word 'prickly', on the other hand, whilst being an ordinary dictionary word, neither describes nor alludes to the goods in any way. In view of this, I find that 'prickly' is more distinctive and dominant and will therefore play the greater role in the overall impression of the mark, whereas 'cards', being purely descriptive and therefore weakly distinctive, will play a lesser role.

25. The applicant's mark is a figurative mark consisting of the words 'prickly' and 'products', presented in lowercase in a green, stylised typeface incorporating decorative thorn-like embellishments. The word 'prickly' appears above the word 'products' in a stacked arrangement. For similar reasons to those set out in paragraph 24, I find that 'prickly' is more distinctive and dominant and will therefore play the greater role in the overall impression of the mark, whereas 'products', being descriptive or highly allusive to the goods and therefore weakly distinctive, will play a lesser role.

³ Form TM7, page 6, question 9

⁴ Form TM8, page 2, question 8

Further, I find that the colour used will play a lesser role. For reasons I will come to discuss below, I also find that the stylisation, including the thorn-like embellishments, while not negligible, contributes only to a limited extent to the overall impression of the mark.

Visual comparison

26. Visually, the marks share the word 'prickly'. This is followed by a different word in each mark, namely 'cards' in the opponent's mark and 'products' in the applicant's mark. While these words play a lesser role in the overall impressions of the marks, they nevertheless constitute points of visual difference. The opponent's mark, being a word-only mark, may be used in any standard typeface and in any colour. However, it would not be appropriate to compare the marks by hypothesising a presentation of the opponent's mark incorporating the stylisation adopted by the applicant's mark, namely its decorative thorn-like embellishments.⁵ Those embellishments, while noticeable, do not obscure the words 'prickly products', which remain readily perceptible. I also bear in mind that the beginnings of marks generally have a greater impact on consumers.⁶ Taking all of the above into account, I find the marks to be visually similar to a medium degree.

Aural comparison

27. The word 'prickly' is an ordinary English dictionary word and will be pronounced in the normal way. The point of aural overlap lies in the word 'prickly' which will be pronounced identically in both marks. The point of aural difference arises from the words 'cards' in the opponent's mark and 'products' in the applicant's mark. Taking these factors into account, I find the marks to be aurally similar to a medium degree.

⁵ See the decision of the Appointed person in *Herno S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 42.

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Conceptual comparison

28. Conceptually, the marks share the word ‘prickly’, which has the same ordinary meaning in both marks, namely something that has or is covered in prickles. The thorn-like embellishments in the applicant’s mark reinforce that concept. In both marks, ‘prickly’ qualifies the word that follows it, namely ‘cards’ in the opponent’s mark and ‘products’ in the applicant’s mark. The words ‘cards’ and ‘products’ differ. However, bearing in mind my findings in relation to the overall impression of the marks, I consider that this difference has only a limited impact on the conceptual message conveyed by the marks. I therefore find the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

29. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from very low, where they are suggestive or allusive of a characteristic of the goods or services, to high, such as invented words with no allusive qualities. Although the distinctive character of a mark may be enhanced through use, the opponent filed no evidence to that effect. As such, I have only the inherent position to consider.

31. The opponent's mark consists of the words 'prickly' and 'cards'. As set out in the overall impression assessment, I find that the word 'cards' is descriptive of the goods and therefore weakly distinctive. Accordingly, the distinctive character of the mark resides primarily in the word 'prickly'. Whilst 'prickly' is an ordinary dictionary word, it neither describes nor alludes to the goods at issue. Consequently, I find that the mark enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

32. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97). As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be mindful of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods down to the responsible undertakings being the same or related.

34. Earlier in the decision I found that:

- The goods at issue are identical.
- The average consumer for the goods at issue is a member of the general public who will pay a low to medium degree of attention during the purchasing process.
- The purchasing process for the goods is predominantly visual, although I do not discount an aural component.
- The overall impression of the opponent's mark lies in the word 'prickly', with the word 'cards' playing a lesser role.
- The overall impression of the applicant's mark lies in the word 'prickly', with the word 'products' playing a lesser role and the colour also playing a lesser role. The stylisation, including the thorn-like embellishments, contributes to the overall impression to a limited extent.
- The marks are visually and aurally similar to a medium degree and conceptually similar to a high degree.
- The opponent's mark is inherently distinctive to a medium degree.

35. Taking all these factors into account and bearing in mind the imperfect recollection of the average consumer, it is my view that there is a likelihood of the marks being mistaken for one another, particularly given the identical goods at issue. I reach this conclusion on the basis that the marks share the word 'prickly', which I have found to be the distinctive and dominant element in both marks. I consider that the average consumer, when paying a low to medium degree of attention, is likely to pin their recollection upon this word, leading them to forget whether the mark was accompanied

by the descriptive or highly allusive word 'cards' or 'products'. I also bear in mind that the thorn-like embellishments in the applicant's mark contribute only to a limited extent to its overall impression and merely reinforce the concept already conveyed by the shared word 'prickly'. Consequently, I find that there is a likelihood of direct confusion between the marks.

36. For the sake of completeness, I will also consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

37. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁷

38. In the event that consumers are able to accurately recall the marks, I am of the view that the differences between them are such that the average consumer would believe that they are different marks originating from the same undertaking. In my view, the shared word ‘prickly’ would be viewed as the indicator of brand origin for both marks. The points of difference, being ‘cards’ and ‘products’, would simply be viewed as logical indicators of a brand extension or a sub-brand. Consequently, I find that there exists a likelihood of indirect confusion.

CONCLUSION

39. The opposition under section 5(2)(b) has been successful. Subject to any successful appeal, the application will be refused in respect of the opposed goods, namely:

Class 16: *Greeting cards; Printed cards*

⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

40. The application may proceed to registration for the unopposed goods, namely:

Class 16: Cards; Greetings cards; Gift cards; Collectable cards; Christmas cards; Birthday cards; Flash cards; Invitation cards; Blank cards; Holiday cards; Index cards; Trading cards; Business cards; Correspondence cards; Scoring cards; Picture cards; Note cards; Trivia cards; Anniversary cards; Occasion cards; Menu cards; Paper boxes for storing greeting cards; Motivational cards; Name cards; Post cards; Record cards; Reference cards; Invitations; Party invitations; Pads of party invitations; Printed invitations; Thank you cards; Note pads; Note paper; Memo pad holders; Note papers; Scribble pads; Memo pads; Paper sheets for note taking; Blank note cards; Note books; Pads (Writing -); Pads [stationery]; Drawing pads

Class 28: Bingo cards; Playing cards and card games; Game cards; Card games

COSTS

41. The opponent has been successful and would ordinarily be entitled to an award of costs. However, as the opponent is unrepresented, it was required to file a completed costs pro-forma in order to claim its costs. It did not do so. I note that a blank costs pro-forma was provided to the opponent under cover of a Tribunal letter dated 18 March 2026. This letter stated:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

42. Although no completed costs pro-forma was filed, the opponent incurred the official fee of £200 in filing its notice of opposition. However, as the proceedings ultimately continued under section 5(2)(b) only, I consider it appropriate to award a sum equivalent to the fee that would have been payable had the opposition been brought solely on that basis. Accordingly, I award the opponent the sum of £100.

43. I hereby order Caktus Limited to pay Prickly Cards LTD the sum of £100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 25th day of September 2026

Sarah Adam-Smith

For the Registrar

ANNEX

Class 16

Cards; Greeting cards; Greetings cards; Gift cards; Printed cards; Collectable cards; Christmas cards; Birthday cards; Flash cards; Invitation cards; Blank cards; Holiday cards; Index cards; Trading cards; Business cards; Correspondence cards; Scoring cards; Picture cards; Note cards; Trivia cards; Anniversary cards; Occasion cards; Menu cards; Paper boxes for storing greeting cards; Motivational cards; Name cards; Post cards; Record cards; Reference cards; Invitations; Party invitations; Pads of party invitations; Printed invitations; Thank you cards; Note pads; Note paper; Memo pad holders; Note papers; Scribble pads; Memo pads; Paper sheets for note taking; Blank note cards; Note books; Pads (Writing -); Pads [stationery]; Drawing pads.

Class 28

Bingo cards; Playing cards and card games; Game cards; Card games.