O/1121/25

TRADE MARKS ACT 1994

IN THE MATTER OF
UK REGISTRATION NO. 3408874
IN THE NAME OF
PHOTOGRAM LTD
IN RESPECT OF THE FOLLOWING TRADE MARK:

ALICE CAMERA

IN CLASS 9

AND

AN APPLICATION FOR DECLARATION OF INVALIDITY
THERETO UNDER NO. 505874
BY
ALICE LTD

Background & Pleadings

1. The trade mark ("contested mark") shown on the front page of this decision stands registered in the name of Photogram Ltd ("the registered proprietor"). The mark was applied for on 23 June 2019 in the United Kingdom and completed its registration procedure on 5 July 2019 for the following goods:

   Class 9: Artificial intelligence and machine learning software; Cameras.

2. On 6 March 2023, Alice Ltd ("the applicant") filed an application to have this trade mark declared invalid under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1], which are relevant in invalidation proceedings under Section 47 of the Act.[2] The applicant relies upon its UK trade mark registration for the following mark and all goods and services for which it is registered:

Trade Mark no.	UK00003362772
Trade Mark	ALICE
Goods and Services for which the mark is registered	**Class 9:** Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and

[1] 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.

[2] On 23 November 2023, the cancellation proceedings were suspended pending the outcome of the IPEC counterclaim for invalidity against the earlier mark. Following the conclusion of the IPEC proceedings, on 3 April 2025, the cancellation proceedings proceeded to await a decision.

	instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting. **Class 37:** Repair, maintenance and refurbishment of apparatus for recording, transmission or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments, and sound reproducing apparatus & instruments.
Filing date	21 December 2018
Date of entry in register	22 March 2019

3. In its statement of grounds, the applicant claims that the competing goods are identical, and the marks as a whole are similar sharing the distinctive element “ALICE”, giving rise to a likelihood of confusion.

4. The registered proprietor filed a notice of defence, admitting that the marks share the same word “ALICE” and that its term “*cameras*” is at least similar to the applicant’s goods. However, it denies that the term “*Artificial intelligence and machine learning software*” is similar to the applicant’s specification and that there exists a likelihood of confusion.

Papers Filed and Representation

5. In these proceedings, the registered proprietor is represented by Brandsmiths SL Limited and the applicant is represented by Downing IP Limited.

6. The applicant's evidence consists of a witness statement dated 31 July 2023 from Mr Michael Downing, a Chartered Trade Mark Attorney practising at Downing IP Limited (the representative of the applicant in these proceedings). His evidence is accompanied by five exhibits (Exhibit MD1-MD5), which primarily aim to demonstrate third party undertakings offering goods that appear in both specifications and possibly that it is particularly in regard to AI and machine learning software for use with these goods.

7. No hearing was requested and neither party filed written submissions in lieu, and thus, this decision has been taken following a careful consideration of the papers.

Decision

8. Section 47 of the Act states that:

> "[…]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > […]
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> […]
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
> > (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

9. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

"A trade mark shall not be registered if because-

[…]

(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."

10. Under Section 6(1) of the Act, the applicant's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the earlier mark was completed less than five years before the registration date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

11. The principles considered in this application for invalidity stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

    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 great 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 and Services

12. When making the comparison, all relevant factors relating to the goods or services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

> “23. In assessing the similarity of the goods or services concerned […], all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

13. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(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 are 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 trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

14. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any

ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

15. In *YouView TV Ltd v Total Ltd,* [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words of phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

17. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

18. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

19. The competing goods and services to be compared are shown in the following table:

Contested Goods	**Registered Proprietor's Goods & Services**
Class 9: Artificial intelligence and machine learning software; Cameras.	**Class 9:** Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound

	recording and sound reproducing apparatus and instruments for use in radio and television broadcasting. **Class 37:** Repair, maintenance and refurbishment of apparatus for recording, transmission or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments, and sound reproducing apparatus & instruments.

20. As mentioned earlier in this decision, the registered proprietor admits that the contested "*cameras*" are similar to the applicant's goods. Thus, even for this term where similarity has not been denied, I will need to assess the degree of similarity or identity between the competing specifications. The registered proprietor also argues that *"[i]t is not admitted that the Cancellation Applicant is using the earlier mark for "apparatus for recording ... or reproduction of ... images"."* I note that the earlier mark is not subject to the proof of use requirement, and thus my assessment will be conducted on a notional basis based on the goods and services as registered.

21. On the other hand, the applicant claims that the contested "*cameras*" goods are identical to the earlier "*apparatus for recording ... or reproduction of ... images*". As to the contested term "*Artificial intelligence and machine learning software*", it argues that the contested goods "*include software for use with the goods in the earlier registration. Software for audio and visual apparatus is complementary to, and shares a purpose, relevant public, and provider with, the goods in the earlier registration, making them highly similar*."

22. Further, I note that the applicant's evidence contains various materials, such as printouts from third party websites, which aim to show that third party undertakings offer audio-visual technology goods equipped with AI capabilities, including AI processing units (Exhibit MD2), engines (Exhibit MD3), or hardware devices (Exhibit MD4). In addition, I note that the online article adduced with Exhibit MD1 discusses a research initiative by Bosch Research scientists involving a technology named 'SoundSee', which employs audio AI signal processing and machine learning to interpret environmental and machine sounds. This technology was launched to the International Space Station in 2019 as part of a research mission. This merely indicates that the technology was still in development and was primarily a research tool. Nevertheless, I highlight that some exhibits are dated after the relevant date[3] and some are undated[4]. Consequently, the applicant's evidence is not persuasive, and my analysis will be conducted on a notional basis based on the respective specifications before me.

Cameras

23. The earlier "*Apparatus for recording, […] or reproduction of […] or images*" is a broad term that would readily include the contested term "*cameras*". Therefore, I find the competing terms to be identical as per *Meric*.

Artificial intelligence and machine learning software

24. The contested software is broadly used for data analysis, inference and automation, exhibiting intelligent or 'thinking' behaviour. I consider that the closest comparable term from the applicant's specification is "*Apparatus for recording, transmission or reproduction of sound or images*". The earlier term is very broad, and to my mind the goods would include physical goods for recording, transmission or reproduction of sound or images,

[3] Exhibits MD1, MD4, and MD3 appear to be dated with copyright dates of 2023 and 2021, respectively.

[4] Exhibits MD2 and MD5.

such as cameras, microphones, headphones, recording devices and screens for reproducing audio-visual content. In this regard, and based on the core meaning of the competing terms, I consider that they will differ in their nature (hardware vs software) and purpose. The contested goods fulfil computational analysis and automation, whereas the earlier goods are used to capture, render, or reproduce sounds or images. I also bear in mind the perspective of the average consumer at the relevant date in June 2019 and their awareness of the relationship between these goods. Although the contested goods may be used together with the earlier goods in certain contexts, it is not considered important or indispensable for the use or function of one another, and I do not find that the average consumer would assume the goods are provided by the same undertaking. Thus, I do not consider that there is a degree of complementarity between the competing goods. The method of use and trade channels will differ too. Even though there might be an overlap in users, for example, members of the general public (or professionals), I do not consider this factor sufficient by itself to find similarity. I find that the competing terms are dissimilar.

25. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's specification.[5] **The invalidation action cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following goods:**

Class 9: Artificial intelligence and machine learning software.

Average Consumer and the Purchasing Act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average

[5] Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

27. The average consumer of the Class 9 goods will comprise both members of the general public and professionals/business users. The goods are usually offered for sale in online stores, brochures, and catalogues and in high street retail stores. The goods will be the subject of self-selection from catalogues, websites, stores or specialist outlets or their online equivalents where consumers will select the goods relying on the images displayed on the relevant webpages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative when a purchase is made in a high street store, for example. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the goods to ensure that the goods possess the required features. In this regard, the average consumer is likely to pay a medium degree of attention when selecting the goods at issue.

Comparison of Trade Marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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 relative 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."

29. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the 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.

30. The marks to be compared are:

Earlier Mark	Contested Mark
ALICE	ALICE CAMERA

31. I note that the applicant, in its correspondence dated 13 March 2025, drew my attention to paragraph 91 of the IPEC's judgement that deals with the similarity of the competing marks. While I have considered Her Honour Judge Melissa Clarke's ruling on the matter, I will proceed in my

assessment below based on the respective marks and the goods the parties rely on in these proceedings.

Overall Impression

32. The earlier mark is the word “ALICE”. Registration of a word mark protects the word itself.[6]

33. The contested mark consists of the words “ALICE CAMERA”. It is my view that the words do not form a unit. This is because the average consumer will be unable to clearly extract a unified concept from the mark as a whole. I also consider that the second word “CAMERA” will be seen as being descriptive of the respective goods in the contested specification. Therefore, the word element “ALICE” will dominate the overall impression, and the word “CAMERA”, whilst not negligible, will play a lesser role.

Visual comparison

34. Visually, the earlier mark “ALICE” is a single word as opposed to the contested mark, “ALICE CAMERA”, which is two. I bear in mind that the beginnings of marks tend to have more impact than the ends.[7] The marks in this instance share the common word element “ALICE” appearing at the beginning. Nevertheless, they differ in the presence/absence of the descriptive word “CAMERA”. Considering all the factors, including the overall impression, I find that the degree of visual similarity is medium to high.

Aural comparison

35. Aurally, the competing marks will be pronounced entirely conventionally. The competing marks will aurally share the same first word element, “AL-

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[6] *LA Superquimica v EUIPO*, T-24/17, para 39. See also *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[7] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

ICE”, while differing in the articulation of the second word element “CA-ME-RA” in the contested mark, which has no counterpart in the earlier mark. Considering all the factors, including the overall impression, I find that the degree of aural similarity is medium to high.

Conceptual comparison

36. Although the competing marks share the concept of the forename ‘Alice’, the registered proprietor’s mark also gives rise to the concept of ‘camera’, which will be understood in the ordinary way as the equipment for taking photographs. Therefore, it follows that the average consumer will likely treat the word “CAMERA” in the contested mark as descriptive of the respective goods in Class 9 offered by the registered proprietor. For completeness, as mentioned above, I do not consider that the average consumer will conceptualise the contested mark as a whole conveying a new meaning. Taking into account all of the above and given that I have found ALICE to be either the sole or dominant element in the parties’ respective marks, I find that the competing marks are conceptually similar to a high degree.

Distinctive Character of the Earlier Trade Mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> “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).

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)."

38. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

39. Although the applicant has filed evidence, this does not pertain to the use of its mark and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The word "ALICE" is a commonplace forename having no suggestive or descriptive relevance to the registered goods and services. I find the mark to be inherently distinctive to no more than a medium degree.

Likelihood of Confusion

40. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[8] It is essential to keep in mind the distinctive character of the applicant's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[9]

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

42. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, 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 recognized 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."

[8] See *Canon Kabushiki Kaisha*, paragraph 17.
[9] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[10]

43. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is

[10] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

44. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of

a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

45. Earlier in this decision I have concluded that:

- the goods at issue are identical;
- the average consumer will be members of the general public and businesses/professionals. The selection process is predominantly visual without discounting aural considerations. The average consumer will likely demonstrate a medium level of attention during the purchasing process;
- the earlier mark and the contested mark are visually and aurally similar to between a medium and high degree, and conceptually to a high degree;
- the earlier mark is inherently distinctive to no more than a medium degree.

46. Taking the above factors into account, I am persuaded that there is a likelihood of direct confusion for identical goods. Notwithstanding the presence of the divergent word “CAMERA”, this will not be sufficient to avoid a likelihood of direct confusion between the competing marks. As delineated above, it is my view that the words “ALICE CAMERA” in the contested mark do not form a unit, with the word “ALICE” having an independent distinctive role in the mark. Thus, when encountering the

contested mark, the average consumer will consider that the word "CAMERA" will be descriptive of the goods, and I am of the view that its addition to the contested mark (or vice versa) is not capable of preventing the marks from being misremembered or mistakenly recalled as one another. This is because when the average consumer attempts to recall the marks, they will likely attribute trade mark significance to the commonly shared word element "ALICE", being the dominant and distinctive element of both marks. On this point, I remind myself that case law sets out that consumers tend to focus on the beginnings of marks, which is where the common element ("ALICE") of these marks lies, creating a semantic bridge between them. Considering all these factors, along with the similarity of the marks and the principle of imperfect recollection, I find that there exists a likelihood of direct confusion between the contested mark and the earlier mark.

47. For the sake of completeness, I will proceed to consider whether there exists a likelihood of indirect confusion. In particular, were the average consumer to recognise the differences between the marks, they will identify the common word element "ALICE" shared in the respective marks treating it as an indication that the marks originate from the same or economically linked undertakings. The use of the descriptive word "CAMERA" at the end of the contested mark, will merely be perceived as a non-distinctive element, of the kind which one would expect to find in a sub-brand or brand extension. Consequently, I find there to be a likelihood of indirect confusion between the marks.

Outcome

48. Part of the application for invalidation has been successful. **The registered trade mark is declared invalid, subject to any successful appeal against this decision, with effect from 23 June 2019 for the following goods**:

Class 9: Cameras.

49. Part of the application for invalidation has been unsuccessful. **The registered trade mark will remain registered, subject to any successful appeal against this decision, for the following goods:**

Class 9: Artificial intelligence and machine learning software.

Costs

50. The parties have each achieved an equal measure of success. Thus, I order that they should bear their own costs.

Dated this 27th day of November 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General