

O/1174/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003791549
IN THE NAME OF SONS WITH ARTHRITIS PRIVATE LIMITED
FOR THE FOLLOWING TRADE MARK:**



IN CLASS 25

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 438299
BY ACE CAFE LONDON LIMITED**

Background and pleadings

1. On 24 May 2022, SONS WITH ARTHRITIS PRIVATE LIMITED (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK, under number UK00003791549 (“the contested mark”). The application was published for opposition purposes on 23 September 2022. Registration is sought for the following goods:

Class 25: Motorists' clothing; Clothes; Hoods [clothing]; Leisure clothing; Sports clothing; Gym suits; Clothing for men, women and children; Clothing.

2. On 23 December 2022, the application was opposed by Ace Cafe London Limited (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods of the application.

3. The opponent relies upon the following marks:

ACE CAFE

UK trade mark number: UK00901232008¹

Filing date: 2 July 1999

Registration date: 22 September 2000

(“the opponent’s first mark”)

The opponent’s first mark is registered for goods and services in classes 16, 18, 25, 26 and 41, however, for the purposes of this opposition the opponent relies upon the following goods only:

Class 25: Articles of clothing; articles of clothing made from leather; T-shirts; shirts; sweatshirts; jackets; leather jackets; hats and caps; scarves; motorcyclists' seaboot hose; belts; leather belts.

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number **1232008** being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law and the original EUTM filing date remains.



UK trade mark number: UK00900378885²

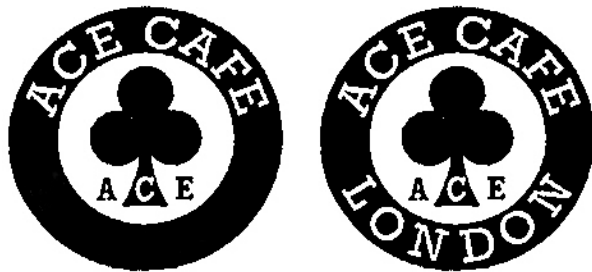
Filing date: 19 September 1996

Registration date: 9 November 1999

("the opponent's second mark")

The opponent's second mark is registered for goods and services in classes 16, 25, 26 and 41, however, for the purposes of this opposition the opponent relies upon the following goods only:

Class 25: Articles of clothing; t-shirts; shirts; sweatshirts; jackets; hats and caps; scarves; belts.



UK trade mark number: UK0002000931B

Filing date: 9 November 1994

Registration date: 27 February 1998

("the opponent's third mark")³

The opponent's third mark is registered for goods and services in classes 16, 25, 26 and 41, however, for the purposes of this opposition the opponent relies upon the following goods only:

² The same applies as set out in the above footnote. Original EUTM no: 378885

³ The Opponent's third earlier mark is a series of two marks.

Class 25: Articles of clothing; T-shirts; sweatshirts; jackets; hats and caps; scarves; belts

4. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. As they have been registered for five years or more at the filing date of the contested mark, they are subject to the proof of use requirements specified within section 6A of the Act. However, the applicant has not requested that the opponent prove use of its marks. Therefore, the opponent can rely on all of the goods identified under each of its marks.
5. The opponent argues that the competing trade marks are similar as they share the words "ACE", and that the competing goods are either identical or similar. It is these factors that the opponent contends give rise to a likelihood of confusion.
6. The applicant filed a counterstatement denying the ground of opposition.
7. The opponent is professionally represented by Dehns; the applicant represents itself. Neither party filed evidence, nor did the parties asked to be heard on the matter, however, both parties chose to file written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-assimilated national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are assimilated from EU Law and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

DECISION

Legislation

9. Sections 5(2)(b) of the Act read as follows:

“5(2) 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”.

Case law

10. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 goods

11. The goods to be compared are those outlined in paragraphs 1 and 3 of this decision.

12. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.⁴

13. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,⁵ the General Court held that goods or services can be considered as identical when the goods or services designated by an earlier mark are included in a more general category, designated by the trade mark application and vice versa.

14. The applicant states within its Form TM8 that the opponent is using its trademark for a different category of clothing to the applicant. The applicant claims that the opponent is using its trade mark for bikewear and music clothing whilst the applicant is using its trade mark for clothing and gym items. However, as discussed above at paragraph 4, the applicant has not requested that the opponent provide proof of use of its marks, therefore the opponent can rely on all of the terms as listed within its specification regardless of whether the mark is used on the goods

⁴ See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

⁵ Case T-133/05, paragraph 29

within the marketplace in practice. Moreover, this argument fails to further the applicant's position as the applicant accepts that it uses its mark on clothing and the opponent uses its mark on bikewear and music clothing which are types of clothing.

15. I note that all three earlier marks rely on the broad term "*Articles of clothing*". This wide term encompasses all of the applicant's class 25 terms "*Motorists' clothing; Clothes; Hoods [clothing]; Leisure clothing; Sports clothing; Gym suits; Clothing for men, women and children; Clothing*", consequently, I find that the goods are Meric identical.

The average consumer and the nature of the purchasing act

16. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."⁶ 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 in question.⁷

17. Due to the nature of the goods at issue, I find that the average consumer would be a member of the general public.

18. The cost of the purchase is likely to vary, depending on the item of clothing, but, overall, they will be relatively inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that the purchasing process is likely to be fairly casual, however, consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods. The goods are likely to be obtained by

⁶ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

⁷ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

self-selection from the shelves of a retail outlet, online or through a catalogue equivalent. Overall, I am of the view that visual considerations would dominate the purchasing process.⁸ However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales assistants.

My Approach

19. I have considered the similarity between the applicant's mark and the opponent's marks, and in my view, the opponent's best case lies with its reliance upon its first and second marks. This is because the opponent's third mark is a series of marks, one that is identical to the second mark and another with the addition of the word "LONDON" which merely indicates the geographical origin of the goods and is not distinctive. Therefore, if I find a likelihood of confusion with the first or second marks, the issue in respect to the third mark is not relevant but, conversely, if there is no likelihood of confusion, it follows that there is unlikely to be a likelihood of confusion for the third mark. In reaching this conclusion, I have kept in mind that the earlier term of the opponent's specification, "*Articles of clothing*", that I have found identity with the applicant's specification appears in all three of the opponent's marks relied upon. Consequently, for these reasons, I will focus on the first and second marks.

Distinctive character of the opponent's mark

20. The distinctive character of a trade mark can be measured only, first, by reference to the goods 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

⁸ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

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).”

21. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion: the more distinctive the earlier mark, the greater the likelihood of confusion.

22. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

23. The opponent submits the following in relation to the distinctiveness of its earlier marks.

“It is submitted that the inherent distinctiveness of the Earlier Trade Marks, especially the figurative trade marks, is high. The elements that constitute the Earlier Trade Marks

are not descriptive of, or allusive to, the Class 25 goods at issue. Per Canon, it is submitted that the Earlier Mark should, therefore, be entitled to a broader scope of protection than a mark with a low or normal degree of distinctive character.”

The opponent's first mark

24. The opponent's first mark is a word only mark that encompasses the words "ACE CAFE" in upper case. Together, the words will be understood as either referring to an excellent café or a café named after a playing card. Regardless of how the word "ACE" is perceived, the words "ACE CAFE" are not allusive of the clothing goods relied upon. Consequently, contrary to the opponent's submissions, I find that the words possess a medium degree of inherent distinctive character.

The opponent's second mark

25. As for the opponent's second mark it is a figurative mark, with a thick bold black roundel and a black club at its centre. Included in the thick bold black outer circle are the words "ACE CAFE" in white. The word "ACE" is also repeated in smaller writing at the base of the club. Neither the words, nor the figurative roundel device are allusive of clothing goods relied upon. Instead, the words will most likely convey the impression of a physical premise, i.e. a café, named after an ace playing card, given the presence of the suit of clubs playing card device. Overall, I find that the opponent's second mark enjoys an above medium degree of inherent distinctive character.

Comparison of the marks


26. It is clear from *Sabel BV v. Puma AG*,⁹ 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

⁹ Case C-251/95, paragraph 23

“34. [...] 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.”

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

28. The respective trade marks are shown below:

Applicant's mark	Opponent's marks
	<p data-bbox="916 1149 1289 1211">ACE CAFE</p> 

Overall impressions

29. The opponent's marks are described above at paragraphs 21 and 22. As a word only mark that is not descriptive or allusive of the goods, the overall impression of the opponent's first mark rests in the words themselves in equal measure as

they combine to form a unit. As for the opponent's second mark the overall impression lies in the words and the roundel device with the club at its center in roughly equal measure. With the repeated word "ACE" found at the base of the club playing a slightly lesser role.

30. The contested mark is a figurative mark presented on a grey rectangle with three devices positioned in a line diagonally from top left-hand corner to bottom right-hand corner. Each device contains a spade surrounded by a thin circular line. Within each spade is the word "ACE" also in grey. Each device is presented in a different colour being either white, black or yellow. The overall impression lies in the devices and the words in roughly equal measure with the grey rectangular background playing a smaller role.

Visual comparison

The opponent's first mark and the contested mark

31. Both marks contain the word "ACE". The contested mark is a figurative mark whilst the opponent's first mark is a word only mark. The opponent's first mark contains the additional word "CAFE" which is not replicated within the contested mark. Furthermore, the applied for mark is presented on a grey rectangle with three devices as discussed above, positioned in a diagonal line from the top left-hand corner to the bottom right-hand corner, none of which is present in the opponent's first mark. Overall, the marks are similar to a low degree.

The opponent's second earlier mark and the contested mark

32. The competing marks are similar to the extent that both include the word "ACE" and a device of a playing card symbol surrounded in a circle, albeit with some presentational differences. In the applicant's mark the playing card symbol is a spade, with the word "ACE" in the middle of the spade, surrounded by a thin circular line. This device is repeated three times on a grey rectangular background in a diagonal pattern from top left to bottom right corner, each appearing in a different colour, white, black or yellow. In the opponent's mark, the playing card symbol is a club with the word "ACE" positioned across the base of the club. This

is encircled in a roundel with a thick black border displaying the words “ACE CAFE” in white font at the top. I note that the word “CAFE” is absent from the contested mark. Furthermore, the overall shape of the competing marks as well as the colours used differ. Taking into account the total impressions, I find that the competing marks are visually similar to below a medium degree.

Aural comparison

The opponent’s first earlier mark and the contested mark

33. The opponent’s first mark is a word only mark that comprises of three syllables ACE/KA/FAY. As for the contested mark, although it contains the word “ACE” repeated three times, consumers will often try to find the quickest verbal path when interpreting a mark, therefore, rather than pronouncing the word “ACE” repeatedly, consumers are likely to only verbalise it once. Consequently, it contains a single syllable “ACE”. Whilst the marks coincide in one syllable, found at the beginning of the mark, they also differ in the additional syllables contained within the opponent’s mark. As a result, the marks are aurally similar to a medium degree.

The opponent’s second earlier mark and the contested mark

34. As discussed above, I find it unlikely that consumers would express the word “ACE” within the contested mark more than once, I consider it equally unlikely that consumers would pronounce the second “ACE” at the base of the club within the opponent’s second mark. Neither will the playing suits be articulated. As such, it follows that the opponent’s second earlier mark comprises of three syllables ACE/KA/FAY, consequently, these marks share the same level of aural similarity as the opponent’s word mark.

Conceptual comparison

The opponent’s first earlier mark and the contested mark

35. The word “ACE” within the applicant’s mark will be understood in context of the mark as a whole as referring to the ace of spades playing card. As for the

opponent's mark, the word "ACE" when viewed in combination with the word "CAFÉ" creates a unitary meaning that will be understood as either describing an excellent café, or a café named after an ace playing card. Where consumers view the word "ACE" as referring to an excellent café, the marks will convey different messages and, will therefore, be conceptually dissimilar. However, where consumers understand the word "ACE" to convey an ace playing card there will be some limited overlap in this shared concept. Nevertheless, the difference created by the opponent's unitary meaning as a café premises named after a suit of playing cards acts as a point of conceptual difference. Overall, for those consumers that identify the word "ACE" to refer to an ace playing card, there will be a low level of conceptual similarity.

The opponent's second earlier mark and the contested mark

36. As for the opponent's second mark, the words "ACE CAFÉ" will be understood in combination with the suit of clubs playing card device as a café named after an ace playing card only. As discussed above, the word and device within the applicant's mark will convey the impression of the ace of spades playing card. Whilst both marks convey an ace playing card, the words and device used within the opponent's second mark creates the overall impression of a café named after it which is absent from the applicant's mark. Such a meaning leads me to find that the opponent's mark forms a unitary phrase. Consequently, whilst there is some limited overlap in the meaning of the word "ACE" the presence of the unitary meaning in the opponent's second mark (as found with the opponent's first mark) results in a conceptual point of difference. Overall, I find that the marks are conceptually similar to a low degree.

Likelihood of confusion

37. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. 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. It is also necessary for me to keep in mind the distinctive character of the opponent's

trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware 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.

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

39. In relation to 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 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.

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).”

40. 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 in *Liverpool Gin*.¹⁰ 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.¹¹

41. Furthermore, in *Liverpool Gin*, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.¹²

The opponent’s first mark and the contested mark

42. I have found identity for the goods at issue. The average consumer of the goods will be the general public, who will pay a medium level of attention during the

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

¹¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹² *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 13

purchasing process. I have found that the purchasing process will be largely visual given the nature of the goods, however, I have not discounted aural considerations. I have found that the competing marks are visually similar to a low degree, aurally similar to a medium degree, and where consumers identify the word “ACE” to refer to a playing card, conceptually similar to a low degree. I have also found that the opponent’s first mark possesses a medium level of inherent distinctive character overall.

43. The identity of the goods is clearly a factor in favour of the opponent. With regards to the use of the shared word “ACE” found within both the respective marks, in my view, irrespective of how the word “ACE” is understood within the opponent’s mark, the presence of the additional word “CAFE” has the effect of combining to form a unitary meaning with the word “ACE”. In combination the words “ACE CAFE” in the opponent’s mark will be seen as referring to a physical cafe premises. This unitary meaning has the effect of creating enough conceptual difference to render the marks distinguishable from one another.¹³ Further, although the marks overlap in the shared word “ACE”, the marks differ both visually and aurally in length as the opponent’s mark contains the additional word “CAFE”. Moreover, the figurative mark contains a device that creates an added visual difference. It is my view, that these visual and aural differences are unlikely to be overlooked. Taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers paying a medium level of attention, to avoid mistaking the marks for one another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

44. As for indirect confusion. Whilst consumers will recognise the differences between the marks, they will also identify the use of the common word “ACE”. However, as discussed above, I find that the overall unitary meaning resulting from the addition of the word “CAFE” within the opponent’s first mark creates enough of a conceptual difference that the applicant’s mark will not be seen as a logical brand extension or sub-brand. As such, I do not believe that consumers will assume that the competing marks are economically linked. Instead, the commonality of the word

¹³ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch),

“ACE” will be perceived as a coincidence. Consequently, I do not consider there to be a likelihood of indirect confusion.

The opponent’s second mark and the contested mark

45. Although the identity of the goods, the level of attention paid to those goods and the nature of the purchasing act will be the same as the opponent’s first mark. In contrast to the first earlier mark, I have found that the competing marks are visually similar to below a medium degree, aurally similar to a medium degree and conceptually similar to a low degree. I have also found that the opponent’s second mark possesses an above medium level of inherent distinctive character overall.

46. The identity of the goods is clearly a factor in favour of the opponent. With regards to the use of the shared word “ACE” found within the respective marks, in my view, the same principle will apply here as I have found for the opponent’s first mark. That is the presence of the additional word “CAFE” within the opponent’s mark, has the effect of combining to form a unitary meaning with the word “ACE”, which will be perceived as a physical cafe premises named after the ace playing card, whereas, in contrast, the applicant’s mark will be identified as conveying an ace playing card. This provides enough conceptual difference to render the marks distinguishable from one another. Further, whilst I accept that the marks overlap in the shared word “ACE” and the presence of a circular device with a playing card suit device in the middle, the overall shape and colours of the competing marks differ. The applied for mark is presented in grey, white, black and yellow and encompasses a rectangular shape with three circular devices contained within it, whilst the opponent’s second mark appears in a roundel in black and white only. In my view, any similarities arising from shared or highly similar elements are outweighed by the differences. Taking all the above factors into account, consumers paying a medium level of attention, are likely to avoid mistaking the marks for one another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

47. As for indirect confusion, as explained above, consumers will recognise the shared word “ACE” and the commonality in the playing card suit device within a circular shape. However, the words “ACE CAFÉ”, within the opponent’s second mark forms a unit which creates enough of a difference in the conceptual impression that it has the effect of distinguishing the marks from one another. Together, this conceptual impression, along with the visual and aural differences, do not give rise to a logical brand extension or sub brand in my view. Primarily, I am unconvinced that an “ACE” branded clothing company would add the word “CAFÉ” as it would change the overall conceptual message of the mark. Further, it is illogical that a commercial undertaking would also go on to change the colour and overall shape of the mark, i.e. the ‘get up’ of the mark. Collectively, there is too much alteration between the marks for there to be a logical brand extension. Instead, the commonality of the word “ACE” and the use of the playing card suit, even in combination, will be perceived as a coincidence, particularly as an ace is a type of playing card. Equally the use of a circle within the respective marks is not so strikingly distinctive that the consumer will believe that only one undertaking would be using this element. Consequently, I do not consider there to be a likelihood of indirect confusion, even for goods which are identical.

Conclusion

48. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal, the application will proceed to registration in the UK.

Costs

49. As the applicant has been successful, ordinarily it would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 2 February 2022 that, if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, further I note within the applicant’s written submissions that the applicant clarifies

it has no intention of claiming any costs as it does not believe this to be moral or ethical. Therefore, I make no award of costs.

Dated this 12th day of December 2024

**Sarah Wallace
For the Registrar**