

O/799/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3513610
IN THE NAME ACE PIZZERIA LIMITED FOR THE TRADE MARKS**



IN CLASS 43

AND

**OPPOSITION THERETO UNDER NO. 422194
BY ACE CAFE LONDON LIMITED**

Background and pleadings



1. Ace Pizzeria Limited (“the applicant”) applied to register the trade marks



and **ACE PIZZA** (series of two) under application no. 3513610 in the UK on 20 July 2020. The marks were accepted and published in the Trade Marks Journal on 21 August 2020 in respect of the following services:

Class 43: Restaurant services; cafe services; snack bar services; bar services; take away food and drink services; preparation and provision of food and drink; preparation of meals or foodstuffs for consumption off the premises; catering services; restaurant reservation services; information, advisory and consultancy services all relating to the aforesaid services.

2. Ace Cafe London Limited (“the opponent”) opposes the trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opposition is on the basis of its two trade mark registrations outlined in the table below:

Trade mark / Territory	Registration no.	Filing date/ Registration date	Services relied upon
ACE CAFE / EU ²	17776576	06/02/2018 / 21/05/2018	<i>Class 43: Providing food and beverages; services for providing food and drink; catering services; restaurants; cafes; coffee</i>

¹ The opposition filed was initially based on a further ground, namely section 5(4)(a) of the Act. Within its final written submissions, the opponent opted to withdraw the opposition on this ground and so it will not be considered.

² Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

("the earlier word mark").			<i>shops; coffee shop services; tea rooms; tea room services; bar services.</i>
 / EU ("the earlier logo mark")	15812332	07/09/2016 / 23/12/2016	<i>Class 43: Providing food and beverages; catering services; restaurants; cafes; bar services.</i>

3. By virtue of their earlier filing dates, the marks relied upon constitute earlier marks under section 6 of the Act.
4. The opponent argues that the respective services are identical or similar and that the marks are similar, and that they coincide in visually, aurally and conceptually in respect of their most distinctive elements. The opponent argues that the figurative 'A' serves as the first letter of ACE to reinforce the importance of the word. The opponent also stated the businesses are located next each other, which it submits increases the risk of a likelihood of confusion.³
5. The applicant filed a counterstatement denying the claims made. The applicant submitted that the word ACE is laudatory, and is descriptive of something being of outstanding quality, and that the marks are not sufficiently similar to give rise to a likelihood of confusion.
6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.

³ Prior to filing its TM8 and counterstatement, the applicant confirmed that its recorded address at the same postcode as the opponent was the result of a clerical error at the stage of filing the application. The correction was made and the address was amended to an alternative location in London.

7. On 7 September 2021, the applicant contacted the Tribunal to confirm that it had applied to cancel one of the earlier EU registrations relied on by the opponent within these proceedings, namely the earlier word mark. The applicant asked if it should still meet the deadline to file its written submissions in this case, which fell that day. The applicant was informed by the Tribunal that it should meet its deadline, and provide the information relating to the cancellation action within its written submissions. The applicant was told it may request that proceedings be suspended pending the outcome of the European Union Intellectual Property Office (“EU IPO”) proceedings, but that the decision on this would be at the discretion of the Hearing Officer.

8. Within its final written submissions, the applicant requested as follows:

“After attempts on the part of the Applicant to settle this matter amicably have failed, on 6 September 2021, the Applicant applied to invalidate EU registration No. 017776576 ACE CAFE with the EUIPO in the light of the non-distinctive and descriptive character of that mark.

Should the EUIPO’s decision in that case be relevant to the outcome of these proceedings, we ask that the UKIPO delays providing a final decision with an appeal deadline in relation to this dispute, until the outcome of the invalidation proceedings is known.”

9. Considering the present opposition relies on a second mark that is not the subject of an invalidation application, and considering the late stage of these proceedings at which the challenge to the earlier word mark has been filed, it is my view that it would not be appropriate to suspend proceedings at this stage. However, should the opponent’s earlier word mark relied upon be decisive, I accept the applicant’s request above and this decision will be provisional only, pending the outcome of the EU proceedings. Should it be appropriate to issue a provisional decision only at this stage, the appeal deadline will be delayed until the final decision is issued.

10. Both sides filed written submissions in these proceedings, which will be referred to as and where appropriate during this decision. No hearing was requested

and so this decision is taken following a careful perusal of the papers. The applicant is represented by Wilson Gunn and the opponent is represented by Dehns.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived 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 derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

The opponent's evidence

12. The opponent filed its evidence in the form of a witness statement in the name of Wayne Phillip Huff, described as the Chairman of the Board of Directors of the opponent. The statement confirms that Mr Huff has held a position as a Director of the opponent since 1 September 2000. The statement introduces 12 exhibits, namely Exhibit CAW1 to Exhibit CAW12.

13. Mr Huff explains that the Ace Cafe, known then as 'the Ace' was set up in 1938 on the North Circular Road, a location popular for travellers and truckers. The cafe was closed after two years, having been damaged in the war, and reopened between 1949 – 1969.⁴

14. Mr Huff explains that an event to mark 25 years of closure of the café was held in 1994, and the demand from the motorcyclist community shown at this event led the opponent to purchase the site and fully reopen the Ace Cafe in 2001. Since that time, the opponent has opened Ace Cafe establishments around the world.⁵ Exhibit CAW1 comprises a print-out of the history page from the opponent's website setting out the history of the Ace Cafe. The screenshot itself is dated 22 April 2021 and provides details of the grand opening of the Ace Cafe in 2001. An image of the cafe itself is shown as below:

⁴ See paragraph 5

⁵ See paragraph 5



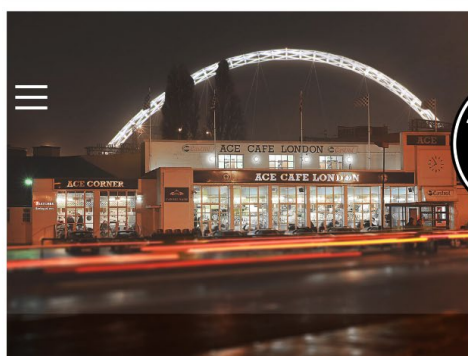
The Grand Re-Opening

Today we´ve made it – and the Ace Cafe is alive and kicking.
No – it´s not 1964, welcome back Ace Cafe!

2001

The Ace is back!

15. A further image of the Ace Cafe in London from 2013 is shown on the page as below:



The 75th Anniversary



2013

Ace 75th Anniversary



16. Within his witness statement, Mr Huff submits that the Ace Cafe is “... one of the world’s most famous motor cafes”.⁶ Exhibit CAW2 provides screenshots of a page from Wikipedia detailing the ‘rocker’ subculture, describing ‘rockers’ as members of a biker subculture. The screenshots are dated 22 April 2021. In his witness statement, Mr Huff directs me to the passages which refer to the Ace Cafe as the “famous transport cafe”, and the reference to its events now attracting “up to 40,000 motorists”. A further Wikipedia page is also provided at this exhibit, again dated 22 April 2021 and providing details about ‘biker bars’.

⁶ See paragraph 6

In his witness statement, Mr Huff directs me to the fact that the Ace Cafe is the first UK venue on the list of examples of biker bars on the page.

17. Also under Exhibit CAW2 is an extract from a book named 'ACE TIMES Speed thrills and tea spills, a cafe and a culture' by Mick Duckworth, who is described by Mr Huff and confirmed in the exhibit as a motorcycling journalist.⁷ The book provides further information on the Ace Cafe, stating it "rapidly became a Mecca for motorcyclists" and referring to the cafe winning "numerous awards and accolades" since reopening. The back cover of the book describes the Ace Cafe as "...the roadside pull-in that became the most famous haunt of motorcycle-riding 'Ton-up kids' in the Fifties and Rockers in the Sixties. The price of the book is given on the back in GBP. Mr Huff states it was published in 2011 and is available on Amazon UK.⁸

18. Exhibit CAW3 comprises a certificate presented to the opponent in appreciation of its café services and in recognition of services to the community. Mr Huff states it was presented by the Mayor and Lady Mayoress of Brent as well as the Brent Central MP.⁹ The certificate shows the dates 2016 – 2017. Mr Huff states that Ace Cafe is also a tourist attraction, bringing people into the borough from around the UK and further afield.¹⁰

19. Mr Huff states in his witness statement that on 8 September 2019, the opponent was awarded the Red Wheel by the National Transport Trust. Mr Huff explains scheme was created to recognise the most significant sites of historical importance to transport heritage in the UK.¹¹ An article that Mr Huff confirms is from the Brent and Kilburn times and is dated 20 September 2019,¹² which details the award given, is provided at Exhibit CAW4. The article describes the Ace Cafe as an 'iconic' bikers café and shows the image of the award in the café as below:

⁷ See paragraph 6

⁸ See paragraph 6

⁹ See paragraph 7

¹⁰ See paragraph 7

¹¹ See paragraph 8

¹² See paragraph 8



20. Turnover figures are provided by Mr Huff as below:

The following is generalised sales information for the last five years relating to my Company's food and drink services in the UK provided under the Earlier Trade Marks:

Year	Turnover ("Not less than...")
2020	£850,000
2019	£1,500,000
2018	£1,500,000
2017	£1,500,000
2016	£1,500,000
	TOTAL: Not less than £6,850,000

21. Exhibit CAW5 provides an image of the opponent's menu headed as shown:

ACE CAFE LONDON
1938 - 1969
REOPENED 2001

WORLD FAMOUS HOME OF
TEDS, TON-UP BOYS (AND GIRLS)
AND THE



22. In addition, this exhibit shows an image of the outside of the premises that Mr Huff explains is from the opponent's twitter profile on 20 September 2020,¹³ as well as a screenshot of the company website showing the earlier logo mark. The image of the premises shows it to be largely unchanged since the 2001 and 2013 images provided.
23. Exhibit CAW6 shows the ACE CAFE yearbook, displaying both the earlier logo mark and the wording ACE CAFE on the front page. Mr Huff confirms this was put into circulation in 2016 by "the UK's biggest selling magazine publisher".¹⁴ Mr Huff refers me to the section stating that ACE CAFE serves between 200 – 600 meals a day. No distribution figures are provided for the yearbook.
24. An article discussing the Ace Cafe and naming it as a historic London breakfast location is provided at Exhibit CAW7. The screenshot of the article is dated 22 April 2021, but the article itself states it was 'last updated 06 August 2019'. The article refers to 'Ace Cafe' as 'London's oldest and most famous motoring café, opened in 1938'.
25. A page from the opponent's website dated 13 January 2019 and displaying the earlier logo mark is provided at Exhibit CAW8, as well as a still image from YouTube described by Mr Huff as a still from a promotional video from 2017.¹⁵ The webpage details how to win tickets for the MCN Motorcycle show in London. Mr Huff explains that the opponent has had "involvement" in events such as the Carole Nash MCN London Motorcycle show 2018, 2019 and 2020 and Silverstone in in 2018 and 2019. Mr Huff states Silverstone attracts over 109,000 people a year, and the London Motorcycle show over 40,000 a year.¹⁶
26. Figures for promotional spend it provided by Mr Huff as below:

¹³ See paragraph 9

¹⁴ See paragraph 10

¹⁵ See paragraph 12

¹⁶ See paragraph 12

Year	Expenditure (“Not less than...”)
2020	£5,000
2019	£18,000
2018	£9,500
2017	£7,500
2016	£15,000
	TOTAL: Not less than £55,000

27. Exhibit CAW9 comprises a page from the opponent’s website listing events taking place at the Ace Cafe. The page is dated as ‘posted’ on 9 May 2019, and it shows the earlier logo mark.

28. Mr Huff explains his company also holds various events, such as an annual reunion ride from London to Brighton which has taken place every year since 1994.¹⁷ Further information about this, including reference to 40,000 participants of the event are provided at Exhibit CAW10. Exhibit CAW11 provides details of a partnership with a solicitor’s firm. The article is from the website of the firm and is dated 27 September 2018. It describes the Ace Cafe as ‘iconic’ and a ‘famous landmark’ and shows an image of the café below:



29. Details of Ace Cafe’s TV appearances are provided at Exhibit CAW12. Two screenshots from YouTube showing clips dated 18 April 2007 and 20 February 2017 have been provided, described as being from the BBC show ‘Top Gear’. A post from the opponent’s website describing its appearance on The Motorbike

¹⁷ See paragraph 14

Show on ITV4 'this Thursday' is provided, with the post itself dated 4 June 2019. Mr Huff also states the cafe was the set of the cult film 'The Leather Boys', and an episode of Car SOS on BBC, in addition to being featured on National Geographic.¹⁸

The applicant's evidence

30. The applicant has filed its evidence in the form of a witness statement in the name of Rachel Jones, described as the director for the applicant. Ms Jones describes the applicant's business as a sit down and takeaway pizza service that was set up at the end of June 2020.¹⁹
31. The witness statement provides the dictionary definitions of 'Ace'. This includes 11 definitions in total, including a die, domino or any four playing cards with one spot, or a single spot on the same, a winning serve in tennis, a hole in one in golf, and the informal meaning of superb or excellent, amongst others.
32. At the time that the witness statement was written, Ms Jones explains they have had 5,241 orders,²⁰ and states that they have not had any instances of confusion.²¹ The statement is dated 12 July 2021.
33. With her witness statement, Ms Jones introduces 9 exhibits, namely Exhibit RJ1 – Exhibit RJ9. RJ1 is a certificate of incorporation for the applicant dated 9 October 2019. Exhibit RJ2 comprises a selection of promotional articles relating to the use of its own ACE PIZZA mark. Turnover for the applicant is provided at RJ3 and begins in June 2020. Artwork for the pizza boxes, menus and flyers are provided at Exhibit RJ4 – RJ6 showing the use of both ACE PIZZA and the stylised 'A' in various combinations.
34. In her witness statement, Ms Jones provides screenshots of Google searches for ACE PIZZA which show a list of several results. The results do not show if the businesses are still trading, or much information about each of the same other than an address for some of the results. Exhibit RJ9 is a Companies

¹⁸ See paragraph 16

¹⁹ See paragraph 3

²⁰ See paragraph 3

²¹ See paragraph 12

House results page for businesses with ACE in their name. The screenshot is dated 7 December 2021.

35. Details of the applicant's promotional activity and spend of the applicant are also provided by Ms Jones in her statement.

36. I have summarised the evidence to the extent I consider it necessary to do so. Any evidence not detailed in the summary has nonetheless been carefully considered.

Preliminary issues

37. I acknowledge that the applicant filed its evidence prior to the opponent dropping its case under section 5(4)(a). However, for the avoidance of doubt, I note here that the applicant's evidence of its own first use of the mark can be of no assistance to the applicant's defence against the section 5(2)(b). The section 5(2)(b) claim is to be assessed as at filing date on which the applicant filed its trade mark application - "the relevant date". In any event, the applicant's use predates its filing by approximately one month only, meaning the fact that there had been no confusion at the time of filing, or the time the evidence was filed, offers little indication that there will be none in future.

38. I also note the applicant's reference to other businesses using the word ACE in its evidence. The evidence of businesses registered at Companies House using the word ACE is of no assistance to the applicant, as it does not show that these business names are in use as trade marks in respect of the relevant services. Further, I find this also to be true for the list of Google results for businesses trading using the mark ACE. The details provided about the businesses are limited and this evidence is not sufficient to show that the consumer is accustomed to distinguishing between businesses using ACE in respect of the services. This evidence will therefore not be considered further in this decision.

Proof of use

39. The earlier marks had not been registered for a period of over five years at the date on which the application filed, and so they are not subject to proof of use under section 6A of the Act.

Decision

Section 5(2)(b)

40. Section 5(2)(b) of the Act is 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”.

41. Section 5A of the Act is as follows:

“5A 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 trade mark is applied for, the application is to be refused in relation to those goods and services only.”

42. The following principles are gleaned from the decisions of the EU 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 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.

The principles

(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 services

43. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

44. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

45. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that goods may be considered “complementary” where:

“...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”.

47. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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 or 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.”

48. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general

term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

49. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

"29. 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".

50. The services for comparison are below:

Earlier services	Contested services
<p>The earlier word mark</p> <p><i>Class 43: Providing food and beverages; services for providing food and drink; catering services; restaurants; cafes; coffee shops; coffee shop services; tea rooms; tea room services; bar services.</i></p>	<p><i>Class 43: Restaurant services; cafe services; snack bar services; bar services; take away food and drink services; preparation and provision of food and drink; preparation of meals or foodstuffs for consumption off the premises; catering services; restaurant reservation services; information, advisory and consultancy services all relating to the aforesaid services.</i></p>
<p>The earlier logo mark</p> <p><i>Class 43: Providing food and beverages; catering services; restaurants; cafes; bar services.</i></p>	

51. Both of the opponent's earlier marks cover the services *Providing food and beverages; catering services; restaurants; cafes; bar services*. I find all of the applicant's services below to either be self-evidently identical to the opponent's services, or to be identical in line with the principles in *Meric*:

Class 43: Restaurant services; cafe services; snack bar services; bar services; take away food and drink services; preparation and provision of food and drink; preparation of meals or foodstuffs for consumption off the premises; catering services;

52. Whilst I do not find the opponent's services outlined above to be identical to the applicant's *restaurant reservation services*; I find these will likely be offered via

the same trade channels, and they are complementary in the sense that restaurant services are indispensable to restaurant reservation services, and the consumer will believe they may be offered by the same undertaking. For example, reservation services may be offered by a company also responsible for running a group of restaurants. The intended user will also be shared, namely members of the general public. Whilst I acknowledge that there may be some entities that offer only restaurant reservation and not the restaurant services themselves, I do not find that this detracts from my previous findings. I do not find the services to share a nature or to be in competition. Overall, I find the services to be similar to a medium degree.

53. Finally, I consider the applicant's services *information, advisory and consultancy services all relating to the aforesaid services*. It is my view these may also be offered via the same entities as those offering services for providing food and drink, or providing food and drink, and they are complementary. However, whilst there may be a shared intended user in respect of the information and advisory services relating to the food and drink services, and the services themselves, it is my view that this is not the same for the consultancy services, which will primarily be offered to business consumers for the purpose of helping to start or improve a food business. The nature of the services will differ, as will the method of use, and these services will not be in competition. Weighing up all of the relevant factors, I find the applicant's *information, advisory and consultancy services all relating to the aforesaid services* to be similar to the opponent's services to a medium degree.




Comparison of marks

54. 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 Court of Justice of the European Union 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.”

55. 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 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.

56. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p style="text-align: center;">ACE CAFE</p>	<div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p style="text-align: center;">ACE PIZZA / ACE PIZZA</p>
	

57. The earlier word mark comprises the two words ACE CAFE. As CAFE is directly descriptive of the services, and is at the end of the mark, the word ACE plays a greater role in the overall impression and is the dominant element of the same, despite its laudatory connotations to something being very good.

58. The earlier logo mark comprises several elements, including the image of a club (one of the four card suits) and the word ACE in small letters in the centre of the mark, and the wording ACE CAFE and LONDON in a circular boarder

around the edge of the same. The words CAFE and LONDON appear again to be directly descriptive and the border is fairly decorative, and as such the larger of the two words 'ACE' and club device appear to play the greatest role in the overall impression of the mark. However, the overall impression resides in the mark as a whole.

59. The contested mark comprises two distinct elements, namely the heavily stylised letter 'A' in the circle, and the wording ACE PIZZA. The 'A' is the first letter of the wording below, however, this device element still plays a large role in the overall impression of the mark, along with the wording ACE PIZZA to which the eye is naturally drawn. The word PIZZA is again descriptive of the services, and so ACE plays a greater role once again, despite its laudatory connotations. As one of the series marks is filed in black and white it may be used in any colour combination.

Visual comparison

60. Visually, the earlier word mark and the contested mark both use the word ACE but differ through the use of the descriptive words CAFE and PIZZA, in addition to the device element in the contested mark. The marks are visually similar to a medium degree.

61. The earlier logo mark also shares the use of the word ACE with the later mark, but the layout and additional elements of the marks differ. Both marks include device elements inside of a circle, but the devices inside the circles bear no visual resemblance. The wording in the earlier mark appears within a circular boarder, whereas this is separate to the circular device element in the later mark. Overall, two marks are visually similar to a low degree.

Aural comparison

62. The earlier word mark consists of the two pronounceable words, ACE CAFE. I find the letter 'A', representing the first letter of ACE is unlikely to be pronounced in the contested mark. Where the marks are pronounced ACE CAFE and ACE PIZZA, they are aurally similar to medium degree.

63. In respect of the earlier logo mark, again I find it unlikely that LONDON will be verbalised in the mark, and I find the same for the second ACE in the middle of the mark. Instead, I find it likely it will be pronounced as ACE CAFE and so this mark shares the same level of aural similarity as the earlier word mark.

Conceptual comparison

64. In respect of the conceptual comparison, the applicant submits:

“At the conceptual level, the ACE element in the Opponent’s mark either relates to the ace in a pack of playing cards, or something which is excellent or superb. As the Applicant has incorporated a stylised letter A in their mark, and not a device of a playing card, their mark is unlikely to be assumed to have the first meaning, so the mark will be assumed to relate to an excellent or superb product. The CAFE element of the ACE CAFE marks indicates what is typically an informal venue at which to consume food and drink, whereas the term PIZZA refers to a specific type of foodstuff. Thus, conceptually the respective marks have significant differences.”

65. On the contrary, the opponent submits:

“Since the respective marks all contain the word ‘ACE’ as their most distinctive element, they are also conceptually similar insofar as they would, or could, all be understood by consumers as a reference to the playing card.

In addition, whilst the words ‘PIZZA’ and ‘CAFE’ do not have identical semantic content, we submit that they are conceptually linked because these terms both relate to food/the provision of food. Overall, the degree of conceptual similarity between the signs is high.”

66. The earlier word mark includes the two English words ACE and CAFE. The word CAFE describes to the consumer a relaxed establishment serving food and drink. The applicant has provided the dictionary definition for the word ACE and this provides several meanings, including an ACE in a pack of playing

cards, an ACE in tennis, and the informal meaning of something being excellent, amongst other definitions. I find the concept of ACE in respect of the mark may change depending on the context in which the services are offered, for example, the ACE CAFE at a tennis club may convey a different meaning to the consumer to an ACE CAFE at a golf club, and ACE CAFE in a town centre. However, I accept the applicant's submission and consider the most likely concept that will be derived from the word mark to the consumer is of an informal word for excellent, and overall the earlier word mark will be most likely to convey to the consumer the concept of an excellent cafe. I accept that to some this may also convey one of the alternative meanings of ACE as provided by the applicant, but I find this far less likely.

67. In the earlier logo mark, the use of the club image generally associated with a suit in playing cards means that despite the identical wording ACE being used, it will convey the concept of an ACE playing card, alongside the concept of a café based in London, rather than the informal word suggesting excellence.

68. I find the word ACE in the contested mark will again most likely convey the concept of excellence. I agree with the applicant's submission that in the context of the later mark, the word ACE is unlikely to convey the concept of a playing card to the consumer. The stylisation of the mark does not lend itself to the meaning of ACE as a playing card. It is my view that the mark as a whole will convey to the consumer the concept of excellent pizza.

69. Although all three marks share the word ACE, I find the concept of ACE as an informal term for excellent is shared only by the earlier word mark and the contested mark. These marks differ due to the different concepts conveyed by the words PIZZA and CAFÉ, but overall I find the marks conceptually similar to a medium degree. The earlier logo mark conveys a different meaning to the consumer through its use of ACE, and overall, I find the earlier logo mark to be conceptually dissimilar to the contested mark.

Average consumer and the purchasing act

70. 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.

71. In *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), Birss J. described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

72. Before deciding on the likelihood of confusion, I must first identify the relevant consumer of the services, and the level of attention paid.

73. The average consumer of most of the applicant's services will be members of the general public, with the exception of *information, advisory and consultancy services all relating to the aforesaid services*. In respect of the information and advisory services in relation to the services covered, these may be aimed at both professionals and the general public, depending on the nature of the information and advice given. In the case of consultancy services these are likely aimed at professionals only. The catering services offered may also be aimed at both the general public and professionals running events.

74. In respect of the services aimed at the general public, the consumer will likely consider factors such as the type of food and drink offered and the price point, possibly in addition to any reviews received, and so they are likely to pay a medium level of attention to the majority of the services offered. When engaging catering services, the level of attention will be slightly higher due to the services

being purchased on a larger scale for a particular event, and the level of attention in respect of these services when engaged by the general public will be above medium. In respect of the information and advisory services, in addition to the reservation services, the attention paid to these services by the general public will likely be lower, with more attention given to the services ultimately chosen for consuming the food or drink rather than who provides the information and reservation services themselves, and so the level of attention paid is likely to be below medium. Where professionals are concerned, whether it is in respect of the catering services or the information, advisory or consultancy services, they are likely to pay a higher level of attention than the general public. Where catering is concerned, this may have an impact on the success of their event or business, and they may have an extra level of liability in respect of the same. Where professionals are directly seeking advice and information or consultancy services in respect of the services, they will wish to use trusted parties, as again this may have a direct impact on the success of their business. The professional consumer will likely pay an above medium to high level of attention in respect of the services mentioned.

75. All of the services may be selected visually, either following visual marketing material or a website, or by walking past the premises. Word of mouth recommendations may also play a part in the selection process, and although generally there will also be a visual element when ultimately engaging with the services, aural considerations cannot be completely ignored.

Distinctive character of the earlier trade mark

76. 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).”

77. The applicant has argued in its submissions that the distinctive character of the earlier mark ACE CAFE “...is not, prima facie, sufficient to distinguish the goods of one entity from another”. It is well established in the case law that for opposition purposes, an earlier registered trade mark will be assumed to hold at least some distinctive character,²² and so I cannot accept the applicant’s submissions.

78. The earlier word mark is made up of two words, namely ACE and CAFE. Together they convey the meaning of an excellent café. Whilst I acknowledge that ACE is not the most commonly used term, I still find the earlier word mark to hold only a low level of inherent distinctiveness.

79. The earlier logo mark comprises several elements. In this mark, the word ACE is combined with the club device to make its meaning clearly relate to the playing card, rendering it meaningless in relation to the services within the context of this mark. This, along with the club device and the stylisation of the

²² See paragraphs 41 – 44 of the CJEU decision in *Formula One Licensing BV v OHIM*, Case C-196/11P

mark means the mark as a whole is inherently distinctive to an above average degree.

80. The opponent has claimed that its marks hold an enhanced degree of distinctive character, with Mr Huff stating in his witness statement:

“The enhanced distinctiveness of the earlier trade marks should exist at the time of (i) the filing of the Application (being 20 July 2020) and (ii) taking the decision (“the relevant dates”).

It is hereby submitted that, as a result of a prolonged and sustained period of use in the United Kingdom prior to the relevant dates, the Opponent’s earlier trade marks enjoy an enhanced degree of distinctive character, in the sense that the relevant public recognises the earlier trade marks as having a high capacity to identify the services for which they are registered as coming from the Opponent. Evidence in support of this submission was filed on 10 May 2021 in the form of a Witness Statement from Wayne Philip Huff (“the WPH Statement”) and Exhibits CAW1-12.”

81. Firstly, I note that the relevant date for assessing if the earlier marks hold an enhanced degree of distinctive character is the date that the contested application was filed, namely 20 July 2020. The evidence attesting to the history of the café, shows it was popular in the 1950s and 1960s under the earlier word mark, and that it had been running for nearly 20 years after its reopening by the opponent and before the contested mark was filed. There is also evidence stating that the café is involved in events within the world of biking, including the London Motorcycle show and Silverstone, although I note that the opponent only holds one UK premises for its services, located in London. The menu shows the café sells main meals for between approximately £5-£10, meaning its turn over figures of over 1.5 million GBP for the years 2016 – 2019 relate to a very healthy number of sales each year from a single premise and the events attended. Although limited, the press provided includes a review of the opponent’s ACE CAFE referring to it as ‘London’s oldest and most famous

motoring café'. The café has been the subject of a book, although I have no distribution figures for this, and the café has been featured on several BBC motoring TV shows. Whilst I note that the BBC show Top Gear has been very successful in its time, I do not have any viewing figures for the episodes on which the opponent's café featured,²³ and I have not been provided with much detail on the prominence of the ACE CAFE within the shows it featured on.

82. I note the promotional spend evidenced is fairly low, although I accept this does not appear to have negatively impacted the opponent's business, with reference to it serving between 200 – 600 meals a day. This level of trade, in addition to the press references to its fame and 'iconic' status within the biking industry indicates that it is likely the cafe is sought out by some of its customers, although I cannot ignore that a (possibly large) portion of this business may also simply be passing trade, particularly due to its location. The evidence also shows that the café has been recognised as important by those in the biking industry, having been awarded the Red Wheel by the National Transport Trust to recognise it as a site of historical importance to transport heritage in the UK.

83. From the sum of the evidence I find it likely that to some members of the general public with a particular interest in motorsports, or the "rockers" culture, the ACE CAFE will be known. However, I consider that the services applied for are services aimed at the general public at large. The question I therefore ask myself is whether a finding that the distinctive character of the mark ACE CAFE has been enhanced in respect of the services applied for, which are aimed at the general public at large, is justified in light of its referenced 'status' within the biking community.

84. I consider this question in respect of the opponent's primary *café services*, as it is for these services that I find the distinctive character most likely to have been enhanced. I note I have no evidence on the size of the market for these services in the UK but there is no doubt in my mind this will be very large. Whilst healthy, the turnover figures provided by the opponent will be only a very small fraction of the market as a whole. In addition, whilst there are references to the

²³ I note the YouTube views for the Top Gear episodes references are 13,243 (2017) and 620,441 (2007)

cafe being an iconic or famous bikers bar, I have only a very small number of press articles to consider. As I mentioned, the advertising spend is low. Whilst there is a recognition from 'industry', this is recognition of the importance and significance of the cafe to the transport sector, rather than its significance within the cafe industry, although I note this will likely have resulted in exposure, nonetheless. As mentioned, the information about the TV exposure lacks detail. Whilst I therefore find the evidence suggests that there will be a group of consumers to whom the café is better known, I have no indication of the number of consumers to whom this will apply. I find this to be far from conclusive that the opponent has materially enhanced the distinctive character of its mark through the use of the same, in respect of cafe services as a whole. I have no real indication from the evidence filed of the portion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking. Pairing this with the low advertising spend, the healthy but proportionately small turnover, the limited geographic presence and the very thin press coverage provided, I find that if the distinctive character of the earlier word mark ACE CAFE has been enhanced, this will only be at a marginal level that will have little bearing on the outcome of this decision. I do not find that the evidence provided shows that the distinctive character of the opponent's logo mark has been enhanced beyond its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

85. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 42 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character

held by the earlier mark will have an impact on the likelihood of confusion. I must consider that the likelihood of confusion may be increased where the distinctive character held by the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.²⁴ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods or services are obtained will have a bearing on how likely the average consumer is to be confused.

86. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.²⁵

87. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

²⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

²⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

88. As the earlier word mark is subject to invalidation proceedings at the EU IPO, for ease of reference I will clearly separate my findings in respect of each of the earlier marks below.

The earlier word mark

89. I found the earlier word mark to be visually, aurally and conceptually similar to the contested mark to a medium degree. I found the services covered by this earlier word mark to range between identical and similar to a medium degree to those filed by the applicant. I found that the earlier word mark held an inherently low degree of distinctive character, and that the evidence filed was not sufficient to show this had been meaningfully enhanced through use. I found the average consumer of the services filed will comprise primarily of the general public but there will also be a portion of professional consumers in respect of some of the services, and I found the level of attention paid will vary from below medium to high. After careful consideration of all of the factors, and keeping in mind the consumer imperfect recollection, it is my view that the differences between the marks, including the addition of the large 'A' device in the latter, are too great for the consumer not to notice and recall the same. I therefore find no likelihood of direct confusion between the marks.

90. In respect of indirect confusion, I consider whether I find that the use of the common element, namely 'ACE' will lead consumers to believe that the marks derive from economically linked undertakings. I consider that the word element of the contested mark appears to play an independent role within the same, with it appearing to be slightly separated from the device element. Whilst this does not mean the device element should be ignored in my considerations, I do find the separation of the device and word element makes it more likely for the consumer to think that the mark may be used with or without this element. I consider that the word CAFE and PIZZA are directly descriptive of the services, and that ACE, despite its meaning as an informal reference to excellence, is the, or a dominant element in each of the marks.

91. In *L.A. Sugar*, Mr Iain Purvis Q.C., as the Appointed Person, identified three scenarios in which indirect confusion is likely to occur as follows:

“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).”

92. I note that the two marks I have to consider do not fall squarely into any one of the categories outlined above. However, I note this is not an exhaustive list. Considering all of the relevant factors it is my view that in this instance, there is a likelihood of indirect confusion based on what may be considered an extended version of category B above. It is my view that there is a real likelihood that when viewing the marks, the consumer will reach the conclusion that the later mark represents a brand extension or sub-brand of the earlier ACE CAFE mark, that focuses on pizza in particular. Notwithstanding the low level of inherent distinctiveness of the earlier mark, I still find this would be a logical and likely conclusion for the consumer to reach based on the earlier word mark as registered, which could be used a similar stylisation to the later mark filed.

The earlier logo mark

93. I found the earlier logo mark to be similar to the contested mark to a low degree visually and to a medium degree aurally. Despite the use of the dominant word ACE in both of the marks, I found them to be dissimilar conceptually due to the different meanings that will be attributed to this word in each. I found the services to range from similar to a medium degree to identical. My findings in respect of the average consumer and the level of attention paid towards the services as outlined above also apply here, and I found this mark as a whole to be inherently distinctive to an above average degree. I note in this case that this higher level of inherent distinctiveness is the result of the combination of the elements in the mark, and not simply the ACE or ACE CAFÉ element in isolation. Considering all of the relevant factors, and keeping in mind the consumers imperfect recollection, I find the differences between these marks too significant for the consumer to forget or not notice these, and I therefore do not find a likelihood of direct confusion between the marks.

94. In respect of indirect confusion, I ask myself again if I find the common element ACE will result in the consumer believing the services derive from the same economic undertaking. It is not lost on me that this is a slightly unusual case, in that I have found an identical word provokes a different conceptual meaning in each mark. However, it is nonetheless how I find the average consumer is likely to interpret the marks, particularly remembering they will not benefit from a side by side comparison. Whilst the chances of the consumer linking the marks based on their common elements may be lower without a memorable conceptual link between the marks, it is my view that the complete reproduction of the word element ACE will, for some consumers, be enough to call the earlier mark to mind.

95. However, it is my view that in this case the different conceptual meanings that the marks provoke, in addition to the very different layout and stylisation used will mean that despite the identity of some of the services, whilst one mark may call the other to mind, the consumer is very unlikely to conclude that the later mark is a brand extension or sub-brand of the earlier mark, or vice versa. It is my view that it is much more likely that the consumer will put the common use

of ACE in these marks down to coincidence, and not down to an economically-linked undertaking being responsible for both. I therefore find there is no indirect confusion where the opponent relies on its earlier stylised mark.

Final Remarks

96. The opposition has been successful on the basis of the earlier word mark, EU registration number 17776576, only. The mark upon which the opponent's success is based is currently the subject of an invalidation application at the EU Intellectual Property Office. If successful, the earlier mark upon which the success of this opposition relies will not have been validly registered at the date on which the application was filed. As such, this is a provisional decision, which will be made final only once the proceedings at the EU Intellectual Property Office have ended. An appeal deadline will be set only after a final decision has been issued.

COSTS

97. As this decision is yet to be made final, there will be no award of costs made at this time. Costs will be awarded along with the issuance of the final decision.

Dated this 19th day of October 2021

Rosie Le Breton

For the Registrar