

o/1105/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003722881

BY UK ELITE GROUP LTD

TO REGISTER THE TRADE MARK:

Mambo 50

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431493

BY PRODUCCIONES MAMBO S.L.

BACKGROUND AND PLEADINGS

1. On 18 November 2021, UK Elite group Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 3 December 2021. The applicant seeks registration for the following goods:

Class 33 Alcoholic cocktails; Alcoholic cocktail mixes; Rum [alcoholic beverage]; Alcoholic fruit beverages; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic coffee-based beverage; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Alcoholic carbonated beverages, except beer.

2. The application was opposed by Producciones Mambo S.L. (“the opponent”) on 2 March 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:



UK registration no. 3189130

Filing date 4 October 2016; Registration date 10 March 2017.

Relying upon some of the services for which the earlier mark is registered, namely:

Class 41 Disc jockeys for parties and special events; arranging of musical events; arranging of musical performances; arranging of musical entertainment; organising events for entertainment purposes; organising of music concerts; live music performances; provision of live music and live

musical performances; live music concerts; music entertainment services; music production services; music publishing and music recording services; recording of music; disc jockey services; party planning; entertainment services; nightclub services; entertainment services provided at nightclubs; reservation services for show tickets; musical concerts by radio; providing digital music [not downloadable] from the internet; audio and video recording services; publishing of music records.

Class 43 Bar services; nightclub services; restaurant services; restaurant services incorporating licensed bar facilities; snack bar services; provision of food and drink; hospitality services [food and drink].

3. The opponent claims that there is a likelihood of confusion because of the high degree of similarity between the marks and the high degree of similarity between the respective goods and services.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Reddie & Grose LLP and the applicant is represented by Sanderana Limited. Neither party requested a hearing, nor filed any evidence or submissions during the evidence rounds or in lieu of a hearing. This decision is taken following a careful perusal of the papers.

6. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

7. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

8. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

9. 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:

(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 and services

10. The competing goods and services are as follows:

Opponent's services	Applicant's goods
<p><u>Class 41</u></p> <p>Disc jockeys for parties and special events; arranging of musical events; arranging of musical performances; arranging of musical entertainment; organising events for entertainment purposes; organising of music concerts; live music performances; provision of live music and live musical performances; live music concerts; music entertainment services; music production services; music publishing and music recording services; recording of music; disc jockey services; party planning; entertainment services; nightclub services; entertainment services provided at nightclubs; reservation services for show tickets; musical concerts by radio; providing digital music [not downloadable] from the internet; audio and video recording services; publishing of music records.</p> <p><u>Class 43</u></p>	<p><u>Class 33</u></p> <p>Alcoholic cocktails; Alcoholic cocktail mixes; Rum [alcoholic beverage]; Alcoholic fruit beverages; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic coffee-based beverage; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Alcoholic carbonated beverages, except beer.</p>

Bar services; nightclub services; restaurant services; restaurant services incorporating licensed bar facilities; snack bar services; provision of food and drink; hospitality services [food and drink].	
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11. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

12. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 for 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.”

14. 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.”

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

16. 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 “complementary” means:

“... 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 the responsibility for those goods lies with the same undertaking.”

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

18. In *Group Lottuss Corp., SL v OHIM*, Case T-161/07, the GC held there to be a low degree of similarity between beer, cocktail bars, entertainment and discotheques on account of the complementarity, target audience and overlapping points of sale. I see no reason why this logic should not extend to all of the applicant’s class 33 goods. In addition, it is common to find house wines and house branded cocktails in restaurants, bars and cocktail lounges. The goods are, therefore, similar to a low degree, with the opponent’s nightclub services in class 41, and its restaurant and bar services in class 43.

The average consumer and the nature of the purchasing act

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer of the goods will be adult members of the general public over the age of 18. The average consumer for the services will be members of the general public. The cost of the goods and services in question are likely to vary,

however, on balance it is likely to be relatively low. The majority of the goods and services will be purchased relatively frequently. As far as the goods are concerned, the average consumer will take various factors into consideration such as the cost, flavour, ingredients and alcohol percentage. However, considerations such as the food/drink menu choices and the ambiance will come into play for the services. The selection of both the goods and services is likely to attract a medium degree of attention.

21. The goods are likely to be purchased by self-selection from the shelves of a range of retail outlets such as supermarkets and off-licences, and their online equivalents. Such goods are also sold in public houses, bars, and restaurants where they will be publicly displayed behind the counter or on a drinks menu. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be verbally ordered at a bar, or if stocked behind a counter, the average consumer must ask the sales assistant for them.

22. The services are also likely to be selected through mainly visual means, by way of websites, flyers and signs on the premises themselves. Recommendations may be involved in the selection process and therefore the potential for an aural element cannot be discounted.


Comparison of the trade marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

25. The respective trade marks are shown below:

Opponent’s trade mark	Applicant’s trade mark
	<p data-bbox="863 1211 1334 1290" style="text-align: center;">Mambo 50</p>

26. The opponent’s mark consists of the wording “Café MAMBO Ibiza”. I note that the words “Café” and “Ibiza” are presented in the colour blue, in a standard typeface. The word MAMBO is presented in a larger capitalized typeface which only consists of a pink outline. I note that the MAMBO pink outline also connects and continues upwards to depict a stylised outline of a building with a curved roof and window. Behind the building outline, is an orange to yellow gradient semi-circle, which contains black horizontal lines. I consider that the average consumer would recognise this as a sun setting behind the building. I note that all of the above is presented on a black square background. Whilst all of the elements contribute to the overall impression, the eye is

naturally drawn to the word MAMBO and the pink building outline and sun device, which are the dominant and central elements, that carries the most distinctive weight.

27. The applicant's mark consists of the word "Mambo" followed by the number "50". The overall impression of the mark lies in the combination of these elements.

28. Visually, the marks coincide in the word MAMBO. This acts as a visual point of similarity. However, the opponent's "MAMBO" is presented in a capitalized pink outline, in between the blue words "Café" and "Ibiza". The opponent's mark also has the pink building outline and sun device, which is all presented on the black square background. The applicant's mark also ends in the number "50". Therefore, these all act as visual points of difference. Taking all of the above into account, I consider that the marks are visually similar to between a low and medium degree.

29. Aurally, the devices in the opponent's mark won't be articulated. Therefore, the opponent's mark will be pronounced as CAF-AY MAM-BOW EYE-BEE-THA. The applicant's mark will be pronounced as MAM-BOW FIF-TEE. Consequently, the beginnings of the marks differ aurally. However, as the marks overlap in the pronunciation of MAMBO, they are aurally similar to a medium degree.

30. Conceptually, the applicant submits that the opponent's mark "conveys a meaning of a physical place in Ibiza where you may be able to dance the Mambo this is because of the inclusion of the images depicting sun, a castle and the words 'Café MAMBO Ibiza'". Firstly, I consider that the average consumer will recognise the word Café as being descriptive of its class 43 services. I consider that the average consumer will conceptually recognise the geographical location of Ibiza, which is a Spanish island. I also consider that a significant proportion of average consumers would recognise the MAMBO as being a type of dance. However, I also consider that there may be a proportion of average consumers who would recognise "MAMBO" as an invented word with no conceptual meaning.

31. Regardless, when reading the opponent's mark as a whole, I consider that it will be assigned the conceptual meaning of a Café, called MAMBO, located or from Ibiza. I also consider that the building device may be interpreted as a depiction of the 'café'.

32. The applicant's mark also consists of the ordinary dictionary word MAMBO, which as highlighted above, would be either recognised a type of dance, or an invented word with no conceptual meaning. This is presented with the number '50'. I therefore consider that the applicant's mark has no overall meaning because the word MAMBO (whether a dance, or invented word), and 50, do not link together. They remain as separate elements with their own meanings.

33. Taking the above into account, the opponent's and applicant's marks, as a whole, have different conceptual meanings (a café called MAMBO in Ibiza vs an invented word or a type of dance with the number 50). However, I acknowledge that both marks share the MAMBO element and therefore, must overlap to some extent in concept. Consequently, I consider that the marks are conceptually similar to a low degree.

Distinctive character of the earlier trade mark

34. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

35. 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. The distinctiveness of a mark can be enhanced by the use that has been made of it.

36. As highlighted above, the opponent’s mark consists of the words ‘Café MAMBO Ibiza’, presented in front of a pink building outline and sun device, presented on a black square background. I note that the word Café is descriptive of the opponent’s class 43 services. However, taking the mark as a whole into account, I consider that it is inherently distinctive to between a medium and high degree.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 he has retained in his mind.

38. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a low degree.
- I have found the opponent's mark to be inherently distinctive to between a medium and high degree.
- I have identified the average consumer to be (adult) members of the general public and businesses who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods and services.
- The parties' goods and services are similar to a low degree.

39. The visual and conceptual differences between the marks appear to me to be sufficient to rule out any likelihood of direct visual confusion. I do not consider that the average consumer would overlook, or misremember the blue words "Café" and "Ibiza", the pink building outline and sun device which is all presented on the black square background in the opponent's mark. This is due to the size and placement of all the above elements, which are all presented in bright colours, which stand out against the black background. I also do not consider that the average consumer would overlook the number "50" in the applicant's mark. Furthermore, regardless of whether 'MAMBO' is recognised as a type of dance or an invented word, in the opponent's mark the word 'MAMBO' is used alongside the wording 'Café' and 'Ibiza'. I bear in mind that the average consumer does not dissect the mark, it is read as a whole. Therefore, 'MAMBO' will be assigned the meaning of the name of the café in Ibiza. As highlighted above, the applicant's MAMBO is presented with the number '50', which do not link together, they remain as elements with their own meanings. Therefore, MAMBO, whether an invented word, or a type of dance, with the word 50, differs conceptually to the opponent's café MAMBO based in Ibiza. Consequently, I do not consider that there is a likelihood of direct visual confusion. This is even after allowing for a certain

degree of imperfect recollection on the part of average consumers and the fact that the goods and services are only similar to a low degree.

40. Although it could be argued that consumers or serving staff will mishear 'Mambo 50' for 'Café MAMBO Ibiza', when ordered in a noisy bar or restaurant environment, I bear in mind the judgment of the General Court in *Stock Polska sp zoo v EUIPO*¹ where the court held that:

..when the goods concerned, such as those at issue in the present case, are also ordered verbally for consumption in bars, restaurants or nightclubs, the phonetic similarity between the marks at issue is, by itself, sufficient to give rise to a likelihood of confusion.”

41. I accept that the likelihood of aural confusion may be sufficient by itself to constitute a likelihood of confusion, even where there is no likelihood of visual confusion. Whether that is so depends, amongst other things, on the degree of aural similarity between the marks (which will determine the extent of the likelihood of aural confusion) and the relative importance of oral orders in the selection of the goods or services.

42. I have accepted that oral order are a relevant factor in this case. As to whether 'Mambo 50' may be misheard as 'Café Mambo Ibiza' in settings with loud ambient noise, I bear in mind that in *Rani Refreshments FZCO v OHIM*², the General Court held that the likelihood of confusion must be assessed on the basis of normal marketing conditions. Therefore, whilst it is appropriate to make some allowance for the fact that applicant's alcoholic beverages and cocktails are sometimes sold in settings with significant background noise, it is not appropriate to assess the likelihood of confusion in settings with so much noise that consumers cannot make themselves properly heard. Further, even in the case of noisy bars and restaurants, consumers often choose drinks from a list where the mark can be seen. Therefore, whilst it is necessary to consider the effect of all normal and fair use of the applicant's mark, it is

¹ Case T-701/15, at paragraph 44 of the judgement

² Case T-523/12

not appropriate to give disproportionate weight to the possibility of orders being misheard because of the degree of noise in noisy bars and restaurants.

43. Notwithstanding that both marks contain the 'MAMBO' element, I do not consider that the average consumer would shorten both the opponent's and applicant's mark to 'MAMBO' aurally. I consider that the average consumer would articulate the '50' element in the applicant's mark, and I consider that the average consumer would articulate the beginning "Café" aural element, and the ending "Ibiza" aural element in the opponent's mark. Consequently, I reject the likelihood of direct aural confusion between the opponent's and applicant's mark.

44. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis K.C. (formally Q.C.), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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."

45. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, 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.

46. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think that the applicant’s trade mark was connected with the opponent, simply because they share the MAMBO element. The opponent’s mark, as a whole, is “Café MAMBO Ibiza”, with significant design and stylised device elements (the building outline and sun device and use of colour against the black background). The applicant’s mark as a whole is the word MAMBO (the dance or invented word) with the number 50. Therefore, these marks are clearly not natural variants or brand extensions of each other. Consequently, I consider that there is no likelihood of indirect confusion.

CONCLUSION

47. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

48. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£200** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Total	£200

49. I therefore order Producciones Mambo S.L. to pay UK Elite group Ltd the sum of £200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of December 2022

L FAYTER

For the Registrar