

O/0363/23

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

CONSOLIDATED PROCEEDINGS INVOLVING

TRADE MARK APPLICATION
NOs. 3436503 & 3436505 BY

ANDREW BENNETT

TO REGISTER THE SERIES OF TWO TRADE MARKS:

ACE CREAMS

AND

ace creams

IN CLASSES 30 & 43

AND

TO REGISTER THE SERIES OF TWO TRADE MARKS:

ACE CREAMS AND TAPAS

AND

ace creams and tapas

IN CLASSES 29, 30 & 43

AND

TWO OPPOSITIONS THERETO
UNDER NOs. 421001 & 421005
BY
ACE CAFE LONDON LIMITED

Background

1. On 24 November 2021, a decision in the above opposition proceedings was published under reference number BL O/860/21. Whilst upholding the opposition in part, the decision was provisional due to the fact that the earlier mark, namely EUTM registration number 17776576, on which the opposition succeeded, was itself the subject of invalidity application at the EUIPO. The opponent in these proceedings, Ace Cafe London Limited, was directed to notify the Tribunal when the invalidation application at the EUIPO was determined.
2. On 03 April 2023, the representative of the opponent informed the Tribunal about the conclusion of the invalidity proceedings at the EUIPO against the earlier mark. Because of the withdrawal of the cancellation application, the earlier mark stands now as registered. In this regard, this supplementary decision makes no changes to the contents of decision BL O/804/21 in so far as it concerns the assessment of the goods and services, the extent of the likelihood of confusion, or the reasoning of the decision.

Supplementary Decision

3. Paragraphs 96 to 97, as expressed in my decision of 24 November 2021, are to be replaced as follows:

“Outcome

96. Part of the oppositions under Section 5(2)(b) **succeed and, subject to an appeal against this decision, the applications will be refused for the following services:**

Class 43: Services for providing food and drink; provision of food and drink; self-service restaurant, bars, cafes and restaurants and catering services; snack bar, bistro café, cafeteria and coffee shop

services; tapas bars; take-away services, and counter service for the sale of take-away and fast foods, ice cream parlour services; snack bar services; event catering services; mobile catering services; preparation of foodstuffs and beverages for consumption on or off the premises; restaurant and cafés serving ice cream, edible ices, milk beverages, milk shakes, pastry and confectionery, coffee-based beverages, cocoa-based beverages, chocolate-based beverages, tea-based beverages, biscuits, cookies, cakes, chocolate, pancakes, pralines, sherbets, sorbets, waffles, yoghurt, crepes and smoothies; information, advisory and consultancy services relating to all of the aforesaid.

97. Part of the oppositions **fail, and the applications may, subject to appeal, proceed to registration for the following services:**

Class 29: Meat; fish; shellfish; molluscs; crustacea; poultry; game; meat extracts; preserved, dried, cooked and frozen fruits, fungi and vegetables; preserves; jellies; jams; marmalades; cranberry sauce; desserts; eggs; milk and milk products; cheese; edible oils and fats; butter; soups; sandwiches, meals and snacks included in this class; potato crisps; pickles; Tofu; Vegetables, cooked; Vegetables, dried; Vegetables, preserved.

Class 30: Breads, rolls, pastries; cereal based snacks; preparations made from cereals; bruschetta; bread sticks; pastries and confectionery; sandwiches; prepared meals; pizzas, pies and pasta dishes; tea and beverages ready for consumption; bakery products, products made from flour; speciality breads, French breads, croissants, rolls, scones, pastries, patisseries, cakes, pizza bases, biscuits, bagels, sweets, chocolates; ices and frozen confectionery; ice creams; frozen yoghurt; ice-cream and ice-cream products; dairy ice cream; sweets; sauces; ice cream sauces; flavourings; chocolate; chocolate flavourings; chocolate flavoured coating; puddings; desserts; coffee, tea, cocoa, sugar,

artificial coffee; pastry and confectionery, ices; honey, treacles; ice; sorbets; frozen confections; ice cream bars; frozen yogurt bars; pies; pastry; puddings, tarts, pastries and flans, pastry products; cookies; buns; confectioneries; hot chocolate; ice beverages; waffles.

Costs

98. In terms of costs, whilst both parties have achieved a measure of success, proportionately, the applicant has been more successful than the opponent. This is pitched as being around 75%. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	£150
Preparing evidence and considering and commenting on the other side's evidence	£225
Preparing for and filing submissions	£225
Total	£600

99. I, therefore, order Ace Cafe London Limited to pay Andrew Bennett the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.”

4. Taking account of the amendments above, my provisional decision dated 24 November 2021, together with the associated award of costs above, becomes final, subject to any appeal.

5. The appeal period for my decision to uphold the opposition will run from the date of this supplementary decision.

Dated this 14th day of April 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General