

**BL O/0722/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3537698**

**FOR THE TRADE MARK:**



**IN CLASS 43**

**IN THE NAME OF KANIZ SAMIR-MOSTAFFA**

**AND**

**AN OPPOSITION UNDER NO. 600001676**

**BY THE BLACK CAB COFFEE COMPANY**

## **Background and pleadings**

1. On 27 September 2020, Kaniz Samir-Mostaffa (“the applicant”) filed an application for the trade mark shown on the cover page of this decision (“the contested mark”). The application was published for opposition purposes on 8 January 2021, for the following services:

Class 43 Cafe services; Cafeteria services; Cafeterias; Catering in fast-food cafeterias; Catering services for company cafeterias; Providing food and drink in Internet cafes; Self-service cafeteria services; Serving food and drink in Internet cafes.

2. On 1 April 2021, the application was opposed in full under the fast-track opposition procedure by The Black Cab Coffee Company (“the opponent”), based upon section 5(2)(b) of the Trade Marks Act (“the Act”). The opponent relies on its earlier UK trade mark number 2612158, ‘The Black Cab Coffee Company’ (“the earlier mark”), which has a filing date of 28 February 2012 and a registration date of 8 June 2012. The opponent relies upon all services for which the mark is registered, namely:

Class 43 Provision of coffee via a mobile London taxi; catering services in respect of artisan bread, cakes and sandwiches provided at events.

3. The opponent claims that the marks are highly similar, and that the services are identical or similar, with the result being that there is a likelihood of confusion. The applicant filed a counterstatement denying the claims made.

4. The earlier mark is subject to use conditions in accordance with section 6A of the Act because it was registered more than five years before the application date of the contested mark. In its notice of opposition, the opponent made a statement of use and filed proof of use evidence in relation to all the services relied upon.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of the above is to require parties to seek leave in order to file evidence in fast-track oppositions. This would apply to evidence, which is filed later in the proceedings, and therefore would not include evidence of use which is required to be filed alongside the notice of opposition (Form TM7F). The opponent filed evidence within their TM7F and at a later date, also sought leave to file additional evidence in the form of a witness statement,<sup>1</sup> accompanied by five exhibits (GB1-GB5). Whilst the request to file further evidence was accepted by the Tribunal, this was only in relation to the witness statement and three of the five exhibits.

7. Rule 62(5) (as amended) states that arguments in fast-track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. On 14 December 2023, a hearing was requested by the applicant in order to ensure that the evidence and submissions filed by the parties during these proceedings were correctly considered and clearly understood. However, the Tribunal was of the view that oral proceedings were not necessary and therefore the request was refused.

8. The opponent is represented by Stephen Rimmer LLP and the applicant is unrepresented.

## **EVIDENCE AND SUBMISSIONS**

9. As noted above, the opponent filed evidence of use with its Form TM7F, this took the form of Exhibits 1 to 5. Additionally, during proceedings, the opponent filed further evidence in the form of a witness statement of Graham Buck dated 14 August 2023, Director of the opponent, along with 3 exhibits (Exhibits GB1 to GB3). This evidence was adduced in order to demonstrate the nature of the opponent’s services and illustrate how those services are marketed and selected by the relevant public.

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<sup>1</sup> Witness statement of Mr Graham Buck [Director of the opponent].

10. The opponent filed written submissions in lieu of a hearing, dated 15 March 2024.

11. I have taken the evidence and submissions into account in reaching this decision and will refer to them below, where necessary. This decision is taken following a careful perusal of the papers.

## **RELEVANCE OF EU LAW**

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

## **DECISION**

### **Proof of use**

13. I will begin by assessing whether there has been genuine use of the earlier mark in relation to the registered services relied upon. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application i.e. 28 September 2015 to 27 September 2020.

15. Section 100 of the Act reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the UK in the relevant period, and in respect of the relevant services as registered.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant services. For example, use of the mark by a single client which imports the relevant services can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the services at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The services for which use has been shown;
- iv) The nature of those services and the market(s) for them; and
- v) The geographical extent of the use shown.

19. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, (as he then was) sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:<sup>2</sup>

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark

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<sup>2</sup> Case BL O/230/13

has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.<sup>3</sup> Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

21. The comments of Mr Geoffrey Hobbs QC (as he then was) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.<sup>4</sup> He stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed

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<sup>3</sup> Case BL O/424/14

<sup>4</sup> Case BL O/404/13

in *Matsushita Electric Industrial Co. v. Comptroller General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

22. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the mark.

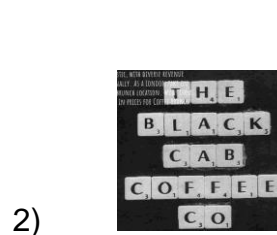
## Form of the mark

23. Before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered.<sup>5</sup>

24. With regards to use of the opponent's mark shown in its evidence, the applicant submits the following in its counterstatement:

“In the proof of use supplied by the opponent there are no actual documents showing them using their actual trademarked words as they appear on the register. Their trademark as a registered word is ‘The Black Cab Coffee Company’, however, all of the documents and evidence they have provided as proof of use shows a round black circle, resembling a coaster with an image and the words - THE BLACK CAB COFFEE CO LONDON. This is in itself a different representation of the words they have registered. Meaning they themselves are not using the registered mark in the form it has been registered. Therefore the trademark they have registered is different to the evidence they have provided. For the purposes of this statement I can only comment on the actual registered trademark which is a word trademark and for which I am not satisfied is being used by the opponent to run their business.”

25. The opponent's registration is for the word mark ‘The Black Cab Coffee Company’. Where the opponent has used its registration as registered, that will clearly be use on which the opponent can rely. For the avoidance of doubt this would also include slight variations to the mark, such as the words, ‘Black Cab Coffee Co’. However, it is noted from the evidence that the opponent's mark has also been used in the following ways:



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<sup>5</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

26. In conjunction with the above case law, I remind myself that Section 6A(4)(a) of the Act enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. As the registered trade mark is in word only format the distinctive character of the mark resides in the words ‘The Black Cab Coffee Company’.

27. I acknowledge that where a registered mark is used as part of another mark or with additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin.<sup>6</sup> Accordingly, I am of the view that use of the marks shown above, do constitute use of the registered mark as this element in the above versions continues to indicate origin. Consequently, I find that use of the stated marks is use upon which the opponent can rely.

28. However, even if I am wrong in my finding, I am of the view that the addition of the figurative elements at issue, do not sufficiently alter the distinctive character of the earlier mark, and therefore use of the marks constitutes as acceptable variant use of the earlier mark, upon which the opponent can rely.

### Genuine use

29. Whether the use shown of the earlier mark is sufficient will depend on whether there has been real commercial exploitation of the same, in the course of trade, sufficient to create or maintain a market for the services at issue, in the UK, during the relevant five-year period.

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>7</sup>

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<sup>6</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>7</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

31. The opponent claims to have used its earlier mark in relation to all the services relied on, namely:

Class 43 Provision of coffee via a mobile London taxi; catering services in respect of artisan bread, cakes and sandwiches provided at events.

32. In its Form TM7F the opponent states that its earlier mark 'The Black Cab Coffee Company' has been used throughout the relevant period and has submitted five exhibits (Exhibits 1-5), in its TM7F in support of its claim.

33. The opponent states that the earlier mark has been used since its registration in 2012, and has provided the following turnover figures (estimated), based on the five year period from 2016 to 2020:

| ESTIMATES OF TURNOVER PROVIDED FOR THE PREVIOUS FIVE YEARS, BASED ON THE TAKINGS FROM THE BUSINESS. |                     |
|---|---------------------|
| FIXED LOCATION  | MOBILE COFFEE SHOPS |
| 2016 - £270,000   | 2016 - £80,000      |
| 2017 - £400,000   | 2017 - £80,000      |
| 2018 - £400,000   | 2018 - £90,000      |
| 2019 - £350,000   | 2019 - £90,000      |
| 2020- £294,000  | 2020- £35,000       |

34. The turnover figures are supported by a selection of invoices (Exhibit 1). The earlier mark features prominently in each invoice, which are all dated between 2018 and 2019, being within the relevant period. However, whilst the invoices clearly relate to the services at issue being provided at various UK locations, such as Clapham Junction and Richmond, it is not clear who exactly these services were provided to as the opponent has chosen to redact this information from its evidence. However, in their TM7F the opponent states that the invoices demonstrate their 'Black Cab' being rented out as a mobile coffee business for events for the provision of drinks including coffee and sundries. In this regard, from the selection of invoices submitted, I am able to ascertain that they relate to various events, such as promotional coffee and coffee cocktail events in and around London, and involve the hiring of the opponent's 'Black Cab' and the provision of coffee and sundries to hundreds of people, as the following example invoices show:



INVOICE

07773 766553
grahambuck@theblackcabcoffee.co.uk
abcoffee.co.com

Natwest Bank
Acc: 84485752
Sort: 60 04 02
TheBlackCabCoffeeCo

22 West Street
Bromley
BR1 1RF

Date: 18/06/2018
Project Title: Promotional Coffee Morning for
Project Description: Provide coffee for
starting Wednesday and finishing Thursday am.
Invoice Number: 00891
Terms: Payment by event date

Table with 4 columns: Description, Quantity, Unit Price, Cost. Includes rows for hire fee, branding options, and 500 branded cups & lids.



INVOICE

07773 766553
grahambuck@theblackcabcoffee.co.uk
abcoffee.co.com

Natwest Bank
Acc: 84485752
Sort: 60 04 02
TheBlackCabCoffeeCo

22 West Street
Bromley
BR1 1RF

VAT No:
270 4043 36

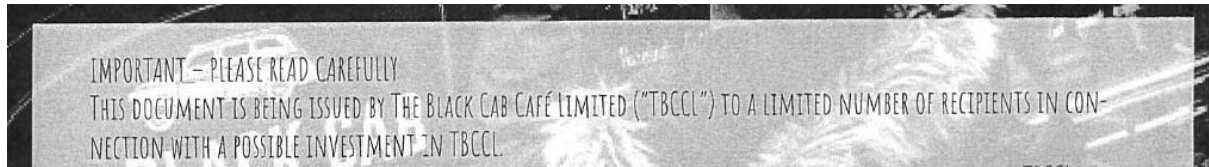
Date: 10/08/2018
Project Title: Promotional Coffee Morning
Project Description: Provide coffee for
at office location
Invoice Number: 00897
Terms: Payment prior to event.

Table with 4 columns: Description, Quantity, Unit Price, Cost. Includes rows for hire fee including 6kg of coffee, branding options, VAT @ 20%, and a total row.

35. Exhibit 2 contains a menu and price list featuring numerous breakfast, lunch and snack items, as well as numerous beverage options such as coffee, teas, juices, beers wines and spirits. The undated lists prominently feature the earlier mark.

36. Exhibit 3 appears to contain a business plan detailing marketing and promotional information relating to the opponent's company and its brand (the earlier mark). The

information relates to, amongst other things, the sale of coffee. The exhibit also includes a price list relating to numerous beverages, including coffee, teas, and hot chocolate. The contents of the exhibit are undated. Whilst it is not clear who the information was made available to, page 9 of the exhibit states the following:



37. Exhibit 4 contains details of numerous coffee titles originating from the opponent, such as 'Mayfair Coffee Blend', 'Shoreditch Coffee Blend', and 'Brick Lane Coffee Blend'. The undated information features the earlier mark numerous times.

38. In exhibit 5 the opponent submits information with regards to the similarity of the marks and the respective services at issue. In addition, the opponent states that the earlier mark is used on all its marketing information, uniforms, posters, and merchandise, as well as being displayed in its store and throughout its business. The opponent adds that it has used its trademark continuously over the past 8 years and will continue to do so as its business expands.

39. The opponent states that over the years it has spent a considerable sum of money marketing and promoting the earlier mark, via posters, flyers, website, signs and promotional goods. In regard to this, the opponent states that it has spent in excess of £12,000 per year promoting its trade mark.

40. Whilst I note that the opponent states that it is widely recognised across the UK and that its 'black cab' is known as a 'coffee shop', I have nothing before me to demonstrate that this is actually the case.

41. With regards to the additional evidence filed by the opponent in the form of a witness statement of Mr Graham Buck, dated 14 August 2023, along with 3 exhibits (Exhibits GB1 to GB3), I note that this evidence was adduced in order to demonstrate the nature of the opponent's services and illustrate how those services are marketed

and selected by the relevant public. In his witness statement, Mr Graham Buck explains that the opponent's company is a coffee business which has been operating under the trade mark 'The Black Cab Coffee Co', for the past 10 years, adding that the opponent is a speciality coffee roaster and coffee shop selling both packaged coffee beans and prepared drinks.

42. Mr Buck states that the opponent's business originated in black cabs, selling coffee around London, adding that part of the business is still conducted on a mobile basis. He explains that for the past 6 years the opponent has been operating a speciality coffee shop and café, under the trade mark 'The Black Cab Coffee Co', from a fixed location, in Nine Elms, London, where a variety of speciality coffees are roasted for consumption on and off the premises. Mr Buck adds that coffee is also supplied to customers from the premises in the form of roasted beans, where they can choose a variety of different beans with specific names based on their origins which he explains are all marketed under the trade mark 'The Black Cab Coffee Co' trademark and logo.

43. With regards to the names of the opponent's coffee goods, Mr Buck states the following:

*"The Brick Lane Blend is based on our long running presence at the street food market.*

*The Shoreditch Blend is based again on our long running presence in Brick Lane and the Shoreditch area where we are famous for making speciality coffee and selling roasted coffee beans to the general public.*

*The Mayfair Blend is based on our location and proximity to Mayfair in London."*

44. In his witness statement Mr Buck explains that the opponent's fixed-point location coffee shop is predominantly engaged in the sale of coffee drinks and coffee beans, adding however, that whilst part of running a coffee shop is that cakes, pastries and breakfasts are also provided, this is secondary to the opponent's main brand ambition which is the provision of coffee beans and coffee drinks, and being known as a coffee roaster.

45. Mr Buck states that the opponent's goods are marketed on their website, Facebook and Instagram, as well as via paid ads, with the emphasis on coffee bean sales. In regard to advertising and promoting the mark in relation to speciality coffee, Mr Buck states that the opponent spends approximately £900 a year.

46. In addition, Mr Buck states that the opponent also promotes its business using the black cab icon. In this regard Mr Buck states that all the opponent's coffees are sold based on customers recognising its branding on the cab, adding that the goods are sold with a prominent 'The Black Cab Coffee Co' logo to identify the brand and the product, including coffee cups where the opponent's logo is prominently displayed (exhibit GB1).

47. Mr Buck explains that the opponent's catering services are marketed online under the same trade mark, 'The Black Cab Coffee Co'. Mr Buck states that the opponent's target audience are in the main, 'well-off' professionals (both young and old) who are likely to have coffee brewing equipment at home, therefore increasing their desire to purchase speciality coffee beans.

48. Mr Buck states that the opponent is contacted by a wide range of businesses for the provision of speciality coffee (and catering), in various contexts, ranging from film sets to craft services, to promotional campaigns and staff parties, etc.

49. Additionally, Mr Buck explains that the opponent has established business relationships with pubs around London in order to supply their coffee beans under the mark 'The Black Cab Coffee Co'. He adds that it currently supplies a large pub in Loughborough Junction and another large hotel in Crystal Palace.

50. Mr Buck states that the opponent's word-of-mouth reputation means that they are contacted on the basis of their coffee brand in order to supply speciality coffee and coffee products.

51. In his witness statement, Mr Buck provides updated figures to those previously provided in the opponent's Form TM7F, with regards to the opponent's turnover

between 2016 and 2020. It is noted that whilst the 2016, 2017 and 2018 estimated figures remain the same as those submitted in the opponent's Form TM7F, the figures provided for 2019 and 2020 are now 'actual' figures rather than estimated figures, and differ slightly from those originally submitted (see above), as can be seen from the following:

| YEAR            | FIXED LOCATION | MOBILE COFFEE SHOPS |
|-----------------|----------------|---------------------|
| 2016 (estimate) | £270,000       | £80,000             |
| 2017 (estimate) | £400,000       | £80,000             |
| 2018 (estimate) | £400,000       | £90,000             |
| 2019 (actual)   | £331,977       | £51,857             |
| 2020 (actual)   | £330,228       | £39,965             |

52. These turnover figures are supported by a selection of invoices (exhibit GB2), dated within the relevant period, between 2018 and 2019, and all relate to the provision of the services at issue. In addition, exhibit GB2 contains a price list of goods provided by the opponent via their services, which includes, various speciality coffees, teas and hot chocolates, etc. The price list is undated. The opponent's mark features prominently on the invoices and the price list. The invoices clearly relate to some of the services at issue being provided at various UK locations, such as the Sussex festival, Richmond and Hanley.

53. With regard to the evidence of use submitted, I remind myself that use does not have to be quantitatively significant to be genuine. It is apparent from the evidence that the opponent has used its mark in the UK, during the relevant period. The turnover figures are reasonable in terms of the services at issue and demonstrate that sales under the earlier mark have been consistent over the relevant period. As such, I am satisfied that the opponent has attempted to create and maintain a market under the mark. Accordingly, I am satisfied that the opponent has demonstrated genuine use of its mark.

### **Fair specification**

54. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the services relied upon.

The opponent's Class 43 services

55. The opponent relies upon the following services:

Class 43 Provision of coffee via a mobile London taxi; catering services in respect of artisan bread, cakes and sandwiches provided at events.

56. I find that the use shown by the opponent overwhelmingly relates *to the provision of coffee via a mobile coffee shop / taxi*. Accordingly, the services would be fairly described by the average consumer as *provision of coffee via a mobile London taxi*.

57. Therefore, a fair specification for the earlier mark is:

Class 43 Provision of coffee via a mobile London taxi.

**Section 5(2)(b)**

58. Sections 5(2)(b) and 5A of the Act states that:

“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.

[...]

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.”

## **Relevant law**

59. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

### 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**

60. In light of my findings above, the competing services are as follows:

| Opponent's services  | Applicant's services   |
|--|--|
| <u>Class 43</u><br>Provision of coffee via a mobile London taxi. | <u>Class 43</u><br>Cafe services; Cafeteria services; Cafeterias; Catering in fast-food cafeterias; Catering services for company cafeterias; Providing food and drink in Internet cafes; Self-service cafeteria services; Serving food and drink in Internet cafes. |

61. 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.”

62. I bear in mind the decision in *Gérard Meric v OHIM*,<sup>8</sup> (*Meric*) in which 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 fur*

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<sup>8</sup> Case T- 133/05.

*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”.

63. Also the decision in *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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”.

64. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

65. With regard to the similarity of the services, in its counterstatement the applicant submits that they are not similar.

66. In its submissions,<sup>9</sup> the opponent submits the following in regard to the similarity of the services:

“The goods that are being sold by both parties are identical insofar the applicant and the opponent both sell coffee, both as beans, ground or in a cup of coffee direct to the customer or as a trade supplier.

There is a strong likelihood of confusion. The signs are very similar combined with identical coffee goods and similar services resulting in a likelihood of confusion on the part of the public.”

Catering in fast-food cafeterias; Catering services for company cafeterias

67. Broadly speaking, catering services are concerned with the provision of food and beverages at a remote site, or a site such as a hotel, business premises, festival, or wedding, etc. I find that the above contested catering services share a degree of similarity with the opponent’s *provision of coffee via a mobile London taxi*. The services share a similar nature and purpose, and trade channels and end users may coincide. Consequently, I find that there is a low degree of similarity between the services.

Cafe services; Cafeteria services; Cafeterias; Providing food and drink in Internet cafes; Self-service cafeteria services; Serving food and drink in Internet cafes

68. In general, the primary purpose of the contested services is the supply of food and beverages to customers, for consumption on or off the premises. There is therefore a degree of similarity in purpose between the above contested services and the

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<sup>9</sup> Submissions in lieu of a hearing, dated 15 March 2024.

opponent's *provision of coffee via a mobile London taxi*. The users will likely be the same. Regardless of how customers of the applicant's services actually obtain the services, I consider that there will be some similarity in the method of use and nature of the service, in that the services at issue are both concerned with, amongst other things, the provision of drinks, albeit at different types of establishments, and will be sought by the user in the ordinary way, i.e. simply ordering them from a till. Furthermore, the services can be in competition. Consequently, I find that there is a high degree of similarity between the services.

### **The average consumer and the nature of the purchasing act**

69. 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”.

70. The services at issue are those related to the provision of food and drink, for which the average consumer is a member of the general public, however in the case of catering services, the average consumer will also likely include business users. The selection of the services is predominantly visual on the basis that they may be chosen after seeing shop fronts, signage and advertising material such as flyers and menus. Word-of-mouth recommendations also play a role and so there will also be an aural element to the selection. The services will be used fairly frequently by the general public and will vary in price according to the establishment in which the services are offered and the particular food and drink offered by those establishments. Sometimes the consumer will need to find something to eat very quickly, whilst on another occasion, they will make a more considered choice, taking account of the range of

options on the menu, the ingredients used, the cleanliness of the restaurant, takeaway outlet or coffee shop, etc., and whether the services cater for any dietary requirements that the consumer has. Accordingly, I consider that a medium degree of attention will be paid during the purchasing process.


### **Comparison of marks**

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

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

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

73. The marks to be compared are:

| Opponent's mark              | Applicant's mark   |
|------------------------------|--|
| The Black Cab Coffee Company |  |

74. With regard to the similarity of the marks, in its counterstatement the applicant states:

“Both marks are significantly different and for this reason there a no grounds at all for complete identity OR likelihood of confusion. First of all the 2 marks differ in their nature; the trademark of the opponent is a word mark and contains 5 words written out in full, with no specific font or design. The trademark being opposed is a figurative / design trademark with a specific design, font, colour and arrangement – with prominent letters being B, L and K.

Both these marks alongside each other are completely different and do not and cannot cause any confusion to any viewer or consumer.

WE ENTIRELY DISAGREE THAT THE TRADEMARKS IN QUESTION ARE IDENTICAL OR "VERY SIMILAR" TO CAUSE CONFUSION.

We are confident that the opponent can continue to carry on their business without being impacted by our brand and that the consumer will be able to easily distinguish between their words mark and the design of the mark we are registering. Further to this our mark intends to clearly trademark the font, size, boldness and arrangement and is distinctive in its own right. Whilst a significant part of our business is the retail of our roasted beans it is imperative, we protect our private blend and roasted single origin beans under our distinctive design trademark.”

75. With regard to the similarity of the marks, in its submissions,<sup>10</sup> the opponent states the following:

“It is arguable there is a clear case of double identity. Whilst the sign is not identical, they are very similar and therefore could be interpreted as being identical.

[...]

There is a strong likelihood of confusion. The signs are very similar combined with identical coffee goods and similar services resulting in a likelihood of confusion on the part of the public.

[...]

There is a clear similarity between the marks. In order for the Intellectual Property Office to determine whether the applicant and the opponent’s trade marks are similar, it must make an overall assessment of the visual, phonetic and conceptual similarities between The Black Cab Coffee Company and BLK Cab Coffee, based on the overall impression each of them gives, and bear in mind their distinctive and dominant components.

The Black Cab Coffee Company and BLK Cab Coffee share strong phonetic and visual similarities. They also have strong conceptual similarities by reference to selling the same goods and providing similar services rendering the marks similar to the average consumer.”

### **Overall impression**

76. The opponent’s word-only mark comprises the ordinary dictionary words ‘The Black Cab Coffee Company’ presented in standard upper and lower-case letters. The overall impression is contained in the mark as a whole, however, the words ‘The’ and

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<sup>10</sup> Submissions in lieu of a hearing.

'Company' will merely be perceived as a company identifier and therefore have no distinctiveness. As such, I find the distinctive elements of the mark to be the words 'Black Cab Coffee'.

77. The applicant's figurative mark contains the letters 'BLK' presented in large, bold, white uppercase letters. The letters are followed by a figurative full-stop element resembling a white coffee bean. The letters and coffee bean device are underlined in white. Positioned below this line are the words 'by BLK CAB COFFEE', which are presented in smaller white text, with the word 'by' being notably smaller than 'BLK CAB COFFEE'. The 'BLK CAB' element is presented in bold type. The words and figurative elements all sit upon a black rectangular background. I find that the initial 'BLK' element to be the most dominant element of the mark due to its size and position within the mark. Due to their size, the words 'BLK CAB COFFEE' will be slightly less dominant. However, these words still contribute to the overall impression of the mark as they will be perceived as a reference to the indicator of origin for the services at issue. I find that the coffee bean full stop element, reinforces the 'coffee' message in the mark. Due to its size, the word 'by', along with the white line and black rectangular background elements will have little impact on the consumer.

78. With regards to the 'BLK' elements in the mark, I consider that the majority of consumers will likely perceive these letters as an abbreviation for the word 'BLACK'. In my view, this is reinforced by the fact that 'BLK' will, in the contested mark, also be viewed in combination with the word 'CAB'. That said, I am also aware that a proportion of consumers will not perceive 'BLK' in this way, but rather will perceive this element merely as three random letters with no particular meaning in relation to the services at issue.

### **Visual similarity**

79. Both marks contain the words 'Cab Coffee / CAB COFFEE'. The marks are visually different in that the opponent's mark contains the additional words 'The Black' positioned at the beginning of the mark, and the word 'Company', positioned at the end of the mark; the applicant's mark contains the additional letters 'BLK' (twice), shown in white, along with a white line and what appears to be a figurative white coffee

bean, which are all placed upon a black rectangular background. Whilst none of these elements are identically replicated in the opponent's mark, I bear in mind that the letters 'BLK' all appear in the word 'Black' present in the opponent's mark. Accordingly, weighing up the similarities with the differences, keeping in mind that both trade marks contain the words 'Cab Coffee / CAB COFFEE', I find the marks to be visually similar to a low degree.

### **Aural similarity**

80. The opponent's mark is made up of common English language words and will be pronounced accordingly, i.e. 'The Black Cab Coffee Company'. Whilst I acknowledge that some of the elements contained in the mark may be regarded as descriptive, this does not in itself render those elements as aurally invisible.<sup>11</sup> Similarly, the words 'by' and 'CAB COFFEE', in the applicant's mark, being common English language words, will also be pronounced accordingly. Whilst I acknowledge that these elements are smaller than the 'BLK' element, I am of the view that they will be pronounced because they are the indicator of origin, i.e. 'BLK By BLK CAB COFFEE'. With regards to the 'BLK' elements in the applicant's mark, I am of the view that the majority of consumers will likely perceive these letters as an abbreviation for the word 'BLACK' and will therefore pronounce this element accordingly. Furthermore, I also bear in mind that if pronounced as a word, 'BLK' would be aurally near identical to the pronunciation of 'BLACK', on the basis that removing the letters 'A' and 'C' from the word 'BLACK' will make very little aural difference. However, for the proportion of consumers who do not perceive the letters as an abbreviation for 'BLACK', they will likely pronounce the letters as 'bee-el-kay'. The figurative elements in the applicant's mark would not be articulated. Taking this into account, whilst bearing in mind the overall impression of the marks, I find that for those consumers that perceive the letters 'BLK' in the applicant's mark as an abbreviation for the word 'BLACK', the marks will be aurally similar to at least a medium degree. However, for those consumers that merely perceive this element as the letters 'B-L-K', I find the marks to be aurally similar to a low degree.

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<sup>11</sup> *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22)

## Conceptual comparison

81. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

82. The only elements in the marks that will carry any identifiable concept are the words within them and the coffee bean device element present in the applicant's mark.

83. Both marks contain the ordinary dictionary word 'Coffee / COFFEE' which will be perceived as reference to a type of beverage.

84. The ordinary dictionary word 'Black' in the opponent's mark will be perceived as reference to a specific dark colour. However, when read in context, namely when combined with the word 'Cab' ('black-cab'), it will likely be perceived as a reference to a particular type of taxi that originated on the streets of London. These cabs are black in colour and have a distinctive look, due to their high ceilings and curved sides. The same can also be said for those consumers who perceive the letters 'BLK' in the applicant's mark as being an abbreviation for the word 'black'. However, for those consumers who do not perceive the letters 'BLK' as an abbreviation for the word 'black', they will likely perceive 'BLK' simply as three random letters with no particular meaning in relation to 'CAB COFFEE' or the services at issue.

85. With regards to the words 'The' and 'Company' present in the opponent's mark, these will merely be perceived as a company identifier. Similarly, when combined with the words 'BLK CAB COFFEE' the word 'by' in the applicant's mark, will likely be perceived as an identifier regarding the origin of the services at issue.

86. As previously stated, the figurative full stop element in the applicant's mark will likely be perceived as a representation of a stylised 'coffee bean', especially bearing in mind that the word 'coffee' is also present in the mark.

87. Accordingly, I find that the opponent's mark creates the concept of a company called 'Black Cab Coffee'. Similarly for those consumers who perceive the letters 'BLK' in the applicant's mark to be an abbreviation of the word 'black', the mark will create the concept that the services in question originate from a company or organisation called 'BLACK ('BLK') CAB COFFEE'. Whilst I recognise that the marks contain additional elements namely 'The' and 'Company' in the opponent's mark, and the word 'by' in the applicant's mark, these elements do not detract from that concept, nor do they add a different concept. Accordingly, I find the marks to be conceptually identical.

88. However, for consumers who merely perceive the letters 'BLK' in the applicant's mark as three random letters with no apparent meaning, I find the marks to be conceptually similar to a low degree due to the shared words, 'Cab Coffee / CAB COFFEE', none of which carry a particularly strong concept in the context of the marks as wholes.

### **Distinctive character of the earlier mark**

89. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>12</sup>

"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-2779, paragraph 49).

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<sup>12</sup> Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

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).”

90. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

91. The earlier mark comprises the words ‘The Black Cab Coffee Company’. The services at issue are the provision of coffee via a mobile London taxi. Accordingly, the mark may be considered as highly allusive if not descriptive as the mark merely describes coffee that can be obtained from a black cab. However, I bear in mind that this service is a somewhat novel concept, as I do not have any evidence before me that would suggest that this type of service is widely used. Accordingly, I consider the opponent’s mark to be inherently distinctive to between a low to medium degree.

92. I note that in its statement of grounds and submissions in lieu of a hearing, the opponent submits that over the years, a considerable sum of money has been spent on marketing and promoting the earlier mark which has resulted in their mark becoming widely recognised across the UK and as such, has an established reputation in the UK within the relevant industry and with consumers. However, the opponent has not specifically pleaded that its mark has acquired enhanced distinctive character through use. Nevertheless, as the opponent has filed evidence of use, as summarised

above, I will make a finding in relation to enhanced distinctiveness for the sake of completeness.

93. The overall turnover figures provided by the opponent demonstrate a modest turnover during the relevant period, taking into account the services at issue. However, I am of the opinion that these sales, supported by the invoices provided, do not represent a particularly significant share of what is undoubtedly an extensive market. Furthermore, whilst I recognise that the use shown has taken place over several years in areas in and around London, the advertising expenditure and marketing activities appear relatively low. Taking all of this into account, I find that there is nothing in the evidence before me to suggest that the opponent's mark has acquired an enhanced degree of distinctiveness in relation to the services at issue. Accordingly, I am of the view, that the opponent's evidence falls short of what would be required to show that the distinctiveness of the mark has been enhanced through use for the services at issue.

### **Likelihood of confusion**

94. 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. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

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

96. Earlier in the decision I concluded that the respective marks are visually similar to a low degree, either aurally similar to at least a medium degree or similar to a low degree, and either conceptually identical or similar to a low degree. I have found the opponent's mark to be inherently distinctive to between a low to medium degree, but I bear in mind that weak distinctiveness does not preclude no confusion.<sup>13</sup> Furthermore, I have found that the opponent's evidence does not show that the distinctiveness has been enhanced through use. I have found that similarity between the parties' services range from similar to a low degree to highly similar. The average consumer for the services will be either a member of the general public or a business user, who will pay a medium degree of attention during the selection of the services at issue. I am of the view that the purchasing process for the services would be predominantly visual in nature, though I have not discounted aural considerations.

97. If, as is my view, consumers read the 'BLK' elements in the applicant's mark as 'black', they will perceive the mark as a whole as 'BLACK by BLACK CAB COFFEE'. Therefore, notwithstanding the principle of imperfect recollection, I consider that the applicant's mark and the opponent's mark 'The Black Cab Coffee Company' are likely to be mistakenly recalled or misremembered as each other, bearing in mind the aural similarities and the shared conceptual hook. Accordingly, taking all of this into account, when used on the services at issue, irrespective of their level of similarity, I consider there to be a likelihood of direct confusion.

98. However, if I am wrong on this, I will now go on to consider indirect confusion.

99. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

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<sup>13</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

100. Further, 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.

101. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

102. The opponent's word mark is 'The Black Cab Coffee Company'. The applicant's figurative mark contains the letters and words 'BLK by BLK CAB COFFEE'. As previously mentioned, I am of the view that upon seeing the applicant's mark, the majority of consumers are likely to perceive the 'BLK' elements as an abbreviation of the word 'BLACK', and therefore perceive the mark as a whole as 'BLACK, by BLACK CAB COFFEE'. As such, I find that it would be reasonable to assume that the average consumer would likely perceive this similarity between the marks, merely as the same company presenting its mark in two slightly different ways. Whilst I acknowledge that there are differences between the marks, as previously stated, the words 'THE' and 'COMPANY' present in the opponent's mark, and the word 'by' in the applicant's mark, though not negligible, do not add distinctiveness to the marks and would be seen merely as an indication as to the origin of the services. Furthermore, I find that the coffee bean full stop element in the applicant's mark, merely reinforces the 'coffee' message, and due to its size and lack of distinctive character, the word 'by', along with the figurative white line and black rectangular background elements will have little impact on the consumer. I am therefore satisfied that consumers would assume a commercial association between the parties, or sponsorship by one of the parties, due to the shared element 'BLACK CAB COFFEE' and 'BLK (BLACK) by BLK (BLACK) CAB COFFEE'. Consequently, taking all of this into account, when used on the services at issue, irrespective of the level of similarity of those services, I consider there to be a likelihood of indirect confusion.

## **Conclusion**

103. The opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

## **Costs**

104. The opponent has been successful in its opposition and is entitled to a contribution towards its costs. The relevant Tribunal Practice Notice for these

proceedings is TPN 2/2015, which states that costs in an opposition brought under the fast-track procedure are capped at £500 (excluding official fees). Accordingly, I award costs to the opponent on the following basis:

|  |             |
|--|-------------|
| Official fee   | £100        |
| Preparing the notice of opposition and considering the counter statement | £200        |
| Preparing evidence   | £200        |
| Preparing written submissions in lieu                                    | £100        |
| <b>TOTAL</b>   | <b>£600</b> |

105. I therefore order Kaniz Samir-Mostaffa to pay The Black Cab Coffee Company the sum of £600. The above sum should 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 31<sup>st</sup> day of July 2024**

**Sam Congreve**  
**For the Registrar**