

BL O/0646/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 4092516

IN THE NAME OF HOT BIRD LTD

IN RESPECT OF THE FOLLOWING TRADE MARK:

Hot Bird

IN CLASSES 25, 29, 30, 32, 35 AND 43

AND

IN THE MATTER OF AN APPLICATION FOR INVALIDATION THERETO

UNDER NUMBER 508596

BY HOT BIRDS CATERING LTD

Background and pleadings

1. HOT BIRD LTD (“the proprietor”), is the owner of the trade mark shown on the cover page of this decision (“the contested mark”) UK trade mark (“UKTM”) number 4092516. The contested mark was filed on 27 August 2024 and registered on 22 November 2024. It stands registered for the following goods/services:¹

Class 25 Clothing; footwear; headgear.

Class 29 **Chicken burgers; Fried chicken;** Waffle fries; Potato fries; **Chicken wings; Chicken legs; Chicken pieces;** Chips [french fries]; Milkshakes; **Chicken.**

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; **prepared meals;** pizzas, pies and pasta dishes.

Class 32 Non-alcoholic drinks; Cola drinks; Juice drinks; Fruit juice drinks; Colas [soft drinks].

Class 35 **Retail services relating to food.**

Class 43 **Providing food namely, fried chicken and chicken burgers; Bar and restaurant services; Bistro services; Catering of food and drink; Catering services; Fast food restaurants; Information and advice in relation to the preparation of meals; Mobile catering; Take away food and drink services; Take away food services; Take-away fast food services.**

2. On 10 March 2025, Hot Birds Catering LTD (“the applicant”) applied to partially invalidate the contested mark based upon sections 47 and 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”).

¹ Only those terms in bold are contested by the applicant.

3. In its statement of grounds, in respect of its claim under 3(1)(b), the applicant states:

“The Invalidity Applicant submits that the mark “Hot Bird” (which clearly, refers to cooked and/or spicy chicken), when used in respect of the Contested Goods and Services, cannot serve to distinguish the goods and services of one undertaking from those of all other undertakings. The overall impression of the average consumer of the contested Goods and Services that encounters the mark “Hot Bird” would be that it refers to characteristics of the goods and services (i.e. that they are, or relate to, food consisting of cooked and/or spicy chicken), and not that it denotes the trade origin of those goods and services.”

4. In its statement of grounds, in respect of its claim under 3(1)(c), the applicant states:

“The Invalidity Applicant submits that, in respect of the Contested Goods and Services, the Contested Registration consists exclusively of signs or indications which may serve in trade to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of the Contested Goods and Services.”

5. The proprietor filed a counterstatement denying the claims made.

6. The proprietor is represented by Lewis Silkin LLP.² The applicant is represented by CMS Cameron McKenna Nabarro Olswang LLP. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of the papers filed.

Evidence and Submissions

7. The applicant filed evidence-in-chief in the form of the witness statement of Humza Ahmed dated 29 July 2025, which is accompanied by 2 exhibits (HA1 and HA2). Mr Ahmed is an owner of the applicant company and has been responsible for the operation of its business since 22 September 2023.

² The proprietor was initially represented by Freeman Harris, however, a TM33 was filed on 20 May 2026 changing the proprietor’s representative to Lewis Silkin LLP.

8. The proprietor filed evidence in the form of the witness statement of Mohammed Salman Fayyaz Qureishi dated 29 September 2025, which is accompanied by 1 exhibit. Mr Qureishi is the director of Hot Bird Ltd and the registered proprietor of the contested mark.

9. The applicant filed evidence in reply in the form of a further statement of Mr Ahmed dated 1 December 2025, which is accompanied by 2 exhibits (HA3 and HA4).

10. The applicant filed written submissions in lieu dated 22 December 2025.

11. The proprietor filed written submissions in lieu dated 5 January 2026.

12. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate to the extent that it is necessary in my decision.

Relevance of EU Law

13. 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 which predate the UK's withdrawal from the EU.

Legislation

14. Sections 3(1)(b) and 3(1)(c) read as follows:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) [...]

(b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it”.

15. Section 3(1) has application in invalidation proceedings by virtue of section 47 of the Act, which states:

“47(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered. [...] (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only. (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made. Provided that this shall not affect transactions past and closed.”

16. The relevant date for assessment under 3(1)(b) and 3(1)(c) is the date of filing of the contested mark, i.e. 27 August 2024.

17. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still to be objectionable under section 3(1)(b).³

³ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25]

18. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁴ In the present case, I consider the parties' goods/services to be day-to-day consumable products, being foodstuffs and the sale of the same, aimed at the general public. The goods/services will be purchased/used fairly frequently, and the goods will be relatively inexpensive. Consideration may be given to the content of the food, taste and its nutritional value. On the whole, I would expect the general public to pay a fairly low degree of attention during their selection.

EVIDENCE ASSESSMENT

Evidence in chief - Witness statement of Mr Humza Ahmed for the applicant

19. I take the following from Mr Ahmed's evidence:

- Mr Ahmed has provided dictionary definitions for the words used within the contested mark, which are as follows:⁵

“2.1.1 The word “hot”, as defined by the Cambridge English Dictionary: *“having a high temperature” or “used to describe food that causes a burning feeling in the mouth...[for example] hot, spicy food”*

2.1.2 The word “bird”, as defined by the Cambridge English Dictionary: *“a creature with feather and wings, usually able to fly”.*”

- Mr Ahmed states that the words “Hot” and “Bird” are commonly used within the restaurant business. Mr Ahmed has provided a list of restaurants within the UK which use or have used the words, and he states that:

“demonstrating that those words are in common usage in the restaurant business as a means of conveying to consumers the nature of the goods and

⁴ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

⁵ Exhibit HA1

services provided at those restaurants (i.e. some variation of foods consisting of spicy and/or cooked chicken).”⁶

I note that the list of restaurants provided include the names “Blazin’ Bird”, “Hot Chick”, “Hot Roosters”, “The Hot Rooster”, “Chicken Hot” and “Bird” (according to the evidence I have before me from Google, the latter is permanently closed). Mr Ahmed states that:

“The above demonstrates that it is common practice for restaurants (and takeaway businesses), and in particular those serving fried chicken, to adopt descriptive names that make use of the words “Hot” or “Bird” to describe the nature of the goods and services that they offer”.⁷ I note that the screenshots were taken between 17 July 2025 and 22 July 2025. One Tik Tok post related to “Blazin’ Bird” is dated 31 March 2024 and I have before me a Facebook post relating to “Hot Roosters” which is dated 13 May 2021. The remainder of the posts are undated.

Evidence in chief - Witness statement of Mr Mohammed Salman Fayyaz Qureishi for the proprietor

20. I take the following from Mr Qureishi’s evidence:

- Mr Qureishi states as follows:

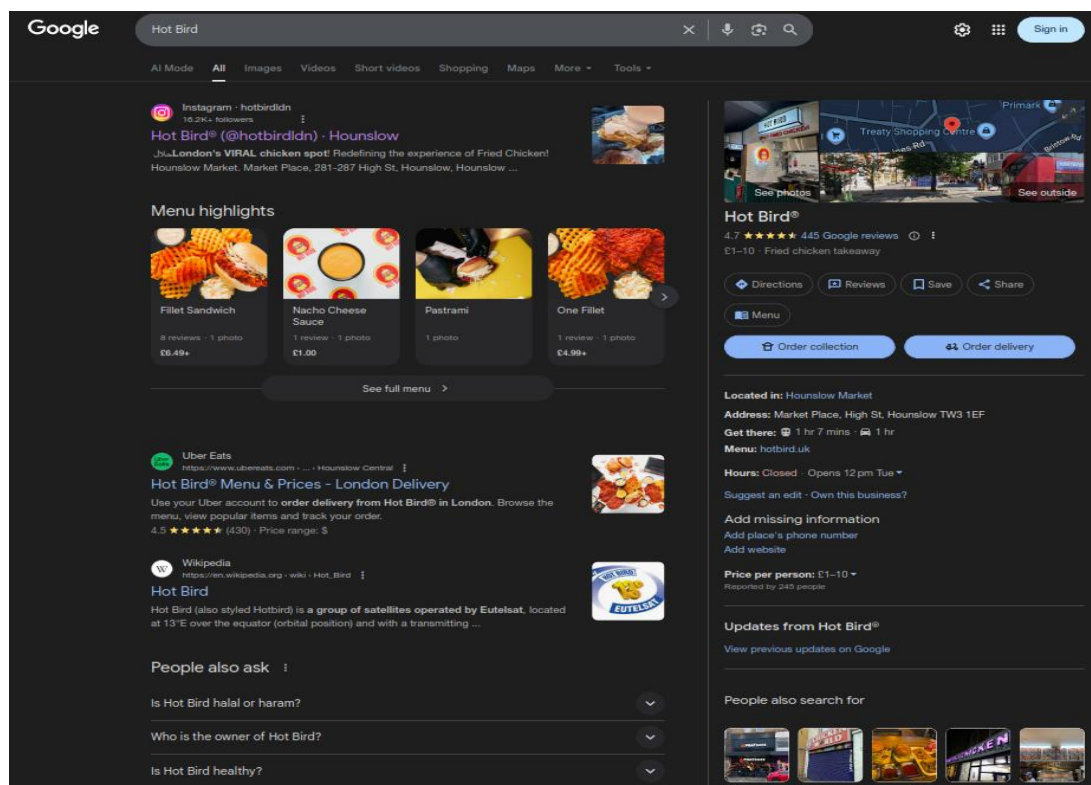
“The witness statement argues that the term “BIRD” is commonly used in the restaurant industry to describe chicken. I disagree with this assertion for the following reasons:

- i. The term “BIRD” is not a common descriptor used by the average consumer to refer to chicken as a food product. While it may be used colloquially in some contexts, it is not a term that the average consumer would immediately associate with chicken in the context of food services.

⁶ Witness statement of Mr Ahmed, para 3.1

⁷ Witness statement of Mr Ahmed, para 3.2

- ii. The combination of "HOT" and "BIRD" creates a unique and memorable mark that is not purely descriptive. The average consumer encountering the mark "HOT BIRD" would perceive it as an indicator of trade origin, rather than a mere description of the characteristics of the goods or services.”⁸
- Mr Qureishi states that the contested mark has acquired distinctiveness through use and has become synonymous with his business. In support of this assertion, he has provided a Google search for “Hot Bird”⁹ which he states “is strongly associated with my business, further evidencing the widespread recognition and public association of the Trade Mark with the goods and services I provide.”¹⁰



- Mr Qureishi states that since the launch of his business, the contested mark has gained significant traction on social media and other platforms, with

⁸ Witness statement of Mr Qureishi, para 3b

⁹ Exhibit 1

¹⁰ Witness statement of Mr Qureishi, para 6b

consumers travelling from various locations across the UK to attend the restaurant. I have no evidence before me in support of this contention.

Evidence in reply - Witness statement of Mr Humza Ahmed for the applicant

- Mr Ahmed disputes the proprietor's contention that the contested mark has acquired distinctiveness. He states as follows:

"2.1 Qureshi 1 states that HOT BIRD has "acquired a substantial degree of distinctiveness through extensive use" and is "synonymous" with his business, but provides no evidence capable of establishing acquired distinctiveness under the Trade Marks Act 1994. There is no dated, verifiable material showing the scale, geography, duration or nature of use prior to the filing date, and no evidence of market penetration, turnover, advertising spend, marketing reach, consumer recognition, or independent trade recognition. In particular, there is no evidence such as:

- (a) dated website analytics or website archive extracts showing continuous use over time;
- (b) sales figures, invoices, or distribution data;
- (c) advertising budgets, media plans, impressions or reach metrics;
- (d) social media analytics with dates, follower growth over time, engagement rates, or targeted geography;
- (e) press coverage, independent reviews, awards, or trade testimonials evidencing consumer perception; or
- (f) market survey evidence, or any other reliable evidence of the relevant public's perception.

2.2 Instead, Qureshi 1 relies merely on assertion and exhibits a single Google search result (Exhibit 1 to Qureshi 1) which is incapable of demonstrating acquired distinctiveness.”¹¹

I agree with the applicant’s above assessment of the evidence provided in respect of acquired distinctiveness.

- Mr Ahmed also disputes the proprietor’s comments regarding the way in which the mark will be interpreted, stating that no evidence has been filed either to support Mr Qureshi’s assertions, or to rebut the evidence filed in his first witness statement.
- In order to dispute Mr Qureshi’s contention that upon encountering the term “bird” in the context of food services, the average consumer is unlikely to associate it with chicken, Mr Ahmed has filed a copy of a Welsh Government report¹² in which it states:

“Chicken accounts for 91% of UK poultry production by number of birds, with turkey accounting for around 4% and other species such as ducks and geese etc. the remaining 5% (Defra 2014).”

DECISION

Section 3(1)(c)

21. I will start with the section 3(1)(c) ground because this goes to the heart of the applicant’s case, which is that the proprietor’s mark has a descriptive meaning in relation to the goods/services in the registration, as it is used to identify food consisting of cooked and/or spicy chicken, and the sale thereof.

22. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J.

¹¹ Witness statement of Mr Ahmed, para 2.1

¹² Exhibit HA4

(as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods

or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it

will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

23. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].

24. The words used within the proprietor’s mark are English dictionary words, and I have no doubt that the consumer will be familiar with the same. The definition of the words in the mark (according to the Cambridge English Dictionary) has been set out in Exhibit HA1 of the applicant’s evidence in chief and is broken down above. In this instance, I consider that the average consumer is likely to understand the mark as having a double meaning. They will understand “Hot” as meaning something having a high temperature or being spicy, and they will understand “Bird” to be a type of poultry. However, I believe that there is also a colloquial meaning which will be understood by the average consumer, in which “Hot” will be interpreted as meaning attractive, and “Bird” is a well-known slang word for describing a woman.

25. I bear in mind that for any mark to be considered descriptive within the meaning of section 3(1)(c) there must be a direct link between the mark and the goods to such an extent that consumers would *immediately* see it as descriptive of a characteristic of the goods at issue. The proprietor submits that the mark “is an unusual combination of words. The average consumer, faced with the Mark would undertake some mental gymnastics to reach the allegedly descriptive meaning contended for by the Applicant”, and that as such it cannot be said to be directly descriptive of the goods.

26. I find that the contested mark does not explicitly set out the nature/purpose of the goods or services. The proprietor submits “whilst ‘HOT CHICKEN’ would plainly be descriptive of spicy cooked chicken, ‘HOT BIRD’ is not. It alludes to but is not exclusively descriptive of the Contested G&S” and I agree with this submission. I do

not consider that BIRD is a common descriptor used by the average consumer to refer to chicken as a food product. The average consumer has to undertake a number of mental steps to connect the mark with the purpose of the goods or services.

27. I have found that “Hot Bird” will be understood by the average consumer as set out above. I believe that the average consumer will understand the mark to be suggestive of cooked/spicy food or restaurant services, and as a result, the mark will be allusive. However, if the average consumer understood the mark as relating to a woman who is attractive, the average consumer is highly unlikely to make the same connection. As a result, I do not consider that the meaning of the mark would be immediately clear but rather would provoke further thought.

28. There is evidence of the words “Hot” and “Bird” being used by various third party companies, but I note that in all of the evidence, the words do not appear together. The following examples are a selection of those provided: “Blazin’ Bird”, “Hot Chick” and “Hot Roosters”. In this regard, I keep in mind the principle behind section 3(1)(c), which is to keep descriptive signs relating to one or more characteristics of the goods or services free to use by all traders offering such goods and services. However, I have no evidence before me of the words in the contested mark being presented together. I am also not satisfied, on the basis of the evidence before me, that there was any particular need to keep the mark free for the legitimate future use by other traders at the relevant date. As such, the evidence of third-party use is not, to my mind, sufficient to dispel the primary finding I have reached. I make this finding in respect of all the contested goods and services. The ground fails.

Section 3(1)(b)

29. I now turn to the application under section 3(1)(b) of the Act. I acknowledge that section 3(1)(b) and 3(1)(c) are distinct grounds with different general interests underlying them. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. However, as the only claim made under this ground was that the mark was descriptive of the characteristics of the goods/services, it does not take the applicant any further than section 3(1)(c). As such, this ground also fails.

CONCLUSION

30. The application to partially invalidate UK trade mark registration number **4092516** under sections 47 and 3(1)(b) and (c) of the Act is unsuccessful in its entirety and, subject to any successful appeal, it may remain registered.

COSTS

31. The proprietor has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice ("TPN") 1/2023. In line with that TPN, I award costs to the proprietor as follows:

Considering the other side's statement and preparing a counterstatement:	£250
Preparing evidence and considering and commenting on the other side's evidence	£700
Considering the other side's written submissions in lieu and preparing written submissions in lieu:	£350
Total:	£1,300

32. I order Hot Birds Catering LTD to pay HOT BIRD LTD the sum of £1,300. This 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.

Dated this 23rd day of July 2026

LA Bailey

For the Registrar,

The Comptroller-General