BL O/0960/26

IN THE MATTER OF THE TRADE MARKS ACT 1994

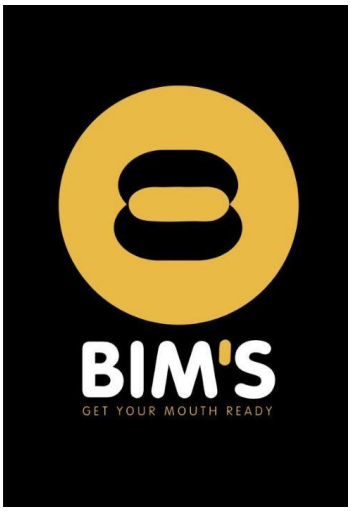
UPON APPEAL TO THE APPOINTED PERSON

IN THE MATTER OF CA504462, CA504464, CA504465 IN RELATION TO TRADE MARKS: UK3407316, UK3546686, UK918324246

DECISION

INTRODUCTION

1. This is an appeal from a decision of the hearing officer (Mr Bryant) dated 18th November 2024 in one of a series of trade mark disputes which concern the use of a range of marks which have as key word elements 'BIM'S' or 'BIMS'.
2. Put broadly, the appellant, BIMS African Foodstore Limited ("BIMS" – referred to in the decision as "Party B"), seeks to cancel the registration of trade mark No. UK918324246 in the name of Bims Walthamstow Limited ("BIM'S" or "Party A"):



in respect of the following services:

> **Class 43:** Fast-food restaurant services; Providing food and drink; Providing food and drink in restaurants and bars; Providing food and drink in food markets; Restaurant services for the provision of fast food; Takeaway food and drinks services; Food preparation services; Services for providing food and drink; Serving food and drinks; Providing prepared meals; Contract food services.

3. This mark was referred to as Party A's Third Mark (for reasons explained below) and for convenience here is referred to as the Challenged Mark.
4. The basis of the challenge was BIMS's earlier trade mark:



previously registered in classes 29, 30 and 33 in respect of

> **Class 29**: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; preserved or dried seeds; preserved or dried nuts; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; pulses, beans and lentils; soya beans; black eye beans.
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> **Class 30**: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces [condiments]; spices; ice.
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> **Class 33**: Alcoholic beverages [except beers]: palm wine.

5. This mark is conveniently referred to as BIM'S Earlier Mark. The decision under appeal and its related decisions involved multiple aspects but the key part for this appeal is the determination by the hearing officer that, despite certain similarities, there was insufficient likelihood of confusion for the challenge to registration to the Challenged Mark to succeed under section 5(2)(b) of the Trade Marks Act 1994 and that the case based on passing off was also not made out.

The decision under appeal in context

6. The hearing officer found a likelihood of confusion and passing off in relation to most of the restaurant/food-service activities covered by BIM'S other word marks. However, the opposition failed for its catering consultancy services and failed entirely against the Challenged Mark. The basis of the case overall was that BIM'S owned three registrations:

1. **No. 3546687, BIM'S**, covering various restaurant, takeaway, food preparation and related services.
2. **No. 3407316, BIMS**, covering fast-food restaurants, food/drink provision, takeaway and food-preparation services.
3. **No. 918324246**, the Challenged Mark in issue on this appeal, also covering Class 43 restaurant and related services.

7. The hearing officer regarded 'BIMS' as the dominant and distinctive part of BIMS' Earlier Mark. He thought that depiction of Africa in that mark possessed some distinctiveness but was also somewhat allusive of African-origin or African-style food. He held that the position differed between the word marks and the Challenged Mark broadly on the basis that its additional graphic features reduced the visual similarity with BIMS' Earlier Mark to a low degree. He held that the Earlier Mark had a medium level of inherent distinctiveness. BIMS also put forward substantial evidence of its trading history. The evidence indicated that its BIMS food store opened in London in 1995, sold African produce, operated as a wholesaler and sold numerous BIMS-branded products. Its recorded annual revenues included approximately: £1.04m in 2014; £651k in 2015; £504k in 2016; £515k in 2017; £525k in 2018; and £585k in 2019.
8. The hearing officer regarded this as evidence of a longstanding business, but modest in the context of the enormous UK food and drink market. Enhanced distinctiveness was therefore modest and confined to food and drink of African origin: the evidence did not show enhanced distinctiveness specifically for meat, fish or rice, which were the strongest goods for comparison with restaurant services which he considered.
9. Despite finding only low similarity between the goods and restaurant services, the hearing officer found a likelihood of direct confusion between BIMS' Earlier Mark and the two word marks for the relevant restaurant/food services. One reason was imperfect recollection. Consumers encountering the earlier mark could regard its Africa device as merely allusive to African food and principally remember the more distinctive 'BIMS' element. They could, in his view, therefore mistake BIMS/BIM'S restaurant services brand for BIMS' despite the difference between the specific retail food products and the restaurant and related services. The hearing officer also considered indirect confusion and reached essentially the same conclusion in that consumers noticing the differences could nevertheless believe the word marks represented a service provided by BIMS or an economically linked business.

10. However, the result was different for the Challenged Mark. In summary, the reasons were as follows: the graphical differences were sufficiently noticeable that there was no direct confusion. Nor was there indirect confusion: viewed as a whole, the logo was sufficiently different that consumers were unlikely to think the restaurant services came from BIMS or a connected undertaking. More specifically, the hearing officer concluded as follows with respect to the Challenged Mark (referred to here as "Party A's third mark":

Direct confusion

> "65. In respect of Party A's third mark, when comparing the visual differences to Party B's mark, they are greater and much less likely to go unnoticed, particularly when factoring in the difference created by the distinct figurative element of Party A's mark, I find that there is no likelihood of direct confusion."

Indirect confusion

> "72. I now consider whether there exists a likelihood of indirect confusion between Party B's mark and Party A's third mark. I have already found that the differences between the respective marks will not go unnoticed by the consumer. Whilst, to some Page 31 of 39 consumers, the figurative element of Party A's mark may create an impression of a burger in a bun, it is sufficiently stylised that its abstract nature will dominate and plays an integral part in identifying the origin of the services. Therefore, when considering the marks as a whole and the relative distance between the respective goods and services, I find that Party A's mark is sufficiently different to Party B's mark so that consumers are not likely to believe its services are provided by the same or linked undertaking as Party B's goods. When the different colour schemes of the respective marks are also taken into account, this puts further distance between the marks. The marks are sufficiently visually different that the consumer will put the presence of the BIM'S/BIMS element, present in both marks, down to no more than coincidence and will do no more than bring Party B's mark to mind."

Passing off

> "86. I also consider that the same outcome as found when considering the ground based upon section 5(2)(b) applies to Party A's third mark. The differences between the respective marks are sufficient that there will be no misrepresentation. Substantial members of the relevant public (i.e. customers and potential customers of Party B) would not be deceived into believing that the services provided under Party A's mark originated from Party B or a linked undertaking. This is likely to be so even in circumstances where Party A's services have an African theme."

11. Thus, the significance and commonality of the word BIMS or its aural equivalent was sufficient to prevent registration of the word marks where the word was the most significant element but not to prevent registration of the figurative mark, when the marks were taken as a whole, having regard to the fact that the designs were not particularly similar. The hearing officer made a careful evaluation of the similarity of the respective marks and reached nuanced conclusions as to the likelihood of confusion. A determination of that kind is resistant to being overturned on appeal unless there is a material error of principle or the decision is clearly wrong.

THE APPEAL

Approach to appeal

12. In *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, Arnold LJ said:

> "110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare *Magmatic Ltd v PMS International Group plc* [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge) , and see *Re Sprintroom Ltd* [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ) , which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin)."

13. I have also borne particularly in mind the further guidance from *Extreme Networks v Extreme E Ltd* [2024] EWCA Civ 1386, per Arnold LJ

> "31. It is common for hearing officers when assessing the similarity of goods or services to express their reasoning in highly compressed form. There are a number of reasons for this: first, their extensive experience in the field; secondly, comparison of goods or services is a routine exercise for them to have to undertake when writing decisions; thirdly, it is frequently necessary for them to have to undertake multiple comparisons in each decision; and fourthly, it is often the case that no evidence has been adduced by either party (leaving the hearing officer to rely upon their own knowledge and experience as a consumer) and that the parties have addressed the issue quite briefly in their submissions. In such circumstances the principles summarised by Lord Hamblen in *HA (Iraq) v Secretary of State for the Home Department* [2022] UKSC 22, [2022] 1 WLR 3784 at [72] apply *mutatis mutandis* to the hearing officer's evaluation:

> "It is well established that judicial caution and restraint is required when considering whether to set aside a decision of a specialist fact finding tribunal. In particular:
>
> (i) They alone are the judges of the facts. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. It is probable that in understanding and applying the law in their specialised field the tribunal will have got it right. Appellate courts should not rush to find misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently: see *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49; [2008] AC 678 per Baroness Hale of Richmond at para 30.
>
> (ii) Where a relevant point is not expressly mentioned by the tribunal, the court should be slow to infer that it has not been taken into account: see *MA (Somalia) v Secretary of State for the Home Department* [2010] UKSC 49; [2011] 2 All ER 65 at para 45 per Sir John Dyson.
>
> (iii) When it comes to the reasons given by the tribunal, the court should exercise judicial restraint and should not assume that the tribunal misdirected itself just because not every step in its reasoning is fully set out: see *R (Jones) v First-tier Tribunal (Social Entitlement Chamber)* [2013] UKSC 19; [2013] 2 AC 48 at para 25 per Lord Hope of Craighead."

14. Those points are particularly apposite because this appeal invites a fairly extensive re-evaluation of an experienced hearing officer's assessment, in some respects on the basis that his decision was "rationally unsupportable".

15. BIMS advances eight grounds of appeal which it is convenient to group some together and take some in a somewhat different order.

Ground 1 and its significance

16. The first ground of appeal is not opposed. It is common ground that the hearing officer ought to have included "coffee, bread, pastries and confectionery" in class 30 and "milk and milk products" in class 29 in his consideration of the relevant goods because the conditions in section 47(2A)(c) were not satisfied at the relevant date. The consequence is that the hearing officer did not compare the services in question against these goods and in particular "coffee", "bread" and "pastries and confectionery" and "milk" and "milk products". This is of significance because there was extensive evidence that suppliers of one or more products of this kind would often also operate cafes, restaurants or takeaways. Examples given were Hagen Dazs, Ben & Jerry's, Hotel

Chocolat, Nespresso, Laduree, Gails, Pizza Express, Pret, Starbucks and Costa. So, the consumer had been educated to expect that those supplying foodstuffs and drinks of these particular kinds may be likely also to operate outlets providing food and drink services under the same or very similar brand.

17. A similar but slightly less strong point applies to "sauces" where examples were given in evidence of Nandos, Cranks, Leon, Eat 17, BeFries, EcoPeace, GBK and Wagamama restaurants selling their brand of sauces in restaurants. There was evidence that BIMS itself sold "BIMS Kitchen" branded sauces.

18. The hearing officer evaluated the similarity of the respective goods and services in para. 23-38 of the decision. It is clear from the discussion there that he attributed significance to the fact that "meat" (which was the category of goods he regarded as BIMS' then best case) was unlike goods such as "coffee", "bread", "pastries and confectionary" in its propensity to be supplied in (for example) fast food outlets at least in raw form. He said (emphases added):

> "32. Mr Jacob relied upon the comments of Emma Himsworth QC (as she then was), sitting as the Appointed Person in J Sainsbury plc v Top Dog Eats Ltd (BL O/044/16) where she found that meat in Class 29 is a product prepared for consumption and will include goods ready to eat.1 Mr Jacob also referred to the findings in the Registry decision in PUKKA Trade Mark2 and submitted that, consequently, there was similarity between meat and Party A's services because the average consumer may choose either to purchase meat to cook or home, or alternatively, go out to eat such food, creating an element of competition between the goods and services. I remain unconvinced by these submissions. Ms Himsworth KC was at pains to point out that her comments were based upon unchallenged findings. It was not open for the Appointed Person to reconsider the first instance case and she may have reached a different conclusion in circumstances where the findings had been challenged. Consequently, this does not provide me with a persuasive precedent. In respect of the PUKKA Trade Mark decision, this is a first instance decision that is not binding upon me. Further, the hearing office was considering the similarity of prepared foods that are ready to eat and can form a meal in themselves, namely pies, to services relating to the consumption of food. In the current case, meat is a foodstuff that, even if cooked would generally only be one constituent of a meal. Pies may be selected as an alternative to eating at a catering venue whereas meat per se is not. Therefore, I do not believe that the case is on "all-fours" with the current case or that meat is as similar as pies are to the services."

19. The hearing officer therefore did not evaluate the question of confusion similarity using BIMS' potentially strongest cases. That was a material error (as BIM'S accepts).

20. In some cases, an error, while material, may not be of sufficient significance to merit overturning a decision (or, in this case, part of a decision) in respect of which it is made. That is not the case here since the error goes to a fundamental aspect of evaluation of the likelihood of confusion. For this reason, this appeal has to be allowed on Ground 1. I consider below whether BIM'S should be permitted to advance a fallback position.

Re-evaluation/remittal

21. The question arises as to the consequence of allowing the appeal. BIMS submits that the case should be decided by me rather than remitted. BIM'S does not oppose this course subject to my being satisfied that this is appropriate.
22. The general question of when a multi-factorial determination should be remitted to a first instance tribunal when a higher court has concluded that a decision is fundamentally wrong and the appellate tribunal is invited to re-make it is currently before the Supreme Court in the *Optis v. Apple* litigation (UKSC/2025/0144). That case was argued in June 2026 and the court may give wider guidance as to the circumstances in which there should be remittal. I therefore considered waiting until the Supreme Court's had handed down its decision but, given the time since the hearing and the limited probability of that guidance having a material impact on this case, I have concluded that it is not necessary to do so: sufficient factual findings have been made by the hearing officer in his helpful and comprehensive decision for it to be possible to make a re-evaluation without a real risk of injustice. Taking the decision myself does remove a further opportunity for appeal but this is a situation in which it is possible to make a sufficiently reliable decision for that to be a more limited concern.
23. I also have regard to the fact that this decision is in respect of a relatively minor part of the dispute as a whole which has already held that BIM'S word marks should not be registered because of a liability to cause confusion with BIMS Earlier Mark. It is also not clear that BIM'S is currently using the Challenged Mark in this form although it may be using a variant of it. So, it would be disproportionate to send the matter back to the hearing officer and would cause further delay.
24. I therefore propose to make the re-evaluation myself, albeit with close attention both to the decision of the hearing officer and the respects in which it is said that he went wrong in this appeal in the other ways addressed under Grounds 2-8.
25. There are some cases in which it is possible to undertake only a partial re-evaluation leaving all other findings untouched. In this case, I think it is preferable to undertake a

more intensive review because the issue of similarity of goods and similarity of marks both feed into the overall evaluation of likelihood of confusion as a result of complementarity. I have also reached the view that certain aspects of the hearing officer's approach to assessing the similarity of the respective marks is open to criticism while respecting the principles of appellate restraint set out in the *Extreme* case. The re-evaluation will therefore be undertaken using the hearing officer's analysis and structure as a basis but making appropriate adjustments where necessary.

EVALUATION

26. Section 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

27. The hearing officer set out the established principles at para. 27 of the decision derived from *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. They are uncontroversial and as follows:

    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.

The hearing officer's evaluation of similarity

28. As to similarity of goods and services, the hearing officer set out the relevant principles derived from *Canon* and *Treat* again uncontroversially. The hearing officer set out the respective goods and services and, as noted above, focussed on "meat" as the strongest basis for the case.
29. The hearing officer said (and I agree) that the services in respect of which the mark was registered can be summarised as describing, in various ways, the provision of food and drink and the preparation of food and meals.

30. The hearing officer went on to say that, all being services, they differed in nature from the goods in respect of which BIMS Earlier Mark was registered. He recorded the submission on behalf of BIMS that its best case was milk and milk products in Class 29 and coffee, bread, pastries and confectionery in Class 30. However, that was the case which the hearing officer (wrongly) rejected and did not consider.
31. There was then argument as to the applicability of the decision of Ms Emma Himsworth QC, sitting as the Appointed Person in *J Sainsbury plc v Top Dog Eats Ltd* (BL O/044/16) where she found that meat in Class 29 was a product prepared for consumption and will include goods ready to eat.
32. BIMS also referred to the findings in the Registry decision in *PUKKA* Trade Mark and submitted that there was similarity between meat and BIM'S services because the average consumer may choose either to purchase meat to cook at home, or alternatively, go out to eat such food, creating an element of competition between the goods and services. The hearing officer was not convinced by these submissions and I agree with him so far as they go.
33. However, he also said in respect of the *PUKKA* Trade Mark decision that the hearing officer there was considering the similarity of prepared foods that were ready to eat and could form a meal in themselves (namely pies) to services relating to the consumption of food. He said (and again I agree) that pies may be selected as an alternative to eating at a catering venue whereas meat per se was not. This highlighted the point that there is a real difference between "meat" as the basis of objection and the kinds of products which are normally – indeed virtually inevitably – available in cafes, restaurants and the like.
34. The hearing officer referred to the evidence that it was common for restaurants and cafes to sell their own branded food and drink in shops and the material showing branded food products offered for sale in supermarkets from Gail's, Nandos, Pizza Express, Wagamama, Pret a Manager, Cranks, Leon, Itsu and Wasabi which were all café, restaurant or fast-food restaurant chains. He also referred to the material showing that Costa Coffee and Starbucks sold drinks through retail outlets. He acknowledged that practice but said that it stopped short of illustrating that fast-food restaurants also offering "meat per se" through retail outlets.
35. He took the view that the evidence illustrated mainly prepared meals and sauces being sold. He held that the purpose of the goods and services offered was similar because they both relate to the provision and consumption of food, but it is less obvious to me

that they generally share channels of trade despite the evidence referred to in the previous paragraph. He held that it was not clear to him that meat and fast-food restaurants were complementary in the sense expressed in *BOSTON SCIENTIFIC*.

36. He concluded that, taking all of these factors into account, there was only a "low degree of similarity between meat and Party A's services". He reached a similar conclusion in respect of fish and said that none of BIMS's remaining goods placed it in a stronger position. However, in my view the analysis undertaken by the hearing officer suggests that had he been considering a case based on the revised specification which I have to consider, he may well have reached a different conclusion himself based on the greater similarity of goods and services alone.
37. As to "Contract food services", the hearing officer understood this term as describing the service of providing food, as stipulated by a contract between Party A (BIM'S) and one or more of its clients. He said that such services could include many of the services discussed above, and, in such circumstances, there would be a reasonable expectation that it would also supply the food itself. There would be a choice made by the customer regarding the scope of such a contract and whether it includes sourcing the food from Party A or choosing to source the food from elsewhere. He considered that there may be shared of trade channels but this will result in only a low level of similarity.

The impact of the greater degree of similarity

38. This evaluation by the hearing officer was based on then BIMS' best case (namely "meat"). BIM'S accepts in its skeleton argument that there will be a "degree of similarity" which it is said will be "not more than at most medium" between the services covered by the Challenged Mark and at least coffee, pastries, sauces [condiments] and milk products. BIMS contends that the similarity assessment should have been "higher" than the hearing officer attributed but, in its skeleton argument, it did not specify a particular level of similarity which he should have found.
39. In my view, having regard to the revised specification of goods, the hearing officer should have found a higher degree of similarity than merely "low level" between the services forming the revised best case. There is a medium degree of similarity between the goods forming BIMS' revised best case namely those providing fast food and drink which in this case are coffee, pastries, sauces [condiments] and milk products and the services in question.

40. BIMS also relies on a number of earlier decisions where there have been findings of similarity between prepared foods and services offering foods of that kind. It is not necessary to refer to all of them but one illustration referred to by the hearing officer comes from the *PUKKA* Trade Mark case. The hearing officer there found that there was an "average degree of similarity" between the relevant goods, particularly those which are prepared meals, tea and coffee, and (inter alia) services for providing food and drink, provision of food and drink in restaurants and fast food restaurants.
41. My evaluation is similar and accords with the approach taken in previous cases with respect to the kinds of foods that are likely to be provided particularly in fast food outlets or cafes. The consequence of attributing a medium level of similarity to at least some of the goods in the earlier specification is that the determination of whether there is a likelihood of confusion changes, potentially significantly. It is not, however, determinative of the outcome because, even if the services covered by the challenged mark are more similar to those of BIMS' prior registration, there may still not be a likelihood of confusion in the light of the differences between the marks.
42. In particular, BIM'S submits that the African theme of the BIMS Earlier Mark affects the likelihood of confusion with respect to the goods in question. I consider that point in the overall evaluation below. BIM'S also submits that there is no (or limited relevant) similarity between "bread", "confectionary" and "milk" being associated with food provision services. While it is true that these may not be as strong a case for similarity as that based on coffee, pastries, sauces [condiments] and milk products, this does not ultimately matter, save possibly for the fallback position considered at the end of this decision.
43. I will return at the end of this decision to whether, in this light of this conclusion, Ground 2 needs to be addressed.

Comparison of marks- Grounds 3 and 4

44. Grounds 3 and 4 of the appeal challenge the hearing officer's determination concerning the similarity of the marks. It is convenient to set out first how the hearing officer dealt with this issue. The key passages where the hearing officer summarized his conclusions on similarity of the marks and likelihood of confusion (I deal with other passages under the individual grounds of appeal) are as follows:

> "59. Earlier in this decision, I have found that:

• The respective goods and services range from being dissimilar to having a low degree of similarity;
• The word BIMS/BIM's is the dominant and distinctive element of Party B's mark and the first and second of Party A's marks;
• The figurative element and the word element "BIM'S" present in Party A's third mark share equal dominance within the mark;
• Visually, the respective marks share degree of similarity ranging from low to medium;
• Aurally, the respective marks are identical;
• There is some conceptual difference based on the presence of the figurative element present in Party B's mark, with Party A's third mark potentially having additional differences, notably the perception of a burger in a bun;
• The average consumer in respect of the majority of the parties' goods and services are ordinary members of the public paying no more than a medium level of care and attention when purchasing such goods and services;
• Party B's earlier mark has a medium level of inherent distinctiveness and it benefits from a modest enhanced distinctive character in respect of some food and drink of African origin, but not extending to meat, fish or rice, which are the goods on which the premise of similarity with Party A's services are based.

60. I remind myself that in Kurt Geiger v A-List Corporate Limited, BL O-075-13, Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited Sabel v Puma at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

61. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out. I have recognised that the verbal elements of the respective marks are distinctive and

in all except Party A's third mark, it is the BIMS/BIM'S element that is the dominant distinctive element. I have also found that it is likely that a significant proportion of consumers are not likely to notice the apostrophe present in the word element of Party A's second and third marks. Consequently, for such consumers, the possessive form BIM'S is not likely to be distinguished from the word BIMS present in Party B's mark.

62. In respect of Party A's third mark, I have found that the word element and the figurative element share equal dominance in the mark. Whilst the figurative element may be perceived by some as a highly stylised depiction of a burger in a bun, this is disguised by the level of its stylisation and, if this is the perception, the figurative element still retains a reasonable level of distinctive character.

63. I also keep in mind that In Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO) (CReMESPRESSO), Case T-68/17, the General Court said: "… it should first of all be noted that, according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements (see, to that effect, judgment of 6 December 2013, Premiere Polish v OHIM – Donau Kanol (ECOFORCE), T-361/12, not published, EU:T:2013:630, paragraph 32 and the case-law cited).

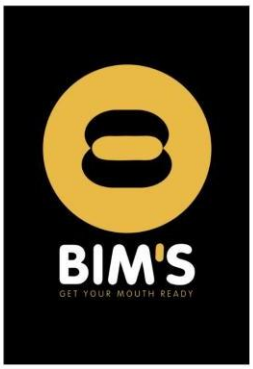
64. Keeping in mind all the guidance cited above and applying it to the circumstances before me, I find that the consumer may pay less attention to the Africa figurative element in Party B's mark, particularly in circumstances where the mark is used in respect of food products that originate from Africa or have an African theme and the consumer will perceive the logo as an allusion to this, thereby lowering its significance within the mark as an indicator of origin. Considering the respective marks as a whole, I find that in respect of Party A's first and second marks and where its services share a low similarity to Party B's goods, there is a likelihood of direct confusion with the consumer confusing one mark for the other. This finding takes account of my belief that, when factoring in imperfect recollection, because of the allusive character of the figurative element in Party B's mark, the consumer may only recall the "BIMS" element. However, in case I am wrong, I will also consider whether there is a likelihood of indirect confusion.

65. In respect of Party A's third mark, when comparing the visual differences to Party B's mark, they are greater and much less likely to go unnoticed,

particularly when factoring in the difference created by the distinct figurative element of Party A's mark, I find that there is no likelihood of direct confusion."

The evaluation of the similarities and differences

45. BIMS criticises this overall evaluation as regards the figurative mark on several grounds and, in particular, contends that the hearing officer erred in his evaluation of key similarities and differences. The hearing officer reproduced the marks side by side as follows:

Party A's marks	Party B's mark
BIMS BIM'S 	

I deal with the criticisms in turn.

Ground 3a – "GET YOUR MOUTH READY"

46. Ground 3 involves two limbs each focussing on the way in which the hearing officer considered the marks.

47. First, BIMS submits that the hearing officer's conclusion that the words "GET YOUR MOUTH READY" significantly lowered the level of similarity of the marks was inconsistent with his finding that the words were so small as to be negligible and likely to go unnoticed. As to this, the hearing offer assessed the marks as follows (emphases added):

> "41. The first two of Party A's marks are identical except for the presence of an apostrophe in one of them. They consist of the single word BIMS or BIM'S presented in capital letters. Those words are inevitably the dominant and distinctive element of those marks. Party A's third mark consists of a black rectangular background containing

> the word BIM'S and, in very small letters underneath, the words "GET YOUR MOUTH READY" in white and with a yellow circle placed above the word BIM'S that contains two elongated black figurative elements, the ends of which curl to touch. This could possibly be perceived by some consumers as a representation of a burger in a bun but this is not obviously so. Again, there is no colour limitation or claim. The device is large and prominent and shares equal dominance with the word "BIM'S". The figurative yellow and black element also contributes to its visual distinctive character. The words "GET YOUR MOUTH READY" are so small in the mark as to be negligible and is likely to go unnoticed.
>
> 42. Visually, Party B's mark includes as its distinctive and dominant element the word "BIMS", which is identical to Party A's first mark ("BIMS") and highly similar to Party A's second mark ("BIM'S"). The figurative Africa element present in Party B's mark creates a notable visual difference from Party A's first and second marks. I do not consider that the presence of an apostrophe has any material difference in assessing visual similarity and may not be noticed at all by many consumers. Taking the similarities and differences into account, I conclude that Party A's first two marks is visually similar to Party B's mark to at least a medium degree.
>
> 43. Party A submits that its figurative mark is visually dissimilar to Party B's mark, pointing to the different figurative elements, the different colours, and the addition of the words "GET YOUR MOUTH READY". I agree that these differences significantly lower the level of similarity but because of the presence of the BIM'S/BIMS elements in the marks, they are still similar to a degree. Taking account of the differences and similarity between the marks, I conclude that they share a low degree of visual similarity."

48. BIM'S for its part contends that there is no basis for overturning the hearing officer's evaluation on the basis of this alleged inconsistency in the hearing officer's approach to the words 'GET YOUR MOUTH READY' in the Challenged Mark. It submits that the hearing officer expressly noted that the words 'GET YOUR MOUTH READY' "*are so small in the mark as to be negligible and is likely to go unnoticed*" but nonetheless relied on the presence of this feature as a point of distinction. It is submitted that the hearing officer would have taken the small size into account and that the other differences in figurative elements were so dominant that this feature did not make a difference to the overall evaluation.

49. It is not entirely clear from the way the hearing officer's decision was written what weight he gave to the 'GET YOUR MOUTH READY' element. However, it does

appear that he treated as a point of distinction an element of the mark which he found (to my mind rightly) would be likely to go unnoticed at least by many.

50. In my view, there is therefore some substance in BIMS' point. The hearing officer was attributing a point of distinction to an aspect of the mark that was visually negligible on his findings. The issue however is whether this made a real difference to his overall assessment or the re-evaluation which I am undertaking. In my view it was not a very significant factor and the issue of visual similarity or dissimilarity was more affected by other considerations relating to the nature of the respective designs. Moreover, it is not clear that this issue affected the overall evaluation of the degree of similarity. I therefore do not uphold Ground 3a as a free standing ground.

Ground 3b – degree of visual similarity

51. The more significant issue under Ground 3 is BIMS' point that the hearing officer wrongly assessed the visual similarity of the respective marks as being low when at least one distinctive element (the word element) was very similar.

52. BIMS criticises the hearing officer for (i) concluding that BIMS' figurative mark includes as a distinctive and dominant element the word 'BIMS', then (ii) referring to the principle repeatedly stated in the case law that word elements are generally kept in mind by the relevant public to identify the mark more than figurative elements (which are more often perceived as decorative) but then (iii) concluding that the degree of similarity between the respective marks was only "low". BIMS says that this conclusion was not rationally supportable, albeit acknowledging the difficulties in inviting an appellate tribunal to reach a different conclusion on an issue of evaluation of similarity of this kind.

53. BIM'S for its part contends that the hearing officer was entitled to adopt the approach he did to the respective visual and 'BIMS' elements in BIMS' Earlier Mark. It submits that the hearing officer was right to find at [64] that "*the consumer may pay less attention to the Africa figurative element in Party B's mark*" and "*may only recall the "BIMS" element*" and that the hearing officer gave appropriate weight to both the figurative and the BIMS element of the mark, not treating either as dominant and each as contributing to the distinctive character of the mark to a degree. It points out that the hearing officer did not say that the key (Africa) visual element would go unnoticed.

It submits that the finding of a low degree of similarity was open to the hearing officer and that this attributed weight to both features. In particular, it is said that this finding had regard to the high degree of dissimilarity (and to some distinctiveness) of the figurative elements, notwithstanding the very high degree of similarity with the BIMS and BIM'S elements.

54. BIM'S also points out that, at para. 64 of the decision, the hearing officer found that "*the consumer may pay less attention to the Africa figurative element in Party B's mark, particularly in circumstances where the mark is used in in respect of food products that originate from Africa or have an African theme and the consumer will perceive the logo as an allusion to this, thereby lowering its significance within the mark as an indicator of origin*". So, the hearing officer was not under-rating the significance of the BIMS element in coming to his conclusion while, equally, he was saying, that despite the allusive nature of the Africa figurative element, it still had a distinctive character at least to some consumers.

55. BIM'S also says that the hearing officer had found that, in the case of its mark, "*The device is large and prominent and shares equal dominance with the word "BIM'S*" (see decision at para. 41). It draws attention to paras. 61 and 62 where the hearing officer evaluates the relative significance of the word element and the figurative element and the finding that the figurative element had a "reasonable level" of distinctive character.

Discussion

56. In my view BIMS is right to say that the hearing officer's evaluation that the marks had a low degree of visual similarity did not take sufficient account of the particularly high degree of similarity of the word elements of each mark and balance that against the considerably more limited distinctiveness of the visual elements. The hearing officer was making the point that, viewed purely visually as designs, the marks were not very similar. In that he was right. But that was not the right way of looking at these marks given the prominence of the respective BIMS and BIM'S and the fact that the visual elements may not have had trade mark significance to consumers. Viewed purely as designs, the respective marks are obviously very different visually. Viewed as composite indicators of trade origin, having regard to the particular significance of the word element, visually they were more similar than merely "low". Put simply, at least

one element which would immediately strike the consumer viewing the marks would be the words 'BIMS' and 'BIM'S". That much is certain. What is less certain is whether the average consumer would attribute trade mark significance to the respective other elements – in the case of the Challenged Mark, a logo which could appear to be a stylised burger and, in the case of the BIMS Earlier Mark, the stylised depiction of Africa which could have geographical significance.

57. There is inevitably a degree of artificiality in the gradation of "low", "medium" or "high" in some of these kinds of evaluations. In this case, it is in my view preferable to focus first on the points of similarity in the word element and determine whether they create a high degree of visual similarity and then consider whether the figurative elements surrounding these words are such that they materially diminish the overall similarity of impression which the similarity in the word elements creates. In this case, the dissimilarities do diminish that to a considerable degree given the extent of them but not in my view to such a degree that, overall, the marks should be regarded as only similar to a low degree. If the hearing officer had approached this evaluation in that way, he would I think have concluded that the marks had a medium degree of similarity. To that extent in my view this was an error of principle or approach to evaluation not merely a matter of evaluation.

58. However, I agree with BIM'S submission that this is not really a *Thomson Life* case (see Case C-120/04 *Medion AG v Thomson Sales Germany & Austria GmbH*). BIMS says that the average consumer may perceive that a composite mark consists of two (or more) signs, one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark. But this is not really a two element case.

59. I also agree with BIM'S point made by reference to the decision of Arnold J, as he then was, in *Whyte v MacKay* [2015] EWHC 1271 (Ch) at [21] that:

> "… even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

60. In summary, in my view the degree of similarity which the hearing officer should have fed into the overall analysis of likelihood of confusion was medium. To that extent,

Ground 3 succeeds. I return to that when considering whether there is here a likelihood of confusion.

Ground 4 – Conceptual similarity

61. As to Ground 4, BIMS contends that the hearing officer failed properly to consider the conceptual similarity between the respective marks. It says that the hearing officer sought to "have it both ways": on the one hand saying that the figurative element in the challenged mark could be seen as a stylised burger but then did not apply this approach consistently when considering the impact of seeing this element of the mark in this way as a description of the services (including, for example, supplying burgers) when considering the likelihood of confusion.

62. The hearing officer addressed the issue of conceptual similarity in the following way:

> "45. Conceptually, the figurative element of Party B's mark conveys the geographical location of Africa. None of Party A's marks contains the Africa device, which gives rise to a point of conceptual difference between the parties' respective marks. The word "BIMS" is Party A's first mark and the dominant and distinctive element of Party B's mark, but it is not obvious to me that the word "BIMS" will be perceived as having any conceptual meaning. It is possible that, if noticed, the presence of apostrophe in Party A's second mark may cause the consumer to perceive BIM as a name of a person or place because the apostrophe creates a word that is a possessive form of the word BIM. However, it is my view that consumers may not notice the apostrophe or may imperfectly recall BIM'S as BIMS. I therefore afford this conceptual difference no consequence in comparing Party A's second mark with Party B's mark.
>
> 46. Party A's third mark includes the word "BIM'S" with an apostrophe presented in a contrasting colour from the letters. However, because of its small size and because it is yellow in colour and appears on a black background (reducing its prominence), it is no more prominent in this mark compared to in Party A's second word mark and is likely to go unnoticed by consumers. Party A's third mark contains its own figurative element, which will evoke either no conceptual message or, as some consumers may perceive it, a very stylised depiction of a burger in a bun.
>
> 47. In my view, it is the concept of Africa created by the figurative element of Party B's mark absent from all of Party A's marks that creates an element of conceptual difference. In addition, Party A's third mark contains a figurative element that may also create a conceptual difference because it is absent in Party B's mark."

63. The hearing officer's approach here was in my view right and he was not inconsistent in his later approach. He pointed out correctly that the two marks shared the concept

of 'BIMS' which had no recognisable conceptual meaning and that, in so far as there was a conceptual meaning in the visual elements this was different. I am not persuaded by this aspect of BIMS' argument. However, BIMS' argument has greater force in that the conceptual nature of the visual elements was not particularly distinctive in the case of either of the marks and did not therefore form a reliable basis on which the average consumer would distinguish the marks.

64. Accordingly, I do not find Ground 4 established.

Ground 5 – level of attention

65. By Ground 5, BIMS contends that the hearing officer was wrong to conclude that the degree of attention was medium when it came to the relevant services including 'fast food services'.

66. BIMS says that the hearing officer should have considered the services within the specification which involved the lowest degree of attention and, since that included cheap fast food which could be purchased with little thought and in a hurry, including impulsively, with little thought and in any event quickly.

67. The hearing officer dealt with the issue of attention of the average consumer as follows:

> "48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: Lloyd Schuhfabrik Meyer, Case C-342/97.
>
> 49. 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."
>
> 50. The majority of the parties' goods and services are provided to ordinary members of the public and will be relatively modest in terms of cost. Party A's services will be accessed frequently but not necessarily every day. Some consideration will be given as to food preferences, but the level of care and

attention will be no more than medium. In respect of Party B's goods, these are everyday grocery items that are likely to be purchased frequently and with no more than a medium level of care and attention."

68. Although there is some substance in BIMS' argument that the respective goods and services are often purchased without a great deal of thought, in my view the more significant point here is that the average consumer who is assumed to be familiar with the BIMS Earlier Mark may not be in a better position to distinguish the trade origin than upon brief attention even if he or she pays closer or longer attention to the Challenged Mark. In the case of both marks, the similarities and differences are immediately apparent and do not require significant analysis. The difference between "low" and "medium" level of care and attention is not in practice likely to make much difference. I think that the hearing officer was right to say that the level of care and attention would be "no more than medium". But that contemplates that, for some, the level of care and attention may be relatively low. I think the way to address this issue, bearing in mind the spectrum of actual consumers assumed to be representative of the actual consumer is to assume that the level of attention ranges from between low and medium and is in any event not high.

69. That said, I am not satisfied that this is different in substance to the hearing officer's determination. On that basis I do not find that Ground 5 is made out.

Ground 6 – likelihood of confusion

70. Ground 6 splits into three distinct points.

    a. Failure to consider aural identity.

    b. Failure to take account of actual confusion.

    c. Inconsistency with earlier decisions of the Registry.

(a) *Aural identity*

71. I have set out above the hearing officer's determination concerning likelihood of confusion (para. 65 of the decision).

72. BIMS submits that the hearing officer failed to take account of aural identity when evaluating the marks. In my view, there is substance in this criticism. Both in para. 65

and in para.72, the hearing officer addresses the issue of visual similarity (and dissimilarity) but does not address the potential for aural confusion. That is of some significance given that the hearing offer had found correctly that, aurally, the marks were identical. This, it seems to me, is to leave out of account a factor which ought to be taken into account in the evaluation of a likelihood of confusion.

73. I have considered whether this situation falls into the category of cases where one should assume that this has been taken into account. BIM'S contends that an appellate court should be slow to infer that a material factor has not been taken into account because it has not been expressly mentioned. It points out that the issue of aural identity had been acknowledged by the hearing officer at paras. 44 and 59, making it unlikely that he had overlooked the point in making the multifactorial determination.

74. In some cases, those would be good points but the issue here is that the focus of the hearing officer's attention in paras. 65 and 72 is on visual similarity and dissimilarity to the exclusion of other factors. That approach is justified where (for example) the nature of the goods or services is such that they are rarely or never purchased by aural reference. In those situations, aural similarity may be much less important in the overall evaluation. However, food and drink and services relating to the provision of food and drink are frequently ordered or referred to aurally. Given that, it would have been appropriate to take aural identity expressly into account which the hearing officer did not here do.

75. To that extent this aspect of Ground 6 is made out.

(b) *Actual confusion*

76. The next aspect of Ground 6 is the alleged failure to take account of the evidence of actual confusion. BIMS contends that there was uncontested evidence of actual confusion. The hearing officer referred to this at para. 17 of the decision. However, it is said that he failed to take this into account in evaluating the likelihood of confusion for these marks.

77. There was undoubtedly some evidence of confusion but it difficult to assess its significance. A degree of confusion can sometimes occur as a result of people doing internet searches and one instance was mentioned of administrative confusion (the

invoice at MAA20). That may not be genuine confusion but searching error. What is not clear from the evidence is the extent to which the confusion (such as it was) existed despite the individuals confused seeing and recognizing the difference between the figurative marks in issue in this case. There are some question marks as well about how significant this confusion was and the extent to which it was operative. I do not think I can properly assume for the purpose of this appeal that the web-site and promotional material referred to was using (or was not using) the Challenged Mark and that the confusion occurred despite the persons concerned appreciating the visual dissimilarities between the respective marks.

78. However, this material suggests that there are at least some people who assume that BIM'S is in some way connected with BIMS as a result of the similarity of the trading names, despite potential differences in the signs used and the differences in the goods and services. That provides general support for the proposition that the likelihood of confusion is real rather than merely theoretical. In my view, this was a factor which the hearing officer was not obliged to take into account but could legitimately do so and I give it some modest weight in the re-evaluation. I do not regard it as made out as a separate ground of appeal.

(c) *Previous decisions*

79. BIMS contends that a number of decisions in which logo marks for restaurant have been found to be similar to various marks (logo and word) for foodstuffs. I will consider that point under an aspect of Ground 7. However, I do not think it affords a ground of appeal as such not to treat a given earlier decision as analogous when it was on different facts.

Ground 7 – inconsistency in evaluation of confusion

80. By Ground 7, BIMS contends that the hearing officer's approach to findings of confusion was inconsistent. The hearing officer held that there was a likelihood of confusion with respect to the word marks (BIMS and BIM'S). BIMS contends that the same conclusion should have been reached with respect to the figurative Challenged Mark. In particular, the hearing officer found that there was a likelihood of indirect confusion inter alia on the basis of the similarity of the word elements.

81. BIMS also refers to the parallel decision O/1091/24 as modified by O/1094/24 where he found that there was a likelihood of confusion (albeit indirect) between the BIMS Earlier Mark and the following sign.



Class 43: *Fast-food restaurants*

82. Although the hearing officer made a finding that there was no likelihood of direct confusion, he made a finding of indirect confusion in such a way that his actual findings appeared more similar to a conventional finding of direct confusion. At para. 59 of the decision in O/1091/24, the same hearing officer said of this issue of confusion:

> "59. The marks in question do not fall neatly into any of the three categories identified by Mr Purvis K.C. but I note that his list of categories is not intended to be exhaustive. I consider that the comparison in the current case is closest to category a) of Mr Purvis KC's list. The different figurative elements, in the respective marks, are overshadowed by the dominant word element in each mark. This is particularly so when the low level of distinctive character of the figurative element of Party C's mark is factored in and that it may not even be recalled by the consumer of its fast food restaurant services. The consumer may pay less attention to the Africa logo element in Party B's mark, particularly in circumstances where the mark is used in respect of food products that originate from Africa or have an African theme and the consumer will perceive the logo as indicating this, thereby lowering its significance within the mark as an indicator of origin. The presentation of the words is different in each mark but, in both, they are presented in capitals and their proportions are approximately the same in each mark. Taking account of these factors and those identified at paragraph 52, above, I find that the average consumer, paying a no more than medium degree of attention, is not likely to notice that the apostrophe present in Party C's mark is absent in Party B's mark. Consequently, it will not perceive any difference in the meaning of the respective word elements, and this is likely to lead to a perception that there is a connection between the respective marks such that there will be a belief that Party C's fast-food restaurant services are provided by the same or linked undertaking as the foodstuffs provided under Party B's mark. Therefore, there will be a likelihood of indirect confusion."

83. The reference to Mr Purvis KC's decision was to the well-known paragraphs in his decision in *LA Sugar*. In para. 52 of his decision in O/1091/24 the hearing officer had taken account (inter alia) of the aural similarity of the respective marks and a range of factors similar to those in the present case. Accordingly, I consider that there is

substance in BIMS' argument that the approach that the hearing officer took in the present case is not easy to reconcile with that taken in O/1091/24. BIMS says that if the average consumer would consider that these signs would result in a likelihood of confusion, that it was inconsistent to say that the Challenged Mark would be unlikely to lead to confusion in the present case.

84. Accordingly, I uphold Ground 7 on that basis.

Summary on re-evaluation

85. Before considering Grounds, 2 and 8, it is appropriate to take stock and re-evaluate the issue of the likelihood of confusion on the basis of the revised specification of goods, a revised assessment of the similarity of the marks a somewhat revised view of the characteristics of the average consumer and the decision in O/1091/94.

86. In my view the key factors to take into account are the following basing the re-evaluation so far as possible on the approach taken by the hearing officer in para. 59 of the decision but modified by my conclusions above:

• The respective goods and services have a medium degree of similarity;
• The word BIMS/BIM's is the dominant and distinctive element of BIMS' Earlier Mark and the BIM'S Challenged Mark;
• The figurative element and the word element "BIM'S" present in BIM'S Challenged Mark share equal dominance within the mark;
• Visually, the respective marks share a medium degree of similarity having regard to the nature of the elements of the marks;
• Aurally, the respective marks are identical and the goods and services in respect of which the marks are registered may be referred to orally;
• There is some conceptual difference based on the presence of the figurative element present in the respective marks but conceptual similarity and difference is unlikely to play a significant role for the average consumer;
• The average consumer in respect of the majority of the parties' goods and services are ordinary members of the public paying between low and medium level of care and attention when purchasing such goods and services;
• BIMS' Earlier Mark has a medium level of inherent distinctiveness and it benefits from a modest enhanced distinctive character in respect of some food and drink of African origin, but it is not easy to tell with any precision the extent to which there is an enhanced level of distinctive character with respect to the particular goods which constitute BIMS' best case.

87. I add to that the finding recorded above that there is a likelihood of confusion between BIMS Earlier Mark and another mark which shares similar characteristics with the Challenged Mark.

88. Having regard to all of those matters and taking into account the spectrum of consumers notionally comprising the average consumer, I find that there is a likelihood of confusion. I do so for reasons similar to those set out by the hearing officer in O/1091/94 although, as indicated above, in my view that is more akin to a finding of a likelihood of direct than indirect confusion. My reasons are as follows (again following the hearing officer's approach but taking account of the revised evaluations):

- The different figurative elements, in the respective marks, are overshadowed by the dominant word element in each mark.
- This is particularly so when the relatively low level of distinctive character of the figurative element of the Challenged Mark is factored in.
- The consumer may pay less attention to the Africa logo element in BIMS Earlier Mark particularly in circumstances where the mark is used in respect of food products that originate from Africa or have an African theme and the consumer will perceive the logo as indicating this, thereby lowering its significance within the mark as an indicator of origin.
- The presentation of the words is different in each mark but, in both, they are presented in capitals and their proportions are approximately the same in each mark.
- Taking account of these factors and those identified above I find that the average consumer, paying a no more than medium degree of attention and possibly a lower level of attention, is not likely to notice that the apostrophe present in the Challenged Mark is absent in BIMS' Earlier Mark.
- Consequently, the average consumer will not perceive any difference in the meaning of the respective word elements, and this is likely to lead to a perception that there is a connection between the respective marks such that there will be a belief that BIM'S fast-food and other restaurant services are provided by the same or a linked undertaking.
- Therefore, there is a likelihood of confusion.

89. I have teken into account BIM'S point that, as Geoffrey Hobbs KC, sitting as the Appointed Person said in *Westlake Chemical Corp's Application for Invalidity* (BL 0-

067-19), at [14] that "there is no rule that 'complementarity' always or necessarily equals 'similarity' for the purposes of s.5(2)(b) of the 1994 Act. Despite that, I consider that here the complementarity of the respective goods and services and the similarities in the marks are sufficient to give rise to a likelihood of confusion, notwithstanding the obvious differences both in the goods/services and in the respective marks.

90. For these reasons, the appeal must be allowed subject to consideration of the fallback position.

BIM'S fallback position

91. In BIM'S skeleton argument for the hearing, BIM'S put forward for the first time a so-called fallback position. It submitted that if the mark was invalid as it stood it should nonetheless be registered for a more limited class of services as follows.

> Fast-food restaurant services; Providing food and drink; Providing food and drink in restaurants and bars; Providing food and drink in food markets; Restaurant services for the provision of fast food; Takeaway food and drinks services; Food preparation services; Services for providing food and drink; Serving food and drinks; Providing prepared meals; Contract food services; all the preceding terms excluding provision of hot drinks, milk-based drinks, ice cream, sauces [condiments] and pastries; Consultancy services relating to catering; Consultancy services relating to the provision of food and drink~~;~~ ~~Contract food services~~.

92. BIM'S acknowledges that this was put forward at a late stage in the proceedings but submits that it is a "relatively straightforward modification of the specification which was not anticipated to give rise to a need for further evidence in light of the submissions already made and evidence already put forward" and that there was no prejudice in this position being considered at this late stage.

93. In my view, it is not appropriate to permit BIM'S to rely on this fallback position for the following reasons.

94. First, it was not put forward before the hearing officer and it is very late for it to be put forward for the first time in a skeleton argument on appeal. This is a point which could have (and in my view should have) been raised in the TM8.

95. Second, in my view this proposed specification does not comply with the Guidance concerning restrictions to specifications set out in Tribunal Practice Notice 1/2024 or

at least does not clearly comply. The Notice on restricting specifications of applications and registrations subject to Tribunal proceedings makes it clear that restrictions to specifications must be sufficiently clear and precise, and must meet the requirements set out in the case law, before they are recorded on the register. It includes the following guidance:

> "15. Restrictions which contradict existing terms in the specification will not be acceptable and the obligation is on the applicant to ensure that they have thoroughly reviewed the specification to remove any contradictory terms. For example, the following would not be acceptable:
>
> > "Clothing; t-shirts; leggings; sports clothing; jeans; shorts; socks; shirts; skirts; dresses; jumpers; cardigans; hoodies; tights; stockings; footwear; trainers; none of the aforesaid being clothing for sport."
>
> 16. Restrictions that are nonsensical will not be accepted. For example:
>
> > "Sunglasses; all of the aforesaid relating to music.""

96. Although the proposed limitation in the fallback position is not as extreme as those examples given in the Notice, this proposed specification is not clear or precise and is potentially contradictory. Providing food and drink in restaurants and bars and fast food services (to take two examples) normally involves the provision of at least one of hot drinks, milk-based drinks, ice cream, sauces [condiments] and pastries. Although it is possible to envisage such services being provided without the provision of at least some of those goods, that is inherently unlikely in relation to at least a fast food restaurant. Indeed, counsel for BIM'S realistically accepted at the hearing that, in the absence of evidence, this was unlikely. One could envisage a wine bar (for example) which did not provide such goods but the specification is not limited to wine bars and so the specification as it stands is potentially contradictory. There is also some artifice in imaging fast food outlets which would not supply at least one of hot drinks, milk-based drinks, ice cream, sauces or pastries when there is no evidence that BIM'S fast food outlets do not do so. Accordingly, there seems to me a contradiction (or at its lowest a potential contradiction) in the proposed specification. The proposed specification is not in any event clear or precise and there is a reasonable doubt as to what it would cover.

97. Third, although limited argument was directed to this head, there is also a potential objection to a specification in this form on the grounds of potential bad faith. Because

the proposed specification was put forward only on appeal and just before the hearing, BIMS did not have an opportunity to investigate this issue fully. However, it seems at least arguable that, having regard to the evidence, BIM'S did not have (and does not have) a bona fide intention to use the mark in relation to fast food restaurant services which did not and do not involve the provision of the proposed to be excluded goods. If so, there is potentially a complex argument as to whether, if BIM'S uses the mark in relation to fast food services which involve the provision of the proposed to be excluded items, this would constitute use of the mark. The argument is not straightforward because it may be said that it still intended to use the mark in relation to the provision of other fast food restaurant services. This point would therefore involve a potentially difficult argument based on the decision of the Supreme Court in *SkyKick* and the scope of the modern law on good faith.

98. I do not think it is appropriate to treat the proposed fallback position as objectionable on this substantive ground in the absence of full evidence and argument on this issue. However, the way in which the point arose just before the hearing made it impossible for this to be fully developed. I therefore do think that the manner in which the point was advanced has caused prejudice to BIMS and I do not think it is appropriate to entertain it.

99. Fourth, it is in any event, far from clear how this fallback position would save the mark from the objection to registration outlined above in any event. Prima facie it would not. Not only does it not purport to exclude other of the goods which may form the basis for objection (such as bread), more fundamentally, it still suffers from the problem that the reason for the likelihood of confusion is not because the Challenged Mark's services specifically involve the provision of (for example) hot drinks, milk-based drinks, ice cream, sauces [condiments] and pastries. It arises because the average consumer may expect that an undertaking engaged in the provision of such goods may also engage in the provision of (for example) fast food outlets, regardless of whether the particular outset supplies specifically those products. That is to say, the finding of the likelihood of confusion based on the goods in question does not depend on these specific goods being supplied by the provider of these food services. For these reasons, even if it were appropriate to entertain the fallback position I do not think it would save the Challenged Mark from invalidity on the grounds on which I have set out above.

100. I prefer not to decide this point definitively since it was not fully argued but having considered it in some detail after the hearing it seemed to me that this fallback position would not make a substantive difference.

Grounds 2 and 8

101. In the circumstances, it is unnecessary to consider Grounds 2 and 8. In brief, Ground 2 challenges the hearing officer's findings based on "meat" which he considered to be the best case. That has been overtaken by the fact that it is common ground that the other goods referred to above were better cases. So, this ground does not add anything to this appeal. Since it raises some quite complex questions, I think these are best considered in a case in which they matter.

102. Ground 8 (passing off) does not add anything to the points on Grounds 1, 3-7 and I do not think it is necessary to say anything more about it.

CONCLUSION ON APPEAL

103. The appeal is allowed and the Challenged Mark is held to be invalid.

COSTS

104. At the hearing, the parties both said that costs should follow the event and fell to be summarily assessed on the scale. The hearing officer thought that the position as to costs was sufficiently complex with respect to the proceedings as a whole that he made a separate decision, giving the parties an opportunity to make further submissions. That decision is referenced as O/0081/25. In relation to the decision under appeal (which he described as the Group C case) he made no order as to costs on the basis that both parties had enjoyed a measure of success.

105. Since BIMS has now been more successful on this appeal and the aspect of the case on which it failed below has been overturned, that gives rise to the question of whether the decision of no order as to costs below should also be disturbed. In my view the fair position is this: BIMS should have its costs of this appeal on the scale basis in any event including the costs of preparing the Notice of Appeal, Skeleton Argument and attendance at the (c. 1/2 day) hearing.

106. I assess the costs of the appeal at **£2000** in total on the basis that this was a reasonably substantial appeal with a number of points albeit conducted efficiently orally and have taken into account that while BIMS did not succeed on all of them, the Grounds of Appeal were interrelated making it hard to divide out aspects on which BIMS did not succeed.

107. Greater difficulty arises in respect of the costs before the hearing officer, partly because it is not possible to tell reliably from the material before me to what extent the evidence and argument was duplicated from that in the other three groups of cases and the submissions on costs on this issue both before me and the hearing officer were rather brief.

108. Without attempting real precision and doing the best I can on limited material, I have concluded that a fair award of the costs below would be **£2500.** This lies between the award of costs for the Group B proceedings and the Group D proceedings (the Group D proceedings were those giving rise to the decision in O/1091/24 referred to above). This takes account of the following factors: the number of marks/issues compared with the number of those in the other proceedings, the fact that significant evidence was filed and the substantial hearing although some of it may have been duplicated in other cases and costs already recovered for that. It is not however an award as high as that in the Group B proceedings.

OVERALL CONCLUSION

109. Accordingly:

a. The appeal is allowed;

b. BIMS' application succeeds and UK 918324246 is invalidated;

c. The Respondent (BIM'S) shall pay the Appellant (BIMS) the sum of £4500 in respect of the costs of the proceedings before the Registrar and the Appointed Person that sum to be paid within 21 days.

DANIEL ALEXANDER KC

APPOINTED PERSON

22 October 2026

Representation: Mr Rob Jacob, Stephenson Harwood for the Appellant; Mr Charles Brabin for the Respondent.