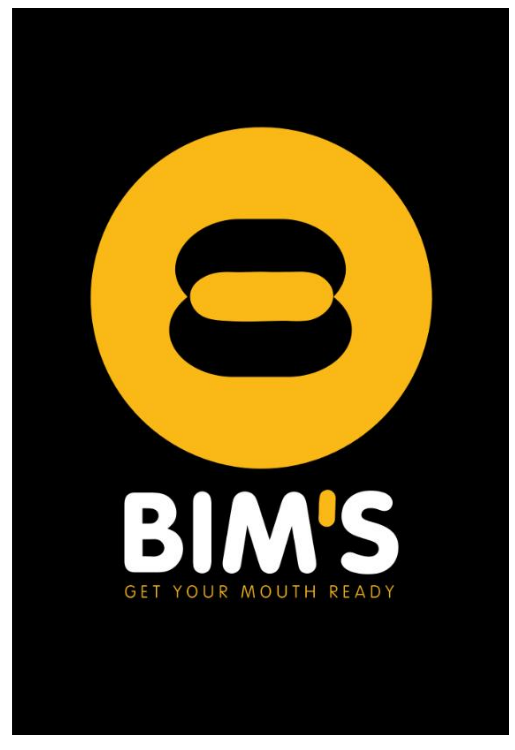
O-1090-24

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NOS. 3546687, 3407316 AND 918324246
IN THE NAME OF BIMS WALTHAMSTOW LIMITED
OF THREE TRADE MARKS IN CLASSES 43

BIM'S

BIMS



AND

IN THE MATTER OF CONSOLIDATED INVALIDATION APPLICATIONS BY BIMS AFRICAN FOOD STORE LIMITED UNDER NOS. 504462, 504464 AND 504465

BACKGROUND AND PLEADINGS

1. This decision is in respect of consolidated applications for invalidation by BIMS African Food Store Limited ("Party B") in respect of three trade marks registered in the name Bims Walthamstow Limited ("Party A").

2. The relevant details of these three marks are shown below:

(i) Trade mark 3546687

BIM'S

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; Consultancy services relating to catering; Consultancy services relating to the provision of food and drink; Contract food services.*

(ii) Trade Mark 3407316

BIMS

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.*

(iii) Trade Mark 918324246

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; Consultancy services relating to catering; Consultancy services relating to the provision of food and drink; Contract food services.*

3. The respective relevant dates are as follows:

Mark No	Filing Date	Registration Date
3546687	21/10/2020	26/02/2021
3407316	17/06/2019	06/09/2019
918324246	17/06/2019	20/10/2020

4. In all three applications for invalidation, Party B relies upon grounds based upon section 47(1), 47(2)(a) and (b), section 3(6), section 5(2)(b) and section 5(4)(a) of the Act.

5. In respect of the grounds based upon section 5(2)(b), Party B relies upon one earlier mark, the details of which are:

Trade Mark 3185199

Filing date: 12/09/2016
Registration date: 13/01/2017

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.*

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.*

Class 33: *Alcoholic beverages [except beers]: palm wine.*

6. By virtue of having a filing date that is earlier than the filing dates of Party A's contested marks, Party B's mark is an "earlier trade mark" as defined in section 6 of the Act. Party B asserts that the respective marks are highly similar, with the dominant element "BIMS" in its earlier mark being also wholly contained within the contested marks. It also asserts that the respective goods and services are similar. On this basis, it asserts that the contested marks should be declared invalid under section 47(2)(a) and section 5(2)(b) of the Act.

7. In respect of the grounds based upon section 47(2)(b) and section 5(4)(a), Party B asserts that it has the requisite goodwill identified by the following sign:

8. I note that this is not the same as the representation of its mark 3185199 that presents in two shades of the colour blue. However, on the Form TM26(I) the representation of the 3185199 is also presented in black and white and without the grasslands representation running across the centre of the Africa representation. Further, none of the evidence appears to show the black and white version of the sign. This leads me to believe that the sign relied upon for the ground based upon section 5(4)(a) is intended to be the same as the 3185199 mark. I will proceed on this basis.

9. It is claimed that this sign was first used in London in 1998, in respect of *food and alcoholic beverages (except beers)*. It asserts that:

(i) as a result of its use of this sign, it has acquired a reputation and protectable goodwill;
(ii) because of the similarities between the respective marks/sign and goods and services, use of the contested marks is likely to give rise to misrepresentation resulting in damage to Party B;
(iii) consequently, use of the contested marks will be an actionable passing off under section 47(2)(b) and section 5(4)(a) of the Act.

10. In respect of the grounds based upon section 47(1) and section 3(6), Party B asserts that Party A had knowledge of Party B, its business and reputation prior to the date of registration of the disputed marks. On 25 October 2019, solicitors acting for Party B wrote to Party A in relation to another trade mark application made by Party A. As a result, Party

A dishonestly applied for the contested marks in the full knowledge of Party B and its earlier rights and with the intention of either benefitting from Party B's reputation or to stop it from using its earlier mark**.**

11. Party A filed counterstatements denying Party B's claims and further states that:

(i) the respective marks are not similar, its Class 43 services are dissimilar to Party B's goods and that, therefore, the proceedings cannot succeed under section 5(2)(b);

(ii) Party B does not have the requisite goodwill and puts Party B to proof that a proportion of the public will be confused or deceived as a result of use of the contested marks. Party A is firmly of the view that the average consumer would be able to ascertain the distinction between its fast-food restaurant distinct to Party B's activities. In the absence of misrepresentation, there can be no damage and the grounds based upon section 5(4)(a) must fail;

(iii) that its success with fast food restaurants in France led to relocation to the UK where it continued to expand its enterprise and it did not, nor ever had any knowledge of Party B. It did not, therefore, act in bad faith.

12. The parties both filed evidence and this will be referred to as and where appropriate during this decision.

13. This consolidated group is "Group C" of five groups of proceedings between the parties as shown below:

Group A	Group B	Group C	Group D	Group E
CA505291 (lead file) CA504844 CA505290 CA503843	CA504693 (lead file) CA504695 CA504697 CA504699 CA504694 CA504696 CA504698 CA504700	CA504462 (lead file) CA504464 CA504465	CA504463	CA435891

14. The Group E proceedings are currently stayed, but the hearing was in respect of the other groups. Whilst each group is distinct, there are underlying issues and themes that made them suitable to be heard in a single hearing, but they will be subject of different decisions.

15. A Hearing took place over one and a half days on 30 January 2024 and the morning of 31 January 2024, with Party A represented by Mr David Dadds of Dadds LLP and Party B by Mr Rob Jacob of Stephenson Harwood LLP. Party A's Mr Karim Zigheche and Party B's Ms Mary Adejumo both appeared for cross-examination in respect of the Group A and Group B cases.

16. 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.

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<u>Evidence</u>

Party B's Evidence

17. Party B's evidence takes the form of the following:

(i) a witness statement, dated 6 June 2022 by Ms Adejumo, sole director of Party B and Annexes MAAO 1 to MAAO 20. Ms Adejumo provides evidence in respect of Party B and its predecessor's activities dating back to 1993 and evidence of customer confusion between the parties' offerings.

(ii) a witness statement, dated 15 August 2022, by Mr Jacob, a partner at Stephenson Harwood LLP. He responds to Party A's written submissions (referred to in the next paragraph).

Party A's Evidence

18. Party A did not file any evidence, but it did file written submissions dated 8 August 2022.

HEARING

19. Following a Pre-Hearing Review, it was agreed with the parties that a single hearing would be held to take submissions regarding a total of twelve proceedings between the parties - the three proceedings to which this decision relates, and two further groups of proceedings – as well as one further case where Party B challenges another "BIM'S" mark that is in the name of Mr Zigheche, the witness and controlling mind behind Party A.

Preliminary issues

Party A's further written submission

20. On the eve of the hearing, Party A provided further written submissions claiming that, in its skeleton argument, Party B had changed its case in respect of the historical ownership of its claimed goodwill. In particular, Mr Dadds pointed to a claim that Party B had always owned the goodwill from 1995 and that, if not. It was held on trust by Mrs Amole for Party B. Mr Jacob submitted that this was not an attempt to introduce new evidence and that Party B was relying only upon the evidence as admitted into the proceedings. I agreed that it was permissible to rely on these submissions as they amounted to no more than an opinion on what the evidence showed. However, I recognised that the trust point may require a considered reply and I indicated that I would be prepared to allow Party A to provide written submissions on the point if requested. This was not requested and, further, as will become apparent, the issue played no material role in my decision.

Section 3(6) grounds

21. The parties' skeleton arguments made no reference to the section 3(6) grounds relied upon by Party B in the Group C and Group D cases. Mr Jacob confirmed that Party B was no longer pursuing these grounds.

DECISION

Grounds based upon Section 5

22. Section 5(2)(b) and section 5(4)(a) is relevant when considering an application for invalidation by virtues of the part of section 47 of the Act, namely:

> "**47 Grounds for invalidity of registration**
>
> ...
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> Unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> ...
>
> (2A) The registration of a trademark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met

...

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

...

(5) Where the grounds of invalidity exists 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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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."

Section 5(2)(b)

23. Earlier mark 3185199 was the subject of two of the cases forming part of the Group A proceedings and, consequently, it had been agreed to suspend the section 5(2)(b) grounds in the present proceedings until the outcome of the Group A cases was known. However, during the course of the oral submissions on the Group A cases, it became apparent that the goods that Party B claimed use (in respect of the 3185199 mark and as set out in Party B's counterstatement in CA504843) was no longer challenged by Party A. Therefore, the scope of the earlier mark, in the subject proceedings in this decision, is known. As a result, I informed the parties that there was no longer any need to maintain the suspension in respect of this ground and I directed that the parties provide written submissions on the grounds within 14 days of the date of the hearing. The parties both provided such submissions and I take these into account when making my decision.

24. The list of goods, now unchallenged by Party A, and set out by Party B at part 7 of its Form TM8N in parallel proceedings CA504843, is:

Class 30: *Rice; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; Honey, Spices*

Class 29: *Fish, meat; preserved, frozen, dried and cooked fruits and vegetables; preserved or fried seeds and nuts; edible oils and fats; pulses, beans and lentils; soya beans; black eye beans*.

Class 33: *Palm oil*.

25. Party B may rely upon the above list of goods for its ground based upon section 5(2)(b).

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Similarity of goods and services

28. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

29. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

30. The respective goods and services are:

Party B’s goods	Party A’s services
Class 29: *Fish, meat; preserved, frozen, dried and cooked fruits and vegetables; preserved or fried seeds and nuts; edible oils and fats; pulses, beans and lentils; soya beans; black eye beans.* **Class 30:** *Rice; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; Honey, Spices* **Class 33:** *Palm oil.*	**All three of Party A’s contested marks:** **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* **Additionally, 3546687 and 918324246 also include:** **Class 43:** *Services for providing food and drink; Serving food and drinks; Providing prepared meals; Consultancy services relating to catering; Consultancy services relating to the provision of food and drink; Contract food services.*

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

31. All these services can be summarised as describing, in various ways, the provision of food and drink and the preparation of food and meals. All being services, they differ in nature to Party B’s goods. In his written submissions Mr Jacob suggested that Party B’s best case rested with the comparison of Party A’s services to the terms in Party B’s specifications that are underlined in the table above. In the submitted best case, Mr Jacob also relied upon *milk and milk products* in Class 29 and *coffee, bread, pastries and confectionery* in Class 30. However, no use was claimed in respect of these goods in CA504843 and consequently, these goods did not survive the revocation

proceedings (see my paragraph 20, above). Therefore, Party B may only rely upon the underlined terms in the above table.

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 Mark*[2] 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.

33. Ms Adejumo also provided evidence[3] in support of her claim that it is common for restaurants and cafes to sell their own branded food and drink in shops. Her exhibit shows branded food products offered for sale in supermarkets from Gail's, Nandos, Pizza Express, Wagamama, Pret a Manager, Cranks, Leon, Itsu and Wasabi that are all café, restaurant or fast-food restaurant chains. The exhibit also shows Costa Coffee and Starbucks selling drinks through retail outlets. I keep this practice in mind and I acknowledge that the evidence appears to illustrate that the practice appears to occur

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[1] See [25] and [26] of that decision
[2] BL O/434/17 at [93]
[3] At [19] of her witness statement and Exhibit MAAO 19

more than occasionally in respect to some goods, but it stops short of illustrating that fast-food restaurants also offering *meat* per se through retail outlets. Rather the evidence illustrates mainly prepared meals and sauces being sold.

34. The purpose of the goods and services offered are 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. Further, it is not clear to me that *meat* and *fast-food restaurants* are complementary in the sense expressed in *BOSTON SCIENTIFIC.*[4] Taking all of this into account, I conclude that there is only a low degree of similarity between *meat* and Party A's services.

35. An analogous argument can also be applied where Party B relies upon *fish*, also in Class 29 and *rice* in Class 30.

36. None of Party B's remaining goods place it in a stronger position.

Contract food services

37. I understand this term as describing the service of providing food, as stipulated by a contract between Party A and one or more of its clients. Such services can include many of the services discussed above,[5] and, in such circumstances, there would be a reasonable expectation that it would also supply the food itself. There will 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. Therefore, there may be shared of trade channels but this will result in only a low level of similarity.

[4] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06 where "complementarity" was defined as where goods or services are indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.
[5] Such as *Food preparation services; Services for providing food and drink; Serving food and drinks; Providing prepared meals.*

Consultancy services relating to catering; Consultancy services relating to the provision of food and drink

38. These consultancy services are directed at catering professionals. Party B's goods are also relevant to the food and beverage sector, but it is not obvious to me how consumers would assume that Party B's goods would originate from the same provider as the consultancy services. The respective goods and service differ in nature, purpose, method of use, are not in competition, nor are they obviously complementary. Finally, they would not share the same distribution channels. Therefore, I conclude that the respective goods and services are dissimilar. To be successful under grounds based upon section 5(2) of the Act, there must be some similarity between the respective goods and services.[6] I have found that Party A's *consultancy services relating to catering* and *consultancy services relating to the provision of food and drink* are dissimilar to Party B's goods and it follows that there can be no likelihood of confusion. I need say no more about the section 5(2) ground against these services.

Similarity of marks

39. The respective marks are:

[6] See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

Party A's marks	Party B's mark
BIMS	BIMS
BIM'S	
BIM'S GET YOUR MOUTH READY	

40. Party B's mark consists of a figurative element, being depiction of the continent of Africa together with the word BIMS. The word element is the word BIMS presented in capital letters is clearly the more distinctive element in the mark. The Africa device has an allusive nature (in indicating that the products in which it is used have a link with Africa in some way), and it is presented in two shades of blue, with a grasslands motif. It still has distinctive character. Although the Africa device is positioned at the start of the mark and is quite large, it is less dominant than the distinctive word element, which is larger and draws the eye. I note that the mark is presented in two shades of blue but that the mark has no colour limitation or claim.

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.

44. All of the respective marks will be expressed as the single syllable "bims" and are aurally identical. The presence of the apostrophe in two of Party A's marks has no impact upon aural similarity. Party A also points out that its logo mark also contains the words "Get Your Mouth Ready" to support its submission that the marks are aurally dissimilar. These words appear underneath the word BIM'S in very small writing and are negligible when considering the words impact upon the mark as a whole and they may go unnoticed. Further, even if they are noticed, they are not likely to be used when

referring to the mark. Consequently, I conclude that their presence does not impact upon the aural character of the mark.

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.

The average consumer and nature of the purchasing process

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.

Distinctive character of the earlier mark

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

52. Party B's earlier mark consists of a representation of the continent of Africa split roughly two thirds to one third by a line that resembles a grassy horizon. The word BIMS is presented directly to the right of the figurative element. These elements combine to present as a mark with a medium level of inherent distinctiveness. This takes into account that the word has no obvious meaning and that, in respect of food and drink goods originating from Africa or in an African style, an image depicting Africa is of a low level of distinctiveness, even taking account of its colour and the depiction of grass.

53. Party B, in its written submissions, claims that its mark benefits from an enhanced level of distinctive character because of the use made of it. It relies upon the evidence provided by Ms Adejumo in her witness statement and, in particular, I note:

- Party B's BIMS food store opened in 1995 in London selling African produce and it also operated as a wholesaler to customers throughout the UK and elsewhere;[7]

[7] Ms Adejumo's witness statement ("WS1") at [4]

- The store sells over 200 food and drink products under the BIMS brand. Such products include black eye beans, dried shrimp, drum beans, maize, Nigerian soya beans, pounded yam and palm oil;[8]
- 99% of Party B's sales are in respect of its BIM branded products. Photographs are provided of bags of foodstuffs such as egusi, Nigerian ginger, pepper soup, pounded yam, fufu, plantain flour, ijebu gari, yellow gari, yam flour, Ghana gari and okra. All have labels bearing Party B's earlier mark and priced in pounds.[9] The photographs are not dated but where "use by" dates are visible, they are all "Oct22";
- By 2012 it was selling food and drink under the BIMS brand to high profile clients such as the United Nations;[10]
- The business also advertises via its website www.bimsfoods.com. The domain name was purchased in 2018 and screenshots provided show a mark very similar to the earlier mark but with the addition of the word "foods" appearing in smaller letters under the word BIMS;[11]
- Revenue for the years 2014 – 2019 are provided:[12]

Year	Revenue (£)
2014	1,040,015
2015	650,687
2016	504,496
2017	514,840
2018	525,255
2019	584,703

- The business was set up in 1995 by Mrs Amole, the mother of Ms Adejumo. Mrs Amole was awarded numerous awards for business and enterprise from 1997 and includes one awarded in 2016 after her death for her outstanding and invaluable service to the community and her achievements as an international

[8] Ditto at [5] and Exhibit MAAO 2
[9] Ditto at [5] and Exhibit MAAO 4
[10] Ditto at [8]
[11] Ditto at [14] and Exhibit MAAO 16
[12] At [12] of WS1 and taken from the audited accounts shown at Exhibit MAAO 14

businesswoman for her work importing and selling African produce under the BIMS brand.[13]

54. This evidence suffers from a number of defects such as the "expiry dates" on packaging being several years after the relevant date for all three invalidations, which does not directly support the claim of an enhanced distinctive character at those relevant dates. Nevertheless, when the evidence is taken as a whole, it clearly shows a longstanding business that has been operating for around 23 years prior to the relevant dates. However, when considered within the self-evidently huge food and drink market, the size of the business is modest and the level of promotional activities is unclear beyond the business having a shop front in London and a website. Taking all of this into account, I conclude that if the earlier mark benefits from an enhanced level of distinctive character, then it is modest in nature and restricted to food and drink of African origin. However, it is impossible to gauge what sales have been made under the mark in respect of meat, fish or rice, which are the high points of the bases of similarity between the parties' goods and services. Certainly, the evidence fails to establish any enhanced distinctive character in respect of those goods.

Likelihood of confusion

55. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the

[13] Ditto [7.4] and Exhibit MAAO 8

distinctiveness of the common elements is key.[14] I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

56. There are two types of confusion. The first is direct confusion and this occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[15]

57. In its written submissions of 8 August 2022, in an attempt to distance its services from Party B's goods, Party A claimed that its services are focused on fast food provision and American-style in origin. The analysis I must undertake when considering a case based on Section 5(2)(b), is a notional analysis of the respective goods and services i.e. a comparison between the respective marks' listed goods and services.[16] In this respect, I note that the list of services in the contested marks are wider than merely American-style fast food services. Consequently, I dismiss Party A's submission that the "moron in a hurry"[17] could not be confused by the different trading styles and the goods and services provided. This is not the test.

58. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06, the CJEU stated, at paragraph 66 of its judgment, that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

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

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[14] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. 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.

[15] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

[16] See *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220 at [78]

[17] A phrase taken from *Morning Star Cooperative Society Ltd v Express Newspapers Ltd* [1979] FSR 113

- 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.

66. In summary, I find that there is a likelihood of direct confusion between Party B's mark and Party A's first and second marks, in respect of the following services:

3546687 BIMS

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*

3407316 BIM'S

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.

67. In respect of indirect confusion, I keep in mind the following guidance of Mr Iain Purvis Q.C., (as he then was) as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

68. I do not understand these categories to be an exhaustive list.

69. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

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

71. I begin by considering Party's first and second marks. For the purposes of considering indirect confusion, I proceed on the basis that, the consumer will notice that the figurative Africa element present in Party B's mark is absent from both of Party A's marks. As I have noted earlier, the Africa element, whilst it benefits from some additional styling, having the grassland effect and being presented in two shades of blue, it is likely to be perceived as alluding to Party B's goods are in some way linked or originating from Africa. As I noted earlier, this figurative element does play a distinctive role but one that is of lesser importance than the word "BIMS". Consequently, whilst not fitting precisely into Mr Purvis' second category of marks where the consumer would expect the respective marks to originate from the same or linked undertaking, it is my view that this would be the case in these proceedings. The consumer upon encountering Party A's word marks will assume that it is used in respect of services provided by Party B or vice-versa. Therefore, I find that there would be a likelihood of 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

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.

73. In summary, Party B's opposition, insofar as it is based upon section 5(2)(b) ground, succeeds, in respect of Party A's first two marks, to the following extent:

3546687 BIMS

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*.

3407316 BIM'S

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.*

74. It fails in respect of the following:

3546687 BIMS

Consultancy services relating to catering; Consultancy services relating to the provision of food and drink

918324246 BIM'S logo mark

Consultancy services relating to catering; Consultancy services relating to the provision of food and drink

75. It also fails in its entirety in respect of Party A's third mark (918324246 BIM'S figurative mark).

Section 5(4)(a)

76. Section 5(4)(a) states:

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) […]

(b) […]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

77. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

78. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> “55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

79. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> “Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> > (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation1 among a relevant class of persons; and
> >
> > (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

80. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In SWORDERS TM O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the

applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

81. There is no counterclaims or evidence to support a finding that Party B has goodwill identified by its marks. Consequently, I need only consider the position from the date of application of Party B's marks, namely 21 October 2020 in respect of the first mark and 17 June 2019 in respect of the second and third marks.

82. At the hearing, Mr Dadds submited that Party B has no goodwill and relies on the fact that no value has been given to goodwill in its accounts submitted to Companies House. I dismiss this submission for the following two reasons:

(i) Party A has not provided any evidence of Party B's company accounts and, in any case, this is irrelevant because;

(ii) As Mr Jacob drew attention to, the commentary on this issue in Wadlow on the Law of Passing-Off[18] illustrates that no value is given to goodwill in Party B's accounts is irrelevant. In Wadlow's it was noted that:

"accountancy goodwill is almost the precise opposite of goodwill as the term is understood in the law of passing-off."

83. The rest of that paragraph is also relevant as it explains how, in circumstances where a business has not been acquired, the balance sheet valuation of goodwill is zero. In the current case, Ms Amole was the controlling mind behind Party B and this business passed from mother to daughter as part of the deceased mother's estate. Therefore, when the business moved from Ms Amole's sole trader business to Party B and then when Ms Adejumo inherited Party B, there was no "acquisition" as such that would require a valuation to be put on the goodwill (as separate to the value of the

[18] He referred to paragraph 3-10 but in the latest, 6th Edition, it appears at 3-14

business). Therefore, I agree with Mr Jacob that the absence of a valuation of Party B's goodwill in its accounts is irrelevant to my considerations here.

84. I am satisfied that the evidence summarised at paragraph 49, above, is sufficient to demonstrate that Party B has the requisite goodwill at the filing dates of the contested marks (being the relevant dates for assessing a claim under section 5(4)(a)).[19] The evidence illustrates that the sign relied upon by Party B has been used since at least 2014 to identify its goodwill in respect of numerous food and drink products of African origin (see my evidence summary at paragraph 49). Turnover in the six years 2014 to 2019 ranged between £525k and £1.04 million a year and demonstrates continuous trading at a level that is clearly sufficient to establish the requisite goodwill in respect of these food and drink products.

85. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora,* it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here when considering the case against Party A's first two marks and I find that members of the public are as likely to be misled into purchasing Party A's services in the belief that they are provided by Party B or a linked undertaking to the same extent as I found likelihood of confusion under section 5(2)(b).

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.

[19] See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11 at [43] and the reference to *SWORDERS TM*, BL O-212-06

87. In summary, I find that the ground based upon section 5(4)(a) succeeds to the same extent as the grounds based upon section 5(2)(b).

Summary

88. Party B's oppositions succeed in respect of the following:

3546687 BIM'S

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*.

3407316 BIMS

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*.

89. It fails in respect of the following:

3546687 BIM'S

Consultancy services relating to catering; Consultancy services relating to the provision of food and drink.

3407316 BIMS

Consultancy services relating to catering; Consultancy services relating to the provision of food and drink.

90. It also fails, in its entirety, in respect of Party A’s third mark (918324246 BIM’S figurative mark).

COSTS

91. In light of the complexity of the proceedings that were subject to the hearing, I indicated that I would seek written submissions on costs after all four substantive decisions are issued covering all the proceedings that were the subject of the hearing. The parties are therefore directed to provide written submissions within 21 days of the date of this decision and these are to address each group of cases in turn. I will then issue a supplementary decision in respect of the costs award in each group of cases.

Dated this 18th day of November 2024

Mark Bryant
For the Registrar