

O-1091-24

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3333445 IN THE NAME
OF KARIM ZIGHECHE IN RESPECT OF THE TRADE MARK**



IN CLASS 43

**AND IN THE MATTER OF INVALIDATION PROCEEDINGS THERETO UNDER
NO. 504463 BY BIMS AFRICAN FOOD STORE LIMITED**

BACKGROUND AND PLEADINGS

1. This decision is in respect of an application for invalidation by BIMS African Food Store Limited (“Party B”) in respect of a trade marks registered in the name Karim Zigheche. Mr Zigheche is the controlling mind behind a company involved in numerous other proceedings with Party B. The company in those proceedings is referred to as Party A. To avoid any confusion with that entity, I will refer to Mr Zigheche as “Party C”.

2. The relevant details of the contested trade mark are shown below:

Trade mark 3333445



Class 43: *Fast-food restaurants*

3. The relevant dates are as follows:

Filing date: 22/08/2018

Registration date: 16/11/2018

4. Party B relies upon grounds based upon sections 47(1) and 47(2)(a) and (b), section 5(2)(b), section 5(4)(a) and section 3(6) of the Trade Marks Act 1994 (“the Act”).

5. In respect of the grounds based upon section 47(2)(a) and 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. Party B asserts that the respective marks are highly similar with dominant element BIMS in its mark being also wholly contained within the contested mark and that this similarity is not diminished by the respective colour schemes. It also asserts that the respective goods and services are similar. On this basis, it claims 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(l) 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 these signs were 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 these signs, it has acquired a reputation and protectable goodwill;
- (ii) because of the similarities between the respective marks/signs 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 C 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 C in relation to another trade mark application made by Party C. As a result, Party C dishonestly applied for the contested mark 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 C filed a counterstatement denying Party B's claims and further states that:

(i) whilst recognising that the respective marks are aurally similar they are visually and conceptually dissimilar and that, overall, the marks are dissimilar. Party C asserts that the respective goods and services are either similar to a low degree or not similar and the proceedings cannot succeed under section 5(2)(b);

(ii) Party B does not have the requisite goodwill and puts it to proof that a proportion of the public will be confused or deceived as a result of use of the contested marks. Party C asserts that the parties are not in the same fields of activity and concludes that there is no passing off 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. Only Party B filed evidence and Party C filed written submissions in lieu of evidence. This will be referred to as and where appropriate during this decision.

13. This decision relates to the single proceedings identified as Group D 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. It is noted here that this decision relates to the only proceedings involving Mr Zigheche rather than his company identified as Party A in the other 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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Evidence

Party B's Evidence

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

18. A second witness statement, dated 15 August 2022, is provided by Mr Jacob, a partner at Stephenson Harwood LLP. He responds to Party C's written submissions.

Party C's Evidence

19. As already noted, Party C did not file any evidence but it did file written submissions dated 8 August 2022.

HEARING

20. Following a Pre-Hearing Review, it was agreed with the parties that a single hearing would be held to take submissions regarding the Group A – Group D proceedings. This current case is “Group D” and involves a challenge by Party B to a mark that is in the name of Party C, the witness and controlling mind behind Party A (in the Group A, B and C cases).

Preliminary issues

Party C’s further written submission

21. On the eve of the hearing, Party C 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 C 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

22. 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

23. Sections 5(2)(b) and 5(4)(a) are relevant when considering an application for invalidation by virtue 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)

24. 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 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 not challenged by Party A. Therefore, the scope of the earlier mark, in these Group D proceedings, 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 submissions and I take these into account when making my decision.

25. 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”.

26. 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

27. 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.”

28. 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.

29. The respective goods and services are:

Party B's goods	Party A's services
<p>Class 29: <i><u>Fish, meat</u>; 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.</i></p> <p>Class 30: <i><u>Rice</u>; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; Honey, Spices</i></p> <p>Class 33: <i><u>Palm oil</u>.</i></p>	<p>Class 43: <i>Fast-food restaurants</i></p>

30. Services are fundamentally different, in nature, to goods but this does not necessarily result in a finding of no similarity. In his written submissions Mr Jacob suggested that Party B's best case rested with the comparison of Party A's services to the underlined terms (in the table above) of Party B's specifications. In this best case, he also relied upon *milk and milk products* in Class 29 and *coffee, bread, pastries and confectionery* in Class 30 but no use was claimed in respect of these goods in CA504843. Consequently, these goods did not survive the revocation proceedings (see my paragraph 23, above). Therefore, Party B's best case is based upon its reliance on *fish* and *meat* in Class 29 and *rice* in Class 30 (i.e. the underlined terms in the above table).

31. 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 and once 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

¹ See [25] and [26] of that decision

² BL O/434/17 at [93]

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.

32. Ms Adejumo also provided evidence³ 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 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.

33. 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. 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.

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



35. None of Party B’s remaining goods place it in a stronger position.

Similarity of marks

36. The respective marks are:

³ At [19] of her witness statement and Exhibit MAAO 19

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.

Party C's mark	Party B's mark
	

37. Party B's mark consists of a figurative element, being a depiction of the continent of Africa, together with the word BIMS. The word element is presented in capital letters and is the dominant and distinctive element but the figurative element also plays a distinctive, if less significant, role and has an allusive nature in that it may indicate that the products in which it is used have a link with Africa. All of the goods listed may have such a link. It is, therefore, the less dominant distinctive element despite it being positioned at the start of the mark. I note that the mark is presented in two shades of blue but that the mark has no colour limitation.

38. Party C's mark consists of the word BIM'S appearing in capital letters along a slightly curved axis and placed to the right is a figurative representation of a cheese burger with flames appearing to rise from it. By virtue of its position at the front of the mark and being the largest part of the mark, the word BIM'S is the dominant and distinctive element. Further, the representation of a cheese burger, in respect of fast food restaurants, lacks the same level of distinctive character as the BIM'S element, and is endowed with, at best, a low level of distinctive character in respect of fast food restaurants.

39. Visually, the word BIMS or BIM'S is common to both marks and is a point of similarity. I do not consider that the presence of an apostrophe in the word element of Party C's mark makes any material difference in assessing visual similarity because it is not likely to be noticed by many consumers. The figurative elements in the respective marks are different and this creates a point of difference between the marks. Taking the similarities and differences into account, I conclude that Party C's

mark is similar to a medium degree to Party B's mark. In reaching this view I have kept in mind that the word element is the dominant element in both marks with the device elements playing a secondary role in each mark.

40. The respective marks both contain a single verbal element and both will be expressed as the single syllable "bims" and are aurally identical. The presence of the apostrophe in Party C's mark, even if noticed, has no impact upon aural similarity.

41. Conceptually, the figurative element of Party B's mark conveys the geographical location of Africa. The figurative element of Party C's mark conveys the concept of a flaming cheese burger. These are points of conceptual difference. The marks share the same word element BIM/BIM'S, but it is not obvious to me that this has any conceptual meaning. It is possible that, if noticed, the presence of the apostrophe in Party C's marks 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 BIM but as I have already commented, consumers are not likely to notice the apostrophe and, therefore, not notice the possible slight difference in conceptual identity of BIMS/BIM'S. Taking these points into account, I conclude that there is some conceptual difference between the marks.

The average consumer and nature of the purchasing process

42. 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*.

43. 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.”

44. The parties’ goods and services are provided to ordinary members of the public and will be relatively modest in terms of cost. Party C’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. The purchasing process will be predominantly visual in nature with Party B’s goods being selected from a shelf or located in a list/catalogue of available items. Party C’s services are likely to be selected by way of the establishment’s frontage and the mark on display there. However, I keep in mind that aural considerations may play a part, particularly when a verbal recommendation is made or where the parties’ marks are promoted in an aural format (i.e. on the radio).

Distinctive character of the earlier mark

45. 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).”

46. 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.

47. 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 following evidence:

- The business conducted under the BIMS mark extends back to 1995 when Ms Adejumo’s mother opened the BIMS food store in Peckam, London and selling fresh African produce and now sells to wholesale customers across the UK and Europe;⁵
- The first goods sold by the BIMS business included gari, beans, cessava, pounded yam and palm oil and it now sells over 200 own-product African products.⁶ Photographs of the following goods are provided,⁷ all having the

⁵ Ms Adejumo’s witness statement, at [4]

⁶ Ditto at [5]

⁷ Exhibit MAAO4

earlier sign appearing prominently on the labels and with a “best before” date of “OCT22” unless otherwise stated:

- bags of Egusi priced at £14.99
 - bags of Nigeria Ginger priced at £4.99
 - a bag of pepper soup priced at £4.99. Its “best before” date is recorded merely as “OCT” but a label of a second, unidentifiable product, has the date of “OCT22”
 - a 9kg bag of pounded yam priced at £17.99, 3kg bags at £6.99 and 1.5kg bags priced at £3.99 but no date is discernible on the latter
 - a bag of fufu priced at £4.99
 - a 1.5kg bag of plantain flour priced at £4.99
 - a 2.5kg bag of IJEBU Gari priced at £4.99 and 1.25kg bags at £2.49
 - a 10kg bag of yellow gari priced at £16.99
 - a 10kg bag of yam flour priced at £22.50
 - bags of Ghana gari priced at £2.99 but it is not possible to see any date on the label
 - 3kg bags of Okpa priced at £16.99. No date is visible
- Three invoices all with the earlier mark appearing prominently at the top and dating from August and November 2014 are provided relating to large quantities (two in respect of 2825kg and the third in respect of 8500kg) of, variously, cassava flour, flour plantain and flour yam;⁸
 - A screenshot from 27 April 2022 (i.e. nearly 4 years after the relevant date in these proceedings) of the homepage of Party B’s website that features its mark and promotes “A world of fresh African foods/Flours, snails, vegetables” and Party B’s wholesale service;⁹
 - Ms Adejumo’s mother won a number of awards, between 1997 to 2016 as a result of her BIMS brand including African Business Woman of the Year in 1997 and a posthumous certificate of appreciation for her service to the community and for her achievements as an international business woman;¹⁰

⁸ Exhibit MAAO 11

⁹ Exhibit MAAO 16

¹⁰ Ms Adejumo’s witness statement at 7 and Exhibits MAAO 5 – MAAO8

- By 2012 BIMS was selling its food and drink to high profile clients such as the United Nations and the business was recommended in The Voice African and Caribbean Food and Restaurant Guide 2016 – 2017;
- The BIMS business turnover was:¹¹

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

48. This evidence suffers from a number of defects such as the “expiry dates” on packaging being some four years after the relevant date in these proceedings, which does not directly support the claim of an enhanced distinctive character at that date. 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 date. 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

49. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be

¹¹ Ms Adejumo’s witness statement at [12]

borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

50. Confusion can be direct or indirect and I begin by considering the likelihood of direct confusion.

51. Earlier in this decision I found that:

- a) The respective goods and services share a low degree of similarity.
- b) The dominant and distinctive element of both marks is the word BIMS/BIM'S. The figurative element of Party B's mark is less distinctive because it may be perceived as alluding to characteristics of Party B's goods but it still retains some distinctive character. The figurative element of Party C's mark has no more than a low level of distinctive character because it depicts the nature of the goods purchased from a fast food restaurant;
- c) The respective marks are visually similar to a medium degree and aurally identical. Conceptually, the respective figurative elements create a point of conceptual difference;
- d) The average consumer is the general public who will pay no more than a medium degree of attention during the purchasing process. The purchasing process is predominantly visual in nature.
- e) 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.

52. I keep all these findings in mind when considering whether a likelihood of direct confusion exists.

53. The visual differences in the presentation of the word elements of the respective marks together with the presence of different figurative elements are sufficient to prevent there being a likelihood of direct confusion. The consumer is likely to notice these differences and will not confuse one mark for the other even where imperfect recollection is factored in.

54. Before turning to the question of indirect confusion, I remind myself that:

- I must consider all the circumstances the contested mark might be used¹² and this includes Party A's fast-food services being provided from premises in close proximity to the premises where Party B sells its own-branded food and drink products;
- the scope of the specification of services in Party C's registration includes fast-food restaurants selling African sourced or themed food and Party B's goods can be sourced from Africa (and is the actual case);
- descriptive or non-distinctive matter is given less weight when comparing marks¹³ and the figurative element present in Party C's mark has, at best, a low level of distinctive character;
- The marks share a very similar word element. These word elements are the dominant and distinctive part of each mark;

55. Party C, in his written submissions stated that "there is a stark difference between the wholesaler of fruit and vegetables sourced from Africa and that of an American styled fast food restaurant selling hamburgers, fries [...] etc." This is not

¹² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]

¹³ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 at [22] and [23]

the comparison I must make. Party A's specification states *fast-food restaurants* and is not limited in any way to being "American style". I am required to consider likelihood of confusion from the perspective of the goods and services listed in the respective registrations and not the particular circumstances in which the goods in question are marketed.¹⁴ Consequently, I reject this submission.

56. The difference between direct and indirect confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

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

¹⁴ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P at [59]

(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).”

57. 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.”

58. 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. In respect of the respective goods and services, I have found that they share a low level of similarity and I factor this into my considerations.

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.

60. Regarding the moderate enhanced distinctive character of Party B's mark in respect of a limited number of its goods, this has a minimal impact on my considerations, and I would have made the finding of indirect confusion even if Party B had failed to demonstrate that its mark enjoyed an enhanced distinctive character in respect of a limited range of goods.

61. The application for invalidation is successful insofar as it is based upon section 5(2)(b) of the Act.

Section 5(4)(a)

62. 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.”

63. 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.”

64. 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).”

65. 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.”

66. 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.’ ”

67. There is no counterclaim or evidence to support a finding that Party C has goodwill identified by his mark. Consequently, I need only consider the position from the date of application of Party C’s mark, namely 22 August 2018.

Goodwill

68. Party C submits 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 C 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-Off¹⁵ 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.”

69. 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 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.

70. I remind myself of my evidence summary provided at paragraph 45, above. I found that the earlier mark benefits from a modest enhanced level of distinctive character restricted to food and drink of African origin, but the evidence fails to establish any enhanced distinctive character in respect of meat, fish or rice, being the primary goods relied upon by Party B.

¹⁵ He referred to paragraph 3-10 but in the latest, 6th Edition, it appears at 3-14

71. When considering this evidence in the context of assessing goodwill, I find that it is clearly sufficient to find that Party B has the requisite goodwill since at least 2014 in respect of some food and drink of African origin, namely:

Class 29: *preserved [and] dried fruits and vegetables; preserved or dried, preserved or dried nuts; pulses, beans and lentils.*

Class 30: *flour and preparations made from cereals; cassava flour, yam flour, plantain flour; garri; garri cassava; spices.*

Misrepresentation and damage

72. 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*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes.

73. Party B’s goodwill attaches to a narrower list of goods it was able to rely upon when I considered the issue of likelihood of confusion under section 5(2)(b) of the Act. In respect of those grounds, it was also able to rely upon *meat, fish and rice*. This is a possible factor that may result in a different outcome under section 5(4)(a), but it is my view that it does not materially impact upon the strength of Party B’s case. The same considerations apply, namely:

- the common element Party B’s sign and Party C’s mark is the word BIMS or BIM’S and that whilst they have different presentational styles, this element dominates both signs both presented in capital letters;
- The figurative element of Party C’s mark has, at best, a low level of distinctive character;
- The narrower list of Party B’s goods share a low level of similarity to Party C’s *fast-food restaurants*;

- Party C's services include fast-food restaurants producing African-themed or sourced foods and these services are closer to Party B's goods.

74. Taking account of these points a customer of Party B, upon encountering Party C's fast-food restaurant is likely to consider that the two businesses are the same or linked and this would be a misrepresentation. The figurative element of a flaming cheese burger present in Party C's mark is likely to be perceived as indicating the nature of the food provided from Party C's fast food restaurants rather than indicating a business unrelated to Party B. Therefore, when viewing the respective sign and mark as a whole, Party B's customers, upon encountering Party C's mark are likely to be deceived.

75. In such circumstances, Party B's business would be damaged if customers choose Party C's fast-food meals in preference to buying Party B's goods or where the quality or image associated with Party C's services impacts negatively on the goodwill associated with Party B.

76. In summary, I find that the ground under section 5(4)(a) succeeds and that members of the public are likely to be misled into purchasing Party C's services in the belief that they are linked to Party B's business. I note that for the purposes of section 5(4)(a) there is no requirement for the parties to be in the same field of activity. With this in mind that, even if Party C's services were considered to be in a different field, they would be considered to be in adjacent fields and, to my mind, this would not impact upon my overall assessment, taking all relevant factors into account, nor my conclusions.

Summary

77. Party B's application for invalidation fails in its entirety and Party C's mark remains registered.

COSTS

78. 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