

O/0409/25

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS**

IN THE MATTER OF APPLICATION NO. UK00003815842  
BY BEAK FRIED CHICKEN LTD TO REGISTER:

**BEAK**

AS A TRADE MARK IN CLASSES 35 & 43

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 438638 BY DANIEL TAPPER

AND

IN THE MATTER OF APPLICATION NO. UK00003849951  
BY DANIEL TAPPER TO REGISTER:



AS A TRADE MARK IN CLASSES 32 & 35

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 439467 BY BEAK FRIED CHICKEN LTD

## BACKGROUND

1. This decision involves proceedings that were previously determined by way of decision number BL O/0888/24 that was issued by myself on 12 September 2024 (“my original decision”). As I will come to explain below, that decision was appealed and was subsequently remitted to the Registry by the Appointed Person.
2. My original decision involved cross-oppositions wherein Beak Fried Chicken Ltd (“BFC”) and Daniel Tapper (“DT”) brought actions against one another. I do not intend to summarise the relevant proceedings here but, instead, refer to my summary of the same at paragraphs 2 to 15 of my original decision.
3. The outcome of my original decision was that both parties’ oppositions succeeded in full. However, both parties’ oppositions were partial meaning that the marks at issue were still permitted to proceed to registration for some goods and services. In summary, the outcome of my original decision was that the trade mark for which BFC sought registration, being that under trade mark number 3815842 (“BFC’s mark”) was refused registration for the following services:

Class 35:           Retail services relating to clothing, headwear and footwear, namely T-shirts, sportswear, hats and socks.

Class 43:           Preparation of food, namely fried chicken burgers, fried chicken wings and fried chicken strips.

4. However, BFC’s mark was permitted to proceed to registration for the following services, being those that were not opposed by DT:

Class 35:           Retail services relating to stationery, namely stickers.

5. The trade mark for which DT sought registration, being that under trade mark number 3849951 (“DT’s mark”) was refused registration for the following services:

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, books on brewing beer, beer mats, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.

6. DT's mark was, however, permitted to proceed to registration for the following goods and services on the basis that they were not opposed:

Class 32: Beer; beers; flavored beer; black beer; imitation beer; malt beer; beer wort; wheat beer; bock beer; saison beer; craft beer; flavored beers; craft beers; black beer [toasted-malt beer]; coffee-flavored beer; de-alcoholized beer; non-alcoholic beer; de-alcoholised beer; low-alcohol beer; beer-based beverages; barley wine [beer]; beer-based cocktails; barley wine [beer]; alcohol-free beers; extracts of hops for making beer.

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of sausages with ale, meat and ale pies, beer batters for frying, pickles, sauces, preserves, relishes, marinades, beer, beers, flavored beer, black beer, imitation beer, malt beer, beer wort, wheat beer, bock beer, saison beer, craft beer, coffee-flavored beer, de-alcoholized beer, non-alcoholic beer, de-alcoholised beer, low-alcohol beer, beer-based beverages, barley wine [beer], beer-based cocktails, extracts of hops for making beer, beer brewing ingredient kits consisting primarily of malt wort, hop concentrates and hopped wort, wines, spirits, cocktails.

7. I do not consider it necessary to reiterate the findings made throughout my decision. However, for reasons that will become obvious below, I remind myself

that at paragraphs 88 to 90 of my original decision, when considering the opposition against DT's mark, I determined that DT's comments in his counterstatement constituted a concession as to identity between the services at issue under BFC's opposition (being that brought under number 439467). In making this finding, I referred to DT's submissions wherein he attempted to change his position and argue that the services were dissimilar but concluded that he was bound by his concession as to identity. This was the issue that formed the subject of appeal, which was brought by DT on 11 October 2024 in accordance with section 76 of the Trade Marks Act 1994 ("the Act"). The appeal was brought under the following grounds:

- i) That I failed to appreciate that DT's admission in his Form TM8 was in respect of only the challenged services in BFC's mark; and
- ii) Proceeding on a basis in respect of identity was contrary to Registry practice and procedure.

8. The appeal was dealt with by Dr Brian Whitehead who, sitting as the Appointed Person, issued his decision on 1 February 2025. This decision was issued under number BL O/0096/25 ("the appeal decision"). In the appeal decision, the Appointed Person allowed the appeal under the second ground referred to above and remitted the proceedings back to the Registry for a fresh determination on the following points:<sup>1</sup>

- i) Whether DT should be permitted to resile from or qualify the admission of identity of services made in his Form TM8;
- ii) If so, whether any of DT's "advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, books on brewing beer, beer mats, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses,

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<sup>1</sup> This conclusion can be found at paragraph 26 of the appeal decision.

bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets” are identical or similar to the BFC’s “retail services relating to stationery, namely stickers”; and

- iii) If so, whether there is a likelihood of confusion in light of my other findings.

9. In making his decision, the Appointed Person issued the following directions:<sup>2</sup>

- i) That BFC be given the opportunity to file submissions on the issue of whether DT should be permitted to resile from his admission. Furthermore, although BFC did not file any submissions in respect of the services comparison, it may have chosen to do so had it understood that similarity/identity of services was disputed. The Appointed Person therefore directed that BFC may file, within 28 days of the appeal decision, written submissions addressing each of the numbered points set out at paragraph 26 of the appeal decision (being those I have reproduced at paragraph 8 above); and
- ii) That DT may file, within 28 days of the appeal decision, written submissions addressing issue (i) at paragraph 26 of the appeal decision (being that which I have reproduced at paragraph 8(i) above). DT’s submissions in lieu dated 7 February 2024 shall stand as its submissions in relation to issues (ii) and (iii) of paragraph 26 of the appeal decision (again, being points 8(ii) and (iii) above).

10. DT filed additional submissions in accordance with the Appointed Person’s directions. These are dated 28 February 2025 and I will, where necessary, discuss them further below. BFC did not elect to file any further submissions.

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<sup>2</sup> The directions can be found at paragraphs 27 and 28 of the appeal decision.

11. In addition, it is noted that during the appeal process, DT sought to amend its specification by filing a Form TM21B. The Appointed Person, in correspondence to the Tribunal regarding the remittal, set out that this should be dealt with by the Tribunal. In doing so, the Tribunal ultimately permitted DT to amend his specification by removing the term “advertising, marketing, promotion and/or retail (whether in store, by mail order, telephone, or via the internet) of [...] books on brewing beer [and] beer mats.” As such, the specification of DT’s mark that remains live in these proceedings is as follows:<sup>3</sup>

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets, sausages with ale, meat and ale pies, beer batters for frying, pickles, sauces, preserves, relishes, marinades, beer, beers, flavored beer, black beer, imitation beer, malt beer, beer wort, wheat beer, bock beer, saison beer, craft beer, coffee-flavored beer, de-alcoholized beer, non-alcoholic beer, dealcoholised beer, low-alcohol beer, beer-based beverages, barley wine [beer], beer-based cocktails, extracts of hops for making beer, beer brewing ingredient kits consisting primarily of malt wort, hop concentrates and hopped wort, wines, spirits, cocktails.

12. As was the case in these proceedings prior to the appeal, DT remains represented by Abion UK Limited and BFC remains represented by Agile IP LLP.

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<sup>3</sup> Though I note that the opposition against DT’s mark is only partial. Therefore, the services that remain subject to the decision at hand will be set out where necessary below.

## DECISION

13. The first point for me to consider in this decision is whether DT should be permitted to resile from his pleaded case. In doing so, I remind myself that, as per the directions from the Appointed Person in the appeal decision, DT was directed to file submissions speaking to the fact that he should be permitted to resile from his pleaded case. On this point, and as above, DT did file submissions. I do not intend to copy these verbatim but summarise them as follows:

- a. The initial concession as to identity was made while BFC's specification included "retail services relating to clothing, headwear, and footwear, namely T-shirts, sportswear, hats and socks" and that it would have been counterproductive for DT to not acknowledge this identity. DT does acknowledge, however, that he could have included words that everything which was not identical was, therefore, different.
- b. DT believed that he made his position manifestly clear by the fact that he chose not to oppose BFC's "retail of stationery, namely stickers" (in his own opposition) that he considered these dissimilar to everything else at issue. On this point, DT states that if he considered them similar then he would have opposed all of BFC's services, but he did not.
- c. As a result of the preceding point, DT set out that not opposing "retail of stationery, namely stickers" was a deliberate choice and, as such, it should be accepted that his position was that they were not similar to his own services for the purposes of his own opposition.

14. As above, BFC was permitted to also file submissions speaking to the points raised by the Appointed Person in the appeal decision. However, it did not do so.

15. In considering the present issue, it is my view that DT's position is that he now seeks to provide clarity to his initial pleadings as opposed to seeking to make an application to resile from his pleaded case (which would require an application in

accordance with Rule 14.2(11) and 14.5 of the Civil Procedure Rules, being the provisions referred to by the Appointed Person at paragraph 22 of the appeal decision).<sup>4</sup> I note that, as per paragraph 4.1 of the Tribunal section of the Trade Marks Manual, parties before the Tribunal are permitted to seek to provide clarity to their pleadings at any point during the proceedings.

16. In respect of the above, I turn to the Trade Mark Rules 2008 (“the Rules”), namely Rule 62(1)(e), which sets out as follows:

**“62(1) -** Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

[...]

(e) allow a statement of case to be amended, provided that—

(i) where an application is made to add grounds of opposition other than under subsections 5(1) or (2) of the Act, the application shall be made on Form TM7G; and

(ii) in the case of fast track oppositions the registrar may only permit a statement of case to be amended to add additional or alternative earlier registered or protected trade marks as additional grounds of opposition under subsections 5(1) or 5(2) of the Act, provided that the total number of earlier trade marks relied upon may not exceed three.”

17. DT is not seeking to add grounds to his opposition. As such, there is no requirement for DT to seek to amend his pleadings by way of a Form TM7G. Further, the present case does not involve fast track proceedings so point (ii) of Rule 62(1)(e) does not apply.

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<sup>4</sup> On this point, I note that no such formal application was made in any event.



18. In light of the explanation provided by DT and the lack of any further submissions from BFC, I am of the view that DT's latest submissions should be introduced into these proceedings so as to clarify the comments in his counterstatement. In making this decision, I accept DT's explanation that he believed it was clear that by choosing not to oppose certain services in BFC's specification, his base position was that they were not identical to his own services. Such a position is, in my view, logical upon the provision of a further explanation. While I do not consider that it was initially clear in his pleaded documents, I accept that subsequent documents filed made clear that his initial intention was to argue that his own services were dissimilar to "retail of stationery, namely stickers" on the basis that he did not seek to initially oppose them. This is further supported by the fact that when seeking to expand his case in his final written submissions, he made extensive comment as to the dissimilarity of the services and even introduced reference to other cases of the Tribunal wherein marketing and advertising services were not similar to retail services. Lastly, I appreciate that in filing his additional submissions upon the remittal of these proceedings, DT admitted that he could have included additional words to clarify his initial position.

19. As a result of the above, I hereby permit DT to amend his pleadings so as to remove his concession that the services at issue under BFC's opposition are identical.

20. In reaching the above finding, I have given consideration as to whether I should permit BFC time within which to make further comment on DT's amended pleadings.<sup>5</sup> On this point, I remind myself that the Appointed Person gave BFC an appropriate opportunity to (1) argue against any attempt by DT to amend his pleadings and (2) to comment on the similarity of the services. As set out above BFC did not respond. In light of the fact that BFC has already been given the opportunity to file submissions in respect of the similarity of the services (in the event that DT's concession was to be disregarded), I see no reason to provide BFC

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<sup>5</sup> Which would be the ordinary approach to an amendment of pleadings in proceedings before the Tribunal.

with further opportunity to make additional comments at this stage. While that may be the case, I will still proceed as if BFC's pleaded case is that the services are similar.

21. As a result of the above, it is now necessary for me to proceed to consider the comparison of the services anew. In doing so, I remind myself that just because DT's concession in his notice of opposition is to be disregarded, it does not mean that I must find the services at issue to be dissimilar. In addition, I do not consider that the impact of the appeal and the findings above will affect the comparison of the marks or the distinctive character of DT's mark. Therefore, in considering this below, I will simply repeat the findings of my original decision as they were not subject to any appeal.

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

22. In reconsidering BFC's opposition, I remind myself that DT's opposition against BFC's mark was not subject to any appeal. As a result, the outcome of my original decision in respect of DT's opposition carries through to BFC's opposition that I must now reassess in my remitted decision. Therefore, BFC is only permitted to rely on its mark for the following services, being those that were not opposed in DT's own opposition:

Class 35:           Retail services relating to stationery, namely stickers.

### **Legislation and case law**

23. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

(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 or association with the earlier trade mark.”

24. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

25. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

26. Given its filing date, BFC’s mark qualifies as an earlier trade mark under the above provisions. BFC’s mark had not completed its registration process more than five years prior to the filing date for the DT’s mark, meaning that it is not subject to proof

of use pursuant to section 6A of the Act. This means that BFC can rely on its mark without having to demonstrate use of the same.

27. The following principles are gleaned 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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.

### Comparison of services

DT's services	BFC's services
<u>Class 35</u> Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer	<u>Class 35</u> Retail services relating to stationery, namely stickers.

pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.	
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28. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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. While I do not have any additional submissions in respect of the similarity of the services at issue, I remind myself that during the initial set of proceedings, both parties made submissions as to the similarity of the services at issue. I do not intend to reproduce those here but confirm that I have taken them all into account in making the following comparison.

31. In considering the services at issue here, I consider that DT's services can be broken down into two categories, the first being the advertising, marketing and/or promotion of the various goods listed in the term and the second being retail services in relation to those same goods. I will address the similarity of these services separately.

*Advertising, marketing, [and/or] promotion of key rings, pens, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.*

32. I note that in its submissions in lieu filed during the main proceedings, DT relied upon the case of *ASSEMBLY* (BL O/555/20) wherein the Hearing Officer found that a range of retail services had no similarity with any of the advertising, marketing or promotional services on the basis that their natures were different, so too were their purposes and user. While I am not bound by the decision of the Hearing Officer in that case, I am of the view that the outcome in respect of similarity between the above services and BFC's "retail services relating to stationery, namely stickers" can mirror that reached in *ASSEMBLY*. On this point, I accept that the nature of the services differ, so too do their methods of use and purposes. Further, I see no reason why there exists any overlap in trade channels or user. Lastly, the services are not complementary or competitive to one another. As such, these services are dissimilar.

*Retail (whether in store, by mail order, telephone, or via the internet) of [...] pens.*

33. In comparing the above services to BFC's "retail services relating to stationery, namely stickers", I am of the view that there is a degree of similarity between them. I say this because the terms at issue, whilst relating to different goods, are goods that can be said to be closely associated with one another on the basis that both are items of stationery. These services, plainly, share the same nature as well as method of use and purpose. Further, the services will be offered by the same trade channels (i.e. stationery stores) and even where a larger store such as a supermarket sells both goods, they will be found in close proximity to one another. Lastly, the goods are likely to be sought by the same user. As a result, I find that these services are similar to a high degree.

*Retail (whether in store, by mail order, telephone, or via the internet) of key rings, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.*

34. In considering the above services against BFC's term of "retail services relating to stationery, namely stickers", I note that both parties' services cover retail services, albeit the retail of different goods. Such a point could potentially result in a degree of similarity between these services on the basis that clearly their natures, method of use and purpose are the same (i.e. they are both retail services that will be sought in the same way and their aims are to simply sell products to the end consumer). While that may be the case, the nature of the goods being retailed are entirely different. I appreciate that the goods can reasonably be said to be those sold as merchandising goods. Further, I accept that some large supermarkets may sell a range of clothing or tableware as well as stickers. However, it is not necessarily common in the trade for the retailers of such goods to overlap. On this point, I will say that it does not automatically mean that retail services covering a wide range of goods that may be said to be merchandising goods is sufficient to give rise to a finding of similarity. Further, even where the goods may be sold at



large supermarkets. they will be found in different sections of those stores. In considering this issue, I remind myself of the case of *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) wherein Mr Iain Purvis KC (sitting as a deputy High Court judge) set out that, in the end, any finding of similarity requires the exercise of common sense and requires a Hearing Officer to stand back and consider the overall question of similarity.<sup>6</sup> In confirming this point, I note that Mr Purvis KC set out that a comparison of goods or services was not necessarily a tick-box exercise looking at how many of the *Treat* or *Canon* (both cited above) factors overlap. In adopting the approach set out by Mr Purvis KC, I appreciate that if I were to take a step back and exercise common sense, it is logical for me to conclude that the services are not the same. As set out above, they are both retail services, however, I do not consider that this alone is sufficient to warrant a degree of similarity, especially when the goods being retailed are different. As a result, I am of the view that the common-sense outcome here is one where I deem the services to be dissimilar.

#### Conclusion on the services comparison

35. Where there is no similarity between services, there can be no likelihood of confusion under section 5(2)(b) grounds.<sup>7</sup> In light of my findings above, it follows that BFC's opposition fails against the dissimilar services. It will, however, proceed against the following services, being those I have found to be similar:

Class 35:           Retail (whether in store, by mail order, telephone, or via the internet) of [...] pens.

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

36. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course

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<sup>6</sup> See paragraph 24 of *Veronese*

<sup>7</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

of trade. 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. (as he then was) 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.”

37. The services at issue are ordinary consumer services that will be selected by members of the general public at large. The services are likely to be selected having considered, for example, promotional material (in hard copy or online) or signage appearing on the high street. In my view, visual considerations will be an important part of the selection process, however, I do not discount aural considerations playing a part as a result of word-of-mouth recommendations or advice from sales assistants.

38. The services will, for the most part, be selected on a frequent basis and will be relatively inexpensive selections. Regardless of the cost of the goods subject to the services, they will be selected after the consumer gives consideration to relatively ordinary factors such as stock, delivery methods (if selected online, for example) and the price of goods. Taking all of this into account, I am of the view that the selection process for the services is likely to attract a medium degree of attention.

### **Comparison of the marks**

39. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to


analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

40. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

42. The competing marks are as follows:

BFC's mark	DT's opposed mark
<p style="text-align: center;">BEAK</p>	

43. In my original decision, I found at paragraphs 95 to 97 that the marks at issue under BFC's opposition were visually similar to a medium degree, aurally identical and conceptually similar to a high degree. Those findings were not subject to any appeal so are applicable to the present remitted decision.

### **Distinctive character of BFC's mark**

44. As was the case in respect of the marks comparison above, my findings in respect of distinctive character of BFC's mark, being those made at paragraph 98 of my original decision, were not subject to appeal. As such, my finding that BFC's mark was inherently distinctive to a medium degree applies here.

### **Likelihood of confusion**

45. While I found confusion for identical services in my original decision, I consider it necessary to assess the likelihood of confusion anew on the basis that some of the services that remain at issue are only similar (albeit to a high degree) and not identical.

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the DT's 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 trade marks and must instead rely upon the imperfect picture of them that he or she has retained in his or her mind.

47. I have found the services to be similar to a high degree. I have found the average consumer for the services to be members of the general public at large who will select the goods with primarily visual considerations (though I do not discount aural considerations) after paying a medium degree of attention. I have found the marks to be visually similar to a medium degree, aurally identical and conceptually similar to a high degree. I have found BFC's mark to be inherently distinctive to a medium degree.

48. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that consumers will inaccurately recall or misremember the marks at issue. While I appreciate that the device element in DT's mark will not be overlooked, consumers will seek to pin their recollection of the marks on the word 'BEAK'. Given the identity of this word across the marks, I am of the view that it will lead consumers to forget which mark was which, i.e. which mark included a device element and which did not. Consequently, I find that there exists a likelihood of direct confusion between the marks.

49. For the sake of completeness, I will proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

50. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

51. In the present case, if consumers are able to recall the marks for one another due to the device element in DT’s mark, then I consider that they will still believe them to be the responsibility of the same or an economically linked undertaking. I appreciate that the device element has no obvious connection to the services at issue. However, I am of the view that consumers will believe the marks to be alternate marks used by the same undertaking in different contexts. For example,

consumers will consider it reasonable that the word only mark was one used in promotional materials whereas the device mark was one used on product packaging. Consequently, I consider that there exists a likelihood of indirect confusion between the marks.

## CONCLUSION

52. The outcome of this remitted decision is that BFC's opposition still succeeds, albeit only partially. I hereby find that subject to any successful appeal against this decision, DT's mark is refused registration for the following services:

Class 35: Retail (whether in store, by mail order, telephone, or via the internet) of pens.

53. DT's mark may, however, proceed to registration for the following goods and services, being those that were not opposed in the present proceedings and those for which BFC's opposition failed:

Class 32: Beer; beers; flavored beer; black beer; imitation beer; malt beer; beer wort; wheat beer; bock beer; saison beer; craft beer; flavored beers; craft beers; black beer [toasted-malt beer]; coffee-flavored beer; de-alcoholized beer; non-alcoholic beer; de-alcoholised beer; low-alcohol beer; beer-based beverages; barley wine [beer]; beer-based cocktails; barley wine [beer]; alcohol-free beers; extracts of hops for making beer.

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets, sausages with ale, meat and ale pies, beer batters for

frying, pickles, sauces, preserves, relishes, marinades, beer, beers, flavored beer, black beer, imitation beer, malt beer, beer wort, wheat beer, bock beer, saison beer, craft beer, coffee-flavored beer, de-alcoholized beer, non-alcoholic beer, dealcoholised beer, low-alcohol beer, beer-based beverages, barley wine [beer], beer-based cocktails, extracts of hops for making beer, beer brewing ingredient kits consisting primarily of malt wort, hop concentrates and hopped wort, wines, spirits, cocktails.

54. For the avoidance of doubt, the outcome in respect of DT's opposition was not subject to any appeal and, therefore, the outcome reached in my original decision remains. For completeness, BFC's mark is hereby refused for the following services:

Class 35: Retail services relating to clothing, headwear and footwear, namely T-shirts, sportswear, hats and socks.

Class 43: Preparation of food, namely fried chicken burgers, fried chicken wings and fried chicken strips.

55. However, BFC's mark is permitted to proceed to registration for the following services, being those that were not opposed by DT:

Class 35: Retail services relating to stationery, namely stickers.

## **APPEAL PERIOD**

56. As repeated throughout this decision, the purpose of my remitted decision was to re-evaluate BFC's opposition only. Therefore, the outcome in respect of DT's opposition was not at issue during the appeal or this remitted decision and, therefore, the appeal period for the same has expired. As a result, it is only my



decision in respect of BFC's opposition that remains subject to any appeal going forward.

## **COSTS**

57. I note that at paragraph 29 of the appeal decision, the Appointed Person set out that:

“Whereas the Appellant has succeeded in this appeal, it remains to be seen whether it is successful following reconsideration by the Hearing Officer. I accordingly reserve the issue of the costs of this appeal to the Registry.”

58. I am of the view that in light of the remitted decision, DT has enjoyed the greater degree of overall success in these proceedings. He is, therefore, entitled to a contribution to his costs based upon the scale published in both Tribunal Practice Notice 1/2016 and 1/2023. This is on the basis that DT's opposition was brought prior to 1 February 2023 thereby being covered by the earlier TPN whereas BFC's opposition, being brought after that date, is covered by the latter TPN. Where appropriate, I will award costs in line with the respective scale. However, where the tasks overlap, on the basis that there is not much difference in the costs set out across these two scales, I consider it reasonable to award costs in line with the latter TPN.<sup>8</sup>

59. In the circumstances, I consider it necessary to reflect the comments of the Appointed Person that I have reproduced at paragraph 57 above in the overall costs awarded in favour of DT. Additionally, I note that BFC enjoyed some degree of success in its own opposition. While this related to only one term, I consider it necessary for this to also be reflected in the following costs award.

60. I hereby award DT the sum of £2,500 as a contribution towards his costs. The sum is calculated as follows:

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<sup>8</sup> In doing so, I rely on the wide discretion of the Registry in awarding costs as governed by section 68 of the Act and Rule 67 of the Rules.

Preparing a notice of opposition and considering the counterstatement:	£250
Considering a notice of opposition and preparing a counterstatement:	£300
Evidence:	£700
Filing written submissions in lieu:	£550
Filing written submissions post-decision of the Appointed Person:	£500
Official fees:	£200
<b>Total:</b>	<b>£2,500</b>

61. I hereby order Beak Fried Chicken Ltd to pay Daniel Tapper the sum of £2,500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 2<sup>nd</sup> day of May 2025**

**A COOPER**  
**For the Registrar**