BL O/0096/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK3815842 BY BEAK FRIED CHICKEN LTD TO REGISTER

BEAK

AS A TRADE MARK IN CLASSES 34 & 43

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

AND IN THE MATTER OF APPLICATION NO. UK3849951 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

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF A COOPER DATED 12 SEPTEMBER 2024.

DECISION

Introduction

1. This is an appeal by Daniel Tapper ("**Appellant**") from decision O/0888/24 of Mr Arran Cooper ("**Decision**") concerning cross-oppositions between the Appellant and Beak Fried Chicken Ltd ("**Respondent**").

2. On 2 August 2022, the Respondent filed Application No. UK3815842 ("**the '842 mark**") for the trade mark **BEAK** for the following services:

> **Class 35**: *Retail services relating to clothing, headwear, stationery and footwear, namely T-shirts, sportswear, hats, stickers and socks*.
>
> **Class 43**: *Preparation of food, namely Fried chicken burgers, fried chicken wings and fried chicken strips*.

3. The Appellant opposed the '842 mark on 16 January 2023 under ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994, relying on the following marks ("**Earlier Marks**"):

Mark No.	**Mark**	**Filing & Registration dates**	**Goods/services relied upon**
UK3380292	The Beak Brewery	4 March 2019 / 24 May 2019	**Class 25**: *Articles of clothing; beanie hats; beanies; caps; caps [headwear]; casual clothing; casual shirts; clothing; hats; hooded sweatshirts; hooded tops; jackets; jackets [clothing]; knit tops; padded jackets; rain jackets; rugby tops; shirts; socks for men; sweatshirts; tee-shirts; trousers; t-shirts; windproof jackets.* **Class 43**: *Bar and restaurant services; bar information services; bar services; bars; beer bar services; beer garden services; cafés; canteens; consultancy services relating to food; contract food services; food and drink catering; preparation of food and drink; providing food and drink; providing restaurant services; provision of food and drink; provision of food and drink in restaurants; pubs; restaurant and bar services; restaurant services; restaurants; services for providing drink; serving food and drink in restaurants and bars; wine bar services; wine bars.*
UK3120818	The Beak Brewery	4 August 2015 / 30 October 2015	**Class 40**: *Brewing of beer.*

4. The Appellant opposed all of the Respondent's class 43 services and the following of its class 35 services: *retail services relating to clothing, headwear, and footwear, namely T-shirts, sportswear, hats, and socks*.

5. On 18 November 2022 the Appellant filed Application No. UK3849951 ("**the '951 mark**") for the mark shown below.

6. He sought registration for the following goods and services:

> **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, 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, 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. The Respondent on 1 March 2023 filed an opposition under s. 5(2)(b) in respect of the services underlined above. The Respondent relied upon the following services in the '842 mark:

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

8. The proceedings were subsequently consolidated. The Appellant filed evidence in chief and also evidence in reply. The Respondent did not file evidence but elected to file written submissions during each of the evidence rounds. No hearing was requested and only the Appellant filed written submissions in lieu. In the Decision, A. Cooper for the Registrar held that both oppositions were successful.

9. On 11 October 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

10. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

a. Given that the mark relied upon by the Respondent in its opposition to the '951 mark is itself opposed, it is necessary first to determine the Appellant's opposition to the '951 mark.

b. The Appellant's opposition to the '951 mark succeeded in full under s. 5(2)(b), and accordingly the '951 mark may proceed to registration only in respect of "*Retail services relating to stationery, namely stickers*" in class 35. That decision is not challenged in this appeal, and I accordingly say no more about it.

c. At question 8 of his Form TM8 counterstatement, the Appellant accepted that the services in class 35 are identical.

d. The average consumer for the retail services will be members of the general public at large who will select the services on a primarily visual basis (although aural considerations cannot be discounted) after paying a medium degree of attention. The average consumer of the advertising, promotional and marketing services will for the most part be business users, who will pay attention to the visual and aural components equally and pay a relatively high degree of attention when selecting the services.

e. The marks are visually similar to a medium degree, aurally identical and conceptually similar to a high degree.

f. The '951 mark has a medium degree of inherent distinctive character.

g. There is a likelihood of direct confusion between the marks, and accordingly registration was refused for "*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*" in class 35.

Grounds of Appeal

11. The Appellant contends that the Hearing Officer erred as follows (my numbering):

a. **Ground 1**: Failing to appreciate that the Appellant's admission in its Form TM8 was in respect only of the challenged services in the '842 mark.

b. **Ground 2**: Proceeding on a basis in respect of identicality which is contrary to Registry practice and procedure.

12. The Appellant's trade mark attorney, Mr Jennings, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent did not file any written arguments nor participate in the hearing.

Standard of review

13. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

    i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

    ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

    iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

    iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

    v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

    vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

    vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning

given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

14. I shall bear all the above in mind when reviewing the Decision.

Discussion

(1) Failure to appreciate that the Appellant's admission in its Form TM8 was in respect only of the challenged services in the '842 mark

15. The Appellant contends as follows:

> "the Hearing Officer appears to have been pedantic in that at para 89 he maintains his instance that DT had asserted that all of the services were the same. We say that it is clear (to us but not apparently the Registrar) that intention was that **the challenged** services in BFC's application are identical.
>
> …
>
> What was intended but perhaps not clearly communicated was that the fact that DT considered that the highlighted services below were identical to the challenged services in Class 35 of UK00003815842.
>
> 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". (Appellant's emphasis and highlighting).

16. I am unable to agree. The Appellant's Form TM8 said only:

> "The Applicant accepts that the word element is identical, however the Applicants mark has a strong and distinctive visual identity.
>
> The Applicant accepts that the services in Class 35 are identical.
>
> However the Applicant has opposed the Application UK00003815842 under number OP000438638 as the Applicant has been trading as the Beak Brewery since 2015 and has

provided food & drink under its mark and has also sold a wide range of merchandise under the mark since that time.

Accordingly the Applicant requests that these cross Oppositions are consolidated".

17. There is nothing in the wording above which suggests, either expressly or implicitly, that the admission in respect of identicality of services was in any way qualified. Both the Respondent and the Hearing Officer were entitled to proceed on the basis that identicality of services was admitted by the Appellant.

18. I therefore dismiss this first ground of appeal.

(2) Proceeding on a basis in respect of identicality which is contrary to Registry practice and procedure

19. The Appellant contends that even if, contrary to Ground 1, it has admitted identicality of all services, that admission is contrary to trade mark law and Registry Practice. Specifically, it says that *Advertising and promotion services* are not identical to *retail services*, and *Retail services relating to stationery namely stickers* are not identical to the *retail of clothing, footwear, headgear* or indeed anything 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.*

20. As explained at 2.4.1 of Contentious Trade Mark Registry Proceedings (2nd Edition) by Michael Edenborough KC, however, "*If an allegation is admitted, then that fact or matter is no longer in issue between the parties, and so (a) no evidence needs to be adduced to establish it; (b) no argument needs to be advanced to promote or defend it; and, (c) the tribunal need not trouble itself about it, as it becomes an agreed point between the parties and may be used by the tribunal as a basis for its decision*".

21. Accordingly, the Hearing Officer was not wrong in refusing to go behind the Appellant's admissions and determine identicality/similarity for himself.

22. However, it is in principle possible for a party who has made an admission to seek to resile from that admission. By CPR 14.2(11), "The court's permission is required to amend or withdraw an admission". CPR 14.5 states:

> "In deciding whether to give permission for an admission to be withdrawn, the court shall consider all the circumstances of the case, including—
>
> (a) the grounds for seeking to withdraw the admission;
>
> (b) whether there is new evidence that was not available when the admission was made;
>
> (c) the conduct of the parties;
>
> (d) any prejudice to any person if the admission is withdrawn or not permitted to be withdrawn;
>
> (e) what stage the proceedings have reached; in particular, whether a date or period has been fixed for the trial;

(f) the prospects of success of the claim or of the part of it to which the admission relates; and

(g) the interests of the administration of justice".

23. As stated above, the Appellant's TM8 contained a blanket admission of identicality. The Appellant's submissions in lieu contained detailed arguments as to why the Appellant's services are neither identical nor similar to the Respondent's class 35 services. In my view, it ought to have been obvious to the Hearing Officer that the Appellant was seeking to resile from, or at the very least to qualify, its admission. As such, the Hearing Officer ought to have sought clarification from the Appellant, sought the Respondent's views as to whether the Appellant should be permitted to resile from or qualify its admission, and then made a decision as to whether the Appellant should be permitted to resile from its admission, taking into account all the circumstances of the case including the factors set forth in CPR 14.5.

24. In my view, the Hearing Officer's statement at §90 that "*Given DT's pleaded case, I am bound to proceed on the basis that DT concedes that the services at issue are identical*" indicates that he failed to give any consideration at all as to whether the Appellant should be permitted to resile from or qualify its admission. In doing so, he overly fettered his discretion, which is contrary to principle.

25. I therefore allow this second ground of appeal, albeit on different grounds than advanced by the Appellant. The matter should be remitted to the Registry for consideration of:

    i) whether the Appellant should be permitted to resile from or qualify the admission of identicality of services made in its Form TM8;

    ii) if so, whether any of the Appellant'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, 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 Respondent's "*Retail services relating to stationery, namely stickers*"; and

    iii) if so, whether there is a likelihood of confusion in light of the Hearing Officer's other findings.

Conclusion

26. The appeal is allowed. The matter is remitted to the Registry for consideration of:

    i) whether the Appellant should be permitted to resile from or qualify the admission of identicality of services made in its Form TM8;

    ii) if so, whether any of the Appellant'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, 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 Respondent's "*Retail services relating to stationery, namely stickers*"; and

iii) if so, whether there is a likelihood of confusion in light of the Hearing Officer's other findings.

27. The Respondent should be given the opportunity to file submissions on the issue of whether the Appellant should be permitted to resile from its admission. Furthermore, although the Respondent did not file any submissions below, it may have chosen to do so had it understood that similarity/identicality of services is disputed. I therefore direct that the Respondent may file, within 28 days of this decision, written submissions addressing each of the numbered issues in paragraph 26 above.

28. The Appellant may file, within 28 days of this decision, written submissions addressing issue (i) in paragraph 26 above. The Appellant's submissions in lieu dated 7 February 2024 shall stand as its submissions in relation to issues (ii) and (iii).

Costs

29. 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.

Dr. Brian Whitehead

1 February 2025

Representation

Steven Jennings of Abion UK Limited for the Appellant

The Respondent took no part in this appeal