

BL O/0564/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 4012152

IN THE NAME OF FLAKE BAKE LTD

IN RESPECT OF THE FOLLOWING TRADE MARK

Flake Bake

IN CLASSES 30 AND 35

AND

OPPOSITION THERETO UNDER NUMBER 446756

BY FLAKEY BAKES LTD

AND

IN THE MATTER OF UK REGISTRATION NO. 3735978

IN THE NAME OF FLAKEY BAKES LTD

IN RESPECT OF THE FOLLOWING TRADE MARK

Flakey Bakes

IN CLASSES 30 AND 35

AND

AN APPLICATION FOR INVALIDATION THERETO UNDER NUMBER 507478

BY FLAKE BAKE LTD

Background and pleadings

1. Flake Bake Ltd (“Party B”) applied to register the UK Trade Mark 4012152 in the UK on 7 February 2024 in respect of the following mark:

Flake Bake

2. It was accepted and published in the Trade Marks Journal on 1 March 2024 in respect of the following goods and services:

Class 30: *Savory pastries; Pastries; Frozen pastries; Aromatic preparations for pastries; Mixtures for making pastries; Pastries consisting of vegetables and fish; Pastries consisting of vegetables and meat; Pastries consisting of vegetables and poultry; Preparations for making bakery products.*

Class 35: *Retail services relating to food; Retail services in relation to foodstuffs; Retail services relating to bakery products; Wholesale services in relation to foodstuffs; Business management; Business management of wholesale and retail outlets; Business administration and management; Advertising and marketing; Internet marketing; Online marketing; Influencer marketing; Mail order retail services related to foodstuffs; Trade marketing [other than selling]; Sales promotion using audiovisual media; Business administration services for the processing of sales made on the Internet.*

3. Flakey Bakes Ltd (“Party A”) opposes the contested mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The ground is based on its earlier UK Trade Mark 3735978 for the mark “Flakey Bakes”. The relevant details and list of goods for this mark are shown below:

Filing date: 22 December 2021

Publication date: 15 April 2022

Registration date: 24 June 2022

Class 30: *Pastries; Pastry; Danish pastries; Savory pastries; Puff pastry; Pastry mixes; Fruit pastries; Shortcrust pastry; Frozen pastries; Frozen pastry;*

Chocolate pastries; Macaroons [pastry]; Almond pastries; Pastry shells; Pastry cases; Viennese pastries; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Pastries containing fruit; Frozen pastry sheets; Sopapillas [fried pastries]; Prepared desserts [pastries]; Pastries with fruit; Pastries containing creams; Orange based pastry; Flaky pastry containing ham; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin [pastry]; Pastries filled with fruit; Aromatic preparations for pastries; Fruit filled pastry products; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; Skin [pastry] for spring rolls; Pastries containing creams and fruit; Pastries consisting of vegetables and poultry; Pastries consisting of vegetables and fish; Pastries, cakes, tarts and biscuits (cookies); Pastries consisting of vegetables and meat; Frozen pastry stuffed with meat and vegetables; Bakery goods; Gluten-free bakery products; Preparations for making bakery products; Mixes for making bakery products; Chocolate fillings for bakery products.

Class 35: *Retail services in relation to bakery products; Retail services relating to food; Retail services relating to bakery products; Business administration; Business management and administration; Sales administration; Provision of administrative staff; Business advice; Business networking; Business planning; Promotional marketing; Product marketing; Video recordings for marketing purposes (Production of -); Production of video recordings for marketing purposes; Marketing; Product launches; Product sampling; Product merchandising; Retail services relating to delicatessen products.*

4. Party A asserts that the respective marks, goods and services are similar. It asserts that, as a result, use of Party B's mark is likely to lead to consumer confusion and offends under section 5(2)(b) of the Act.

5. Party B subsequently applied to invalidate Party A's earlier mark on the basis of section 5(4)(a) and section 3(6) of the Act.

6. In respect of the ground based upon section 5(4)(a), Party B relies on goodwill identified by the sign "Flake Bake". It claims use throughout the UK since 2012 in respect of "*Pastries, patties and foodstuffs; retail and wholesale services relating to the same*". When filing its evidence (discussed later) and preliminary submissions, it

conceded that it was claiming goodwill only in respect of “*patties*” and the retail and wholesale of the same.

7. Party B claims that by 2021, its goods and services were also sold in the London area to wholesale customers such as restaurants, take-aways, bakeries and pubs.

8. It asserts that the respective mark and sign are virtually identical and claims that use of Party A’s mark will amount to misrepresentation to the relevant public and that the goods and services originate from, are licensed by, or endorsed by Party B.

9. In respect of the ground based upon section 3(6), Party B claims that it had a significant reputation at the time Party A applied for its mark and that it must have known about this reputation considering that Party B trades in the same area and is in the same field of activity. It alleges that to deliberately choose its mark, Party A intended to pass off itself as Party B. It is also claimed that the sole director of Party A has previously acted in a similar manner by setting up a company in March 2023 called “Baker’s Nxtion CIC” being highly similar to the existing brand “Baker’s Nation”.

10. In addition, Party B asserts that, when filing its mark, Party A had no intention to use it for any goods and services other than patties.

11. Party A filed a counterstatement denying the claims and counterclaiming that Party B did not have a reputation in its mark at the relevant date (22 December 2021, being the date of filing of Party A’s mark).

12. The parties both filed evidence and written submissions in these proceedings. I will keep the submissions in mind and refer to them to the degree that I consider it necessary.

13. The two proceedings were subsequently consolidated.

14. No hearing was requested but Party B filed further written submissions in lieu of a hearing. I make this decision after taking careful consideration of the papers.

15. Throughout the proceedings, Party B was represented by Ionic Legal and Party A was represented by Legalvision Law UK Ltd.

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.

Evidence

17. Party B's evidence includes the two witness statements of Michael Anthony Williams, its managing director. The first statement is accompanied by Exhibits MAW1 – MAW21, the second statement is accompanied by Exhibits SMAW1 – SMAW10. His first statement provides evidence in support of Party B's defence in the opposition proceedings and in support of its application for invalidation of Party A's earlier mark in the opposition. His second statement is provided as evidence-in-reply to Party A's evidence.

18. Party B also relies upon the witness statement of Graham Thomas Mogg, founder, director and CEO of WR Investigations Ltd. His statement is accompanied by Exhibit GTM1. He explains that he was instructed by Party B's representative to conduct an investigation into the trading location of Party A and to conduct subsequent test purchases.

19. Party A's evidence takes the form of the witness statement of Onyekachukwu John Nwajei, sole director and shareholder of Party A, together with exhibits OJN-1 – OJN-8 and is a response to Mr Williams's first witness statement and Mr Mogg's witness statement.

DECISION

Party B's Application for Invalidation

Section 3(6)

20. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

21. Section 3(6) is relevant in applications for invalidation because of the following part of section 47:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

22. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaeenvnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45;

[*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may

constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It

may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

23. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

24. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

25. Party B claims that:

- (i) it had a significant reputation at the time Party A applied for its mark;
- (ii) Party A must have known about this reputation considering that Party B trades in the same area and is in the same field of activity;
- (iii) Party A deliberately chose its mark and intended to pass itself off as Party B;

- (iv) the sole director of Party A has previously acted in a similar manner by setting up a company in March 2023 called “Baker’s Nxtion CIC” being highly similar to the existing brand “Baker’s Nation”.

Was that an objective for the purposes of which the contested application could not be properly filed?

26. Points (i) and (ii) of the previous paragraph are not essential for a claim of bad faith and the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith.¹ However, if Party A deliberately chose its mark and intended to pass off itself as Party B, that would clearly be an act of bad faith.

27. Party B’s fourth claim is not established in the evidence and, therefore, the exact circumstances are unknown. Even, if it was, it may, but not necessarily, add weight to an argument that Party A’s registration was obtained as part of a pattern of behaviour, but is not, in itself, sufficient to find a claim of bad faith in respect of its Flakey Bakes mark. I do not need to say anymore on this point.

Was it established that the contested application was filed in pursuit of that objective?

28. In its written submissions Party B relies upon the following evidence to support its claims:

- It is claimed that Clifton Donovan Wade is Mr Nwajei’s business partner and operates the Golden Flakes Enterprise Limited (hereafter “Golden Flakes”) store within 4 miles of Party B’s bakery. Party B infers that, because of this close proximity, Party A must have known about Party B.² I also note that Mr Nwajei, the director and stakeholder of Party A, worked for Golden Flakes from 2019.³ Party B states that its delivery vans would have passed Mr Nwajei’s place of work in 2019/20 and Party B also had customers in close proximity to his location;⁴

¹ *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 and *Koton* at [55]

² MAW WS1, [43]

³ Mr Nwajei’s own witness statement, [6]

⁴ MAW WS2, [23] and Exhibit MAW-1) to his first witness statement.

- Party B has operated an extensive delivery of flyers and its goods in London over the last 12 years, including in the Stratford area being the specific geographical location of Golden Flakes;
- A large number of Party B's customers are, or have been, based in the Stratford area of London as illustrated in an exhibited customer list;⁵
- It is alleged that even rudimentary market and company research would have identified the existence of Party B and the use of its sign.⁶ This assertion is supported by contemporaneous results of a Google search where Party B appears as the first result;⁷
- Mr Nwajei is not of Caribbean heritage and has no obvious connection or history with baking Caribbean patties;⁸
- Mr Nwajei has three County Court judgments against him;⁹
- Party A operates within the Stratford area of London and targets its sales in London and supplies its products through the Golden Flakes bakery located in that area.¹⁰ Mr Mogg placed an order for Jamaican patties from the Facebook account "@flakeybakes" and paid for by way of bank transfer to Party A and collected from the Golden Flakes bakery in Stratford;¹¹
- It is alleged that Party A has copied elements of the packaging for Party B's goods.¹² The relevant part of the packaging from Mr Mogg's test purchase is shown below:

⁵ MAW WS1, [26] and MAW13, [115] being a map showing proximity of Party B's customers to Party A's location

⁶ MAW WS1, [44]

⁷ Exhibit MA20

⁸ MAW WS1, [45]

⁹ Mr Mogg's witness statement, [3.4] – [3.5]

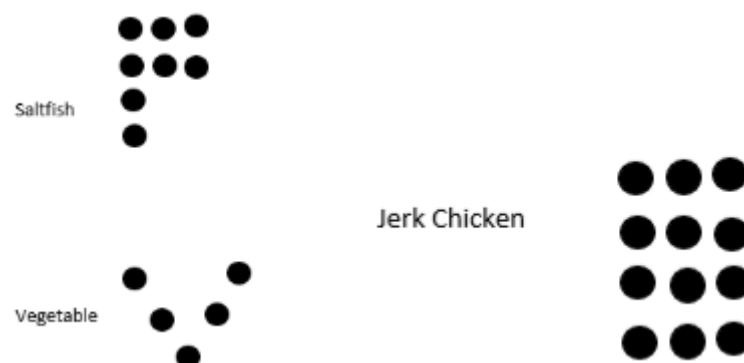
¹⁰ Mr Mogg's witness statement, [5] and his investigation report provided at Exhibit GTM1

¹¹ Exhibit GTM1

¹² MAW WS1, [46]



- Party B states that it uses the following motifs and, as far as Mr Williams is aware, these are distinctive and are not used by any competitors:¹³



- Mr Williams states that he finds “it inconceivable that Party A was not aware of the FLAKE BAKE name or [its] activities before setting up its company and registering a similar name.”¹⁴

¹³ Ibid, [46]

¹⁴ Ibid, [47]

- In response to Mr Nwajei's claim that he found no similar name to "Flakey Bakes" when conducting online searches prior to choosing Party A's mark. Party B provides pages from an Internet search for "Flake Bake"¹⁵ that shows hits only for Party B. It is asserted that this demonstrates that "nobody else has used the term "Flake Bake" either before Party B started in 2012 or since."¹⁶ A search for "Flakey Bakes" was also conducted.¹⁷ The screenshots show an advertisement for Party B appearing alongside the top listing, being a link to the Companies House record of Party A. The second listing is a link to Party B and it is asserted that during the time when Party A contends that it undertook online searches (i.e. before Party A existed) it is a logical conclusion that Party B would have been the top listing;¹⁸

29. Party A's evidence that I consider most relevant in respect of the bad faith claim is as follows:

- The "Flakey Bakes" mark was chosen because it "directly described" what Party A intended to sell, namely, flakey Jamaican bakes and because it was also a homage to its supplier, Golden Flakes;¹⁹
- Mr Nwajei claims that "flakey"/"flaky" and "bakes"/"bake" are descriptive and he provides dictionary meanings. He also points to Party B's descriptive use of "flaky" and "bake" on its website;²⁰
- Mr Nwajei claims that, before adopting the name, he undertook online searches of the marketplace, Companies House register and the UK trade marks register but did not find any similar businesses using a similar name.²¹ These searches also included "many businesses using the words "flake" and "bake", or something similar."²² The only descriptive use identified in the exhibit is a reference "freshly baked goods". I also note that on the same page there are

¹⁵ At Exhibit SMAW9

¹⁶ MAW WS2, [21]

¹⁷ See Exhibit SMAW10

¹⁸ MAW WS2, [22]

¹⁹ Mr Nwajei's witness statement ("OJN WS") at [7]

²⁰ OJN WS at [9] and Exhibit OJN-2

²¹ Ibid, [10]

²² Ibid and Exhibit OJN-2

several times where Party B refers to “Flake Bake Products” as a way of identifying the trade origin of the goods discussed;

- Mr Nwajei states that he had no prior knowledge of Party B, its brand, business, reputation or goods and services at the time he adopted the mark “Flakey Bakes” as his business name in February 2020;²³
- Mr Nwajei denies that Mr Wade is his “business partner”,²⁴ but is silent on whether he has a business relationship with Mr Wade in his capacity as a controlling mind of Golden Bakes;
- Mr Nwajei confirms that he conducted a Google search at the time of adopting the name “Flakey Bakes” in 2020 but asserts that Party B did not appear in the results;²⁵
- In response to Party B’s evidence that Party A replicated parts of Party B’s packaging when using the same motifs linked to particular flavours, Mr Nwajei states “the flavours ... are basic meat and vegetable flavours ...[and] are generic fillings used historically in Jamaican patties. Party B does not own, and did not invent, these fillings.”²⁶ In response to Party B’s claim that Party A has copied the motifs used with each flavour, Mr Nwajei asserts that Party B has failed to show ownership of these and that they are “highly generic”. He further claims that Party A has no control over their use because it is its supplier, Golden Flakes that uses them “as it is common practice in the industry”;²⁷
- In response to Party B’s claim about Mr Nwajei’s “Baker’s Nxtion” trade mark, Mr Nwajei states that it is currently being used for a different purpose, namely as a name of a community group and space for bakers and chefs and he sees no need to use that mark for Party A’s flakey, baked products;²⁸

²³ Ibid, [11]

²⁴ Ibid, [17b]

²⁵ Ibid, [17e]

²⁶ Ibid, [17g]

²⁷ Ibid

²⁸ Ibid, [17h]

- It is asserted that Party B's evidence referencing County Court judgments against Mr Nwajei is irrelevant to the issue of bad faith in these proceedings.²⁹

30. I agree with Party A that certain of the points made by Party B fail to shed light on the issue of bad faith such as Party B's reliance on outstanding County Court judgments against Mr Nwajei, however, other points have more force. The central question before me is whether Party A's filing of the contested mark (being highly similar to the sign used by Party B) was a coincidence or with some other honest motive, or was its filing done with the intention of undermining the interests of Party B in a manner inconsistent with honest practices.

31. It is not disputed that Party A's goods are sold by Golden Flakes in the same locality in London where Party B is based and where some of its customers are based. Further, the central business of both parties is the sale of Jamaican patties. The respective signs are highly similar. I accept that the words "flake", "flakey", "bake" and "bakes" separately have descriptive significance in relation to bakery goods and pastries. However, that does not, of itself, explain why Party A adopted a sign which so closely approximates to Party B's trading sign, particularly where both parties operate in the same specific field and in the same geographical area. The explanation that "Flakey Bakes" was chosen because it described Party A's intended goods and was a homage to Golden Flakes does not, in my view, adequately account for the particular combination selected, nor for its closeness to "Flake Bake".

32. The evidence regarding the packaging motifs adds to my concerns. Party B's case is not simply that Party A used commonplace flavours or descriptive indications of those flavours. Rather, it is that Party A used motifs which correspond to those used by Party B to indicate particular patty fillings. Party A's response is that such motifs are generic and that their use is controlled by Golden Flakes, its supplier. I do not find that explanation satisfactory. No evidence has been provided to show that the same combination of motifs is common in the trade, nor is there evidence from Golden Flakes explaining the source of the motifs or why they were selected. In circumstances where the parties' signs are already highly similar, the unsupported assertion of why Party A uses some of the same motifs as Party B is a further objective circumstance

²⁹ Ibid, [18]

pointing away from coincidence and towards an intention to benefit from, or at least to come too close to, Party B's presentation in the market.

33. I also have doubt about Party A's evidence concerning the searches it says were undertaken before the adoption and filing of the mark. Mr Nwajei states that searches of the marketplace were carried out as well as searches of the Companies House register and the UK trade marks register, but no documentary evidence of those searches has been provided and the evidence is not detailed as to the precise search terms used, the dates on which the searches were conducted, or the results obtained. In particular, if a Companies House search was carried out for "Flakey Bakes" or closely similar terms, it would be expected to reveal the existence of Flake Bake Ltd. That is an obvious source which a trader adopting a company or trading name in the same field would be expected to check. The absence of a convincing explanation for why such a search did not reveal Party B, or why the existence of Party B was not otherwise discovered, undermines Party A's denial of awareness.

34. When factoring the above points onto the overall assessment, I am satisfied that the objective circumstances rebut the presumption of good faith. The high similarity between the respective signs, the parties' close field of activity and close geographical proximity of their trading activities, the absence of an acceptable explanation for the adoption of corresponding motifs, and the doubts surrounding the Companies House register search said to have been undertaken, when taken together lead me to conclude that Party A did not file the application with the aim of engaging fairly in competition, but with the intention of undermining Party B's interests in a manner inconsistent with honest commercial practices. The section 3(6) ground is therefore made out.

Section 5(4)(a)

35. 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.”

36. 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.”

37. Section 5A of the Act is as follows:

“5A 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.”

38. Section 5(4)(a) is relevant in invalidation proceedings under section 47(2)(b) of the Act:

47 Grounds for invalidity of registration.

(1) ...

(2) ... the registration of a trade mark may be declared invalid on the ground—

(a) ...

(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.

39. 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).”

40. 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 reputation 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.”

41. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), 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.' "

42. Party A's mark has a filing date of 22 December 2021, and this is the primary relevant date for assessing passing off. In its evidence,³⁰ Party A states that it was incorporated on 11 February 2020 and labels this as "the date of first use". In its written submissions, Party B states that it "is content" to take this date as the relevant date. I will, nonetheless, consider the issue of goodwill at both dates.

Goodwill

43. The following comments from *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) still hold good in understanding the meaning of "goodwill":

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

44. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The

³⁰ Mr Nwajei's witness statement (hereafter "OJN WS") at [13]

requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

45. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least *prima facie*, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

46. Party B has provided the following evidence that is relevant to the assessment of goodwill:

- Party B's FLAKE BAKE business was established in 2012 producing Jamaican patties³¹, with Flake Bake Ltd incorporated on 7 February 2012, taking over

³¹ Mr Williams' first witness statement (hereafter "MAW WS1") at [10] and [11]

existing goodwill, equipment, customer lists, recipes and employees from the predecessor sole-trader business.³²

- The FLAKE BAKE name was adopted and used from 2012 onward in connection with this specialist Jamaican patty business. Mr Williams says the company focused solely on manufacturing and supplying Jamaican patties, and that the name reflected the product's characteristically flaky pastry.³³
- Party B registered and used the domain name flakebake.co.uk on 21 February 2012,³⁴ and says the website operated under the FLAKE BAKE brand selling patties from that date.³⁵ A list of invoices is provided showing expenditure for setting up the domain name flakebake.co.uk on 21 February 2021 and, thereafter, several invoices a month relating to what appears to be the upkeep and renewal of the domain name up to October 2024.³⁶
- Its patties are sold to numerous restaurants, takeaways, bakeries, pubs, market stalls, caterers, corporate offices and individuals.³⁷ The products can be purchased by wholesalers from stalls, online or over the phone. A flyer showing Party B's product range (since 2012) are shown in the copy of a flyer shown below:³⁸

³² MAW WS1 at [12]

³³ MAW WS1 at [11] and [15]

³⁴ MAW WS1 at [13]

³⁵ MAW WS1 at [20]

³⁶ MAW WP1 at [20] and Exhibit MAW4

³⁷ MAW WP1 at [16]

³⁸ Exhibit MAW1



- Mr Williams estimates that 99% of Party B's business is through Business to Business (B2B).³⁹
- Party B has operated from the website www.flakebake.co.uk since at least December 2012 featuring prominent use of the FLAKE BAKE name, with website screenshots provided from 11 August 2013 and 31 October 2024 both showing the following mark ("the figurative mark"):⁴⁰



- Party B states that it has traded from its physical premises in London bearing FLAKE BAKE branding, and photographs of the store are provided showing the

³⁹ MAW WS1 at [17]

⁴⁰ MAW WS at [19] and Exhibit MAW3

banner reproduced below. It is stated that the branding was in the same format before December 2021.⁴¹



- Party B has sold patties in packaging clearly displaying the FLAKE BAKE mark, and Mr Williams says the exhibited packaging has been used since the business first started trading in 2012.⁴² Undated photographs of boxes and packaging show the “the figurative sign” appearing prominently with the additional words “WE BAKE, YOU TASTE” appearing underneath the sign:



- Party B had significant sales by December 2021, with Mr Williams estimating that by that date about 73% of more than 6 million patties sold to date had already been sold.⁴³
- Turnover figures before the relevant date rise from £314,683 (2014) to £608,224 (2020), with £354,432 recorded for 2021.⁴⁴ Estimated patty sales

⁴¹ MAW WS1 at [18] and Exhibit MAW2

⁴² MAW WS1 at [22] and Exhibit MAW6

⁴³ MAW WP1 at [23]

⁴⁴ ditto

figures for the same period show 810,965 patties sold in 2020 and 472,576 in 2021⁴⁵.

- Party B provides the following information regarding its customer network before 2021:
 - Mr Williams states that before December 2021 Party B's customers included five retail outlets "based throughout London, including Stratford in particular, and other parts of the UK".⁴⁶
 - Party B provides a collection of 43 redacted invoices and delivery slips dating from between November 2013 and December 2021 all for amounts between the tens of pounds and £450. The first 23 (the latest of which is date April 2014) are headed "Packaging/Delivery Slip" and show the figurative sign appearing at the top right of each slip, The remaining 19 dated between October 2018 and December 2021 are headed as invoices and are for similar amounts as the slips. These invoices are identified as coming from "FLAKE BAKE LTD" but the sign does not appear elsewhere. The invoices relate to the sales of different flavours of "Patty" and "Cocktail Patty". The documents labelled as delivery slips do not identify the goods, but rather only the flavours which correspond to those identified in the later invoices, such as beef, chicken, lamb, fish etc and I accept that the delivery slips relate to patties.⁴⁷
 - Mr Williams states that Party B has 318 customers on its customer list (that is dated 2022 and includes individuals and businesses) including customers in Stratford and elsewhere in London and the UK.⁴⁸

⁴⁵ MAW WP1 at [24]

⁴⁶ MAW WS1 at [26]

⁴⁷ MAW WS1 at [26] and Exhibit MAW13

⁴⁸ ditto

- A high-profile customer was Levi Roots' Caribbean Smoke House, supplied by Party B between 2015 and 2018, which Mr Williams relies on as an example of the brand's market presence.⁴⁹
- Party B promoted its goods extensively before December 2021 through printed leaflets, with around 10,000 flyers printed and distributed across South, East and West London, including Stratford, Hackney, Enfield, Tottenham and Wood Green.⁵⁰
- Party B promoted the brand through:
 - sponsorship of a UCL TedX Talk in 2012, where leaflets and business cards were handed out,⁵¹
 - the supply of products through local schools and mentoring links, providing work experience to more than 15 students between 2012 and 2021 and supplying patties for school sports days, cultural days and lunches.⁵²
 - supplying takeaways in London, which displayed Party B's posters in their windows to show that they sold its patties; examples of posters used before 2021 are provided and show the figurative mark prominently.⁵³
 - posters were displayed at the market stalls of Party B's customers including at festivals such as Glastonbury.
 - its branded delivery van that, before 2021, made regular deliveries across South East, South West, East and North London.⁵⁴

⁴⁹ MAW WS1 at [26] and [25(g)] and Exhibit MAW13

⁵⁰ MAW WS1 at [25(a)] and Exhibit MAW7

⁵¹ MAW WS1 at [25(b)] and Exhibit MAW5

⁵² MAW WS1 at [25(c)]

⁵³ MAW WS1 at [25(d)] and Exhibit MAW8

⁵⁴ MAW WS1 at [25(g)] and Exhibit MAW10 (being a photograph of a van with promotional material appearing on it including the figurative mark and Party B's web address)

- Party B supplied vendors at Notting Hill Carnival every year since 2012, selling at least 7,500 patties each year from 2015 onwards, and over 10,000 patties in 2019, exposing the brand to a very large public event.⁵⁵
- Party B advertised on local London radio from 2012 to 2014 using a FLAKE BAKE jingle to raise the business profile and attract customers.⁵⁶
- Party B has maintained a Facebook presence from March 2012 and by 4 November 2024 had 587 likes and 812 followers. An example of post, dated 16 March 2012, has the name of the account as “Flake Bake Patties” and the following two figurative signs also appear:⁵⁷



- Further Facebook posts from the same exhibit and dated 1 June 2012 also shows the name of the account as “Flake Bake Patties”.

47. Party A submits that the use shown in Party B’s evidence is insufficient that the law of passing off would prevent Party A’s use of its mark. It supports this position with the submission that it is not believed that Party B has met “the higher threshold for section 5(4), despite this threshold having [allegedly] been met for Party A’s section 5(2)(b) ground”⁵⁸ in its opposition. I take this as a submission that the threshold for demonstrating genuine use is lower than the threshold for demonstrating the existence of goodwill. I do not consider this to be correct, but in any case, as Party A’s does not rely upon enhanced distinctive character in its opposition (based on section 5(2)(b) only), this statement is irrelevant. In the invalidation proceedings, I only have to

⁵⁵ MAW WS1 at [25(h)]

⁵⁶ MAW WS1 at [25(i)]

⁵⁷ MAW WS1 at [21] and Exhibit MAW5

⁵⁸ Paragraph 7b of Party A’s written submissions.

consider actual use to the extent that it demonstrates Party B's claim to be the owner of goodwill.

48. I do not accept Party A's submission that Party B's evidence is insufficient to establish goodwill for the purposes of section 5(4)(a). The evidence shows that Party B has traded since 2012 in relation to Jamaican patties and the wholesale of such patties. Although some of the exhibits are undated and the evidence is not as complete as it might have been, the material as a whole presents a coherent picture of a continuing business well before the relevant date of 22 December 2021. Its turnover, rising from £314,683 in 2014 to £608,224 (equating to over 800,000 patties sold) in 2020, is small but not trivial and illustrates sustained commercial activity. There is also corroborative evidence in the form of invoices and delivery slips spanning 2013 to 2021, together with evidence of an established customer network. Whilst Mr Williams estimates that approximately 99% of the business was conducted on a business-to-business basis, that does not detract from the existence of goodwill. On the contrary, this evidence illustrates that Party B has goodwill established during a period of nine years prior to the relevant date in these proceedings in respect of Jamaican patties and the wholesale of the same. The scale of use suggests that this goodwill is modest in nature and limited to the London area. There is narrative evidence of Party B conducting its business further afield, but this is not substantiated or corroborated in the evidence. Nevertheless, the use shown is sufficient to demonstrate that it has a protectable goodwill. Party B acknowledges that its business has operated mainly in London but, as it correctly points out, a localised goodwill can be sufficient to run a successful action under section 5(4)(a) as per the comments of Patten LJ in *Caspian Pizza Ltd v Shah* [2027] EWCA Civ 1874 at [23]:

“The only requirement is that the opponent should have established goodwill in the mark over an identifiable geographical area that would qualify for protection in passing off proceedings ... goodwill which is established in a particular locality will be capable of preventing registration of a countrywide mark”

49. It is well established that the law of passing off protects goodwill as a property right of the claimant's business, rather than conferring any proprietary right in a mark or

sign as such.⁵⁹ Keeping this in mind, it is necessary for Party B to demonstrate that the get-up under which the goods have been sold has become associated in the minds of substantial numbers of the purchasing public specifically and exclusively with Party B.⁶⁰ Party B claim that its goodwill is attached to the word sign “FlakeBake”,⁶¹ however, its evidence illustrates that in the vast majority of Party B’s trading, it and its goods are identified by reference to the following figurative sign:



50. Therefore, the question before me is whether the public has come to recognise the sign “Flake Bake” as being distinctive of Party B’s goods or services. I am not aware of any rule of law preventing goodwill from subsisting in the verbal element of a composite or figurative sign. The question is one of fact, namely, whether the word element relied upon has come to denote the claimant’s business independently of, or at least distinctly within, the overall get-up. As Lord Oliver made clear in *Reckitt & Colman*, the claimant (Party B, in this case) must show goodwill “attached to the goods or services ... by association with [their] ... brand name or a trade description, or the individual features of labelling or packaging”, such that the relevant public identify the get-up as distinctive of its goods and services.⁶²

51. I do not consider that this requirement prevents the conclusion that the verbal element present in a figurative mark is functioning in a way that the relevant public perceives and relies upon it as indicating trade origin. Therefore, goodwill may be identified by the verbal element alone. Conversely, if the evidence shows that recognition is confined to the composite presentation as a whole and that the word element does not function independently as a badge of origin, the goodwill will be

⁵⁹ *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 at [499] and [510]

⁶⁰ See *Reckitt & Colman* at [499]

⁶¹ As shown on page 4 of its Form TM26(l)

⁶² *Reckitt & Colman* at [499]

identified only in the figurative sign as used. The absence of use of the verbal element as a “plain word mark” is not always determinative. The existence and scope of goodwill depend upon the perception of the relevant public, and whether the element relied upon (in this case, the verbal element) has become distinctive of Party B’s business.

52. Turning to the circumstances in this case, Party B has relied upon the sign “Flake Bake” rather than the figurative sign shown in the majority of the evidence. However, I am satisfied that this does not present any difficulty on the facts of this case. The words “Flake Bake” are clearly legible within the figurative sign and would be readily understood by customers as the verbal element of that branding. In ordinary use, customers are likely to refer to and remember that sign by those words. The same words also appear on many of the invoices exhibited where they identify the originator of the invoices as “Flake Bake Ltd”.

53. In particular, I have regard for the following facts established in the evidence:

- (i) The words “Flake Bake” are used as part of Party B’s Facebook presence from March 2012, with its account name being “Flake Bake Patties”;
- (ii) The words “flake bake” form the principal and memorable element of Party B’s website and domain name, “flakebake.co.uk” and this company name is shown in use on many of the exhibited invoices, and;
- (iii) 99% of Party B’s trade is business to business. I consider it likely that business customers are more likely to be aware of the company behind the goods and services (namely Flake Bake Ltd) and that increases the likelihood that Party B being known to its customers as “Flake Bake”.

54. There is narrative evidence that Party B’s brand was promoted by way of a local London radio and therefore there has been promotion by way of aural use of the verbal sign “Flake Bake”. However, there is no corroboratory evidence to support this and I do not take this evidence into account. Nevertheless, taking all of the points identified in the previous paragraph, together with the use of the figurative sign where the dominant element is the verbal element, I find that Party B’s goodwill is identified by

the words “Flake Bake” at least in respect of *Jamaican patties and the wholesale of the same in the London area*.

55. I also do not consider that the position was materially different on 11 February 2020, being the earlier date of first use asserted by Party A. The evidence points to an established trading business operating continuously for a number of years before either date. Consequently, whether the matter is assessed by reference to 11 February 2020 or 22 December 2021, Party B has demonstrated that it owned protectable goodwill for the purposes of section 5(4)(a) of the Act and this goodwill attaches to the name “Flake Bake”.

56. I also comment briefly on Party A’s submission that Party B cannot generate goodwill associated by the sign “Flake Bake” on the basis that the sign is “highly non-distinctive for Jamaican patties”.⁶³ Party A, in its evidence,⁶⁴ provides a number of exhibits which, it purports, supports this view but I agree with Party B in that they do not illustrate descriptive use of “Flake Bake”. The dictionary definitions of “flakey” and “bakes”⁶⁵ is not disputed by Party B, but it points out that the term is not defined in either the Cambridge Dictionary, the Collins Dictionary or the Oxford Dictionary. I consider the sign to be allusive of baked products that are flakey in nature however, the evidence fails to illustrate that there is a product described as a “flake bake”. Further, and despite this conclusion, I also agree with Party B that even if it was perceived as being descriptive, this would not necessarily preclude Party B from acquiring goodwill attaching to the sign. In reaching this conclusion, I keep in mind the following from *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or

⁶³ Party A’s written submissions of 14 January 2025 at [26]

⁶⁴ Exhibit OJN-8

⁶⁵ Provided at Exhibit OJN-1

in part of words descriptive of the articles to be sold or the services to be rendered.”

57. I will keep the allusive nature of Party B’s sign and the resultant lower level of distinctive character in mind when considering the question of misrepresentation.

58. In summary, I find that Party B has a small but not trivial goodwill in the London area in respect of *patties and wholesale of the same* and this goodwill attaches to the sign “Flake Bake”.

Misrepresentation

59. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product]”

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions

are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

60. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

61. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

62. In *Neutrogena*, Morritt L.J. also stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

63. In considering whether misrepresentation will occur, I have regard for:

(i) The strength of Party B's goodwill

I have found that Party B has a small, but not trivial goodwill in the London area.

(ii) The respective signs

Party A's mark consists of the words "Flakey Bakes" and that these words are very similar in appearance and meaning to Party B's sign "Flake Bake". They differ in that Party A's mark has an additional letter "y" at the end of the first word and an "s" at the end of the second word. The addition of these letters gives the mark only a marginally different meaning to Party B's sign. Party A has relied on an argument that the words in both parties' marks are descriptive, but it is clear from the evidence before me that they are both using their marks as indicators of origin.

(ii) The respective fields of activity

Party A's Class 30 goods, namely, *Savory pastries; Pastries; Frozen pastries; Aromatic preparations for pastries; Mixtures for making pastries; Pastries consisting of vegetables and fish; Pastries consisting of vegetables and meat; Pastries consisting of vegetables and poultry; Preparations for making bakery products* are either broad terms that include Jamaican patties or are products or preparations for making Jamaican patties, therefore, all of Party A's goods are identical, or very similar to Party B's goods and I conclude that they are in the same field of activity.

Party A's Class 36 services include *Retail services relating to food; Retail services in relation to foodstuffs; Retail services relating to bakery products; Wholesale services in relation to foodstuffs; Mail order retail services related to foodstuffs*. In respect of *wholesale services in relation to foodstuffs*, this self-evidently includes the services in which I have found Party B has goodwill. In respect of Party A's various retail services, whilst they are not identical to Party B's wholesale services, nevertheless, they are so highly similar that a customer or potential customer of Party B, encountering such retail services are likely to

assume that they are being provided by Party B as part of an expansion of its activities.

In respect of Party A's *Business management; Business management of wholesale and retail outlets; Business administration and management* are services that, when provided to others, are in a different field of activity to patties and the wholesale of such. Party B submits that all of Party A's services are in the identical field of activity. I do not agree that they are. Here Party A's goods are business management and administration services provided to others rather than provision of, or wholesale of food.

In respect of Party A's remaining services, namely *Advertising and marketing; Internet marketing; Online marketing; Influencer marketing; Trade marketing [other than selling]; Sales promotion using audiovisual media; Business administration services for the processing of sales made on the Internet*, it is not clear to me that such services would be provided by a business producing patties and the wholesale thereof. Such services are clearly not in the same or related field of activity. The relevant public would not expect that such services would be provided by Party B. The relevant consumer would expect to go to a specialist provider of promotional and administration services.

(iii) The degree of attention of consumers

Party B's activities are predominantly business to business and it is these business customers and other potential customers that are the consumers who must be likely to be deceived. They are likely to buy larger quantities (and therefore larger financial outlay) than individual members of the public and are likely to have a slightly increased level of attention, but still not particularly high.

64. The absence of a common field of activity is not fatal, but it remains a relevant consideration.⁶⁶ Taking this and all of the above into account, the contested mark and Party B's sign are so similar that a significant number of the relevant public would be highly likely to be deceived in respect of goods and services that are identical or are in the same field of activity.

⁶⁶ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

65. In respect of Party A's business services that could be provided to customers in the same field as Party B, the extra distance between the nature of the services makes misrepresentation less likely than where they are in the same field of activity. This is counterbalanced to a degree by the closeness of the contested mark to the sign. I consider that deception becomes more likely but, to my mind, still not likely to occur.

66. Party B, in its written submissions, also relies on a claim that Party A should not be able to resile from its position in the consolidated opposition that similar considerations under section 5(2)(b) should lead to a finding that there is a likelihood of confusion. I note this, but I am not aware of any rule preventing a party from advancing inconsistent positions in different proceedings. I need say not more on the point.

67. I have found earlier that Party A's application was made in bad faith and with the intention of undermining Party B's interests in a manner inconsistent with honest commercial practices. I keep in mind that if intent is proven, misrepresentation will be more readily inferred.⁶⁷

68. Taking all of the above into account, I find that misrepresentation is likely to occur in respect of at least some of Party A's goods and services. I discuss the scope of success of Party B's claim below.

Damage

69. In *Harrods*, Millett L.J. described the requirements for damage in passing off cases like this:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the

⁶⁷ *Office Cleaning Services*

plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

70. It is clear to me that damage may occur to Party B's goodwill in circumstances where Party A's mark is used in respect of goods and services in the identical field of activity. I consider all of the following terms, in Party A's Class 30, to describe the goods provided by Party B or broad terms that include goods provided by Party B. Therefore, they are self-evidently in the same field:

Class 30: *Pastries; ...; Savory pastries; ...; Frozen pastries; ...; Sopapillas [fried pastries]; Flaky pastry containing ham; Mixtures for making pastries; ...; Aromatic preparations for pastries; ...; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; ...Pastries consisting of vegetables and poultry; Pastries consisting of vegetables and fish; Pastries, ...; Pastries consisting of vegetables and meat; Frozen pastry stuffed with meat and vegetables; Bakery goods; Gluten-free bakery products; Preparations for making bakery products;*

71. I consider that all of Party A's remaining goods (listed below), whilst not identical to Party B goods are, nonetheless, bakery products and, therefore highly similar, and I consider that they are in the same field of activity and likely to be considered a natural extension of the goods provided by Party B:

Class 30: *... Pastry; Danish pastries; ...; Puff pastry; Pastry mixes; Fruit pastries; Shortcrust pastry; ...; Frozen pastry; Chocolate pastries; Macaroons [pastry]; Almond pastries; Pastry shells; Pastry cases; Viennese pastries; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Pastries containing fruit; Frozen pastry sheets; ... Prepared desserts [pastries]; Pastries with fruit; Pastries containing creams; Orange based pastry; ...; Pastry shells for monaka; Spring roll skin [pastry]; Pastries filled with fruit; ...; Fruit filled pastry products; ...; Skin [pastry] for spring rolls; Pastries containing*

creams and fruit; ..., cakes, tarts and biscuits (cookies); ...; Mixes for making bakery products; Chocolate fillings for bakery products.

72. In respect of Party A's Class 35 services, I consider that none of the terms describe the same services of Party B (being the *wholesale of patties*), however, I consider that the following terms are very similar to those of Party B and describe the services in the same field of activity (or at least in a highly similar field of activity) and also in the same field of activity as Party B's goods:

Retail services in relation to bakery products; Retail services relating to food; Retail services relating to bakery products; Retail services relating to delicatessen products

73. In respect of Party A's use of its mark in respect of the goods and services that I have found to be in the same field of activity, it is clear that Party B would lose some control over its own reputation with the relevant consumer likely to believe that Party A's goods and services were those of Party B and would also likely lead to an unfair loss of business to Party A. Therefore, I find that damage to its goodwill is likely to occur.

74. Party A's remaining services are:

Business administration; Business management and administration; Sales administration; Provision of administrative staff; Business advice; Business networking; Business planning; Promotional marketing; Product marketing; Video recordings for marketing purposes (Production of -); Production of video recordings for marketing purposes; Marketing; Product launches; Product sampling; Product merchandising

75. In respect of these services, I keep in mind that cogent evidence of damage, or a real likelihood of damage, is required in a case where the parties are engaged in very different fields of commercial activity. In *Stringfellow and Anr. v McCain Foods (G.B.) Limited and Another* [1984] RPC 501 (COA) Lord Justice Stephenson said:

"The development of the law of passing off can be justified by the need to protect traders' business and goodwill and at first sight seems to justify the

learned judge's decision in this case. But I have come to the conclusion that we can and should reverse his decision for the reasons given by Slade LJ.

The case is very far removed from the case of a small and perhaps disreputable trader deliberately seeking to attract to his business the goodwill attaching to the established business of a well known trader in the same field. In such a case damage and the likelihood of damage are easily proved. It is, however, much too late to confine the tort of passing off to such clear cases. Decisions of the highest authority permit the courts to restrain innocent and reputable traders from describing and advertising their own goods in a manner which may lead their customers reasonably to assume a connection with another's business, even if they do not intend to derive, or in fact derive, any benefit from the innocent description and the assumed connection and even if they are operating in a different line of business.

Here the respondents seek to supplement what Slade LJ. has aptly called the "tenuous overlap" between their fields of activity and the appellants' by contemplating the prospect of damage to the respondents in the field of future franchising or merchandising.

I have some doubts whether such damage is recoverable in a passing off action, but I have no doubt that it is not recoverable by the respondents on the facts set out by Slade LJ. I agree with him that in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or the real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser of Tullybelton said in the *Advocaat* case, be substantial. In this case there was no such proof."

76. In the current case, insofar as Party A's application covers services not in the same field as Party B. In line with Lord Justice Stephenson's comments above, Party B's claim that such services are in fact in the same field of activity and use of Party A's mark would result in misrepresentation and damage to its goodwill is not made out in its evidence. I, therefore, dismiss the claim in respect of these services.

Summary of findings under section 5(4)(a)

77. Party B's application for invalidation based upon section 5(4)(a) succeeds in respect of all of Party A's Class 30 goods and the following of its Class 35 services:

Retail services in relation to bakery products; Retail services relating to food; Retail services relating to bakery products; Retail services relating to delicatessen products.

78. It fails in respect of the following of Party A's Class 35 services:

Business administration; Business management and administration; Sales administration; Provision of administrative staff; Business advice; Business networking; Business planning; Promotional marketing; Product marketing; Video recordings for marketing purposes (Production of -); Production of video recordings for marketing purposes; Marketing; Product launches; Product sampling; Product merchandising

Party A's Opposition based upon Section 5(2)(b)

79. Party B has been wholly successful in its application to invalidate Party A's earlier mark relied upon in this opposition insofar as it relied upon section 3(6) of the Act. I also found that it was partially successful in respect of its grounds based upon section 5(4)(a). As a result, the earlier mark will be invalidated in its entirety. The consequence of this is that Party can no longer rely upon its earlier mark and the opposition fails.

80. In light of the above finding it is not necessary for me to consider further Party A's opposition. However, I record here that if my finding regarding bad faith is found to be incorrect, and Party A would still be allowed to rely on its earlier mark insofar as it is

registered in respect of the list of services set out in paragraph 78, above, then its opposition would partially succeed as explained below.

81. The high similarity between the respective marks together with the fact that some of the respective services are identical or very highly similar are both factors pointing towards a finding of likelihood of confusion. The consumer of Party A's surviving goods and those of Party B listed below are business users who are likely to pay an average degree of care and attention (not particularly low or high). I consider this to be neutrally weighted in terms of its contribution to the assessment of likelihood of confusion.

82. Party B's application for invalidation was not based on a section 3(1) ground, therefore, in line with section 72, it would not be open to me to find that the earlier mark lacks any distinctive character or that it designates a quality of the services. Therefore, I would have to proceed on the basis that the earlier mark is endowed at least with the minimum level of distinctive character for registration. This is a factor that can support a finding of no likelihood of confusion. However, when I factor in all of the different aspects of the global appreciation test, I would have found that the opposition succeeded in respect of the following of Party B's services:

Business management; Business management of wholesale and retail outlets; Business administration and management; Advertising and marketing; Internet marketing; Online marketing; Influencer marketing; Trade marketing [other than selling]; Sales promotion using audiovisual media; Business administration services for the processing of sales made on the Internet.

Conclusion

83. Party B's application for invalidation succeeds in its entirety and Party A's Trade Mark registration 3735978 in respect of the mark "Flakey Bakes" is invalidated in full. As a result, Party A is not able to rely upon this registration as its earlier mark in its opposition proceedings and, therefore, it fails in its entirety and Party B's mark can proceed to registration.

COSTS

84. Party B has been successful in bringing its application for invalidation against Party A's mark and has successfully defended Party A's opposition. Therefore, it is entitled to a contribution towards its costs. In the circumstances I award Party B costs, calculated as follows:

Filing fee for Form TM26(I)	£200
Preparing Invalidation statement of case and considering the Notice of Opposition and preparing counterstatement	£800
Considering evidence and preparing submissions in reply	£1300
Preparing final written submissions	£550
Total:	£2850

85. I therefore order Flakey Bakes Ltd to pay Flake Bake Ltd the sum of £2850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

M Bryant

For the Registrar