

O-1089-24

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NOS. 2566730, 3036230,
3039469 AND 3023980**

**IN THE NAME OF BIMS WALTHAMSTOW LIMITED IN RESPECT OF THE SAME
TRADE MARK**

Bim's Kitchen/BIM'S KITCHEN/Bims Kitchen/BIMS KITCHEN (SERIES OF 4)

Bim's Kitchen
Modern, African-inspired cuisine



Bim's Kitchen
Modern, African-inspired cuisine



Bim's Kitchen
Modern, African-inspired cuisine



IN CLASSES 29, 30, 32 AND 43

**AND IN THE MATTER OF CONSOLIDATED INVALIDATION AND REVOCATION
PROCEEDINGS THERETO UNDER NOS. 504693, 504694, 504695, 504696,
504697, 504698, 504699 AND 504700 BY BIMS AFRICAN FOOD STORE LIMITED**

BACKGROUND AND PLEADINGS

1. This decision is in respect of consolidated applications for invalidation and revocation by BIMS African Food Store Limited (“Party B”) in respect of four trade mark registrations in the name Bims Walthamstow Limited (“Party A”).

2. The relevant details of these four registrations are shown below:

(i) Trade mark 2566730

Bim’s Kitchen

BIM’S KITCHEN

Bims Kitchen

BIMS KITCHEN

(SERIES OF 4)

Class 29: *Meat, fish, poultry and game; edible oils and fats; prepared meals; soups and potato crisps.*

Class 30: *Sauces (condiments); spices; prepared meals.*

Class 32: *Fruit drinks and fruit juices; syrups for making beverages.*

Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

(ii) Trade Mark 3036230

Bim’s Kitchen
Modern, African-inspired cuisine



Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.*

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.*

(iii) Trade Mark 3039469

Bim's Kitchen

Modern, African-inspired cuisine



List of goods and services identical to Trade Mark 3036230

(iv) Trade Mark 3023980



List of goods and services identical to Trade Mark 3036230

3. The respective relevant dates are as follows:

Mark No	Filing Date	Registration Date
2566730	10/12/2010	01/04/11
3036230	28/12/2013	11/04/2014
3039469	27/01/2014	25/04/2014
3023980	27/09/2013	27/12/2013

4. In respect of the four applications for revocation, Party B seek revocation of Party A's registrations on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"). Party A filed a counterstatement denying the claims and asserting it has used its marks in respect of all of the listed goods and services.

5. Revocations are sought under Section 46(1)(a) in respect of all the goods and services listed in respect of the 5-year periods following the dates of completion of the registration procedures of Party B's marks. Revocations are also sought under Section 46(1)(b). The dates relevant to these claims are detailed in the table below:

Trade Mark	Section 46(1)(a) period	Section 46(1)(a) Revocation Date	Section 46(1)(b) period	Section 46(1)(b) Revocation Date
2566730	02/04/2011 – 01/04/2016	02/04/2016	18/03/2017 – 17/03/2022 and 12/09/2011 – 11/09/2016	18/03/2022 and 12/09/2016
3036230	12/04/2014 – 11/04/2019	12/04/2019	18/03/2017 – 17/03/2022 and 12/04/2014 – 11/04/2019	18/03/2022 and 12/04/2019
3039469	26/04/2014 – 25/04/2019	26/04/2019	18/03/2017 – 17/03/2022 and 26/04/2014 – 25/04/2019	18/03/2022 and 26/04/2019
3023980	28/12/2013 – 27/12/2018	28/12/2018	18/03/2017 – 17/03/2022 and 28/12/2013 – 27/12/2018	17/03/2022 and 28/12/2018

6. In respect of the four applications for invalidation, Party B relies upon section 5(4)(a) of the Act and claims goodwill in respect of the following two signs:

(i) BIMS



7. It is claimed that these signs were first used in London in 1998, in respect of *food products, drinks and importation and retail of food and drink products*. It claims that:

(i) as a result of its use of these signs, they have acquired a reputation and protectable goodwill;

(ii) The disputed marks are highly similar to these signs due to the dominant BIMS element being entirely included in the challenged marks.

(iii) The respective goods are identical or highly similar;

(iv) As a result of this, use of the contested marks is likely to give rise to misrepresentation to the public resulting in damage to Party B and would amount to actionable passing off.

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

(i) Party B has filed accounts for a dormant company from 1996 until 2010. From these accounts it can be inferred that Party B was not trading between 1996 and 2010 and that no goodwill was acquired;

(ii) between the years 2011 and 2013, it denies there is any goodwill but adds that if there is any, it is merely nominal and that more than nominal goodwill is required to base a passing off case;

(iii) Party B did not have the requisite goodwill at the relevant dates.

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

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

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

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

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

13. 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

Party B's Evidence

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

(i) a witness statement, dated 2 February 2023 by Ms Adejumo, sole director of Party B and Annexes MAAO 1 to MAAO 20. Ms Adejumo provides evidence in respect of Party B and its predecessor's activities dating back to 1993.

(ii) a second witness statement, dated 30 June 2023, also by Ms Adejumo, is provided together with Exhibits MAAO 21 to MAAO 27 and is reply evidence

Party A's Evidence

15. Party A's evidence takes the form of two witness statements of Mr Zigheche, director of Party A. The first appears to be undated but received on 5 December 2022 and accompanied by Exhibit KZ1, the second is dated 27 June 2023, and accompanied by Exhibits KZ2 – KZ10. In his second witness statement, Mr Zigheche addresses the alleged passing off cases brought by Party B.

HEARING

16. Following a Pre-Hearing Review, it was agreed with the parties that a single hearing would be held to take submissions regarding the four groups of proceedings identified as Group A, Group B, Group C and Group D. This decision relates to the Group B cases. Group D is a single case where Party B challenges another BIM'S mark that is in the name of Mr Zigheche, the witness and controlling mind behind Party A.

Preliminary issues

Party A's further written submission

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

Scope of cross-examination of Ms Adejumo

18. Party A's request for cross examination of Ms Adejumo was accepted but only in respect of her comments at paragraphs 33 – 35 of her witness statement of 2 February 2023 submitted in support of Party B in this group of cases (Group B). These comments are repeated at paragraphs 51 – 53 of her witness statement of 7 January 2023 provided in support of the Group A proceedings and with the agreement of the parties the cross examination was extended to cover this group too.

Cross-examination Mr Zigheche

19. The scope of the cross-examination of Mr Zigheche was agreed in respect of these proceedings and the Group A proceedings. Cross examination is agreed on the issue of proof of use (and may also be relevant to the issue of goodwill, where claimed by Party A¹) as described by Party B's letter of 4 July 2023:

“... it is noted that Mr Zigheche is the only witness that has been proffered by BIMS Walthamstow. Despite not making it clear in his witness statement, it is BIMS African Food Store's understanding that Mr Zigheche was actually not involved with the BIM'S Kitchen business during the Relevant Dates and it is likely to be hearsay evidence. It is therefore contended that the strength of the evidence put forward by Mr Zigheche should be pressure tested under cross examination.”

20. Mr Zigheche sometimes appeared disinterested and often requested that questions be repeated. It appeared to me that this was because English was not his native language. However, he did understand questions when they were repeated or re-formulated and he would then give cogent answers. I was left with the impression that he provided honest answers to the questions put to him.

21. Cross-examination was undertaken on the basis that it was Party B's position that Mr Zigheche's evidence relating to the activities of his predecessors is hearsay. Mr

¹ As explained in the Registry's letter of 27 September 2023

Zigheche confirmed that any sales before February 2022 (when Party A purchased the business) were communicated to him by the prior owner.² He also confirmed that he had no knowledge of the business and its operation when it was run by the original owners or when the second owner, Castell Howell took over its operation.³ He confirmed that the sales report provided at Exhibit KZ1, was obtained from Castell Howell but he did not know how the sales included in the report were generated.⁴

22. Mr Zigheche stated that three invoices provided at Exhibit KZ1 (pages 19 – 21) came from the original owner, Mr James Adedje after one of Mr Zigheche's employees had contacted him by email.

23. Mr Zigheche stated that a list of wholesalers provided at Exhibit KZ1 (page 58) was obtained by Castell Howell from Mr Adedji. He also claimed that the BIMS brand was used on Party A's range of sauces⁵ and whilst it sold it in pouches rather than in bottles as Castell Howell did, it retained the same branding.⁶

Cross-examination of Ms Adejumo

24. The scope of the cross examination was limited to Ms Adejumo's understanding of the chain of title of Party B's business and its goodwill and is relevant to these Group B cases because it goes to Party B's defence that it is the senior user.

25. Ms Adejumo, appeared a little unsure in her answers and did not engage regarding the issue of the chain of title of the goodwill despite, at the time, being a director of Party B. Her responses to questions on the issue were met with a response that she either did not know because she was very young at the time or because she is not an accountant. These responses were evasive in nature, but in light of the written evidence on the issue (that will be referred to later in the decision), they did not lead me to believe that Ms Adejumo's evidence was anything other than what she

² Transcript, [32] from line 6

³ Ditto at [41] line 3 onwards

⁴ Ditto at [51], line 8 to 18

⁵ Ditto [42] line 23 to [43] line 9

⁶ Ditto, [44], line 14 - 16

believed/was able to uncover regarding Party B's claims regarding historical goodwill and chain of title.

26. Ms Adejumo's evidence provides no accounts in relation to the revenue or trading for 2010 or 2011. It was established that Ms Adejumo was company secretary from 2008 but she pointed out that she was very young at the time⁷ and that she has failed to find accounts for that period despite finding them for before and after.⁸

27. Ms Adejumo was questioned about the absence, at any time, of any acquisition or purchase of the business from Ms Adejumo's mother, who originally established the business, in Party B's accounts. Ms Adejumo's response was that it was a long time ago and that she didn't know because she is not an accountant.⁹ This was put to her more than once, but her responses remained the same.¹⁰

28. On the trust point discussed as a preliminary issue and detailed earlier, Ms Adejumo was asked if she was aware of any records, minutes or notes forming a trust between her mother and Party B. Her response was that she did not know, adding that she was very young at the time¹¹ being only about 5 years old when Party B was formed.¹² When asked for confirmation that, because of her age at the time, she was not aware of how her mother's sole trader business was transferred to Party B, Ms Adejumo's response was "I do not know. I am not an accountant".¹³

DECISION

Revocation proceeding relating to genuine use of Party A's marks (CA504694, CA504696, CA504698 and CA504700)

29. Section 46 of the Act states:

⁷ Ditto [26] at line 11 and 12

⁸ Ditto [27] line 6

⁹ Ditto [27] line 15 - 22

¹⁰ See, for example, [28] line 8 of the transcript

¹¹ Ditto [29] line 6 - 13

¹² Ditto [29] line 12 - 14 where she discloses her current age

¹³ Ditto [30] line 15 to [31] line 9

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

30. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v*

Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve

an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. I also keep in mind Section 100 of the Act:

“100 Burden of proving use of trade mark

If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

32. The relevant parts of Mr Zigheche’s evidence are described in some detail below because they are central to Party A’s proof of use claim:

- He provides “Screenshots of the marks applied to a variety of goods covered by the Marks between 2011 and 2022”.¹⁴ These screen shots are obtained from the Internet archive “Waybackmachine” and consist of:
 - 21 June 2012: a photograph appearing on the website www.bimskitchen.com showing a product being handed to Prince Charles (as he was then) at the Ideal Home Show and the supporting text states that Bims Kitchen were exhibiting there. It is not possible to see the detail of the cover of the goods but the three outlines of Africa (consistent with the 3023980 mark) can be made out;
 - 10 December 2014: the following mark appears in the banner at the top of the page that consists of a photograph that includes two jars of sauce and one jar of chilli jam all with an outline of Africa visible behind the product description on the label. The banner offers click through options that include “buy online” and “stockists”:



- 29 September 2015: Again, the same mark appears in the banner at the top of the page. Packets of peeled tigernuts (not covered by any of Party A’s specifications) are shown with the same mark visible on the labels. The following statement appears below the image: “Bim’s

¹⁴ Mr Zigheche’s witness statement at [7] and KZ1 pages 1 - 12

Kitchen makes a delicious and innovative range of hand-made African-inspired sauces and condiments”;

- 11 March 2016: An image shows a jar of plum and baobab syrup and what appears to be two jars of different flavoured sauces, a jar of peanut butter and a jar of tigernut, coconut and cashew butter. Three gift boxes of chilli based products are also shown. Due to the size of the images it is difficult to make out detail on the labels but on three of the jars the same mark as shown above can just be made out;
- 11 March 2016: a selection of seven jars of sauces, a chilli jam and a chilli coconut relish are displayed (three that are visibly priced at £4.50) together with a bag of peeled tigernuts. Again, due to the size of the image it is difficult to make out the detail of the labels but all seven jars appear to have something at the top of the label that resembles the above mark;
- 29 March 2016: the same mark appears in the banner at the top of the page and there is an image of a lemon, garlic and pepper sauce. As with the previous exhibits, the detail on the label is difficult to make out but there is something visible at the top of the label that resembles the same mark;
- 12 November 2016: images of a chilli jam, tigernut and chilli sauce and a pepper sauce are displayed. As with the other exhibits discussed, it is not possible to say for certain that the mark reproduced above appears on the label but on one of them there is something that resembles it;
- 17 September 2017 and 4 February 2018: Two identical pages with a banner at the top of the page shows the above mark and the following text appears in the bottom banner: “Bim’s Kitchen makes a delicious and innovative range of hand-made African-inspired sauces and condiments”;
- 6 November 2020: An image of two jars, one for Spicy Papaya Ketchup and one for Baobab Chilli Jam where the label for both bears the mark shown above;
- 21 September 2021: An image reproduced across two pages of seven jars of sauces, baobab chilli jam and a chilli coconut relish. All appear to have the above mark at the top of each label;

- A list of sales is provided¹⁵ with about 40 items listed per page. The greatest proportion of these items is in respect of a quantity of one but other quantities up to 6 are dotted throughout the list. In addition, there are three items where the quantity is 10 and one where the quantity is 16. The earliest sale is dated 22 February 2019 and the latest on 21 January 2022. I estimate that this list relates to about 1400 individual sales of approximately 2000 product items. All items are identified as being “Bims” and are identified as sauces, relishes or jams and item prices range from between £2.09 and £3.11. Assuming an average selling price of £2.60, the sales of 2000 items would amount to approximately £5200 i.e. about £1750 per year;
- Three invoices are provided:¹⁶
 - Dated 27/08/2012 and totalling £80 for six “Bim’s Kitchen Spicy African Ketchup (250ml (Pack of 2))” and six “Bim’s Kitchen African Lemon/Garlic and Pepper Sauce 250ml (Pack of 2)”. These were sold to Amazon EU S.A.R.L. in Slough, UK. The above mark also appears at the top of the invoice;
 - Dated 30/05/2017 and totalling £150 to a company in Chelmsford, UK. The above mark appears on the header of the invoice that is in respect of:
 - 12 x African Peanut Curry Sauce (360g)
 - 12 x Spicy African BBQ Sauce (250ml)
 - 6 x African Chilli Coconut Relish (190g)
 - 6 x African Baobab Chilli Jam (215g)
 - 12 x Sweet African Tigernut & Chilli Sauce (250ml)
 - 12 x African Pepper Sauce
 - Dated 23 September 2015 and totalling £265.20 to a company in Singapore and is in respect of various sauces, several jams and a ketchup;

33. At the hearing, Mr Jacob explained that it was Party B’s position that there was no use at all shown in respect of the goods listed in Party A’s specifications with a

¹⁵ At [13] – [48] of Exhibit KZ1

¹⁶ At [49] tp [51] of Exhibit KZ1

few small exceptions. It was accepted that there was some minimal use in respect of sauces, condiments and jams but this was too little for a finding of genuine use.

34. I agree with Mr Jacob that what evidence there is, is in respect of sauces, condiments and jams, but the evidence in respect of these goods is insufficient to demonstrate genuine use. In light of this, I find that the Party B's registrations are revoked from the dates indicated below and in respect of the following goods and services:

2566730

Class 29: *Meat, fish, poultry and game; edible oils and fats; prepared meals; soups and potato crisps.*

Class 30: *...; spices; prepared meals.*

Class 32: *Fruit drinks and fruit juices; syrups for making beverages.*

Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

(revoked in respect of these goods and services from 12 September 2016)

3036230, 3039469 and 3023980

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; ..., compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.*

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.*

(Revoked in respect of these goods and services from 12 April 2019 [3036230], 26 April 2019 [30394469] and 27 December 2018 [3023980] respectively)

35. By way of explanation, I have included in these lists all the goods for which no use has been shown. Similarly, with the services, if any use has been shown, it would only be in respect of retail of sauces, jams and ketchup or similar, however, there are no retail services covered by any of the registered marks and it follows that there is no evidence whatsoever in respect of any other services.

36. The remaining goods are, therefore, as follows:

2566730 *Sauces (condiments)*

3036230, 3039469 and 3023980 *jellies, jams*

37. Mr Jacob submitted that whilst there is some evidence in respect of these goods, it is insufficient to demonstrate genuine use because of the following reasons:

(i) The types of sauces for which some use is shown are not of the type that would be considered to be “condiments”. The sauces shown in the evidence are cooking sauces rather than condiments

38. Mr Jacob submitted that in the Collins Dictionary¹⁷ a “condiment” is defined as “a substance such as salt, pepper, or mustard that you add to food when you eat it in order to improve the flavour”. I do not agree with Mr Jacob’s argument. Whilst some of the sauces shown in the evidence may be considered as cooking sauces, I also note that a number of items are described as “ketchup” that is described in the same dictionary¹⁸ as “a thick, cold sauce” and is something that is added to food when you eat it. Further, I keep in mind the following guidance for formulating a fair specification.

39. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

¹⁷ [CONDIMENT definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/condiment-definition-and-meaning)

¹⁸ [KETCHUP definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/ketchup-definition-and-meaning)

Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

41. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations,

Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

42. I consider “ketchup” to be within the category of *sauces (condiments)* and that this latter term is a category that does not have sub-categories. Consequently, keeping the above guidance in mind I find that there is some use shown in respect of *sauces (condiments)*, a term that appears in the Class 30 specification of all four contested registrations.

43. Of course, this on its own, is not determinative and I must also go on to consider the other criticisms of the evidence and quantum.

(ii) Lack of sufficiency of the evidence

44. In respect of all four registrations, Mr Jacob criticised Party A’s evidence as being mainly hearsay. This was confirmed during the cross examination of Mr Zigueche who stated that Party A acquired its marks in February 2022 and much of the evidence relating to before this time was obtained from previous owners. Mr Jacob referred to the following comments of Arnold J in *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074, [2013] FSR 29:

“9. Some of Ms Lee’s statements contained information that, as she readily acknowledged during cross examination, was not within her own knowledge, but without making this clear or stating the source of the information. This is a breach of CPR Practice Direction 32, Para 18.2(b). Furthermore, in my view it has the consequential effect that the statement cannot function as a proper notice of intention to rely upon hearsay evidence in accordance with s.2 of the Civil Evidence Act 1995 and CPR r. 33.2(1)(a). Yet further, it inevitably causes unnecessary difficulties for the witness when cross examined.”

45. Mr Jacob submitted that hearsay evidence is typically given little or no weight unless it can be corroborated by witnesses giving direct evidence or with supporting

corroboratory documentation. I agree with this. The Registry has its own rules (Trade Marks Rules 2008 (hereafter “the Rules”)) and the CPR is not directly applicable to the Registry. However, it provides useful guidance in situations, such as this, where an issue is not specifically covered by the Rules. I see no reason to depart from the guidance in *Starbucks*. Consequently, I agree with Mr Jacob’s submission that Mr Zigheche’s evidence should be looked at with scepticism.

46. There is no corroboratory witness evidence to support the hearsay evidence of Mr Zigheche but there is some documentary evidence. This document, detailed earlier (at paragraph 32 above), shows some use either of the word “Bim’s” or of a mark containing the same elements as the 3023980 mark but in slightly different positions. As Mr Jacob pointed out, the only documents showing any use in the most recent five-year period for all four contested registrations (namely 18 March 2017 to 17 March 2022) can be summarised as:

- Four images of website pages from:
 - 17 September 2017: Shows no products but the mark shown in paragraph 32, above, is present in the top banner and the bottom banner has the words “Bim’s kitchen makes a delicious and innovative range of hand-made African inspired sauces and condiments”.
 - 4 February 2018: The same page as above but captured at a later date.
 - 6 November 2020; A page with the statement “A taste of Africa sauced by us” alongside the image of a jar of Spicy Papaya Ketchup and a jar of African Baobab Chilli Jam. Both jars feature the mark reproduced at paragraph 32, above.
 - 21 September 2021: a page showing images of three jars, the first being African Baobab BBQ Sauce, the second African Baobab Chilli Jam and the third African Chickpea & Moringa Curry Sauce. A fourth product is described as African Chilli Coconut Relish but there is no image.

- One invoice dated 30 May 2017: shows sales of £150 in respect of 60 items comprising of three types of sauces, one type of relish and one type of chilli jam.
- A table showing sales between 2019 and 2021: I have estimated that this list has about 1400 individual sales amounting to approximately £5200 in total for the three years. All items are identified as being “Bims” and are identified as sauces, relishes or jams.

47. During cross examination, Mr Zigheche suggested that I should look at publicly available records that show the turnover of Party A. This does not assist Party A’s case because such records have not been presented in evidence and even if they had been, they would not link turnover to particular goods/services or to particular trade marks.

48. Mr Jacob referred me to his detailed arguments set out in his written skeleton arguments as to why this evidence is insufficient to demonstrate genuine use. He pointed out that only one of the website screenshots was of the “product” section of the website and this only shows four products being offered for sale at that time. I keep this in mind but remind myself that I must take a view based on the evidence as a whole.

49. He also pointed to the African Chickpea and Moringa Curry Sauce and the African Chilli Coconut Relish as being cooking sauces and therefore, not covered by the term that appears in the specifications, namely, *sauces (condiments)*. Similarly to my comments regarding ketchup (see paragraph 42), it is not clear to me that a relish is a cooking sauce. It is defined as “a sauce or pickle that you eat with other food in order to give the other food more flavour”¹⁹ and would appear to describe a condiment more than a cooking sauce. Consequently, I consider that this submission does not take forward Party B’s case that there is no genuine use.

50. Mr Jacob also made a more general criticism that the screen shots fail to illustrate whether they were actively used to promote the goods, when the images of

¹⁹ [RELISH definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/relish-definition-meaning)

the products were first uploaded to the website, how many visitors there were to the website or if any were purchased. I accept that the criticisms have some force, but in themselves, these criticisms do not render the evidence hopeless. These screenshots show that at the time they relate to, they show that there was some activity in respect of some goods covered by the term *sauces (condiments)* and that this activity was occurring over a number of years within the relevant period, even if this activity can't be quantified from these exhibits.

51. In respect of the invoice, dated 30 May 2017, Mr Jacob points to Party B's evidence²⁰ illustrating that the recipient of the invoice is a company that works with brands to help them promote their products for export out of the UK and he contended that it does not relate to genuine use in the UK. He also observed that the goods listed in the invoice and covered by the term *sauces (condiments)* amounts to just £105. I agree that this brings into question the purpose of providing goods to this company and whether or not it constitutes an example of genuine use. Party A did not address this in its reply evidence and I accept that, without further explanation, it cannot be taken as an example of genuine use.

52. In respect of the list of sales provided by Party A, in his skeleton argument, Mr Jacob pointed out again that it is hearsay evidence. He further submitted that there are no corroboratory invoices. He added that, even if taken at face value, the level of sales shown that could be covered by the term *sauces (condiments)* and shown in the website screenshots amounts to only £679.01 over three years (142 250ml bottles of Spicy Papaya Ketchup amounting to £366.59 and 120 250ml bottles of African Baobab BBQ sauce amounting to £312.42). He submitted that this is a very small amount of sales and claimed it is "a *Reber*²¹-type case" in that it is not sham use, but neither is it sufficient to maintain a market.

53. As far as it goes, this strikes me as a fair assessment of this evidence. However, whilst not supported by the website screenshots, there are a number of additional goods that fall under the category of *sauces (condiments)* such as African Pepper

²⁰ Exhibit MAAO 20

²¹ Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089]

Sauce, Lemon and Garlic Pepper Sauce and Spicy African BBQ Sauce to name a few. Despite this, however, I still agree with Mr Jacob's submission that the use shown is insufficient to demonstrate genuine use. I have estimated that total sales shown in the list amount to about £5200 over the three-year period covered by the list being equivalent of a little over £1700 for each of the years. Clearly a proportion of this relates either to cooking sauces or other goods that are not *sauces (condiments)* such as relishes and jams so the annual sales in respect to goods that are *sauces (condiments)* will be even less.

54. I keep in mind the low levels of sales shown together with the hearsay nature of this list, that is an internal document produced by a previous owner of the mark who has not provided evidence, and the fact that there is very little information to illustrate who the sales were to or even if they were in the UK. When all of this is taken into account together with criticisms of the other relevant exhibits, when taking all the relevant evidence together, whilst I have not been persuaded by all of Mr Jacob's arguments, I agree with Party B's position that the evidence fails to demonstrate genuine use in the latest five-year period in respect of *sauces (condiments)*.

55. The same finding extends to goods covered by the terms *jellies* and *jams* present in the Class 29 specifications of the contested registrations 3036230, 3039469 and 3023980. I consider that there is some use in respect of *jams* and also *relish* (that I consider to be covered by the term *preserved ... fruits and vegetables*). Nevertheless, the evidence suffers from the same shortcomings as set out above in respect of *sauces (condiments)*. Consequently, I find that genuine use has not been shown in respect of these Class 29 goods.

56. Turning to the question of whether there was genuine use of any of the marks in any of the earlier five-year periods, the following evidence²² is relevant to these periods:

- Two invoices:

²² At Exhibit KZ1

- Dated 27/08/2012 and totalling £80 for six “Bim’s Kitchen Spicy African Ketchup (250ml (Pack of 2))” and six “Bim’s Kitchen African Lemon/Garlic and Pepper Sauce 250ml (Pack of 2)”. These were sold to Amazon EU S.A.R.L. in Slough, UK. The above mark also appears at the top of the invoice;
- 23 September 2015: this is addressed to a customer in Singapore and is in respect of 17 cases of sauces, chilli jam, pepper jam and chilli coconut relish charged at £15.60 per case.
- Six Internet screenshots:
 - 21 June 2012: This is headed “Bim’s Kitchen makes a unique range of hand-made African-inspired products”. There is a photograph from the 2011 Ideal Home Show showing a box of what appears to be Bim’s products being presented to the then Prince of Wales;
 - 10 December 2014: With the same banner as the screenshots discussed in regard to the later period and shows the same variant of the 3023980 mark. Jars of African Peanut Curry Sauce, Spicy African BBQ Sauce and African Baobab Chilli Jam are shown;
 - 29 September 2015: Again showing the same mark is shown in the top banner, and there is a photograph of packs of peeled tigernuts with the same mark appearing at the top of the labels;
 - 11 March 2016: Two pages showing a total of 16 product images including, various sauces, African Baobab Chilli Jam and African Chilli Coconut Relish;
 - 29 March 2016: A web page with the same banner and mark shown, together with an image of a jar of African Lemon Garlic & Pepper Sauce;
 - 12 November 2016: a web page with images of a jar of chilli jam and two images of jars of sauce. The mark shown earlier can just be made out in the first of these.

57. Mr Jacob submitted that this evidence is insufficient for the purposes of demonstrating genuine use. In respect of the two invoices, he pointed out that one of the invoices was in respect of sales to Singapore and does not constitute UK use. I agree. There is nothing in the evidence to show that this overseas sale resulted from

promoting or offering the goods for sale in the UK.²³ The second relates to a sale to the Amazon EU office in Slough and Mr Jacob suggests that these goods were for onward sale outside the UK. It is not clear whether they were for use by Amazon EU or whether they were for selling on its online platform targeted at customers in unknown locations but based on the small quantities involved, it would suggest use by Amazon staff. That said, such a small amount cannot be sufficient to amount to genuine use in the UK.

58. In respect of the screen shots, Mr Jacob has already commented, namely that they fail to illustrate whether they were actively used to promote the goods, when the images of the products were first uploaded to the website, how many visitors there were to the website or if any were purchased. I have already commented that whilst I accept these criticisms they do not render the evidence hopeless. These screenshots show that at the time they relate to, there was some activity in respect of some goods covered by the term *saucers (condiments)* even if this activity can't be quantified from these exhibits.

59. In summary. I agree with Mr Jacob, that this evidence shows a level of use that is difficult to quantify and fails to illustrate use sufficient for a finding of genuine use. Consequently, Party A's marks are revoked from the following dates:

2566730: Revoked from 2 April 2016

3036230: Revoked from 12 April 2019

3039469: Revoked from 26 April 2019

3023980: Revoked from 28 December 2018

²³ It is recognised that overseas sales may constitute genuine use in the UK where such sales were for the purpose of creating or preserving an outlet in the UK. See, by analogy, the comments of the General Court in *Standard International Management LLC v EUIPO*, T-768/20, EU:T:2022:458 at [33] – [38]

Grounds based upon Section 5(4)(a) in invalidation proceedings

60. This ground is relevant when considering an application for invalidation by virtue of the following parts of section 47 of the Act, namely:

“47 Grounds for invalidity of registration

(1) ...

(2) Subject to subsections (2A) and (2G), 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.

...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

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

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

61. 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.”

62. 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.”

63. 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)."

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

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

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

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

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

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

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

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

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

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

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

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

66. Also in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, Mr Alexander QC considered the relevant date where one or both of the parties have

used the mark(s) at issue prior to the date of the application to register the contested mark(s). He explained that:

“41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user’s mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.”

67. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC, sitting as the Appointed Person, pointed out that “the start of the behaviour complained about” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when the first offer was made to market relevant goods or services under the mark. However, it could also be the

date the first public-facing indication was made that sales were proposed to be made under the mark in future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no one else had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

68. In the current cases, the primary relevant dates are 10 December 2010 (2566730), 27 September 2013 (3023980), 28 December 2013 (3036230) and 27 January 2014 (3039469). However, Party A claims that it is the senior user dating from December 2010. Therefore, this is a second potentially relevant date.

Goodwill

69. Mr Jacob contended that whilst the use shown was insufficient to demonstrate that Party A had shown proof of use he did identify a couple of examples of sales of jams and sauces. On that basis and, for what he explained were reasons of procedural economy, Party B were restricting the scope of its 5(4)(a) challenge to *jams* and *sauces (condiments)* only.

70. Party B claims goodwill identified by the sign “BIMS” and the following figurative sign:



71. It is Party A’s case that the chain of ownership of the goodwill relied upon by Party B is not clear and that there is no evidence that it was ever transferred from Ms Adejumo’s mother, Mrs Adejume to Party B. Mr Dadds submitted that Party A’s position is that when Mrs Adejume ceased trading as a sole trader in 2010 the goodwill was not transferred and therefore, it ceased to exist.

72. The relevant evidence provided by Party B can be summarised as follows:

- Business has been conducted under the BIMS mark since 1993 when Ms Adejumo's late mother Mrs Bola Amole opened the BIMS food store in Peckham, London. The store was branded BIMS AFRICAN FOOD STORE. Further, goods sold in the store were also branded as BIMS and some third party branded goods were also sold;²⁴
- Party B imports goods in bulk from Africa or from local suppliers and repackages them into smaller packages under the BIMS brand using labels with the BIMS sign printed upon them. This was also the case when Mrs Amole ran the business as a sole trader;²⁵
- A small selection (of many available to Ms Adejumo) of airway receipts are provided in respect of goods imported from Africa in bulk;²⁶
- Between December 1993 and March 2010, Ms Adejumo understands that all turnover relating to the BIMS business was recorded in her mother's sole trader accounts. From March 2010, turnover was recorded in Party B's company accounts, but Ms Adejumo does not know why this change was made;²⁷
- The business sold goods from its premises in Peckham but, in addition, it also sold directly to wholesalers, resellers, caterers and restaurants throughout the UK;²⁸
- In 1993 the BIMS store began with the selling of gari, beans, cassava, pounded yam and palm oil. Over time, the number of products grew and it now sells over 200 own-branded African food and drink products;²⁹
- The store itself is branded with the second sign relied upon (shown at paragraph 6, above) since relocation to 102 Rye Lane in approximately 1998 and a photograph showing this is shown and obtained from Party B's website and dated 13 September 2009;³⁰
- In 1995, Ms Adejumo's mother incorporated Party B but all turnover continued to be recorded in her sole trader accounts until 2010;³¹

²⁴ Ms Adejumo's witness statement, dated 2 February 2023 (Ms Adejumo's 1st WS) at [7]

²⁵ Ditto at [11] and [26]

²⁶ Ditto at [26], [27] and Annex MAAO 4

²⁷ Ms Adejumo's 1st WS at [6]

²⁸ Ditto, at [9]

²⁹ Ditto at [10]

³⁰ Ditto at [31]

³¹ Ditto at [16]

- Between 1993 and 2010, the BIMS business generated the following annual sales. Ms Adejumo states that she does not believe that these figures relate to any other business other than the BIMS business and this is stated on the accounts themselves.³²

Accounts Year	Sales
2 December 1993 – 31 January 1995	£215,833
1 February 1995 – 31 January 1996	£178,264
1 February 1996 – 31 January 1997	£171,076
1 February 1997 – 31 January 1998	£403,793
1 February 1998 – 31 January 1999	£403,095
1 February 1999 – 31 January 2000	£217,722
1 February 2000 – 31 January 2001	Not available
1 February 2001 – 31 January 2002	£267,154
1 February 2002 – 31 January 2003	£217,585
1 February 2003 – 31 January 2004	Not available
1 February 2004 – 31 January 2005	£254,829
1 February 2005 – 31 January 2006	£207,664
1 February 2006 – 31 January 2007	£225,041
1 February 2007 – 31 January 2008	£239,948
1 February 2008 – 31 January 2009	£334,676
1 February 2009 – 31 January 2010	£558,756
1 February 2010 – 31 March 2010	£175,844

- Ms Adejumo has been unable to locate accounts for the years 2000 and 2003 but she has no reason to believe that sales in those years would not have been similar to the other years;³³
- A selection of invoices showing use of the BIMS sign between 1993 and 2010 are provided.³⁴ This evidence is in the form of photographs of paper invoices from that period that all have the following sign appearing at the top of the invoice:

³² Ditto at [18] and [19] and Annex MAAO 1

³³ Ditto at [20]

³⁴ Ditto at [21] and Annex MAAO 2



- The earliest invoice is dated 17 February 2005 and the latest 2 February 2009. The lists of goods are hand-written and not always easily legible, but the following are some of the goods listed: cassava flour, pounded yam, luncheon meat, peanut butter, herbs, pepper, bread, fish, coconut, palm oil, snails, custard, palm wine, and beans. Ms Adejumo confirms that each of the products listed would have been branded as BIMS on the packaging or label;³⁵
- Ms Adejumo states that these invoices related to sales to wholesalers and resellers around the UK and points to these being located in Manchester, Aberdeen, Glasgow, Cardiff, Kent, Basingstoke, Leicester, Liverpool, Cricklewood (London), Luton, Northampton, Doncaster and Reading;³⁶
- Ms Adejumo has located two photographs of bags of, what appears to be, grain-like products taken by her in 2006. Images of these are provided but the labels are unclear but it is stated that they both carry the BIMS sign;³⁷
- Ms Adejumo states that under the BIMS name, the goods sold included, at least the following in 2010:³⁸

Class 29

Meat, fish, game; meat extracts; preserved, frozen and dried vegetables; preserved or dried seeds; preserved or dried nuts; edible oils and fats; pulses, beans and lentils; soya beans; black eye beans.

Class 30

rice; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; spices.

³⁵ Ditto at [22]

³⁶ Ditto, at [23]

³⁷ Ditto at [24] and Annex MAAO 3

³⁸ Ditto at [25]

Class 33

Palm wine

- In 2010, Mrs Amole started recording the turnover of the BIMS business in Party B's accounts and at that time her sole trader accounts ceased.³⁹ Party B's accounts from its incorporation in 1995 to 2014 are provided.⁴⁰ These showed no sales until the accounts of 31 March 2010 were filed. The following "cost of sales" are shown:

Period	Sales (£)
Year ending 31 August 2012	1,197,680
Year ending 31 August 2013	1,234,046
Year ending 31 August 2014	1,040,015
Year ending 31 August 2015	650,687

- The first period recorded above is assumed to be a partial year but the accounts do not disclose the exact period.
- Mrs Amole was awarded numerous business awards over the years including Enterprise Woman of the Year by Nigeria Link magazine in 1994, African Business Women of the Year, 1997 by NatWest bank, Yoruba Heritage Award for outstanding entrepreneur of the year award in 2012 and, after her death, a certificate of appreciation from a councillor and former Mayor of Southwark for her running of the business and her charitable work as a donor and mentor within the African community;⁴¹
- Ms Adejumo took over the business in 2015 when her mother passed away.⁴² She states that:⁴³

³⁹ Ditto at [33]

⁴⁰ At Annex MAAO 16

⁴¹ Ditto at [32] and Annex MAAO 9 – MAAO 15

⁴² Ditto at [9]

⁴³ Ditto at [34]

On 11 January 2015, Ms Amole passed away and the operation of the BIMS business was carried on by myself. To the extent that any and all rights to the BIMS business (including the BIMS name) were not vested in BIMS African Food Store, then such rights would have vested with Ms Amole in her personal capacity and, as such, these rights would have been transferred to me on my mother's death. My mother died intestate and, by the order of the High Court of Justice (District Probate Registry at Birmingham) dated 23 March 2017, all assets of my mother were transferred to me. I attach at **Annex MAAO 17** evidence of the same.

- In an attempt to address criticisms in Party A's evidence to a lack of information regarding the transfer of the business from Mrs Amole and what happened to the goodwill in the business during this transfer, Ms Adejumo stated that she does not know why her mother decided to record BIMS revenue through her sole trader account rather than Party B's accounts between 1995 and 2010. She also states that, despite this, some stationery at that time included Party B's and its company number;⁴⁴
- The reason why Mrs Amole began recording revenue through Party B's accounts in 2010 is not known. Ms Adejumo has contacted her mother's accountant from that time, but they cannot recall the reason but noted that the BIMS business revenue was the highest it had ever been and "it made sense" to use the limited company because of the additional protections it afforded;⁴⁵
- The business continued as a going concern with the only difference being that the revenue was recorded in Party B's accounts and that externally, customers would not have been aware of this change in March 2010. The shop signage remained the same and there would have been no announcement of the change;⁴⁶
- In response to Mr Zigheche's suggestion that BIMS ceased trading between March 2010 and 2012, Ms Adejumo states that BIMS has never ceased trading since it began operating in 1993.⁴⁷ Party B's accounts are provided for the year 2010 and 2011 illustrating that it was trading from 2010 onwards.⁴⁸ These accounts record asset values that, Ms Adejumo states,⁴⁹ are comparable to the

⁴⁴ Ms Adejumo's witness statement of 30 June 2023 ("Ms Adejumo's 2nd WS") at [7.1] and Annex MAAO 21 and Annex MAAO 2

⁴⁵ Ditto at [7.2]

⁴⁶ Ditto at [7.5]

⁴⁷ Ditto at [7.6]

⁴⁸ Annex MAAO 23

⁴⁹ At [7.6] of Ms Adejumo's 2nd WS

final sole trader accounts filed by Mrs Amole namely, that “the plant & machinery, stock and debtor amounts are in the overall ballpark⁵⁰ as you might expect for a company continuing the same business.” These respective figures (as far as they appear to relate to comparable items) are shown below:

Item	Sole Trader Accounts as at 31/03/10 (£)	Party B’s Accounts as at 31 August 2010 (£)
Stocks	37,750	65,500
Debtors	36,032	31,071
Cash in bank and in hand	21,604	57,025
Total	95,386	153,510

The turnover shown is as follows:

<i>Period</i>	<i>Sales (£)</i>
<i>Year ending 31 August 2010</i>	<i>1,197,680</i>
<i>Year ending 31 August 2011</i>	<i>1,234,046</i>

Ms Adejumo notes that the revenue for the period to 31 August 2010 is comparable to Mrs Amole’s final sole trader accounts⁵¹ where revenue of a little over £734,000 is recorded for the period 1 February 2009 to 31 March 2010;

- Ms Adejumo believes that the business was transferred to Party B in March 2010 and that there is no doubt that the revenue recorded in Party B’s accounts relates to the same business operated prior to then by Mrs Amole as a sole trader. There were no external changes to alert its customers to this change;⁵²
- Ms Adejumo explains that, to the extent that the business had not been legally transferred to Party B she corrected the position by undertaking a confirmatory

⁵⁰ Of the figures shown in Mrs Amole filed year end accounts to 31 March 2010 exhibited at [76] – [80] of Annex MAAO1 to Ms Adejumo’s first witness statement

⁵¹ Ms Adejumo’s 2nd WS at [7.6]

⁵² Ditto at [8]

assignment of the BIMS business (including related goodwill) from herself to Party B in August 2022;⁵³

73. Mr Dadds put forward a number of arguments in response to Party B's case that it benefits from a continuous goodwill from at least 1995 to the present. His criticisms were:

(i) There is no evidence that Party B acquired the goodwill at any time because there is no evidence that it was ever transferred from Mrs Amole to Party B. There have always been two businesses, namely Mrs Amole's sole trader business and Party B as a corporate entity

74. Putting aside Party A's counterclaim that it has an earlier goodwill for the moment, the relevant dates for assessing goodwill are 10 December 2010 (2566730), 27 September 2013 (3023980), 28 December 2013 (3036230) and 27 January 2014 (3039469). Only one of these falls before the time when there is evidence of sales by Party B (figures are provided from 1 September 2013). Therefore, it is possible that Party B may have generated its own goodwill, independent of Mrs Amole's sole trader business by the relevant dates of respect of the other three marks. However, I note that the periods in which it could have done this are only short and, in the case of 3023980 only 27 days. This will become a relevant factor if I were to find that Party B did not benefit from the goodwill generated by Mrs Amole's sole trader business.

75. Mr Dadds pointed to Ms Adejumo's comments under cross examination and he claimed that her repeated replies to his questions about the goodwill and its transfer that "I am not an accountant" shows that she was being evasive. He points out that whilst she was young at the time, she was a director of Party B. He further submitted that Mrs Amole made a decision not to do the transfer and to co-trade with Party B. He also pointed out that Ms Amole held on to the business premises and, therefore, could have also held on to the goodwill.

⁵³ Ditto at [9] and Annex MAAO 24

76. Mr Jacob accepted that the interaction between Party B and Mrs Amole was not the clearest, but he submitted that this is not unusual, and that there has only ever been one business. He submitted that in March 2010 when the accounts for the business began to be recorded in the company accounts of Party B, its customers would not have noticed any difference. He claimed that the shop front, stock and personnel all stayed the same and that the business' customers would not have considered that or knew that the ownership of the goodwill may have changed. Mr Jacob further submitted that the whilst the goodwill moved from the sole trader, Ms Amole to Party B, it was still attached to the same business at the same premises and with the same shop front. In support of these submissions, Mr Jacob relied upon *Reuter v Mulhens* (1953) 70 RPC 102 that was quoted with approval in *Newman v Adlem* [2005] EWCA Civ 741; [2006] FSR 16:

“The only way in which the goodwill of business can be preserved in the hands of a purchaser is by inducing the public to believe that the purchaser is still carrying on the business which the transferor owned and carried on, and the public may, therefore, expect to receive the same attention and satisfaction and the same type and quality of goods. This, as I remarked in the course of argument, is lawful deception ... it is in my view, in the absence of special circumstances, perfectly legitimate for the purchaser of the goodwill of the business to use the get-up and appearance of the goods previously sold ...”

77. It is clear from the evidence that the business (now undertaken by Party B) has been provided from the same retail premises since relocation to 102 Rye Lane in approximately 1998 and from a premises nearby between 1993 and 1998. I will consider in more detail below, whether such use was continuous and also consider the question of who owned the goodwill generated by this business. The *Newman v Adlem* case will lend support Party B's position if I am satisfied that (a) the business did, in fact continue seamlessly at the time it is alleged that Party B acquired the goodwill and after the business' revenue ceased to be recorded through Mrs Amole's sole trader accounts and, (b) Party B is the successor in business to Mrs Amole's sole trader business.

78. There is a trail of case law considering assessment of goodwill in circumstances where a foreign entity separates from its UK business. This case law is dealing with a different factual situation to that before me but, because of some parallels, I can draw some useful guidance, namely:

“The legal response is that this problem [of who owns the goodwill], if not solved by agreements, is ultimately soluble only by a factual inquiry with all the disadvantages of the length of its duration, the cost of its conduct and the uncertainty of its outcome. There are no quick, cheap or easy answers to be found in hard and fast legal rules, in binding precedents or in clear-cut factual and legal presumptions.”⁵⁴

79. Mr Iain Purvis KC, sitting as the Appointed Person in *UNITED SIKHS* Trade Mark, BL O/0329/24, recently referred to this guidance and identified the following relevant factors:

“27. What is clear from all the authorities is that two strands of evidence are influential (though they may not necessarily point in the same direction). The first is a question of objective fact, the second one of perception:

(a) The degree of actual control over the goods or services supplied under the name or get-up exercised by the rival claimants to the goodwill. Goodwill is created by a link between a name and get up and the provision of particular goods or services. It does not normally matter whether the public know the legal person responsible. See Floyd LJ in *Media Agency Group v Space Media Agency* 2019 EWCA Civ 712 at 23

‘The goodwill vests in the person who is in fact the source of the services, even if the customer is unaware of the identity of that person.’

⁵⁴ *Scandecor Development AB v Scandecor Marketing BV* [1999] FSR 26 at [39]

(b) Which organisation do customers (as a result of the way the goods or services are promoted) perceive as being responsible for the quality or character of the goods or services supplied under the brand?”

80. In its discussion on “Ownership of Goodwill”, *Wadlow* commented on recent cases on the issue as follows:⁵⁵

“... What these cases have in common is their emphasis that, in the absence of agreement, ownership of goodwill is ultimately a question of fact to be decided in the light of all the relevant circumstances, and that arbitrary presumptions or rules of thumb (including some canvassed in previous editions of the present work) provide illusory assistance and are best avoided.”

81. *Wadlow* goes on to state:⁵⁶

The factors which influence the ownership of goodwill were encapsulated by Lord Reid in *Oertli v Bowman* [1959] RPC 1 HL at 7

“Bowmans made and marketed the *Turmix* machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines.”

There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between

⁵⁵ *Wadlow* on the Law of Passing Off 6th Ed at 3-287

⁵⁶ Ditto, at 3-293 to 3-295

the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

To expand, the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, *mutatis mutandis*, a business for the provision of services: (1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

82. Therefore, despite there being no evidence of a formal handing over of the goodwill from Mrs Amole’s sole trader business to Party B, I will consider the current circumstances using the framework identified above. I should add that the confirmatory assignment undertaken in August 2022 cannot have retrospective effect⁵⁷ and, therefore, cannot improve Party B’s case.

(1) Are the goods bought on the strength of the reputation of an identifiable trader?

83. Yes, the BIMS goods are bought from the same retail premises since 1998 that displays the same shop front branding throughout this time and BIMS branded goods were sold together with third party products. Whilst there is a challenge as to whether there was continuous business activity for the whole of this period, based on the evidence before me, I consider it highly likely that the shop traded continuously. There is narrative evidence to this effect and further, the sales shown in the years either side of the gaps in sales figures are similar, something that would be surprising if the

⁵⁷ See the comments of Geoffrey Hobbs QC (as he then was) in *DOUGLAS OF DRUMLANRIG Trade Mark*, BL O/276/19 at [25] – [29] to that effect

business had ceased trading in the in-between period. Also, Mrs Amole was the controlling mind behind the business both during the period when sales were recorded in her sole trader accounts and when the sales were recorded in Party B's accounts. Mrs Amole was the controlling mind of Party B. Therefore, the public would see her continuity in the business as indicating the same undertaking (i.e. the business trading as BIMS from these retail premises) regardless of where the sales were being recorded.

84. In summary, the public were/are likely to buy the goods sold at Party B's retail premises on the basis of the long-standing reputation of the business operating from the premises under the BIMS branding.

(2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory?

85. The public would perceive that the business operating under the BIMS branding from retail premises occupied since 1998 as being responsible for the character or quality of the goods sold, especially so when those goods were also branded as BIMS. Any complaints would be directed at the business operating from the premises.

(3) Who is most responsible in fact for the character or quality of the goods?

86. Up to March 2010, Mrs Adejumo's sole trader business would have been responsible for the character and quality of the goods sold. After that date, with all sales being recorded through Party B's accounts, it would have been considered responsible.

(4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill?

87. I keep in mind that Party A has pointed out gaps in the sales records of Party B and recognise that this could possibly lean away from the goodwill passing immediately to Party B. Similarly, I keep in mind that there appears to have been no

written agreement that transferred the business and its goodwill from Mrs Amole's sole trader business to Party B.

88. It strikes me as unlikely that a cessation of trading would exactly match accounting periods and lends support to the claim that Party B's accounts were misplaced rather than there being no sales during these periods. Both the narrative evidence of Ms Adejumo (who has no recollection of the business ever ceasing trading at any time) and the sales figures either side of the missing periods suggest that business continued.

89. Taking all of the above into account, the public is very unlikely to make a distinction between whether Mrs Amole or Party B were/are responsible for the activities at, and goods sold from, the retail premises branded as BIMS.

90. Party A submits that Party B has no goodwill and relies on the fact that no value has been given to goodwill in its accounts submitted to Companies House. I dismiss this submission for the following two reasons:

- (i) Party A has not provided any evidence of Party B's company accounts and, in any case, this is irrelevant because;
- (ii) as Mr Jacob drew attention to, the commentary on this issue in Wadlow on the Law of Passing-Off⁵⁸ illustrates that no value is given to goodwill in Party B's accounts is irrelevant. In Wadlow's it was noted that:

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

91. The rest of that paragraph is also relevant as it explains how, in circumstances where a business has not been acquired, the balance sheet valuation of goodwill is zero. In the current case, Ms Amole was the controlling mind behind Party B and this business passed from mother to daughter as part of the deceased mother's estate. Therefore, when the business moved from Ms Amole's sole trader business to Party

⁵⁸ He referred to paragraph 3-10 but in the latest, 6th Edition, it appears at 3-14

B and then when Ms Adejumo inherited Party B, there was no “acquisition” as such that would require a valuation to be put on the goodwill (as separate to the value of the business). Therefore, I agree with Mr Jacob that the absence of a valuation of Party B’s goodwill in its accounts is irrelevant to my considerations here.

92. All the evidence strongly suggests that Mrs Amole’s sole trader business ceased trading in 2010 and the business was taken on by Party B with Mrs Amole being the controlling mind. The evidence shows the existence of a local goodwill that was, and continues to be, generated from its retail premises over many years and that since 2010, this goodwill would have been accruing in respect of Party B’s business but clearly existed before then in respect of Mrs Amole’s sole trader business. This is certainly the case if I keep in mind that goodwill is normally owned by whoever the public perceives as being responsible for the goods/services. If I consider who the public would blame for the quality of the goods provided from the BIMS store, it would be Party B and before that, Mrs Amole.

93. I conclude that, from the perspective of the consumer, the business has been operating continuously since 1995, the goodwill will be perceived as being transferred from Mrs Amole to Party B and this reflects the *de facto* reality.

(ii) There is no evidence of revenue between 31 March 2010 and 31 August 2011 and other periods

94. Party A points to an absence of evidence that Party B continued with the business immediately upon the cessation of recording sales through Ms Amole’s sole trader accounts because there is no evidence of sales in the period immediately after this. Party A also points to there being no evidence that Party B purchased the business and goodwill. I agree with this latter point to the extent that there is no evidence of a formal agreement transferring the business from the sole trader business of Mrs Amole to Party B.

95. Mr Dadds submitted that there is no evidence that the business continued between 31 March 2010 (being the latest date that revenue was recorded in Mrs Amole’s sole trader account) and 1 September 2011 (being the start of the earliest accounting year

where revenue was recorded in Party B's company accounts). He also suggested that I can take judicial notice of Companies House records (not in evidence) for that period that illustrate that there was no use because the first sales attributed to Party B were in the 2011 accounts. Whilst such records are on the public record, the onus is upon a party to put its evidence before the Registry during the sequential evidence rounds. Merely being on the public record does not equate to a notorious fact where judicial notice can be taken. Therefore, I decline to investigate these documents, but I note Mr Dadds' submission that it is unknown whether the BIMS shop was trading at that time.

96. The final sole trader accounts are provided⁵⁹ relating to the period ending 31 March 2010 as are Party B's accounts⁶⁰ for year ending 31 August 2013 that also record the previous year's sales. This leaves the period of 17 months between 31 March 2010 and 31 August 2011 where there are no sales turnover figures in evidence. Ms Adejumo does, however, provide Party B's accounts lodged with Companies House that record assets in the years to 31 August 2010 and 2011 that she claims are "in the overall ballpark [as the assets of the sole trader business] as you might expect for a company continuing the same business."

97. It is relevant that the business was operated from the same retail premises from 1998 and that the turnover in the years following the years when no sales figures have been given are at least as high as the year before the missing years. It seems unlikely to me that a business could stop trading for three separate periods (February to January 2000/2001 and 2003/2004, and April 2010 to August 2011) and then resume with an improved turnover than before ceasing trading. This, together with narrative evidence that the business traded continuously during these times points to the accounts for these three periods being lost rather than the business ceasing trading.

98. Party B had the requisite goodwill at the primary relevant dates of 10 December 2010 (2566730) (and if not, the goodwill resided with its predecessor, Mrs Amole's sole trader business), 27 September 2013 (3023980), 28 December 2013 (3036230) and 27 January 2014 (3039469).

⁵⁹ At Annex MAAO16 [49]

⁶⁰ Ditto at [51]

99. The issue of when Party B acquired or developed its own goodwill is important to Party A's case because it claims that it is the senior user as a result of use by its predecessors dating back to 7 February 2011. Therefore, if I found that Party B's goodwill dated back only to 31 August 2011 and that it did not benefit from the goodwill attached to Mrs Amole's sole trader business then it would be necessary to look more closely at this claim. However, I have found that Party B benefits from both the goodwill generated by Mrs Amole's business dating back to the 1990s as well as the goodwill generated by its operation of that business from 2010. Consequently, even if I was satisfied that Party A benefits from its own goodwill dating back to 7 February 2011, its claim of senior user cannot succeed.

100. There is no specific claim to a concurrent goodwill (distinct from being the senior user), but even if it had been claimed, the evidence summarised and discussed earlier in respect of assessing genuine use of Party A's mark is insufficient to support a finding that Party A can benefit from a protectable goodwill.

(iii) Goodwill in the original sole trader business ceased in 2010 and no longer exists

101. Mr Dadds relied upon *Campbell v Campbell* [2016] EWHC 765 (Ch) (21 March 2016) to support his submission that the sole trader goodwill relied upon by Party B in respect of the period up to 2010 was abandoned. To understand the weight this precedent has it is important to consider the concept of abandonment of goodwill.

102. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Iain Purvis QC, sitting as a Deputy Judge considered the law on abandonment of goodwill and summed it up like this:

“68. I deal with the abandonment case first. The doctrine of abandonment of goodwill is intimately tied up with the basic principle that goodwill has no free-standing existence. It is simply a property right attached to a particular business. If the business dies, then so does the goodwill. See Lord Diplock in *Star Industrial v Yap Kwee Kor* [1980] RPC 31:

‘Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and indivisible; if the business is carried on in several countries a separate goodwill attaches to it in each. So when the business is abandoned in one country in which it has acquired a goodwill the goodwill in that country perishes with it although the business may continue to be carried on in other countries...Once the Hong Kong Company had abandoned that part of its former business that consisted of manufacturing toothbrushes for export to and sale in Singapore it ceased to have any proprietary right in Singapore which was entitled to protection in any action for passing-off brought in the courts of that country.’

69. There is little doubt that the business of Peals was abandoned by a series of very public acts. Just as in the well-known abandonment case of *Pink v Sharwood* [1913] 30 RPC 725 the employees were laid off, all sales stopped and the means of production were broken up. There was a clear and explicit expression in an interview with the press that Peals intended to stop trading in the United Kingdom altogether. However, unlike in *Pink v Sharwood*, those acts took place only after the goodwill was assigned to a third party (Brooks Brothers (New York) Limited). Furthermore, the assignment of goodwill was not a ‘bare assignment’. It was on the face of it sold together with the vital assets for maintaining and exploiting that goodwill, namely the customer lists and the lasts and equipment necessary to serve those customers. The thrust of the Agreement is that Peals will cease trading in the United Kingdom and elsewhere (as they did), but there is nothing in the Agreement to indicate that Brooks Brothers will not carry on the business themselves in the United Kingdom in some form.

70. The termination of the business of Peals in January-February 1965 is therefore not determinative in itself of the issue of abandonment. The question must be looked at more broadly. Did Brooks Brothers, through its conduct in the early part of 1965, whilst Peals was winding up its business, behave in such a way that it could be said to have abandoned the business and goodwill

in the United Kingdom associated with the Peal & Co. name and the fox and boot trade mark?

71. In my view it did. Firstly, although it had technically purchased the customer lists and the equipment necessary to keep the established business going in the United Kingdom, it is clear from the evidence of Mr Moore that it allowed those assets to be dissipated or destroyed. In those circumstances, if it had wished to preserve the goodwill in the United Kingdom under the trade marks, it would in my view have had to take steps fairly quickly to preserve the goodwill by launching a new business under those marks and educating the public that it was the successor to the old Peals business. No such steps were taken. Indeed, it must be a reasonable inference that the statement in the Associated Press report, presumably based on a comment of Mr Rodney Peal, that *'Peal's readymade shoes, produced from the firm's lasts and special leather at factory in Northampton, will still be sold in the United States by Brooks Brothers of New York. But the custom-made shoes will be no more, and all the British sales will end'* was a fair reflection of the intentions of Brooks Brothers, and the message which Brooks Brothers were content to send to the market in the United Kingdom.

72. In all the circumstances, by promoting (through clauses 4 and 5 of the Agreement) the destruction of the Peals business, by failing to take any steps to preserve a business in the United Kingdom, and by allowing the United Kingdom market to assume that Peals no longer existed, I consider that Brooks Brothers had abandoned any and all the goodwill in the United Kingdom associated with the Peals business, including any goodwill associated with the fox and boot device.”

103. There is no document in evidence (and on the face of it, it appears that one does not exist) to show that the goodwill associated with Mrs Amole's sole trader business was formerly assigned to Party B. Ms Adejumo offers her opinion that the absence of a formal written sales agreement between Mrs Amole and Party B “is not surprising” as she was sole director and shareholder of Party B. Further, Ms Adejumo does not believe that her mother would have sold the business to Party B “for a fee but rather

that she simply decided to transfer it to the company at no cost so she could benefit from being able to operate the business using a limited company going forward”.⁶¹

104. Unlike in *Campbell v Campbell* and *Star Industrial v Yap Kwee Kor*, there are circumstances that support Party B’s case (and Ms Adejumo’s statement) that business continued seamlessly at the time Mrs Amole stopped recording the sales from the business in her sole trader accounts. In particular, I note that:

- (i) Mrs Amole was the controlling mind behind Party B and therefore was continuously the controlling mind in respect of the goodwill;
- (ii) the business traded continuously from the same premises and under the same branding and its customers would not have been aware of any change;
- (iii) Whilst there is a period of 17 months from when sales were no longer recorded in Mrs Amole’s sole trader accounts there is evidence that Party B’s accounts (lodged with Companies House) recorded assets in that period that are similar to the assets of the sole trader business as you might expect for a company continuing the same business.

105. Taking the points into account, the evidence points to the goodwill not being abandoned in March 2010 when Mrs Amole ceased to record sales in her sole trader account. Rather it points to the business continuing uninterrupted with the goodwill passing to Party B from Mrs Amole’s sole trader business with her retaining control of the goodwill through being the controlling mind of Party B. There is nothing that points to any intention to abandon the goodwill or circumstances that would lead to the abandonment of the goodwill. There is no reason as to why Mrs Amole would wish to abandon the goodwill. Further, whilst there is a gap in recording the sales figures, the information before suggests that this is because they have been mislaid rather than because no sales took place.

⁶¹ Ditto at [7.3]

(iv) The information provided on Party B's goods is inconsistent and there is no clear message indicating who owns the goodwill

106. Mr Dadds pointed out that there is a lack of consistency in how the BIMS business of Party B is presented to the public and directed me to the following different trading styles:

- BIMS African Food Store
- BIMS African Stores
- Bims African Foods
- Bims Cash and Carry
- Bims
- BIM's African Foods
- Bims African Food Cash and Carry
- Bims Superstore

107. Mr Dadds submitted that there is a legal obligation on a business to include their name on official paperwork such as invoices and letters. The issue before me is not to assess compliance with such a legal obligation (this tribunal has no such powers) but rather, to assess whether the use shown supports the claim of goodwill. I need say no more on this point.

108. In his evidence Mr Zigeche submitted that this lack of consistency in the signs used by Party B cannot show use in BIMS alone. Mr Dadds also submitted that "BIMS Cash and Carry" should be taken as the sign and that this is different to the sign relied upon. I disagree with these submissions. In all the variant uses, it is the "BIMS" element that is the distinctive element. All the other elements describe the business in one way or another. Consequently, use of these variants does support a claim of goodwill identified by BIMS alone. Further, Ms Adejumo states⁶² that, for many years, Party B's business has been known as "BIMS" and the "BIMS" element has always been emphasised with this element appearing in larger font to the other elements. This

⁶² At [12] of her second witness statement

claim is supported by most of the use exhibited in the evidence and is consistent with a claim that Party B's use and goodwill is identified by "BIMS" alone.

109. Mrs Adejumo was requested by her representative to confirm what was being sold under the BIMS name in 2010. In her witness statement,⁶³ she provided a list that such goods included at least the following:

- Class 29:** Meat, fish, game; meat extracts; preserved, frozen and dried vegetables; preserved or dried seeds; preserved or dried nuts; edible oils and fats; pulses, beans and lentils; soya beans; black eye beans.
- Class 30:** rice; tapioca and sago; flour and preparations made from cereals; cassava flour, yam flour, semolina flour; bean flour; plantain flour; garri; garri cassava; spices.
- Class 33:** palm wine.

110. Further, a "to whom it may concern" letter from the Mayor of Southwark is exhibited.⁶⁴ He states that "BIMS Food Store started trading in the mid to late 1990s in Peckham selling food and drink products sourced from Africa. As far back as I can remember, food and drink products sold in the store were branded BIMS and the store itself was called BIMS African Food Store." This lends support to the long-standing nature of Party B's business but does not assist in understanding the precise scope of that goodwill.

111. Taking all of the above into account, I conclude that Party B is entitled to rely on its long-standing goodwill identified by the sign BIMS. The evidence is limited in terms of identifying the exact goods sold under the BIMS sign and when they were sold. However, I keep in mind:

- (i) the generally increasing turnover of the business between 1993 and 2015;
- (ii) Ms Adejumo's narrative evidence that Party B's business (and Mrs Amole's business before that) has traded continuously since 1993 and from the same premises since 1998 selling own-branded African food and drink;

⁶³ At [25] of her first witness statement

⁶⁴ At Exhibit

(iii) Hand-written invoices from between February 2005 and February 2009 relate to sales to wholesalers and whilst they are not easily legible, they relate to at least the following: *cassava flour, pounded yam, luncheon meat, peanut butter, herbs, pepper, bread, fish, coconut, palm oil, snails, custard, palm wine, and beans*. Ms Adejumo confirmed that these goods were branded as BIMS on the packaging or labels;

(iv) a limited number of photographs showing a BIMS sign on the label of bags of unidentifiable grain-like foodstuff;

(v) a BIMS sign identifies the retail premises of Party B and that this has remained virtually unchanged over the period of time the business has been in existence.

112. I have previously noted Mrs Adejumo's narrative evidence that the BIMS sign is now used in respect of over 200 food products, but the evidence fails to identify many of the specific products. It is clear that Party B is the owner of a long-standing goodwill identified by the BIMS sign in respect of African foodstuffs and the retail of the same. The evidence does suffer from some flaws, particularly in respect of supporting use of the BIMS sign in respect of specific food products but I am satisfied that it supports Party B's claim to a goodwill.

113. In summary, I conclude that Party B has a long-standing goodwill dating back to the 1990s in respect of *African food products and importation and retail of African food and drink products*.

Misrepresentation and damage

114. 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.”

115. 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.”

116. 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.

117. In the current case, the dominant element of all of Party A's marks are the words "Bim's Kitchen". Its figurative marks also contain the words "Modern, African-inspired cuisine" and a representation of one or three outlines of the continent of Africa. Party B relies upon two signs, the first of which is merely the word "BIMS". Its goodwill is in respect of African foods. This is relevant because of the strap-line and representation of Africa present in all of Party A's figurative marks. The combination of the strap line and the representation will inform customers and potential customers of characteristics of the goods that are the same as those for which Party B has goodwill. The common occurrence of the word "Bim's"/"BIMS" will instantly lead customers to believe that Party A's *jams* and *sauces (condiments)* are those of Party B. The word "KITCHEN" present in all of Party A's marks is commonly used in its normal descriptive way in respect of food goods and services and is likely to have the effect of leading customers to believe that the marks are brand variations of Party B's BIMS signs. This will be further reinforced in respect of Party A's figurative marks because of the references to Africa reflecting the character of Party B's goods.

118. In summary, Party B's customers are very likely to be misled into believing that *jams* and *sauces (condiments)* provided by Party A under its marks are those of Party B.

119. It follows that there will be damage in the form of lost sales for Party B in circumstances where such misrepresentation occurs.

120. In light of such a finding, I will comment briefly on Party A's claim to having a senior goodwill. This can be quickly dismissed because, earlier in this decision, I found that Party A had failed to demonstrate it had made genuine use of its marks for the purposes of assessment under section 46. For the same reasons, its evidence falls

short of demonstrating that it had goodwill of its own. Consequently, I reject this defence.

Summary

121. Party B is successful in revoking all four of Party A's registrations in their entirety from 2 April 2016 (2566730), 12 April 2019 (3036230), 26 April 2019 (3039469) and 28 December 2018 (3023980).

122. Party B is successful in its entirety in respect of its applications for invalidation of all four of Party A's registrations.

COSTS

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

Dated this 18th day of November 2024

Mark Bryant
For the Registrar