

O/577/21

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3446254

BY HALAL FRESH LTD

AND

OPPOSITION No. 419427

BY HELLOFRESH SE

Background and pleadings

1. This is an opposition by HelloFresh SE (“the opponent”) to an application filed by Halal Fresh Ltd (“the applicant”) on 22nd November 2019 (“the relevant date”) to register the trade mark shown below (“the contested mark”).



2. The application covers the following goods:

Class 29: Fish; Meat; all of the aforesaid being halal produce.

Class 31: Vegetables; Fresh fruits, nuts, vegetables and herbs.

3. The opponent is the proprietor of the following earlier EU trade marks:

Number	Mark	Date of filing & Registration	Classes on which opposition is based
EU13716311	HelloFresh	05/02/2015 & 28/07/2015	29, 31, 35 & 43
EU15656961		14/07/2016 & 15/03/2021	As above

EU16528391		31/03/2017 & 17/02/21	As above
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4. By virtue of the transitional provisions set out in paragraph 7(1) of Schedule 5 to the Trade Marks (Amendment etc.) (EU Exit) Regulations¹ made pursuant to the European Union (Withdrawal) Act 2018, earlier EU trade marks filed before 31st December 2020 continue to constitute relevant earlier trade marks for the purposes of sections 5 and 6 of the Trade Marks Act 1994 (“the Act”). Therefore, the opponent can continue to rely on the earlier EU marks notwithstanding the UK’s exit from the EU.

5. According to the opponent:

- (i) The contested mark is similar to the earlier marks;
- (ii) The goods for which registration of the contested mark is sought are identical or similar to the goods/services relied on for this opposition;
- (iii) The earlier marks have acquired an enhanced distinctiveness as a result of the use made of them;
- (iv) There is a likelihood of confusion on the part of the public, including the likelihood that the contested mark will be taken as a brand extension of the earlier marks, i.e. that there is a likelihood of indirect confusion.

6. The opponent claims that the earlier marks have acquired reputations in the EU and UK as a result of the use made of them. According to the opponent, use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier marks.

¹ SI 2019/269

7. The opponent therefore asks for the opposed application to be refused under sections 5(2)(b) and/or 5(3) of the Act.

8. Additionally, the opponent claims to be the proprietor of an earlier unregistered right as a result of the use of HelloFresh in the UK since February 2015 in relation to a wide range of goods/services including, but by no means limited to, foodstuffs, retail services relating to foodstuffs, and providing meals for immediate consumption. According to the opponent:

- (i) It has acquired a valuable goodwill under HelloFresh;
- (ii) Use of the contested mark would constitute a misrepresentation to the public that the applicant is connected to the opponent;
- (iii) Having regard to the opponent's extensive use of the strapline 'Dinner is solved', the inclusion in the contested mark of the strapline 'Dinner is sorted' supports the claim that the applicant intends to free-ride on the opponent's reputation and misrepresent itself as the opponent;
- (iv) Such a misrepresentation would damage the opponent's goodwill and would be contrary to the law of passing off.

9. Therefore, the opponent claims that the application should be refused under section 5(4)(a) of the Act.

10. The applicant filed a counterstatement denying the grounds of opposition. I note the following points:

- (i) The applicant admits that the goods for which registration of the contested mark is sought are identical to the goods in classes 29 and 31 covered by earlier marks EU15656961 and EU16528391;
- (i) The applicant admits that, except for *nuts* and *herbs*, the goods for which registration of the contested mark is sought are identical to the goods in classes 29 and 31 covered by earlier mark EU13716311;

- (ii) The applicant denies that the contested mark is similar to the earlier marks or, alternatively, asserts that any such similarity is to a very low degree;
- (iii) The applicant asserts that the word FRESH is non-distinctive in relationship to foodstuffs and related services and, consequently, that the common use of this word is not sufficient to create a likelihood of confusion, or any of the other consequences the opponent complains about;
- (iv) The applicant denies that the earlier marks have a reputation in the EU and/or that consumers in the UK would make a mental link between the contested mark and the earlier marks;
- (v) The applicant denies that the opponent has acquired goodwill under HelloFresh, or that use of the contested mark could be restrained under the law of passing off;
- (vi) The applicant complains that the opposition had been prepared without the requisite level of care because it did not seek to limit the arguments to those points which could properly be made, and completely failed to respond to the questions in the TM7 form in a way which allowed for the case to be dealt with appropriately.

11. Both sides seek an award of costs.

Representation

12. The applicant is represented by Blaser Mills LLP. The opponent is represented by Bird & Bird LLP. A hearing took place on 13th April 2021 via videoconference. The applicant was represented by Mr Aaron Wood of Blaser Mills. The opponent was represented by Mr Mark Holah, assisted by Mr Tom Hooper, both of Bird & Bird.

The evidence

13. The applicant's evidence consists of a witness statement by Aaron Wood dated 18th November 2020 (with 13 exhibits). Mr Wood's evidence goes mainly to the use by

other businesses in the UK in the field of foodservice and delivery of brand names including the word FRESH.

14. The opponent's written evidence consists of a witness statement dated 1st October 2020 (with 19 exhibits) by Mr Richard Lieberenz. Mr Lieberenz is the opponent's Senior Legal Counsel. He has held this role since 1st May 2017. He explains that, at the relevant date, the opponent provided meal/recipe boxes to customers in nine EU countries, including the UK. Mr Lieberenz's evidence goes to the use, promotion, and reputation of the earlier marks in the EU, UK, and elsewhere.

15. The applicant sought (and received) leave to cross examine Mr Lieberenz on his evidence about the opponent's turnover and marketing activity under the mark HELLO FRESH. This was justified on the basis that "*...this is important to resolving the question of whether there is repute in the EU or the UK and there are material aspects of the evidence that rely entirely on his witness statement as opposed to any exhibits thereto.*" The applicant indicated that, in the light of the COVID restrictions, it was content for cross examination to take place remotely. Consequently, Mr Lieberenz took part in the hearing remotely from his location in Germany and was cross examined by video link.

16. In order to fully understand the background and purpose of the cross examination, it is necessary to go into Mr Lieberenz's written evidence in a little more detail. Mr Lieberenz's written evidence was that the opponent was founded in 2011 and started trading in its meal/recipe boxes in the UK in February 2012. HelloFresh is the opponent's house brand. The opponent's HelloFresh lime logo (trade mark EU EU15656961) was adopted in 2016 and the stylised Hello Fresh word mark (EU16528391) at the end of 2016. Mr Lieberenz said in his written evidence that the opponent's corporate policy prevented him from disclosing revenue figures specific to the EU and UK. This was because such information was considered to be highly commercially sensitive. Instead, he provided worldwide turnover figures split between the US and elsewhere. The revenue figures provided for non-US markets were substantial: €360m in 2017, €545m in 2018, and €784m in 2019. Mr Lieberenz explained that slightly below 50% of this income was derived from sales in the EU, including the UK. His written evidence did not break this down any further. So it was not possible to determine the extent of the opponent's sales in the UK. Similarly, Mr

Lieberenz did not provide figures for the amounts spent promoting the earlier trade marks in the EU/UK. Instead, he provided a global figure for the amount spent on marketing in non-US markets in 2019 - €123.2m - and he noted that “..a proportion of which can be attributed to the EU and UK.”

17. As the opponent relies heavily on the reputation of the earlier marks in the EU/UK for the purposes of this opposition, I accepted that it was appropriate for Mr Lieberenz to be cross examined about what his evidence did (and did not) show in this respect.

18. Two things became clear from cross examination. Firstly, none of the financial data provided in his witness statement relates specifically to the UK or EU. Secondly, that revenue generated under trade marks other than those relied on in the opposition, was included in the revenue and marketing figures provided. The first outcome was no surprise: Mr Lieberenz’s witness statement was clear that the revenue and marketing figures provided were not specific to the EU or UK. The second outcome was unexpected. This is because Mr Lieberenz’s witness statement indicated that “all the evidence set out [in his statement] relates to the recognition and reputation of [the opponent’s HelloFresh house mark].” I return to the significance of this matter below.

19. The omission of revenue and marketing figures specific to the EU/UK resulted in another unexpected development. During Mr Lieberenz’s re-examination by his attorney, Mr Holah, he was asked if it was “..fair to say that you have more information about these [revenue and marketing] figures.. .” Mr Lieberenz responded that he had recently been authorised by his company to provide UK and EU specific figures, albeit within upper and lower financial ranges. He proceeded to give the following evidence:

HelloFresh’s EU revenue	HelloFresh’s UK revenue	HelloFresh’s EU marketing spend	HelloFresh’s UK marketing spend
2015 - €180-200m	2015 - €45-55m	2015 - €60-65	2015 - €19-22m
2016 - €240-260m	2016 - €80-90m	2016 - €65-70m	2016 - €22-27m
2017 - €260-280m	2017 - €90-100m	2017 - €60-65m	2017 - €22-27m
2018 - €310-330m	2018 - €90-100m	2018 - €65-70m	2018- €22-27m
2019 - €355-375m	2019 - €110-120m	2019 - €65-70m	2019 - €22-27m

20. Mr Wood was understandably critical of the opponent's behaviour in introducing this evidence under the guise of 'clarification' of Mr Lieberenz's answers in cross examination, which did little more than confirm what his written evidence did not show. Mr Wood complained that the above evidence should have been given earlier when it could have been properly analysed and possibly challenged. Further, no satisfactory explanation had been offered as to why the evidence could not have been filed earlier. Therefore, he asked me to treat this new evidence as inadmissible.

21. I agree that Mr Lieberenz's oral evidence given during re-examination went beyond the scope of clarification of his answers in cross examination. However, the Registrar has a discretion to admit additional evidence. The discretion is provided by Rule 20(4) of the Trade Mark Rules 2008, which states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

22. Further, Rule 62(1) of the Rules states that:

"62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit,..."

23. Additionally, Rule 62(2) states:

"(2) The registrar may control the evidence by giving directions as to—
(a) the issues on which evidence is required; and
(b) the way in which the evidence is to be placed before the registrar."

24. The net effect of these Rules is to give the Registrar a discretion to accept new oral evidence at a hearing. I therefore considered whether Mr Lieberenz's new evidence should be admitted as new oral evidence. In *Property Renaissance Ltd (T/A Titanic SPA) v Stanley Dock Hotel Ltd (T/A Titanic Hotel Liverpool)*², Carr J. set out

² [2016] EWHC 3103 (Ch)

the factors the Registrar should consider when determining whether to accept late evidence. These are:

- (i) the materiality of the evidence in question to the issues that the registrar has to determine;
- (ii) the justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- (iii) whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and
- (iv) the fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.

25. These factors are similar to those applied when considering the admission of new evidence on appeal. However, when the issue arises at first instance the test should not, in my view, be applied with quite the same degree of vigour as applied on appeal. This is because:

- (i) In order to contain costs and avoid delay, parties should be encouraged to file their best evidence at first instance;
- (ii) Appeals are conducted by way of review, meaning that they are normally limited to correcting errors made at first instance;
- (iii) This approach becomes fraught when the case presented on appeal becomes factually different to the case presented at first instance.

This should not be understood as meaning that additional evidence will necessarily be permitted at any stage of the proceedings. Indeed, I rejected an application to file additional last minute evidence in the very next case I dealt with. Every such application must be assessed on its own merits.

26. Considering the four important factors set out in paragraph 24 above in relation to this opposition, I find that the new evidence is highly material to the opponent's case. This is because the case depends heavily on the existence and extent of the reputation attached to the earlier marks and the new evidence goes directly to that issue.

27. There is no good reason why the evidence could not have been filed earlier. However, I consider it relevant that when the applicant applied to cross examine Mr Lieberenz to resolve "*..the question of whether there is repute in the EU or the UK*" it necessarily accepted a risk that he might give more oral evidence on that matter at the hearing.

28. Provided it was given the opportunity to cross examine Mr Lieberenz on his new evidence, and an opportunity of filing further evidence in reply, the admission of the new evidence would not prejudice the applicant, except in terms of cost and delay.

29. Although there is other written evidence which supports the opponent's claim that the earlier marks had a reputation in the UK and EU at the relevant date, that claim might not be enough to establish the claimed reputation. By contrast, if the new evidence was accepted there appeared to be a reasonable prospect that the opponent would be able to establish the reputation it claimed for the earlier marks. Therefore, there was a real risk of prejudice to the opponent in not being allowed to rely on a reputation the earlier marks may in fact have.

30. Taking all of the above into account, I agreed to admit the new evidence on the following conditions:

- (i) That irrespective of the outcome of the opposition, the opponent would bear the applicant's reasonable costs of dealing with the new evidence;
- (ii) That the applicant should have one month from the date of the hearing to consider the opponent's new evidence and, if it wished, file further evidence and written submissions in reply.

31. Given the potential cost implications, I gave the opponent 24 hours to indicate if it preferred to withdraw the new evidence rather than to accede to these conditions. It did not. Therefore, Mr Lieberenz's new evidence was admitted.

Procedural economy

32. The parties appear to agree that the opponent's best case is based on trade mark EU13716311 – HelloFresh. I will therefore focus on this aspect of the opponent's case under sections 5(2)(b) and 5(3) of the Act, and then briefly consider the case based on the other two earlier marks, before turning to the opposition based on section 5(4)(a). The applicant anticipated that the opponent's major ground of opposition at the hearing would be under section 5(3) of the Act and organised its skeleton accordingly. I agree that section 5(3) is the strongest ground of opposition. I shall therefore start with this.

The section 5(3) ground of opposition

33. At the relevant date, section 5(3) stated:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

34. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

35. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

The opponent's pleaded case

36. In a post-hearing communication dated 28th May 2021 about a late amendment to the opponent's section 5(2) pleading (which I will return to under costs), the applicant's representative stated a belief that the opponent's section 5(3) case was effectively that consumers would be confused into believing that the contested mark is connected to the user of the earlier marks. That narrow understanding of the opponent's case under section 5(3) was not evident from the applicant's skeleton argument, which appeared to acknowledge that the opponent's case included a claim that use of the contested mark would free-ride on the reputation of the earlier marks.³

³ See paragraph 20 of the applicant's skeleton

37. The opponent's case under section 5(3) at the hearing was not solely based on the consequences of a likelihood of confusion. For example, paragraph 31 of the opponent's skeleton stated that:

"Due to the extensive reputation which the Opponent has built up in Fresh's Earlier Registrations, the use of the Mark will inevitably take unfair advantage of that reputation because the consumer is likely to make an association with the Opponent's well-known marks. To put it another way, consumers are more likely to buy Halal's goods than they would have been if they were not reminded of / made a link with Fresh's Earlier Marks."

38. It is therefore necessary to examine the opponent's pleaded case closely to determine whether the various claims are postulated on the existence of a likelihood of confusion. Question 3 in the section of the form TM7 covering section 5(3) claims poses the following question:

"Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?"

39. The opponent answered this question as follows:

"The "Halal Fresh" mark in the contested application is closely similar to the Opponent's earlier rights to "HelloFresh". The Opponent has used their marks extensively in the EU and UK and is well recognized by the relevant public. Use by the applicant of "Halal Fresh", a mark which is visually, aurally and conceptually very similar, would create the impression that the respective parties are commercially connected, and economically linked. Due to the similarities between the marks, use on identical goods, runs the risks of allowing the applicant to unduly benefit from the goodwill, reputation and status which the Opponent has become known for."

40. This part of the opponent's pleading is clearly based on the proposition that there is a likelihood of confusion amongst the public that the marks are used by the same or related undertakings. The following question on the form TM7 asks:

"Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair."

41. The opponent answered this question as follows:

"The Opponent is a well-known food delivery and subscription based food service which sends pre-portioned ingredients and recipes to customers for home cooking in the EU and UK. The Applicant will have knowledge of the Opponent's business and has selected a closely similar brand name (which is visually, aurally and conceptually very closely similar whilst also containing "Fresh" in the second position and a first word of a similar composition to the opponent's "Hello") in a clear attempt at exploiting the Opponent's business. Use of another closely similar mark, especially one containing the "Fresh" suffix, in relation to identical goods, will lead to consumer confusion and the Applicant free-riding upon the power of attraction, prestige and reputation of the Opponent's marks. It also runs the risk of damaging their good name, market leading position and investment (both financial and promotional).

42. Taken alone this is ambiguous. The words "...will lead to consumer confusion and the Applicant free-riding upon the power of attraction, prestige and reputation..." could be understood as meaning that use of the applicant's allegedly similar mark will free-ride on the reputation of the earlier marks as a result of consumer confusion. Alternatively, the words could be understood to mean that use of the contested mark will lead to consumer confusion and [in the sense of 'additionally'] will free-ride on the reputation etc. of the earlier marks. Given that this statement was made in response to a question about whether there was any other basis (than trade origin confusion) for the unfair advantage claim, I consider that the pleading should be understood in the latter (wider) sense. Therefore, for the avoidance of doubt, I find that the case presented at the hearing falls within the opponent's pleaded case.

Reputation

43. In its original pleadings, the opponent claimed that the earlier marks had a reputation for a wide range of goods/services in classes 29, 31, 35 and 43. The opponent's evidence clearly did not support the width of the reputation claimed. When challenged about this at the hearing, the opponent's representative agreed to limit the scope of the reputation claimed for the earlier marks. I directed the opponent to file an amended form TM7 setting out the scope of its revised claims. The reputation claimed for EU13716311 was subsequently limited to:

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.

Class 31 - Agricultural products and grains, not included in other classes; fresh fruits and vegetables; Seeds.

Class 35 - The bringing together, for the benefit of others, of 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 edible fats, agricultural products and grains, excluding the transport thereof, enabling customers to conveniently view and purchase those goods.

Class 43 - Services for providing food and drinks; food preparation and providing advice and information relating thereto; providing food, drinks and prepared meals for delivery; the provision of a database in the field of recipes; all the aforesaid services also provided via electronic means such as the Internet.

44. The applicant submits that this list is wider than the one given orally at the hearing when the opponent was challenged about the mismatch between the breadth of the reputation claimed compared to the goods/services for which use of the earlier marks was shown in the evidence. In particular, the opponent initially framed its revised claim as covering foodstuffs in classes 29, 31 and related retail-type services in class 35. Seizing on this limitation, the applicant's representative submitted that the services

shown in the opponent's evidence did not fall within the retail-type services for which the earlier marks are registered in class 35. According to the applicant at the hearing, the services shown in the evidence are a form of catering services proper to class 43. The applicant now contends that the only services in respect of which it is possible for me to find that EU13716311 has acquired a reputation and enhanced distinctive character through use are:

Class 43: Services for providing food and drinks; home delivery of meals; food preparation; providing food, drinks and prepared meals for delivery; all the aforesaid services also provided via electronic means such as the Internet

Accordingly, the applicant submits that the effect of the opponent's initial oral limitation to services in class 35 was to prevent it from claiming a reputation for any services. This led the opponent's representative to retract the omission of class 43 from the list of services for which reputation was claimed. The applicant says it was too late to do so and the opponent is stuck with its oral limitation to goods/services in classes 29, 31 and 35.

45. I disagree. I return below to the merits of the applicant's point about the opponent's services not being retail services. For present purposes, it is sufficient to note that the opponent was unaware that the applicant was going to take this classification point when it initially agreed to limit its claim that the earlier marks have a reputation to goods/services in classes 29, 31 and 35. The opponent clearly did not intend to abandon its case that the earlier marks have a reputation for services as well as goods. Rather, its intention was to limit its claim to the goods/services shown in the evidence. In these circumstances, it would be unfair to exclude services for which use of the earlier marks is, or may be, shown in the opponent's evidence.

46. With this in mind, I now turn to examine Mr Lieberenz's evidence in more detail. His written evidence states:

"The Opponent provides meal/recipe boxes (meal kits) to customers on a subscription basis. This involves preparing recipes and providing customers with fresh ingredients to prepare meals at home. This is intended to reduce the time that the Opponent's customers spend shopping for all the necessary

ingredients. The recipes are designed using a variety of ingredients, including meat, fish, and vegetables.”

47. Examples of meals made from the opponent’s meal kits are included as exhibit RL-1. They show meals made from various meats, fish, eggs, vegetables, fruit, rice, pasta, nuts, cheese and bread, together with various accompaniments, such as yoghurt.

48. Exhibit RL-12 to Mr Lieberenz’s statement consists of pictures of the opponent’s hellofresh.co.uk and hellofresh.de websites as at November 2018 and January 2015, respectively. They show meal kits being advertised under the HelloFresh mark as being available on a subscription basis.

49. Mr Lieberenz’s written evidence also includes the number of people who visited the opponent’s UK website (www.hellofresh.co.uk) between 2014 and 2019. This ranged from 1.3m in 2014 to over 8m in 2019. A website analysis document is provided which contains more specific information.⁴ It covers the period January 2019 to May 2020. The average number of monthly visits to the opponent’s UK website during this period was around 650k. Over 380k of these were unique visitors. The average number of monthly visits during the calendar year 2019 was around 500k. During cross examination, Mr Lieberenz was asked to explain the discrepancy between the claim in his written evidence that the UK website received around 8m visits during 2019, and the graph in the accompanying website analysis document, which indicates a figure of around 6m visits. Mr Lieberenz could not explain the discrepancy. He said that he had relied on the information provided to him by his company. I consider the figures shown in the website analysis document are more reliable than the figures given in Mr Lieberenz’s statement. These show that during the fourth quarter of 2019 the number of monthly visits to the UK website amounted to just below 500k. Based on the ratio of visits/visitor provided, this indicates that the opponent’s UK website had around 300k unique visitors per month in the quarter spanning the relevant date. However, I note from other information provided in the document that the website had a ‘bounce rate’ of 48%, indicating that almost half the visitors left the site immediately. This

⁴ See exhibit RL-11

suggests that around 150k visitors per month intended to visit the opponent's UK website. According to the report, about 90% of the visitors were based in the UK.

50. Data provided by the opponent's Business Intelligence Department indicates that the opponent had around 10k customers in the EU in 2013. By 2015, this had increased to around 200k. By 2018, the number had grown to over 360k. This increased again in 2019, to over 500k.

51. Mr Lieberenz says that "*Due to the frequency and volume of promotional activities it undertakes the Opponent does not track its promotional activities.*" However, he provides examples of promotional documents "*..that were distributed by the Opponent in the UK on a widespread and regular basis before the Application Date.*"⁵ These appear to consist of promotional leaflets and money-off vouchers (with amounts in pounds sterling) offering meal kits under the earlier marks. I note that two of the pages refer to "*Making it easier you and a friend to cook fresh in 2020*" indicating that at least some of the pages in evidence post-date the relevant date. However, I also note:

- (i) Mr Lieberenz's written evidence that these are proofs and mock-ups of material that was distributed prior to the relevant date; and
- (ii) That when asked during cross examination about the 2020 date shown on one of the pages, Mr Lieberenz's answer was that this was material supplied to him by the marketing department (which neither confirms nor contradicts the claim in his written statement that the pages in exhibit RL-6 are representative of material distributed in the UK prior to the relevant date).

52. Further examples of promotion of the earlier marks in the UK are provided in the form of:

- (i) a picture of EU15656961 used in February 2017 in an advertising space on a platform-facing wall on the London Underground;⁶

⁵ See exhibit RL-6

⁶ See exhibit RL-8

- (ii) the same mark and the words HELLO FRESH alone in use on a pop-up shop that opened in Old Street, London in March 2017;⁷
- (iii) A promotion on the website foodism.co.uk in September 2019 through which HELLOFRESH meal kits could be ordered online with £15 off the first 4 boxes.⁸

53. Exhibit RL-10 to Mr Lieberenz's statement consists of a Brand Awareness Report prepared by the opponent's Global Markets Research Team showing levels of awareness of HELLOFRESH across the UK, Belgium, Netherlands, Germany, France, Austria and Sweden. It covers the seven quarters between quarter 3, 2018, and quarter 1, 2020. According to the methodology described in the report, it is based on 7 minute long online interviews conducted once in each quarter across the countries mentioned above. The description of the methodology states the average sample size was 500-1000. When asked during cross examination about the number of respondents per country, i.e. whether the 500-1000 figure was per country or a global figure, Mr Lieberenz was unable to say. This is because he was not involved in the surveys and relied on the information given to him by his Marketing Department. I note that the page provided in evidence showing the results for the UK (the only country-specific results provided) refers to the average UK sample size over the seven quarters as being 1337. I cannot accept that average sample for the UK was 1337 respondents per quarter. The alternative meaning of the information provided in the report is that 1337 is the global sample size figure for the UK for the whole period of 21 months. On this view of the data, the average UK sample size per quarter was just under 200 people. This is broadly consistent with the total sample across all the countries surveyed having been between 500 – 1000 per quarter.

54. The survey tracked unaided brand awareness and aided brand awareness. To test the first of these, participants were asked *Which meal kit delivery services do you know – even if by name only?* Aided brand awareness was established by asking *“Here is a list of brands/providers (with images). Which of the following have you heard of before today?”*

⁷ See exhibit RL-7

⁸ See exhibit RL-9

55. According to the results provided, 15% of UK respondents identified HELLOFRESH unaided in the research conducted during quarter 4 of 2019 (i.e. the quarter spanning the relevant date). This rose to 50% when participants were given a list of names as prompts. The figures for the other six quarters covered by the research are broadly similar; unprompted recognition of Hello Fresh amongst the UK respondents ranging from 14% to 18% across the whole period. The recognition levels for HelloFresh were higher than for the opponent's two competitors, Gousto and Abel & Cole, which also appear to have been covered by the research.

56. The opponent has a presence on social media sites. The information in exhibit RL-13 shows that the opponent had over 1.7m followers on its German HelloFresh Facebook page as at 29th May 2018,⁹ and around 1.9m followers on its Netherlands and UK specific HelloFresh Facebook pages, as at 7th March 2019. I note that the exhibit also includes Facebook pages from after the relevant date. These pages appear to be intended to show ongoing engagement with customers in these countries starting from well before the relevant date.

57. The opponent also has pages on YouTube aimed at Germany and Austria, Netherlands, Belgium and the UK. The pages from 29th May 2018 show that by that date the content of these pages had been viewed around 870k times (Germany and Austria), 590k times (UK), 370k times (Netherlands) and 215k times (Belgium).

58. Mr Lieberenz also provided examples of coverage of HelloFresh in the UK media.¹⁰ I note the following:

- (i) An article in The Guardian dated 6th March 2019 under the title '*Just Eat and HelloFresh tap into appetite for home-delivered food*' stated that '*Sales surge as consumers in UK and elsewhere look for convenience.*'
- (ii) The website grocergoldawards.co.uk records that HelloFresh won the title 'Specialist Online Retailer of the Year' in 2016.

⁹ Mr Lieberenz says at 7th March 2019, but the page in evidence says different

¹⁰ See exhibit RL-19

- (iii) An online article dated 1st June 2016 posted on the website postandparcel.info states that *“Food delivery company HelloFresh will be opening a new 237,0000 square foot distribution centre in Banbury.”*
- (iv) An article on the BBC website from 2020 states that *“HelloFresh has been based in Banbury since 2016.”*
- (v) An article on the website beastmag.co.uk in 2020 states that *“In the space of just four years, HelloFresh has become one of the biggest, brightest and best recipe box delivery services in the country”,* and continues, *“If you’re not familiar with HelloFresh, then you must have been hiding under a boulder for the past few years. A bit like chuggers, its bright young things...approach you outside tube stations and on busy high streets [offering discount cards for meal kits].”*
- (vi) An article dated 4th November 2016 on the website of the Evening Standard notes that commuters raised £20k for charity by buying HelloFresh vegetable boxes *“..donated by the fresh food specialist.”*
- (vii) An article dated 7th March 2014 on the website wired.co.uk on the subject of ecommerce hailed HelloFresh as its ‘Startup of the Week’.

59. Mr Lieberenz claims that the UK business commenced in 2012. That may be so, but the balance of the evidence indicates that it only really got going here in 2014/15. Indeed, I note that the opponent’s pleaded case under section 5(4)(a) claims a first use date of February 2015. The UK business appears to have grown rapidly in the period between 2015 and the relevant date in 2019. By this time, Mr Lieberenz claims it was generating €110 -120m revenue through UK sales alone. According to Mr Lieberenz, it was also spending between €22 – 27m per annum marketing its meal kits in the UK.

60. As the above description and analysis of Mr Lieberenz’s written and oral evidence shows, there are issues with the quality of some of his written evidence and the exhibits provided to support it. The applicant also objects to his oral evidence about the opponent’s revenue and marketing costs. Mr Lieberenz is not accused of lying. Rather, the applicant submits that the revenue and marketing figures he provided

under oath at the hearing is hearsay which should be given little weight. In this connection, the applicant draws my attention to the following factors from Section 4 of the Civil Evidence Act 1995:

(a) Whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness

The applicant says that the opponent could have produced a separate witness who could speak directly in relation to the revenue and marketing figures provided. It is true that the opponent could have sought leave for the evidence to be given by its Financial Director or accountant. However, it is unlikely that any one person would have first-hand knowledge of financial transactions amounting to hundreds of millions of Euros per annum. Even a Financial Director or accountant would usually have to rely, to some extent, on figures and/or records prepared by other people. Therefore, I do not consider that the evidence in question was tendered by the opponent's Senior Legal Counsel has a major bearing on the weight to be attributed to his evidence.

(b) Whether the original statement was made contemporaneously with the occurrence or existence of the matters stated

The applicant accepts that the revenue and marketing figures were prepared contemporaneously for the hearing, albeit through recalculations based on data collected earlier.

(c) Whether the evidence involves multiple hearsay

The applicant says that the evidence could be based on multiple hearsay. I agree. However, as I have already noted, collecting and presenting financial data for a large business usually requires input from a significant group of people.

(d) Whether any person involved had any motive to conceal or misrepresent matters

The applicant says that the witness had a clear motive to conceal or misrepresent the new evidence because it had belatedly recognised that its other written evidence was likely to be inadequate to establish the reputation claimed. I accept that this was the opponent's motive for giving additional oral evidence at the hearing. I do not accept that this gave the opponent a motive to conceal or misrepresent the new evidence. I also find this accusation hard to reconcile with the applicant's acceptance that Mr Lieberenz was not lying.

(e) Whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose

See above.

(f) Whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight

The applicant says that the financial evidence was given at a time which prevented proper evaluation of its weight, i.e. after the written procedure was closed and after Mr Lieberenz had been cross examined. I agree. However, the potential consequences of this were mitigated by giving the applicant an opportunity to cross examine Mr Lieberenz on his new evidence, and by giving the applicant a month after the hearing to file additional written evidence in response.

I found Mr Lieberenz to be an honest witness. He was open about the facts he had first-hand knowledge of and those about which he had relied on others to inform him. Further, I find the additional evidence given at the hearing about the size of the opponent's business broadly consistent with the picture that emerges from Mr Lieberenz's written evidence. Standing back and considering the evidence as a whole, I am satisfied that the opponent had a substantial business in the EU and UK at the relevant date trading in meal kits providing fresh food to consumers.

61. I pause here to consider the question of which brands were used in relation to this business. Based on information found in the opponent's annual reports and accounts about the opponent growing by acquiring existing businesses, Mr Lieberenz was asked, and readily accepted, that the revenue and marketing figures he provided included income from, and promotion of, some other acquired brands. Asked about the position in the UK, he said that figures provided for some of the years included sales/marketing for another brand. However, his evidence was that the business concerned had ceased and, in any event, only accounted for a small proportion of the figures. Mr Lieberenz was open and candid about the matter and I accept his evidence on this point. Accordingly, I do not consider that the revelation that the evidence includes some use of non-HelloFresh brands undermines the case that at the relevant date the opponent had a substantial business in the UK under marks consisting of, or including, Hello Fresh.

62. According to the revenue figures provided for 2019, the UK accounted for about 30% of the opponent's revenue in that year. Mr Lieberenz's evidence (which stands unchallenged on this point) is that the opponent had around 500k customers in the EU in 2019. This suggests that the opponent had around 150k paying customers in the UK in that year. The reputation of the earlier mark would naturally have extended to the households of its paying customers and, to a lesser degree, to their friends and wider families. It is true that there is little specific evidence as to what the claimed €22-27m annual marketing expenditure was spent on. However, as noted above, there is evidence of an advertisement for Hello Fresh on the London Underground and promotion of the mark through the distribution of money-off vouchers. Therefore, the earlier mark would also have been known to those who saw advertisements for HelloFresh, such as one on the London Underground shown in the evidence, or were offered money-off vouchers on the street or via websites. In my view, the evidence shows that Hello Fresh was known to a significant proportion of the relevant general public in the UK at the relevant date. This is the result of the use of HelloFresh as a word mark, and also as part of EU15656961 and EU16528391.¹¹

¹¹ Per *Société des Produits Nestlé SA v Mars UK Ltd*, CJEU, Case C-353/03

63. The position in the EU is more difficult to establish because it is less clear what proportion of the revenue and marketing figures provided relate to Hello Fresh brands. However, taking the evidence as a whole, including:

(i) The number of visits/visitors to the opponent's HelloFresh EU-based websites;

(ii) The number of followers of HelloFresh on the opponent's social media pages;

(ii) The awareness of the brand shown in the opponent's Brand Awareness Survey;

(iv) The reputation established as existing in the UK;

- I find that at the relevant date, HelloFresh was known to a significant proportion of the relevant public (being the general public) in the EU.

64. It is necessary to determine the goods/services for which the HelloFresh mark had a reputation. As noted at paragraph 43 above, the opponent considers that its use of the earlier mark corresponds to goods in classes 29 and 31, retail-type services in class 35, as well as catering-type services in class 43. The applicant now appears to consider that the opponent's services are limited to class 43. I note that prior to the hearing, the applicant seems to have considered that the opponent's evidence tended to go to services in classes 35 and 43.¹² That is also my view. Classification of services serves an administrative purpose: it makes it easier to find marks registered for relevant goods/services. There is no rule that requires a 'real world' trade to fall within only one of the classes of goods/services into which the register is divided. For example, if a consumer orders a pizza to be cooked and delivered to his or her home, he or she is using a catering service, a delivery service, as well as buying a food product.

65. Mr Wood justified the position he took at the hearing on retail services by arguing that selling one's own goods does not constitute a retail service. It is well established

¹² See paragraph 11 of the applicant's skeleton argument

that retail-type services in class 35 cover the bringing together of a selection of goods for the convenience of the public, and other related services intended to encourage consumers to purchase those goods from the trade mark owner. There is no rule that these goods cannot include those offered by the trade mark owner itself.¹³ Provided the services are more than an integral part of the offer for sale of the goods, they constitute services proper to class 35.¹⁴ The opponent's services of pre-selecting foodstuffs so as to provide the ingredients in the appropriate portions for specific meals is clearly additional to the mere offer to sell the individual foodstuffs. It therefore qualifies, inter alia, as a retail service. This is consistent with the evidence that the opponent was awarded the title 'Specialist Retailer of the Year' in 2016.

66. In its written submissions dated 7th May 2021, the applicant submitted that the only registered services for which it was possible on the evidence for me to find that the EU13716311 mark had acquired a reputation and enhanced distinctive was:

Class 43: Services for providing food and drinks; home delivery of meals; food preparation; providing food, drinks and prepared meals for delivery; all the aforesaid services also provided via electronic means such as the Internet.

I also note the applicant's submission that the only registered services for which it was possible on the evidence for me to find that the EU16528391 mark had acquired a reputation and enhanced distinctive was:

Class 43: The bringing together of goods, namely meat, fish, poultry, vegetables, fresh fruits and vegetables, including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes.

Examining the opponent's amended claim (set out at paragraph 43 above) for the reputation claimed for the EU13716311 mark, I find the following aspects of the business conducted under the HelloFresh word mark fall in class 35 and 43:

¹³ See *Netto Marken*, Case C-420/13, CJEU

¹⁴ *Apple Inc. v Deutsches Patent- und Markenamt*, Case C-421/13, CJEU

Class 35: The bringing together, for the benefit of others, of meat, fish, poultry, agricultural products and grains, excluding the transport thereof, enabling customers to conveniently view and purchase those goods.

Class 43: Food preparation and providing advice and information relating thereto; providing food, drinks and meals for delivery; the provision of a database in the field of recipes.

67. These services represent the core of the opponent's services and this is where the reputation of HelloFresh resides.

68. I accept that the provision of unbranded foodstuffs in HelloFresh meal kits also counts as use of the mark in relation to the goods themselves.¹⁵ However, it would be artificial to say that the earlier mark has a reputation for individual food products. For example, an average consumer would not regard the earlier mark as having a reputation for (say) tomatoes. Therefore, although the reputation of HelloFresh for services in classes 35 and 43 may also have a bearing on the distinctiveness of the mark for foodstuffs in classes 29 and 31 for making up into meals, I find that the reputation of the mark would be perceived as primarily in relation to the types of services listed above.

Link

69. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in Intel are:

¹⁵ See, by analogy, *Cactus SA v OHIM*, EU Court of First Instance, Case T-24/13

The degree of similarity between the conflicting marks

70. The marks are shown below.

Contested Mark	Earlier Mark
	<p data-bbox="900 555 1066 589">HelloFresh</p>

71. The opponent's case is (a) although the round device and strap line 'Dinner is Sorted' cannot be ignored, HALAL FRESH is the dominant and distinctive element of the contested mark, (b) HelloFresh is clearly Hello and Fresh conjoined, (c) HALAL FRESH and HelloFresh are both comprised of 10 letters, eight of which (including all the consonants) are the same (d) both signs use -FRESH as a suffix, and (e) HALAL and HELLO both begin with the letter 'H', include two vowels, and contain two letters 'L'. Therefore, the opponent submits that the marks are visually similar to a medium degree, aurally similar to a high degree and conceptually similar to the extent that they both convey the idea of freshness.

72. The applicant's position is that HELLO and HALAL are completely different well-known words with different meanings, and FRESH is so commonly used in the context of foodstuffs that no material similarity results from its use in multiple marks, including these ones, in the food sector. The applicant's evidence is intended to make good the last point. However, as the applicant's claim that FRESH is a commonly used word in the food sector is not (and could not be) seriously disputed, and the opponent made clear at the hearing that its case is not based simply on the common use of the word FRESH (even as a suffix), there is no need to go further into this aspect of the applicant's evidence.

73. The fork device that follows the letters HALA- in the contested mark will be seen (as no doubt intended) as standing in for a letter 'L'. The first word in the contested mark will therefore be seen and verbalised as HALAL. I find that HALAL FRESH is the dominant and distinctive element of the contested mark. The words 'Dinner is Sorted' are not negligible. However, due to their relative size they are clearly secondary in importance to the words HALAL FRESH. The round black device is really just a setting for the word elements that appear on it in light brown. The colours black and brown are part of the mark, but are no more distinctive than any other two colours.

74. The earlier mark is clearly comprised of the words HELLO and FRESH conjoined.

75. Although they both begin with the letter 'H', include two vowels, and contain two letters 'L', the degree of visual similarity between HELLO and HALAL is low. This is because one of the vowels (the 'O' in Hello and second 'A' in Halal), and one of the letters 'L', appear in different locations in relatively short words. However, the visual similarity that exists between these words is added to by the common use of FRESH as a second word or suffix. As the opponent points out, the overall effect is that eight of the letters from HelloFresh, including all the consonants, are replicated in HALAL FRESH (when the fork device is seen as a second letter 'L'). On the other hand, the degree of overall visual similarity between the marks is reduced a little by the presence of the secondary elements of the contested mark, which have no counterpart in the earlier mark. Taking all these points into account, I find that the marks are visually similar to a low-to-medium degree.

76. The strapline 'Dinner is Sorted' is unlikely to be verbalised when the contested mark is spoken. The earlier mark will therefore be pronounced HEL-LOW FRESH. The contested mark will be pronounced HAL-LAL FRESH. The first syllable is similar and the last syllable is the same. The main aural difference comes from the middle syllables: LAL/LOW. This difference will be less obvious in use than would be the case if it occurred at the beginning of the marks. Overall, I find that the marks are aurally similar to a medium-to-high degree.

77. The words HELLO and HALAL have well-known and very different meanings. I accept that both marks evoke the idea of freshness, but I find that this introduces only a low degree of overall conceptual similarity between the marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

78. The goods covered by the contested mark are the same or highly similar to the goods traded through the opponent's retail services. In my view, they are, at the least, complementary goods/services in the sense described in *Oakley, Inc v OHIM*.¹⁶ For the reasons given in paragraph 64 above in relation to my hypothetical example of home delivery pizzas, the goods in classes 29 and 31 must also be considered complementary (in the sense described in the case law) to the opponent's services in class 43. Further, as the opponent's services may be (and in fact are) offered as an alternative to consumers buying and preparing their own ingredients for meals, the goods/services must be regarded as being in competition. This is another relevant factor in my assessment of the similarity between foodstuffs in classes 29 and 31 and the services in classes 35 and 43 for which the earlier mark has a reputation.¹⁷ I find that the respective goods/services are similar to a high degree.

The strength of the earlier mark's reputation

79. In my view, the evidence as a whole indicates that HelloFresh had a reasonably strong reputation amongst the UK public at the relevant date. I do not attach great weight to the opponent's brand awareness survey because the sample size was relatively small. However, my finding is, at least, consistent with the opponent's evidence that 15% of UK respondents in the market research conducted during the final quarter of 2019 were able to name Hello Fresh as a brand for meal kit delivery services without prompting.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

80. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹⁸ the CJEU stated that:

¹⁶ Case T-116/06

¹⁷ *Canon*, CJEU, Case C-39/97

¹⁸ Case C-342/97

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

81. Although the word ‘Fresh’ is wholly lacking in distinctive character for the types of services at issue, and the word ‘Hello’ is, at best, no more than averagely distinctive, the combination of ‘Hello’ and ‘Fresh’ is not a natural one because this combination makes no sense. I therefore consider that it is inherently distinctive to a medium degree. Whether that is right or not, for the reasons I gave for finding that the earlier mark had a reputation with the public, I find that by the relevant date the earlier mark had become highly distinctive through use in relation to the services specified at paragraph 66 above.

Whether there is a likelihood of confusion

82. Mr Holah submitted at the hearing that there was a likelihood of both direct and indirect confusion. The argument for direct confusion is based on the level of visual and, especially, aural similarity between the marks. I reject that submission. The matter must be assessed through the eyes and ears of average consumers, which in

this case means the general UK public. The average consumer is deemed to be reasonably observant and circumspect.¹⁹ I accept the submission in the applicant's skeleton argument, that average consumers of the goods covered by the contested mark would pay an average degree of attention during the selection process. In my view, the visual, aural and conceptual differences between the contested mark and HelloFresh are sufficient to avoid any significant level of direct confusion amongst average consumers of foodstuffs, even after allowing for a degree of imperfect recollection.

83. The argument for indirect confusion is based on the likelihood of HALAL FRESH being seen as a new variant of the mark HelloFresh, but used specifically in relation to foods being, containing, or sold to accompany, halal meat or fish. Mr Holah likened the case to one of the examples of indirect confusion given by Mr Iain Purvis QC, as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*²⁰ As Mr Purvis explained in that case, indirect confusion arises when the average consumer is caused to think that:

"The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

84. The type of indirect confusion relied on by Mr Holah was explained by Mr Purvis to arise:

"where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

85. For his part, Mr Wood submitted that a change from HELLO FRESH to HALAL FRESH was not a logical brand extension because HELLO was the more distinctive

¹⁹ *Lloyd Schuhfabrik Meyer*, CJEU, Case C-342/97

²⁰ Case BL O/375/10

part of the earlier mark. Therefore, a more logical brand extension would be (say) HelloFish (or perhaps, more relevantly to the current case, HelloHalal).

86. I accept that HELLO is more distinctive than FRESH. I also accept that HALAL FRESH is not the most obvious way of signalling a brand extension of HelloFresh for meals containing halal meat or fish. That would probably be HelloFresh Halal. However, I consider that the combination of:

(i) The reputation and enhanced distinctiveness of HelloFresh; and

(ii) The degree of visual and aural resemblance between the words HALAL FRESH and HelloFresh;

- is sufficient for a significant proportion of the relevant public to identify the former as a 'play' on the latter, particularly if the contested mark were to be used in relation to foodstuffs sold in portions suitable for making up into specific meals. There is no evidence that this is how the applicant intends to use the contested mark, although the inclusion of the strapline 'Dinner is Sorted' in the contested mark suggests that this is, at the least, a possibility. In any event, I consider that such use would fall within the boundaries of normal and fair use of the contested mark in relation to the goods applied for. It follows that the effect of such use must be considered.²¹

87. In my view, many average consumers will be caused to wonder about a possible connection between the users of these marks. There is no single meaning rule so far as average consumers are concerned.²² Taking into account (a) the difference between the words HALAL FRESH and HelloFresh, and (b) the colour and get-up of the contested mark (which I accept does not add to the impression that it is a brand extension from HelloFresh), I find that a majority of such consumers will not believe the evident 'play' on the earlier mark is one made by the proprietor of that mark in the context of a brand extension (or otherwise). However, I find that a significant minority of average consumers are likely to believe that the contested mark is a brand extension of HelloFresh. This perception is most likely to occur amongst those who have heard of that mark, perhaps through oral recommendations or online posts on

²¹ See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, CJEU, Case C-533/06

²² See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J.

social media sites, but have not yet seen, or have an imperfect recollection of, the particular get-up used for HelloFresh. I conclude that the majority of average consumers will not be confused, but there is a likelihood of indirect confusion amongst a still-significant proportion of the relevant UK public.

88. It is now well established that, although relevant, a likelihood of confusion is not a necessary condition for the link required under section 5(3). In *Adidas-Salomon*²³ the CJEU held that:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 General Motors [1999] ECR I-5421, paragraph 23).”

89. In my view, the reputation of the earlier mark and the degree of similarity between it and HelloFresh is sufficient to cause a substantial proportion of the relevant public to make a link between the marks. That is to say, they will perceive the contested mark as making a play on the earlier mark in the context of the marketing of foodstuffs comprising, containing, or sold as accompaniments to, halal meat or fish products.

Unfair advantage

90. As noted at paragraph 37 above, the opponent’s case is that having been reminded of the reputation of the earlier mark, consumers will be more likely to buy goods sold under the contested mark. According to the opponent, this amounts to taking unfair advantage. The opponent says that the applicant chose the contested mark because it intended to take advantage of the earlier mark.

91. The applicant’s representative submitted at the hearing that:

(i) The words Halal and Fresh are ordinary descriptive words the use of which in relation to foodstuffs is with due cause;

²³ Case C-408/01

(ii) The opponent has not pleaded its section 5(3) case based on the applicant intending to take advantage of the earlier mark;

(iii) There is no evidence that the applicant adopted the mark with the intention of taking advantage of the reputation of the earlier mark.

92. The opponent's pleading under section 5(3) includes the following:

"The Applicant will have knowledge of the Opponent's business and has selected a closely similar brand name (which is visually, aurally and conceptually very closely similar whilst also containing "Fresh" in the second position and a first word of a similar composition to the opponent's "Hello") in a clear attempt at exploiting the Opponent's business."

Further, the pleading under section 5(4)(a) of the Act includes the following:

"The Applicant's inclusion of "DINNER IS SORTED" in their application has been intentionally selected as a means of further free-riding on, and misrepresenting, the Opponent's business."

93. In my view, it is clear from either or both of the above pleadings that the opponent's case from the outset was that the applicant intended to take advantage of the reputation of the earlier mark.

94. I do not consider that the inclusion of the strapline 'Dinner is Sorted' in the contested mark adds materially to this part of the opponent's case. This is because there is only one instance of the opponent using the similar strapline 'Dinner is Solved' in its evidence.²⁴ This is not sufficient to show that the opponent made the claimed "extensive use" of the strapline prior to the relevant date. However, I consider that the resemblance between the contested mark and HelloFresh is, when taken together with the reputation of the earlier mark, sufficient to make out a *prima facie* case that the contested mark was chosen with the earlier mark in mind.

95. I accept there is no direct evidence about the applicant's intentions. This is mainly because the party best placed to give such evidence – the applicant itself – chose not

²⁴ See page 169 of the evidence

to. When criticising the sufficiency of the opponent's evidence of the reputation of the earlier mark, Mr Wood reminded me that "*..it is trite law that the Tribunal should weigh the evidence according to the evidence which it was in the power of a party to provide and the power of the other to rebut.*" This point applies equally to the applicant, which has given no evidence to rebut the opponent's claims about its intentions.

96. There is no doubt that the applicant knew about the earlier mark at the relevant date: the applicant made an application to register essentially the same mark about six months before the current application, which it withdrew following opposition from the opponent. As the applicant has given no evidence to counter the opponent's *prima facie* case that the earlier mark was chosen to target the earlier mark, I accept the opponent's claim that it was chosen to derive some sort of benefit from association with that mark. Such an intention is relevant to the issue of whether any advantage derived from that association would be unfair.²⁵

97. Given the differences between the marks, I am not prepared to infer that the applicant sought to deceive the public, or cause confusion, as to the trade origin of the goods sold under the contested mark. It seems more likely that the contested mark was chosen to remind consumers of the earlier mark with its growing reputation for providing fresh ingredients for making up into attractive convenient meals. I am satisfied that use of the contested mark would result in this image of the earlier mark transferring to the contested mark. This would allow the contested mark to free-ride on the reputation of the earlier mark without the applicant incurring the marketing costs that would usually be required to publicise what the brand stands for. The contested mark would thereby derive an economic advantage by attracting more consumers to buy goods offered under it than would be the case without bringing to mind the image of the earlier mark. Therefore, I find that use of the contested mark would take advantage of the earlier mark.²⁶ The advantage would be even greater amongst the significant proportion of average consumers who believe that the contested mark is used by the same undertaking that uses the earlier mark. In those circumstances the

²⁵ See the discussion in *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211

²⁶ See, for example, *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

quality associated with the goods provided under the earlier mark would transfer directly to the goods marketed under the contested mark.

98. I accept that the descriptiveness of 'Halal' and 'Fresh' could, in principle, have a bearing on whether any advantage gained from association with the earlier mark is unfair and/or whether the applicant has due cause to use the mark. The descriptiveness of FRESH is not in dispute. The descriptiveness of HALAL cannot be disputed either so far as the goods in class 29 are concerned. It is not obvious to me how that word is descriptive of *vegetables; fresh fruits, nuts, vegetables and herbs* in class 31, unless those goods are intended to be offered as part and parcel of a food product that also contains halal meat or fish in class 29. In any event, whilst HALAL and FRESH are individually descriptive, the combination HALAL FRESH does not appear to me to form a natural descriptive term. This is because HALAL appears to qualify FRESH, which makes no more sense than HelloFresh.

99. For these reasons, I find that use of the contested mark would, without due cause, take unfair advantage of the reputation and/or distinctive character of HelloFresh. Therefore, this part of the opponent's section 5(3) case succeeds.

Detriment to the reputation/distinctive character of the earlier mark

100. I can deal with this briefly. I have found that there is no likelihood of direct confusion with the earlier mark. There is a likelihood of some indirect confusion. However, lots of trade mark proprietors, including the opponent, use more than one mark without diminishing their distinctive character. Therefore, I see no case for concluding that a mistaken belief the opponent uses both marks for different parts of its business would make HelloFresh any less distinctive of the opponent than it is now. As regards detriment to the reputation of the earlier mark, Ms Anna Carboni as the Appointed Person expressed doubts in *Unite The Union v The Unite Group Plc*²⁷ about whether the hypothetical possibility of an opposed mark being used in relation to goods/services of lesser quality than those associated with an earlier mark of repute is, as a matter of law, sufficient to justify an opposition under section 5(3). Admittedly, there was no likelihood of indirect confusion in the *Unite* case. This could make a

²⁷ Case BL O/219/13

difference. On the other hand, section 5(3) protects the reputation of the earlier mark, rather than the reputation of its user. Therefore, a mistaken belief amongst a section of the public that that a single undertaking uses variant marks in relation to goods/services of different quality standards may not be sufficient to justify an opposition based on section 5(3). I have not heard arguments on this point. I prefer to leave it for decision in a case that requires such a determination. For his case, it is sufficient to record that the opponent's case under section 5(3) based on detriment to reputation or distinctive character cannot succeed independently of its case based on unfair advantage and/or the opposition based on section 5(2)(b) of the Act, to which I now turn.

The section 5(2)(b) ground of opposition

101. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Global assessment

102. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(g) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Similarity of marks

103. I considered the similarity of the marks at paragraphs 70 to 77 above. The same conclusions apply under this heading.

Distinctive character of the earlier mark

104. The applicant submits that the only evidence that the mark HelloFresh was used on the goods themselves prior to the relevant date is a picture from an article published in September 2019, and pictures of food boxes posted on the opponent's UK website on 11th December 2018. These show Hello Fresh on tinned tomatoes, on a sticker applied to fresh tomatoes and bags of rice and pasta.²⁸ The applicant points to other evidence showing that the opponent also provides some third party branded products, i.e. a Volvic-branded can of drink and a GU-branded pudding. The short answer to this point is that it is not necessary for trade marks to be used on the goods themselves in order to be used "in relation to" the goods. It is sufficient that the trade mark is used in such a way that a relevant link is established between the mark and the goods concerned. That is to say that the public will perceive the user of the trade mark as responsible for the quality of the goods. This can include use of the mark as a company, trade or shop name.²⁹ I find that use of the HelloFresh trade mark on the opponent's website and/or on its food boxes is use of that mark in relation to otherwise unbranded goods marketed by the opponent. Therefore, the use of the HelloFresh mark shown in exhibit RL-12 counts as use of EU13716311 in relation to (at least):

Class 29: Meat, fish, poultry, preserved and dried fruits and vegetables.

²⁸ See exhibits RL-9 and RL-12

²⁹ *Céline SARL v. Céline SA*, Case C-17/06

Class 31: Fresh fruits and vegetables.

105. I considered the distinctiveness of the earlier mark in relation to services in classes 35 and 43 at paragraph 81 above. I found that the earlier mark was highly distinctive through use prior to the relevant date in relation to:

Class 35: The bringing together, for the benefit of others, of meat, fish, poultry, agricultural products and grains, excluding the transport thereof, enabling customers to conveniently view and purchase those goods.

Class 43: Food preparation and providing advice and information relating thereto; providing food, drinks and meals for delivery; the provision of a database in the field of recipes.

106. In my view, the enhanced degree of distinctiveness enjoyed by the earlier mark in relation to these services is likely to affect the average consumer's perception of the earlier mark when used in relation to foods, particularly when sold as suitable for making up into meals.³⁰ Taking all the above into account, I find that the earlier mark had an above average degree of distinctive character at the relevant date in relation to (at least) the foods listed at the end of paragraph 104 above. Based purely on its inherent distinctiveness, I find that HelloFresh had an average degree of distinctive character in relation to the remaining goods covered by the earlier mark and relevant to this ground of opposition, i.e. *seeds*.

Comparison of goods and services

108. The relevant goods in classes 29 and 31 are shown below.

Goods covered by EU13716311	Goods covered by the application
Class 29: Meat, fish, poultry, preserved and dried fruits and vegetables.	Class 29: Fish; Meat; all of the aforesaid being halal produce.
Class 31: Fresh fruits and vegetables; Seeds.	Class 31: Vegetables; Fresh fruits, nuts, vegetables and herbs.

³⁰ See paragraph 86 above.

Class 35: The bringing together, for the benefit of others, of meat, fish, poultry, agricultural products and grains, excluding the transport thereof, enabling customers to conveniently view and purchase those goods.

Class 43: Food preparation and providing advice and information relating thereto; providing food, drinks and meals for delivery; the provision of a database in the field of recipes.

The applicant accepts that the goods in class 29 covered by EU13716311 – HelloFresh - are identical to those covered by the corresponding class of the application. It also accepts that the goods in class 31 are identical, except for *nuts* and *herbs*. The opponent argues that:

- (i) Both of these items are covered by *agricultural products*, for which the earlier mark is registered;
- (ii) *Herbs* are a subset of *vegetables*, for which the earlier mark is registered;
- (iii) *Nuts* are covered by *seeds*, for which the earlier mark is registered;
- (iv) *Nuts* are *dried fruits*, for which the earlier mark is registered.

I accept that certain types of nuts are also seeds, e.g. Brazil nuts. I also accept that *herbs* are *agricultural products*. Therefore, these goods must be considered identical on the basis set out in *Gérard Meric v OHIM*.³¹ This means that all the goods covered by the application are identical to one or more of the goods in classes 29 and 31 covered by the earlier mark. In any event, *nuts* are plainly highly similar to *preserved and dried fruits* because they are commonly used and sold together, for use as snacks or as ingredients for meals, e.g. muesli. And *herbs* are plainly high similar to *fresh*

³¹ Case T-133/05, General Court of the EU

vegetables because they are highly similar in nature, sold in close proximity to one another, and used together to make meals. My reasons for finding that the services covered by the earlier mark are highly similar to the goods covered by the contested mark are set out in paragraph 78 above.

The average consumer, the selection process, and the likelihood of confusion

109. There is no dispute about the attributes of the relevant average consumer, or that he or she will pay just an average degree of attention during the selection process. Mr Holah asked me to take into account that foodstuffs, particularly fruits and vegetables, are often ordered by word of mouth and in conditions where the goods themselves are unbranded. I have done so. I have also made some allowance for imperfect recollection. Nevertheless, bearing in mind the importance usually attached to the first element of trade marks³² and the difference between the well-known words HELLO and HALAL, I remain of the view that the overall visual, aural and conceptual differences between the marks are sufficient to rule out a likelihood of direct confusion.

110. Turning to the likelihood of indirect confusion, I find that the majority of average consumers will not be confused. However, for the same the reasons given in paragraphs 86 and 87 above, I find it likely that a significant proportion of relevant average UK consumers will be caused to believe that the contested mark is a brand extension of HelloFresh used in relation to food products consisting of, including, or for use as accompaniments to, halal meats and fish.

111. In *Soulcycle Inc v Matalan Ltd*,³³ Mann J. approved the approach of the Hearing Officer at first instance in that case who took into account the reactions of average consumers who did, and did not, recognise the word SOUL within the mark SOULUXE. The judge said:

“27. I do not consider that the Hearing Officer made an error of principle in this respect. In considering the question of the effect of the mark within the class, by reference to proportions who did not share the same view, he was following

³² See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, General Court of the EU

³³ [2017] EWHC 496 (Ch)

the same line as that pursued by Arnold J at first instance in Interflora Inc v Marks and Spencer plc [2013] EWHC 1291 (Ch) . Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule and then set out his reasoning over the following paragraphs. Paragraph 224 set out important parts of his conclusion; the references to Lewison LJ is to that judge's judgment in an earlier case.

"224 ... Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is confused, then it is likely that confusion extends beyond those who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not

mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused ." (my emphasis)

28. That justifies a consideration of confusion in relation to a proportion of the class of average consumer by reference to perceptions, in the manner in which the Hearing Officer went about the matter. It also justifies applying the same technique (where appropriate on the facts) to validity and infringement proceedings alike."

112. This accords with the judgment of the Court of Appeal in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,³⁴ where Kitchin L.J. (as he then was) held that:

*"..if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."*³⁵

113. In my view, a significant proportion of the relevant public are likely to believe that the contested mark is a brand extension of HelloFresh. Consequently, I find that there is a likelihood of sufficient indirect confusion amongst average consumers of the goods at issue to uphold the opponent's case under section 5(2)(b) of the Act.

The sections 5(3) and 5(2)(b) grounds of opposition based on earlier trade marks EU15656961 and EU16528391

114. I do not consider that the grounds of opposition under sections 5(2)(b) and 5(3) of the Act based on the opponent's other two earlier marks takes its case any further. On the one hand, these marks have the word HELLO and FRESH arranged one above

³⁴ [2016] EWCA Civ 41

³⁵ See paragraph 34(v) of the judgment at [2016] EWCA Civ 41

the other, as with the words HALAL (which I again recognise is literally HALA plus a fork device) and FRESH in the contested mark. Additionally, the background device in EU15656961 is also round(ish) like the one in the contested mark. On the other hand, these marks are in green, which is a point of distinction (albeit a weak one) from the colours shown in the contested mark. In any event, as I have already noted, the parties themselves appear to agree that the opponent's best case is based on EU13716311. I therefore find that the sections 5(2)(b) and 5(3) grounds based on EU15656961 and EU16528391 stand or fall with the case based on EU13716311.

The section 5(4)(a) ground of opposition

115. 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.”

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.”

115. In *Discount Outlet v Feel Good UK*,³⁶ 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).”

Goodwill

116. The opponent claims a goodwill under HelloFresh as a result of trading under that name in the UK since February 2015 in relation to:

Broth [soup]; Artificial milk based desserts; Desserts made from milk products; Egg substitutes; Prepared meals consisting substantially of meat, fish, seafood, vegetables, potatoes, dairy products or dairy substitutes, nuts, eggs and/or broth (oden); Instant soup; Fish and seafood spreads; Fish, seafood and molluscs; Meats; Meat substitutes; Fruit-based snack food; Jellies, jams, compotes, fruit and vegetable spreads; Milk; Milk products and their substitute products; Nut-based snack foods; Oils and fats; Snack foods based on vegetables; Meat-based snack foods; Tofu-based snacks; Mixes for making soup; Processed potatoes; Processed fruits, fungi and vegetables (including nuts and pulses); Birds eggs and egg products; Sausages; Meats; Prepared

³⁶ [2017] EWHC 1400 IPEC

salads; goods and dishes made from aforementioned products, included in this class.

Fresh fruits, nuts, vegetables and herbs; Foodstuffs and fodder for animals; Potatoes, fresh; Agricultural and aquacultural crops, horticulture and forestry products.

Outsourcing services in the nature of arranging procurement of goods for others; provision of an online marketplace for buyers and sellers of goods and services; Coupon procurement services for others; Retail and wholesale services with the following goods: apparatus for cooking, refrigerating, decorative articles, tableware, cooking goods, kitchen goods, cleaning preparations, household containers, crockery and cutlery, goods of glassware and porcelain, household machines and apparatus, electric kitchen machines, software, printed matter, bags, clothing and clothing accessories, household textiles, food, prepared meals, foodstuff, beverages and preparations for making beverages, foodstuffs for animals; Presentation of services on communication media for commercial purposes; Presentation of goods on communication media, for retail purposes; Sales promotion for others; Negotiation and conclusion of commercial transactions for third parties; Procurement of contracts for others; Administrative processing of purchase orders; Advertising, marketing and promotional services; Provision of commercial online information of a database or the Internet; Compilation and systematisation of information in databanks; The bringing together, for the benefit of others, of a variety of services, namely transport services, delivery services, education, services for providing food and drink, personal chef services, health advice and information services, nutritional and dietetic consultancy, enabling consumers to conveniently compare and purchase those services; The bringing together, for the benefit of others, of a variety of goods, excluding the transport thereof, namely of apparatus for cooking, refrigerating, decorative articles, tableware, cooking goods, kitchen goods, cleaning preparations, household containers, crockery and cutlery, goods of glassware and porcelain, household machines and apparatus, electric kitchen machines, to enable customers to conveniently view and purchase those goods; The

bringing together, for the benefit of others, of a variety of goods, excluding the transport thereof, namely of software, printed matter, bags, clothing and clothing accessories, household textiles, food, prepared meals, foodstuff, beverages and preparations for making beverages, foodstuffs for animals, to enable customers to conveniently view and purchase those goods.

Provision of educational services relating to diet; Correspondence courses relating to cookery; Design of educational courses, examinations and qualifications; Publication of printed matter; Education services relating to cooking; Providing online electronic publications, not downloadable; Publishing services; Arranging of lectures; Writing of texts, other than publicity texts; Publication of books, periodical publications, magazines, newspapers and newsletters; Providing educational courses in the field of diet and health care.

Consulting services in the field of culinary arts; Food and drink catering; Reservation services for booking meals; Providing on-line advice and information services relating to wine and food pairings; Personal chef services; Supplying of meals for immediate consumption; advice concerning cooking recipes; Making reservations and bookings for restaurants and meals; Take-out restaurant services; Preparation of food and beverages; Providing information in the field of recipes and cooking from a computer database.

Nutritional advice; Health advice and information services; nutritional and dietetic consultancy; Providing information relating to dietary and nutritional guidance; providing information about dietary supplements and nutrition.

117. This list includes many goods and services the opponent does not trade in. e.g. *Foodstuffs and fodder for animals; Horticulture and forestry products; Design of educational courses, examinations and qualifications; Retail and wholesale services with the following goods: apparatus for cooking, refrigerating, decorative articles, tableware, cooking goods, kitchen goods, cleaning preparations, household containers, crockery and cutlery, goods of glassware and porcelain, household machines and apparatus, electric kitchen machines, software, printed matter, bags, clothing and clothing accessories, household textiles.* The evidence is sufficient to

establish that the opponent had acquired a goodwill under HelloFresh at the relevant date as a result of a trade covering at least the following goods/services:

Meat, fish, processed fruits and vegetables; goods and dishes made from aforementioned products; Fresh fruits and vegetables.

Retail services with food.

Supplying of meals for immediate consumption: Providing information in the field of recipes and cooking from a computer database.

Misrepresentation

118. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd*³⁷ Jacob L.J. drew attention to the difference between merely causing the claimant's customers or potential customers to wonder whether or not the defendant was connected to the claimant, and causing them to assume there is such a connection. The judge pointed out that the former was not sufficient for passing off. He concluded:

"This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former."

119. In my view, the resemblance between the contested mark and HelloFresh is, when taken together with the opponent's reputation under HelloFresh, sufficient to cause a substantial number of the opponent's customers or potential customers to wonder whether there is a connection between the users of the marks. Additionally, I find it is sufficient to cause a substantial number of such persons to assume that there is a connection between the users, i.e. that the contested mark is a brand extension of HelloFresh used in relation to food consisting of, or containing, or sold as accompaniments to, halal meat and fish. Consequently, I find that use of the contested mark at the relevant date would have constituted a misrepresentation to the public.

³⁷ [2007] RPC 5 at 16–17

Damage

120. Given the potential overlap in the parties' fields of activity, the misrepresentation is liable to cause damage to the opponent's business through diversion of sales. Additionally, or alternatively, the misrepresentation is liable to damage the opponent's goodwill through loss of control of its reputation, which is an established head of damage under passing off law. As Warrington L.J. stated In *Ewing v Buttercup Margarine Company, Limited*:³⁸

"To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

121. I conclude that use of the contested mark at the relevant date would have been contrary to the law of passing off. The opposition under section 5(4)(a) therefore also succeeds.

Overall outcome

122. The opposition has succeeded. The application will be refused.

Costs

123. The opponent has been successful and would normally be entitled to a contribution towards its costs. I assess this as follows.

Preparing a statement and considering the other side's statement

124. The opponent originally claimed that earlier mark EU13716311 had a reputation in the EU and UK covering the following goods/services:

Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats; Seafood and shellfish; Crustacea;

³⁸ [1917] 2 Ch. 1 (COA)

Bratwurst; Charcuterie; Pates; Meat; Ham; Antipasto salads, Prepared salads; Ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables; Pre-cooked meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables; Dairy products and dairy substitutes; Cheese products; Butter; Smetana [sour cream]; Dairy-based dips; Cream cheese; Drinks made from dairy products; Yoghurt; Butter with herbs; Margarine; Milk substitutes; Smetana [sour cream]; Sheep cheese; Whipped cream; Soya milk [milk substitute]; Cheese spreads; Soft cheese; Hard cheese; Liquid eggs; Processed eggs; spreads; Fish and seafood spreads, fruit and vegetable spreads; Processed fruits, fungi and vegetables (including nuts and pulses); Processed vegetables; Olive oil; Rapeseed oil; Potato chips; Soups; Broths; Soup cubes; Instant soup; Nut-based snack foods, Fruit-based snack food, Snack foods based on vegetables, Meat-based snack foods, Tofu-based snacks; Pre-assembled and/or pre-portioned combinations of the aforesaid goods, enabling meals to be cooked according to specific recipes, including enclosed recipes.

Class 31: Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; Live animals; Fresh fruits and vegetables, herbs (fresh); Natural plants and flowers; Malt; Raw and unprocessed grains and seeds; Onions, seedlings and grains (seeds) in the form of propagation material; Fungi; Nuts [fruits]; Potatoes, fresh; Flowers; Pre-assembled and/or pre-portioned combinations of the aforesaid goods, enabling meals to be cooked according to specific recipes, including enclosed recipes.

Class 35: Retailing of assortments of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and

yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes, the aforesaid services being provided electronically, online, in fixed locations and/or by means of vending machines; Retailing of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beer, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes, the aforesaid services being provided electronically, online, in fixed locations and/or by means of vending machines; The bringing together of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations

made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beer, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes, including in the form of subscriptions; Arranging of subscriptions to combinations of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes; Event marketing, in particular for cookery, kitchen and tasting events; Advertising; Business management; Business administration; Office functions; Marketing services; Sales promotion; Product demonstrations and product display services; Presentation of goods on communication media, for retail purposes; Sales promotion for others;

Negotiation and conclusion of commercial transactions for third parties; Procurement of contracts [for others]; Administrative processing of purchase orders; Services in the fields (sic); Customer loyalty for sales promotion and/or advertising purposes; Rental of vending machines and kitchen utensils; Retailing and wholesaling in relation to foodstuffs, dietary supplements, baked goods, ready meals, meals, beverages and preparations for making beverages, cooking utensils, coolers, clothing, clothing accessories, crockery, table cutlery (knives, forks and spoons), household goods, decorations, household utensils, utensils for household purposes, cleaning preparations, containers for; Household, Glassware, porcelain, Cooking utensils, Printed matter, Software, cookbooks, Recipes, Kitchen tools, Bags, Household textile articles; On-line ordering services in the field of restaurant take-out and delivery; Outsourcing services in the nature of arranging procurement of goods for others; provision of an online marketplace for buyers and sellers of goods and services; Coupon procurement services for others; Provision of commercial online information of a database or the Internet; Compilation and systemisation of; information in databases; The bringing together, for the benefit of others, of a variety of services, namely transport services, delivery services, education, services for providing food and drink, personal chef services, health advice and information services, nutritional and dietetic consultancy, enabling consumers to conveniently compare and purchase those services; The bringing together, for the benefit of others, of a variety of goods, excluding the transport thereof, namely of apparatus for cooking, refrigerating, decorative articles, tableware, cooking goods, kitchen goods, cleaning preparations, household containers, crockery and cutlery, goods of glassware and porcelain, household machines and apparatus, electric kitchen machines, to enable customers to conveniently view and purchase those goods; The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), namely computer software, printed matter, bags, clothing and clothing accessories, household textiles, meals, ready meals, foodstuffs, beverages and preparations for making beverages; enabling customers to conveniently view and purchase those goods.

Class 43: The bringing together of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and

desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beer, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes; Delivery of goods and/or combinations of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes; Providing of goods and/or combinations of goods, namely meat, fish, poultry and game, seafood and shellfish, meat substitutes, meat substitute products, ready meals consisting predominantly of meat, fish, poultry, game, seafood, potatoes, dairy products and substitutes therefor, nuts (fruits), eggs, broth and/or vegetables, meat extracts, soups and stocks, preserved, frozen, dried and cooked fruits and vegetables (including nuts (fruits), pulses), jellies, jams, compotes, eggs, milk and milk products, dairy

products and substitutes therefor, soya milk, edible oils and fats, ready meals and spicy snacks, sandwiches, snack products consisting of cereals, rice or corn, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, chocolate and desserts, edible ices, frozen yoghurts, sorbets, sugar, natural sweeteners, sweet coatings and fillings, and bee products for culinary purposes, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, flavourings for beverages, ice, raw and unprocessed agricultural, horticultural, aquacultural and forestry products, processed grains and starches for food, and goods made therefrom, baking preparations and yeasts, live animals, fresh fruits and vegetables, fresh herbs, natural plants and flowers, foodstuffs and beverages for animals, malt, raw and unprocessed grains and seeds, bulbs, seedlings and seeds for planting, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), including in pre-portioned form, including for enabling meals to be cooked according to specific recipes, including enclosed recipes, by means of vending machines; Personal chef services; Cookery advice; Advice concerning cooking recipes; Providing of online consultancy and information in relation to recipes, foodstuffs and beverages, and in relation to recommendations for wines with meals; Providing information in the field of recipes and cooking from a computer database; Providing food and drink; Providing temporary accommodation; Rental of furniture, linens and table settings; Consultancy in relation to the preparation of meals and; drink; Consultancy services relating to food; Providing personalized meal planning services via a website; Providing food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Reservation services for booking meals; Services for the preparation of food and drink; Hospitality services [food and drink]; Food preparation services; Providing food and drink by means of automatic dispensing machines; Services for providing food and drink, including for take-away; Take-out restaurant services; Contract food services; Preparation and provision of food and drink for immediate consumption; Supplying of meals for immediate consumption; Catering for the provision of food and beverages; Rental of cooking apparatus; Rental of non-electric cooking heaters; Rental of cooking equipment for industrial purposes; Rental of apparatus for heating meals; Rental of apparatus for keeping meals warm.

125. This list appears to have been cut and paste from the very long list of goods/services for which the earlier mark is registered. It even includes the description “*Services in the fields*” in class 35, which I assume is an error in the original

registration. The same approach was taken with regard to the other two earlier marks relied on by the opponent.

126. The opponent's evidence was manifestly incapable of supporting claims of reputation of the breadth suggested in the notice of opposition. However, the opponent did nothing to limit the breadth of, or otherwise clarify, the reputation originally claimed for the earlier marks until I directed it to do so at the hearing. The opponent subsequently amended the claims. The amended claim for EU13716311 is shown at paragraph 43. It is much shorter. However, the services covered by the revised claim for EUTM 16528391 still included services relating to *Onions, seedlings and grains (seeds) in the form of propagation material; natural plants and flowers, foodstuffs and beverages for animals; live animals; bulbs, seedlings and seeds for planting*, for which no use of the marks, let alone reputation, could possibly be claimed on the evidence provided.

127. As I noted at paragraph 117 above, the list of goods/services for which a goodwill was claimed for the purposes of the opposition under section 5(4)(a) of the Act showed some of the same lack of focus and clarity.

128. The Registrar's published scale of costs states that the amount awarded for completing a notice of opposition and reviewing the other side's counterstatement will normally range *"From £200 to £650 depending on the nature of the statements, for example their complexity and relevance."* Given the evident lack of effort to accurately identify the scope of the reputation relied on under section 5(3) and 5(4)(a) of the Act, I do not consider that the opponent should be compensated for the cost of completing the Form TM7 or reviewing the applicant's counterstatement, the length of which was partly due to the scattergun approach taken in preparing the notice of opposition. The opponent would, however, normally be entitled to recover the official filing fee for form TM7, which in this case was £200.

129. The published scale of costs indicates that the scale costs awarded to help compensate the cost of preparing evidence and considering the other side's evidence will normally be in the range of £500 - £2200. The applicant filed evidence from Mr Wood. The opponent's evidence was fairly substantial. The opponent would normally

be entitled to £1500 towards the cost of preparing its written evidence and reviewing that of Mr Wood.

130. The hearing lasted just over half a day. The opponent would normally be entitled to £1000 towards the cost of the hearing. I would usually also have awarded an additional £100 towards the cost of Mr Lieberenz's time for appearing for cross examination. However, as some of the hearing was taken up addressing what could or should be done to address various defects in the opponent's pleaded case, and the opponent used Mr Lieberenz's appearance for cross examination as a means of introducing additional oral evidence, I consider that £550 would be a fair contribution towards the cost of the hearing.

131. This comes to a total of £2250.

132. As indicated earlier, at the hearing I directed that, irrespective of the outcome of the opposition, the opponent should bear the reasonable cost of dealing with Mr Lieberenz's new oral evidence. I also directed that it should bear the reasonable additional cost incurred by the applicant reviewing the opponent's amended pleadings under sections 5(2)(b), 5(3) and 5(4)(a). I have already explained why I directed the opponent to clarify (by narrowing) its pleaded case under sections 5(3) and 5(4)(a). A related issue arose at the hearing about the opponent's case under section 5(2)(b). The opponent's case at the hearing was partly based on the enhanced distinctiveness of HelloFresh as a result of the extensive use made of that mark. However, although it had claimed a reputation for the purposes of sections 5(3) and 5(4)(a) (albeit an ill-defined one), the opponent had not expressly claimed enhanced distinctiveness for the purposes of section 5(2)(b). I therefore also directed that the section 5(2)(b) pleading be formalised in this respect. Amended pleadings were required within 14 days.

133. The opponent's amended TM7 narrowed the reputation claimed under section 5(3), as described above. The scope of the reputation claimed for section 5(4)(a) purposes was left unchanged. No amendment was made to the section 5(2)(b) case either. I wrote to the parties noting that the section 5(2)(b) pleading was unchanged. I indicated that I would therefore proceed on the basis that the opponent was not pursuing its section 5(2)(b) case based on the enhanced distinctiveness of the earlier

marks. The opponent promptly replied explaining that it had misunderstood the directions given at the hearing. This was because it made its application before the 14 days allowed for doing so had expired, and before it had received the transcript of the hearing. It made another application to further amend its pleadings so as to add a claim of enhanced distinctiveness to the section 5(2)(b) grounds of opposition. In doing so, the opponent pointed out that it was still (just) within the 14 days initially allowed to make the amendment. I indicated to the parties that I was minded to accept this further application, and that I would deal with any additional work caused to the applicant through costs. Under protest, the applicant decided not to dispute this provisional decision.

134. The applicant says that although it was ultimately unable to file any evidence which challenged (or confirmed) the revenue and marketing spend figures given by Mr Lieberenz under oath at the hearing, it spent 7.7 hours investigating and researching the matter at a cost to the applicant of £3850. The task of responding through written submissions to the opponent's amended and clarified claims about the extent of the reputation and enhanced distinctiveness claimed for the earlier trade marks was put at 4.5 hours work, at a cost to the applicant of £2250. The total cost to the applicant as a result of post hearing work occasioned by the opponent's late evidence and amendments was therefore £6100. I see nothing unreasonable about the number of hours spent on this activity.

135. I deduct from this the £2250 scale costs that would normally be due to the opponent. This means that because of its behaviour, and despite having won the opposition, HelloFresh SE should pay Halal Fresh Ltd the sum of £3850. I order that this sum be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated 3rd August 2021

Allan James
For the Registrar