

O-647-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3464518 AND 3464507
BY IAN MCANALLY IN RESPECT OF THE FOLLOWING TRADE MARKS**



IN CLASSES 25, 29, 30, 28, AND 39

**AND IN THE MATTER OF OPPOSITIONS THERETO UNDER NO. 420889 AND
420891 BY HONEST BURGERS LIMITED**

Background and pleadings

1. Ian McNally (“the applicant”) applied to register the two trade marks, shown on the front of this decision, in the UK, on 6 February 2020. They were both accepted and published in the Trade Marks Journal on 28 February 2020 for the following identical list of goods and services:

Class 25: Clothing; footwear; headgear.

Class 29: *Prepared meals consisting substantially of meat, poultry, game, fish, seafood, vegetables, potatoes, dairy products or dairy substitutes, nuts, eggs and/or broth (oden); meat; poultry; game; fish; seafood; meats and meat substitutes; preserved meat; dried meat; cured meat; minced meat; sausages; meatballs; prepared meat broth [soup]; meat products; artificial milk based desserts; desserts made from milk products; egg substitutes; liquid eggs; instant soup; fish and seafood spreads; fish, seafood and molluscs; fruit-based snack food; jellies, jams, compotes, fruit and vegetable spreads; milk; milk products and their substitute products; milk based beverages and preparations and powders for making them; nutritional bars; protein bars; high protein cereal bars; 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; prepared salads; dry whey; cheese; goods and dishes made from aforementioned products, included in this Class.*

Class 30: *Bread; desserts; ice, ice creams; frozen yogurts and sorbets; prepared meals and snacks on the basis of grains, flour, sesame, rice, pasta, desserts and/or sweetmeats; tea-based beverages; coffee-based beverages; dried and fresh pastas, noodles and dumplings; coffee, teas and substitutes therefor; cake powder; flour; farinaceous foods; savoury sauces, chutneys and pastes; prepared pizza meals; rice; sandwiches; sauces; salts, seasonings, flavourings and condiments; doughs, batters, and mixes therefor; processed grains, starches, and goods made thereof, baking preparations and yeasts; sugars, natural sweeteners, sweet coatings and fillings, bee products;*

caramels, candy, malt biscuits, chewing gum, jellies (confectionery), lollipops, toffee, candy mints, pastilles, liquorice [confectionery], gum sweets, cereal-based savoury snacks; grain-based chips, savoury biscuits, chewing candy; confectionary bars; pizza; goods and dishes made from aforementioned products, included in this Class.

Class 39: *Transportation information; delivery of goods; delivery of food and drink, prepared for consumption; transport brokerage; warehousing information; distribution services; delivery of foodstuffs and prepared meals; tracking and tracing of shipments [transport information]; transport; packaging of goods.*

Class 43: *Food and drink catering; reservation services for booking meals; providing on-line advice and information services relating to food and drink; supplying of meals for immediate consumption; advice concerning cooking recipes; take-out restaurant services; preparation of food and beverages; providing information in the field of recipes and cooking from a computer database.*

2. Honest Burgers Limited (“the opponent”) opposes the trade marks, insofar as the cover the above list of goods and services, on the basis of Section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). The underlined goods and services are only challenged under section 5(3) but the remaining goods and services are challenged under both section 5(2)(b) and section 5(3). The basis of the section 5(2)(b) ground is its earlier UK Trade Marks 3301752, the relevant details of which are:

Mark: HONEST

Filing date: 5 April 2018

Registration date: 19 June 2020

Class 29: *Meat, fish, poultry, seafood and game; products made primarily from meat, fish, seafood, poultry or game; meat extracts; hamburgers, cheeseburgers, chicken burgers; ready cooked meals consisting wholly or*

substantially wholly of meat or poultry; frozen products consisting wholly or substantially wholly of meat or poultry; potato fries and potato chips; pickles; preserved, frozen, dried, prepared or cooked fruits and vegetables; kebabs; prepared meals consisting primarily of kebab; eggs; snack foods; dairy products; edible oils and fats; prepared meals; dips; onion rings.

Class 30: *Flour and preparations made from cereals; bread and bread products, pastry, cakes, muffins, rolls, confectionery, snack foods; rice; burgers contained in bread rolls; pizzas [prepared]; pizza crusts; pizza bases; pizza dough; pizza mixes; fresh pizzas; pizza sauces; pizza spices; prepared pizza meals; preparations for making pizza bases; ice, ices, ice cream, edible ices, frozen yoghurt, frozen confectionery; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces, condiments; salad dressings; spices; ice; prepared meals; dips, sugar.*

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

3. The opponent asserts that the goods/services, not underlined in the list at paragraph 1, are identical or similar to its goods and services, that the marks are similar and that this will lead to a likelihood of confusion.

4. In respect of the ground based upon section 5(3) of the Act, the opponent relies upon the same earlier mark as identified above and also UK Trade Marks 2645595, the relevant details of which are:

Mark: HONEST BURGERS

Filing date: 12 December 2012

Registration date: 19 July 2013

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

5. It claims that its marks have acquired a considerable reputation and goodwill in the UK. It asserts that the dominant element of the contested mark is highly similar to the

earlier marks and that use, without due cause, of the contested mark in relation to all of the goods and services claimed will cause the consumer to assume that the goods and services are those of the opponent or are in some way connected with it. It claims that, as a result the distinctive character of its earlier marks will be blurred and diluted by the association and their power of attraction will be diminished.

6. The applicant filed counterstatements putting the opponent to proof of use in respect of its HONEST BURGERS mark and denying many of the claims made. In particular, the applicant denies that the dominant element of his mark is the word HONEST. Rather, it is claimed that the contested mark is a complex composite mark which includes the representation of highly distinctive plant vines wrapped around either the words “HONEST FOOD” or “HONEST MEAL PREP” and that no single element is more dominant than the other. It is accepted that some of the goods and services are similar to those included in the opponent’s earlier marks. The applicant denies that use of his mark would be without due cause and puts the opponent to proof of the claimed power of attraction, reputation and prestige associated with its earlier marks.

7. The two oppositions were subsequently consolidated and the parties both filed single evidence in respect of both proceedings. I will refer to this as necessary or appropriate.

8. A Hearing took place on 21 July 2021, with the opponent represented by Mr Mitchell Beebe of Counsel instructed by Charles Russell Speechlys LLP and the applicant by Ms Caroline Pigott for HGF Limited.

9. 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.

Evidence

10. The opponent's evidence-in-chief takes the form of the witness statement of Mr Dorian Waite, director and co-founder of the opponent together with Exhibits DW1 – DW16.

11. Mr Waite also provided a second witness statement by way of evidence-in-reply together with Exhibits DW17 – DW20.

12. The applicant's evidence takes the form of a witness statement from the applicant, himself, Mr Ian McAnally together with Exhibits IM1 – IM14.

DECISION

Proof of Use

13. By virtue of its filing date being more than five years before the filing date of the contested applications, the opponent's HONEST BURGERS mark is subject to these proof of use provisions and the applicant has invoked this provision in its counterstatement. However, at the hearing, Ms Pigott, whilst strongly disputing that the evidence demonstrates the existence of the necessary reputation for the purposes of section 5(3), conceded that the proof of use test has been met. In light of this concession, it is not necessary that I consider the issue further.

Section 5(2)(b)

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

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

(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”.

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. The following principles are obtained 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:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

17. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Class 29

20. The applicant's *Prepared meals consisting substantially of meat, poultry, game, fish, seafood; sausages; meatballs; prepared meat broth [soup]; meat products and fish and seafood spreads; fish, seafood and molluscs* are covered by the opponent's broader term *products made primarily from meat, fish, seafood, poultry or game* and applying the guidance in *Meric*, the goods are identical.

21. Further, the applicant's *meat; poultry; game; fish; seafood; meats preserved meat; dried meat; cured meat; minced meat* are all covered by the opponent's *Meat, fish, poultry, seafood and game* and are also, therefore, identical.

22. The applicant's various meat-based prepared meals referred to in paragraph 23 are also identical to the opponent's broad term *prepared meals* as are its *[p]repared meals consisting substantially of vegetables, potatoes, dairy products or dairy substitutes, nuts, eggs and/or broth (oden); prepared salads and goods and dishes made from aforementioned products, included in this Class*.

23. The applicant's *birds eggs* are self-evidently identical to the opponent's *eggs and liquid eggs*.

24. Applying the *Meric* principle, the applicant's *processed potatoes; processed fruits, fungi and vegetables (including nuts and pulses)* are identical to the opponent's *potato fries and potato chips; pickles; preserved, frozen, dried, prepared or cooked fruits and vegetables*.

25. The applicant's *[f]ruit-based snack food; nutritional bars; protein bars; high protein cereal bars; nut-based snack foods; snack foods based on vegetables; meat-based snack foods; tofu-based snacks* are all covered by the opponent's broad term *snack foods* and are, therefore, identical.

26. The applicant's *egg products* can be in the form of prepared meals (e.g. scrambled eggs) and dishes made from eggs and are included in the opponent's *prepared meals*

and *dishes made from aforementioned products* [where the “aforementioned products” are eggs]. Therefore, they are identical.

27. The applicant’s *milk; milk products and their substitute products; milk based beverages and preparations and powders for making them; dry whey; cheese and desserts made from milk products* are all covered by the broad term *dairy products* and are, therefore, identical.

28. The applicant’s *substitute products* [for milk products] and *artificial milk based desserts* are not identical to the opponent’s dairy products because they are a substitute for them rather than the same as them. However, they will be in direct competition and share the same purpose and methods of use and I find that they share a high level of similarity.

29. The applicant’s *oils and fats* are self-evidently identical to the opponent’s *edible oils and fats*.

30. Mr Beebe submitted that the applicant’s *egg substitutes* are identical to the opponent’s *eggs*. Clearly, being a substitute, the applicant’s goods are not identical. However, they share a similar nature, and will have the same purpose and overlapping methods of use. Further, they will also be in competition because the consumer may be faced with the choice of either eggs or their substitutes. Taking all of this together, I conclude that they share a high level of similarity.

31. Mr Beebe submitted that the applicant’s *instant soup; mixes for making soup* are covered by the opponent’s *snack foods*. A snack is “a small amount of food eaten between meals” or “a light meal that is eaten in a hurry or in a casual manner”¹. The applicant’s goods may be covered by the second meaning and I, therefore, agree with Mr Beebe.

¹ [SNACK | Definition of SNACK by Oxford Dictionary on Lexico.com also meaning of SNACK](#)

32. Mr Beebe submitted that *meat substitutes* are identical to the opponent's *meat*. Similar to my considerations regarding *egg substitutes* these are self-evidently not identical but I conclude that they share a high level of similarity.

33. As Mr Beebe submitted, the applicant's *jellies, jams, compotes, fruit and vegetable spreads* are identical to the opponent's *preserved, frozen, dried, prepared or cooked fruits and vegetables*. I agree. This is because the opponent's terms are very broad and include the applicant's goods.

Class 30

34. Mr Beebe submitted that the applicant's *Bread; ... prepared meals and snacks on the basis of grains, flour, sesame, rice, pasta, dried and fresh pastas, noodles and dumplings; cake powder; flour; farinaceous foods; prepared pizza meals; sandwiches; doughs, batters, and mixes therefor; baking preparations and yeasts; ... pizza* are identical to the opponent's *Flour and preparations made from cereals; bread and bread products, pastry, cakes, muffins, rolls, confectionery; burgers contained in bread rolls; pizzas [prepared]; pizza crusts; pizza bases; pizza dough; pizza mixes; fresh pizzas; pizza sauces; pizza spices; prepared pizza meals; preparations for making pizza bases; yeast, baking-powder*. It is self-evident that where the same term appears in both parties' specifications then they are identical. This is the case in respect of *bread, flour, prepared pizza meals, yeasts and pizza*. Further, applying the guidance in *Meric*, the opponent's *preparations made from cereals* and *bread products* are broad terms that include all of the applicant's goods listed at the top of this paragraph. Therefore, they are also identical. Further, it is obvious that the applicant's *processed grains, starches, and goods made thereof* are identical to the opponent's *preparations made from cereals*.

35. As Mr Beebe also submitted, the applicant's *cereal-based savoury snacks; grain-based chips, savoury biscuits, malt biscuits* are all covered by the opponent's *snack foods* and they are, therefore, identical. I agree. Mr Beebe also submitted that the applicant's *chewing candy; confectionary bars* are also identical to *snack foods*. This is less clear to me. Candy and confectionary are not normally referred to as snacks despite being technically covered by the definition of a snack. I keep in mind the

guidance in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

36. The core meaning of *snack foods* does not naturally include the applicant's *chewing candy; confectionary bars* and I conclude that they are not identical. Nevertheless, they share the same nature, purpose and methods of use. Further, they may be in competition where the consumer makes a choice between a snack food and *chewing candy* or *confectionary bars*. With this in mind, I find that the respective goods share at least a medium level of similarity.

37. In respect of the applicant's *desserts; ice, ice creams; frozen yogurts and sorbets; desserts and/or sweetmeats; sugars, natural sweeteners, sweet coatings and fillings, bee products*, Mr Beebe submitted that they are all identical to the opponent's *ice, ices, ice cream, edible ices, frozen yoghurt, frozen confectionery; ice; honey, treacle; sugar*. Many of the applicant's goods are reproduced in the opponent's specification and are self-evidently identical. The other terms are identical because they are covered by a broader term that includes the more specific terms.

38. The term *rice* appears in both parties' specification and is self-evidently identical.

39. As Mr Beebe submitted, the applicant's *savoury sauces, chutneys and pastes; sauces; salts, seasonings, flavourings and condiments* are identical to, or covered by (or vice versa) the following of the opponent's goods: *salt, mustard; vinegar, sauces, condiments*. I agree.

40. The applicant's *goods and dishes made from aforementioned products, included in this Class* are self-evidently identical to the opponent's *prepared meals*.

41. Mr Beebe submitted that the applicant's *tea-based beverages; coffee-based beverages; coffee, teas and substitutes therefor* are similar to the opponent's *services for providing food and drink; restaurant services* in Class 43. He argued that is common in the field for food and drink providers to also to provide drinks goods for sale in a retail environment goods and pointed out that in the opponent's own "Meat & Potato" booklet² placed on every table in its restaurants for most of 2018³ makes a reference to the opponent's own iced tea. This is the only evidence of such a practice and I am disinclined to take judicial notice of the fact. Whilst Mr Beebe mentioned a further example (not in evidence) and I, myself, am also familiar with a brand that provides food and drink and produces coffee for sale in retail outlets, this is not in evidence and, even if it was, falls short of demonstrating that it is common in the trade and that consumers are familiar with such a practice. Consequently, I conclude that there is no overlap of trade channels. Services and goods are fundamentally different in nature and their methods of use are also different. The intended purpose is similar in that the opponent's services provide goods that quench thirst and the applicant's goods are intended to quench thirst. There may also be an element of competition where the consumer may have a choice between making a retail purchasing of the goods or visiting an establishment where the beverage is made fresh for them. I conclude that there is similarity but it is no more than low.

42. Mr Beebe submitted that the applicant's *chewing gum, jellies (confectionery), lollipops, toffee, candy mints, pastilles, liquorice [confectionery], gum sweets; caramels, candy* are similar to both *ice, ices, ice cream, edible ices, frozen yoghurt*,

² Exhibit DW8

³ Mr Waite's first witness statement, para 26.5.1

frozen confectionery and *snack foods*. I disagree that they are identical but accept that they share a good deal of similarity. The opponent's *frozen confectionery* may be in direct competition to the applicant's goods, they will have the same purpose (to provide a sweet edible treat) and method of use (to be consumed in a casual manner). Taking all of this into account, they will share a medium level of similarity.

Class 39

43. Mr Beebe submitted that the applicant's *delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals* are similar to the opponent's *services for providing food and drink; restaurant services*. It is common place for restaurants and similar establishments to provide both a takeaway and delivery service to their local area. In this respect there is overlap in trade channels. Further, the consumer may choose between going to a restaurant and having a prepared meal delivered to their home and, therefore, they may be competition between the respective services. In other respects, the services are not similar. Taking all of this into account, I conclude that they share a medium level of similarity.

Class 43

44. The applicant's *food and drink catering; supplying of meals for immediate consumption; take-out restaurant services; preparation of food and beverages* are self-evidently identical to the opponent's *services for providing food and drink; restaurant services*.

45. Mr Beebe submitted that the applicant's remaining services, namely, *reservation services for booking meals; providing on-line advice and information services relating to food and drink; advice concerning cooking recipes; providing information in the field of recipes and cooking from a computer database* are similar to the opponent's Class 43 services. All of the applicant's services can be described as ancillary services to *providing food and drink and restaurant services*. There are common circumstances (on a restaurant's web site, for example) where consumer will encounter the applicant's services. Therefore, there may be overlap in trade channels. In all other respects, there is no obvious similarity and I conclude that the level of similarity is low.

Comparison of marks

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

48. The respective marks are shown below:

Opponent's Earlier Mark	Applicant's First Mark
<p style="text-align: center;">HONEST</p>	
	<p style="text-align: center;">Applicant's Second Mark</p> 

49. The opponent's earlier mark consists of the single word "HONEST" and this is, self-evidently its dominant and distinctive element. The applicant's first mark consists of the two words "HONEST foods" bordered by a circular vine or wreath-like green coloured circle with leaves on its left-hand side. The words dominate the mark but the word "food" is non-distinctive in respect of all of the goods and services of the application except the Class 25 goods. This results in the word "HONEST" being the dominant and distinctive element of the mark. The device element is also distinctive but slightly less dominant in the overall impression created by the mark. The considerations are similar for the applicant's second mark that is identical to its first mark but with the word "food" being substituted for the word "meal" and the abbreviation "prep". Once again, the words "meal prep" is non-distinctive.

50. Visually, both the applicant's first and second mark share the word "HONEST" with the opponent's mark. This creates some similarity between the marks. The other elements of the applicant's marks are absent from the opponent's mark. When considering these similarities and differences, I find that both of the applicant's marks share a medium level of visual similarity to the opponent's mark.

51. Aurally, the opponent's mark consists of the two syllables HON-EST. The applicant's first mark consists of the three syllables HON-EST-FOOD and its second mark consists of the four syllables HON_EST_MEAL_PREP. The applicant's marks share the same first two syllables with the opponent's mark but differ in that the additional syllables are absent from the opponent's mark. This results in a medium level of aural similarity (or slightly lower in the case of the applicant's second mark).

52. Conceptually, the common element HONEST present in both parties' marks is an ordinary dictionary word that will be readily understood as meaning "*free of deceit; truthful and sincere*"⁴. As submitted by Ms Pigott, it also has the meaning of "*simple, unpretentious, and unsophisticated*" as in "*good honest food with no gimmicks*"⁵. Whilst it should not be assumed that the average consumer will know the dictionary meaning of a word⁶ this is nothing before me to suggest that the average consumer would not understand this meaning and the applicant has provided evidence that it is commonly used in this way⁷. Whilst it may not be as well-known as the primary meaning of being "free of deceit"/"truthful", it is still a meaning that a significant proportion of the average consumer is likely to be familiar with. The presence of this word results in the respective marks having a conceptual overlap. The applicant's marks also include the additional verbal elements "food" and "meal prep". The former will be perceived as having its ordinary and common meaning. In respect of the latter, "prep" is likely to be understood as an abbreviation for "preparation"⁸ and, therefore, the phrase "meal prep" will be understood as describing the preparation of meals. The applicant's marks also contain a device element in the form of a circular vine or wreath-like green coloured circle with leaves. The concepts created by this device and the descriptive words "food" and "meal prep" are all absent from the opponent's mark. Taking all of this into account, I conclude that the respective marks share a low to medium level of conceptual similarity.

⁴ [Search Results for honest - Oxford Reference](#)

⁵ Ditto

⁶ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

⁷ I discuss this in more detail when considering the level of distinctive character of the opponent's marks

⁸ [PREP | Definition of PREP by Oxford Dictionary on Lexico.com also meaning of PREP](#)

Average consumer and the purchasing act

53. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

54. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

55. There is no great distance between the parties' positions regarding the level of care and attention paid by the average consumer in respect of these goods and services. Mr Beebe submitted that the average consumer will be members of the general public and will pay an average degree of attention during the purchasing act. Ms Pigott was in agreement but submitted that the level of care and attention is slightly higher than average because the competitive nature of the food and drink industry means that customers are used to having to pay particular attention to the trade mark. I am unconvinced that the food and drink sector is more competitive than any other sector where the general public is the average consumer and I agree with Mr Beebe that there is an average degree of care and attention.

56. The purchase is normally visual in nature with the goods and services being selected from shop shelves, online equivalents or in the case of the services from the

signage appearing on the frontage of food and beverage establishments. However, I do not disregard that aural considerations may sometimes play a part when, for example, requesting a particular item from a shop assistant.

Distinctive character of the earlier trade mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).

16. 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).”

58. A key element of the applicant’s defence is that, whilst acknowledging that the opponent’s HONEST mark has a sufficient level of distinctive character for registration, it is endowed with a very low level of distinctive character and that, secondly, it does not benefit from an enhanced level of distinctive character.

59. Ms Pigott submitted that the word “HONEST” is ubiquitous in the food industry. In support of this claim, the applicant has provided the following evidence:

Exhibit IM1 consists of an article by Packaging News (dated 22 October 2019) entitled “Food Ethics Council calls for ‘honest’ labelling and discusses plain packs” and calls for regulation regarding food labelling in relation to false or misleading claims;

Exhibit IM3 consists of a summary on the BBC website of a *Horizon* documentary episode entitled “*The Honest Supermarket: What’s Really In Our Food*”, aired on 8 July 2019, and again discusses food labelling;

Exhibit IM4 consists of a copy of an article entitled “4 ways to build a more transparent food brand” printed from the website www.thegaragegroup.com on “2/9/2021”. It included the sentence “How is your brand differentiating itself as an honest competitor in your space?”;

Exhibit IM5 consists of an article from the Guardian newspaper, dated 13 December 2017 regarding what Mr McAnally describes as a high-profile scandal in the food industry relating to dishonesty and misleading labelling.

Exhibit IM6 consists of a copy of a government review into the integrity and assurance of food supply networks. Several of the reports recommendations refer to dealing with dishonesty in the food industry and dishonest labelling.

60. Mr McAnally submitted⁹ that these exhibits illustrate that the word HONEST alone is not unique to one entity in the food industry and that it is not distinctive. This evidence relates to, in the main, the practice of the use of misleading labelling on food products. Whilst this will impact upon the level of inherent distinctive character in a way that is consistent with its most common dictionary meaning of being “free of deceit”, however, as a single word used to identify trade origin it is no more than allusive of any labelling being truthful and not deceitful. The consumer would

⁹ Para 8 of his witness statement

perceive the word, when being used in a notional and fair way, as indicating trade origin. Keeping this in mind and the way it is used in the industry and more generally, I find that it is endowed with a reasonably low level of inherent distinctive character. This is higher than that submitted by Ms Pigott who suggested that it does no more than “creep over” the threshold for registrability.

61. The opponent also claims that its mark benefits from an enhanced level of distinctive character. The evidence in support of this can be summarised as follows:

- The opponent has been operating in the restaurant business since 2011 when it opened its first HONEST BURGERS restaurant in Brixton, London¹⁰;
- As of December 2020, the opponent was operating 41 HONEST BURGERS restaurants across the UK, including in Cambridge, Cardiff, Liverpool, London, Manchester and Reading¹¹;
- The following annual revenue is provided¹² in respect of these restaurants:

Year	Revenue (£)
To Jan 2017	10,351,852
To Jan 2018	15,630,820
To Jan 2019	22,258,473
To Jan 2020	30,669,408
To Jan 2021	40,418,270

- The opponent has also spent the following amounts on marketing its brand:

Year	Spend (£)
To Jan 2017	363,507
To Jan 2018	242,184
To Jan 2019	328,791

¹⁰ Mr Waite’s first witness statement, para 4

¹¹ Ditto, para 5

¹² Ditto, para 18

- The opponent predominantly uses its marks in the following ways¹³:



¹³ See Exhibits DW1 and DW5



(NOTE: I shall refer to this mark as “the vertical mark”. The numeral “32” is the evidence page number and not part of the mark).

- The opponent’s online presence includes having 94,000 followers on Instagram with the opponent posting at least once a day in addition to posting regular “Insta Stories” that are seen by an average of 5,000 to 10,000 viewers¹⁴;
- The opponent also operates the website www.honestburgers.co.uk¹⁵ where the vertical mark appears prominently on the single webpage provided;
- Advertisements that appeared in the Guardian newspaper (in 2016) that has a readership in the region of 22 million per month, the Bristol Magazine (in June 2018) that has a monthly circulation of 20,000 in Bristol, and the Hackney Citizen (in February 2017) that has an estimated readership of 30,000 per

¹⁴ Mr Waite’s first witness statement, para 17

¹⁵ Ditto, para 19(2) and Exhibit DW3

month are all provided¹⁶. One refers to “HONEST BURGERS” and the vertical mark. The other two are essentially as follows below:



- There is also evidence of “door drop” flyers sent out by the Chiswick restaurant in 2018¹⁷. In these flyers, the restaurant refers to itself as “Honest Burgers” and the vertical mark also appears prominently;
- A booklet entitled “Meat and Potatoes” containing a history of the opponent was placed on every table in its restaurants for most of 2018¹⁸. There is reference to “Honest Burgers”, “Honest” and to the mark shown on the restaurant frontage (as per the image at the top of the page 23 of this decision);
- The evidence contains numerous third party references to the opponent where “Honest Burgers” and “Honest” are referred to identify the opponent's restaurants. These include:

¹⁶ At Exhibits DW13 and DW

¹⁷ Mr Waite's first witness statement, para 26.2.1 and Exhibit DW5

¹⁸ See Exhibit DW8

- In August 2019, an article in Wales 247 describes how the opponent “pitched up” along side other street traders for three weekends as a prelude to the opening of the opponent’s Cardiff restaurant¹⁹;
- An article dated 31 July 2019 that appeared in Design My Night announcing that Honest Burgers are “heading for Wales” and mentioning existing restaurants in London, Manchester and Bristol²⁰;
- An article dated 6 March 2019 that appeared in “Manchester’s Finest” talking about the launch of a “Honest Burgers” restaurant in Manchester in April 2019 and that it was famed for its “no-frills 100% British beef patties”²¹;
- Two articles that appeared in the Scottish Sun and another unidentifiable publication with a Scottish focus. The first is dated 7 June 2017 and mentions “Honest” as one of a number of “new household names” when reviewing a book entitled “The World is Your Burger”. The second is dated 20 February 2014 and from an unspecified publication and reports a collaboration between “Honest Burger” and the Scottish brewery “BrewDog”;
- The opponent was recognised as one of the 5 leading restaurant chains (having at least 20 branches) by TopDish in November 2019 following a survey of 90,000 diners²². The introduction to the survey states that “[a]cross the [top] five chains, over 91% of diners gave the dishes a rating of 4 or 5 stars...”²³;
- The opponent has won numerous awards from industry bodies, including, in 2018, “Best Restaurant Operator (20 sites or over)” by Restaurant magazine²⁴

62. The applicant submits that this evidence does not support the claim to enhanced distinctiveness. Ms Pigott made a single set of submissions on the inadequacy of the evidence in demonstrating an enhanced distinctive character and reputation. I will

¹⁹ See Exhibit DW14

²⁰ Ditto

²¹ See Exhibit DW15

²² Mr Waite’s second witness statement, para 9

²³ See the first page of Exhibit DW18

²⁴ Mr Waite’s first witness statement, para 28.1.1

comment upon the issue of reputation later and restrict my comments here to the issue of enhanced distinctive character. Ms Pigott submitted that that the opponent's business is mostly in London and that, further, much of its expansion to other parts of the UK only occurred in 2019 (the last full year before the relevant date in these proceedings, namely 6 February 2020). She concluded that the opponent's marks have not been enhanced in any way.

63. I agree that the evidence illustrates that the opponent's business has a greater and longer established business in London, only opening many of its other restaurants elsewhere in 2019 and, therefore, having less time to impact upon the level of distinctive character of the opponent's marks. However, even taking account of the self-evidently huge size of the restaurant market in the UK and the opponent's clear focus on the London area before 2019, when considering the exposure of the mark, either solus or with the descriptive word "burgers", in the press (including national press and press outside London) together with the large and growing turnover, I am satisfied that the opponent's mark benefits from some enhancement to its distinctive character in respect of *restaurant services*, even if it is only modest.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

64. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that, because of their similarities, they both originate from the same or economically linked undertaking.

65. In making my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at Paragraph 19, above.

66. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

67. I have found that:

- Many of the respective goods and services are identical, highly similar or share a medium level of similarity. Some of the applicant’s services share only a low level of similarity;
- In all of the respective marks, the dominant and distinctive element is the word HONEST but I also keep in mind that the device element of the applicant’s marks also contribute to the distinctive character of the applicant’s marks;
- The respective marks share a medium level of visual and aural similarity and a low to medium level of conceptual similarity;
- The average consumer is likely to pay an average level of care and attention and the purchasing act is likely to be visual in nature but I do not ignore the fact that aural considerations may sometimes play a part;
- The opponent’s mark benefits from a reasonably low level of inherent similarity and that this has been enhanced to a modest extent in respect of *restaurant services*.

68. The opponent submits that there is direct confusion. I do not agree. The visual differences between the respective marks are such that they will be easily discernible and remembered by the average consumer. At the hearing, Mr Beebe submitted that if this was my finding, that there would be indirect confusion because the average consumer, when encountering the marks, will conclude that their similarities are the result of the goods and services being provided by the same or linked undertaking.

69. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

70. Mr Beebe submitted that the current case falls squarely within the example categories (b) and (c) set out by Mr Purvis. I keep in mind that Mr Purvis' list is not exhaustive as noted by Arnold LJ in *Liverpool Gin Distillery v Sazerac Brands LLC* [2021] EWCA Civ 1207 at [12]. I am basing my analysis upon the opponent's "HONEST" mark and, consequently, category (c) does not apply. The differences between the respective marks are not quite on all-fours with category (b) because the later marks differ from the opponent's mark not merely because they contain the additional of non-distinctive words "food" and "meal prep" respectively but also because they contain the circular vine or wreath-like green coloured circle device. This is endowed with some distinctive character and results in the comparison of the marks being not strictly covered by category (b). However, the addition of this device does not detract from the fact that the dominant and distinctive element of the applicant's marks is the word "HONEST". Keeping in mind that the categories identified by Mr Purvis are not exhaustive, I find that the common occurrence of this word as the dominant element in all of the marks being considered, in circumstances where the goods or services share a medium level of similarity or higher, there is a likelihood of indirect confusion with the average consumer being likely to assume that the respective goods and services originate from the same or linked undertaking.

71. In reaching this conclusion, I have kept in mind that a finding of indirect confusion should not be made merely because the two marks share a common element nor is it sufficient that a mark merely calls to mind another mark²⁵. I have taken account of the impact of the word HONEST in the respective marks, that the words "Food" and "meal prep", appearing in the applicant's marks, are descriptive/non-distinctive matter and are to be given less weight when comparing marks²⁶, the closeness of the respective goods and services and the expectations of the consumer when encountering the respective marks.

72. I would have reached the same conclusion even if I had not found that the opponent's marks benefit from a modest level of enhanced distinctive character in respect of *restaurant services*.

²⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

²⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paras 22 & 23

73. Therefore, the opposition succeeds under section 5(2)(b) in respect of the following list of goods and services:

Class 29: *Prepared meals consisting substantially of meat, poultry, game, fish, seafood, vegetables, potatoes, dairy products or dairy substitutes, nuts, eggs and/or broth (oden); meat; poultry; game; fish; seafood; meats and meat substitutes; preserved meat; dried meat; cured meat; minced meat; sausages; meatballs; prepared meat broth [soup]; meat products; artificial milk based desserts; desserts made from milk products; egg substitutes; liquid eggs; instant soup; fish and seafood spreads; fish, seafood and molluscs; fruit-based snack food; jellies, jams, compotes, fruit and vegetable spreads; milk; milk products and their substitute products; milk based beverages and preparations and powders for making them; nutritional bars; protein bars; high protein cereal bars; 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; prepared salads; dry whey; cheese; goods and dishes made from aforementioned products, included in this Class.*

Class 30: *Bread; desserts; ice, ice creams; frozen yogurts and sorbets; prepared meals and snacks on the basis of grains, flour, sesame, rice, pasta, desserts and/or sweetmeats; ...; dried and fresh pastas, noodles and dumplings; ...; cake powder; flour; farinaceous foods; savoury sauces, chutneys and pastes; prepared pizza meals; rice; sandwiches; sauces; salts, seasonings, flavourings and condiments; doughs, batters, and mixes therefor; processed grains, starches, and goods made thereof, baking preparations and yeasts; sugars, natural sweeteners, sweet coatings and fillings, bee products; caramels, candy, malt biscuits, chewing gum, jellies (confectionery), lollipops, toffee, candy mints, pastilles, liquorice [confectionery], gum sweets, cereal-based savoury snacks; grain-based chips, savoury biscuits, chewing candy; confectionary bars; pizza; goods and dishes made from aforementioned products, included in this Class.*

Class 39: ... *delivery of food and drink, prepared for consumption; ...; delivery of foodstuffs and prepared meals;....*

Class 43: *Food and drink catering; ...; supplying of meals for immediate consumption; ...; take-out restaurant services; preparation of food and beverages; ...*

74. This ground fails in respect of the following:

Class 30: *tea-based beverages; coffee-based beverages; coffee, teas and substitutes therefor*

Class 43: *reservation services for booking meals; providing on-line advice and information services relating to food and drink; advice concerning cooking recipes; providing information in the field of recipes and cooking from a computer database*

Section 5(3)

75. Section 5(3) states:

“(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”.

76. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

77. 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 C383/12P, *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*).

78. I will deal with this ground more briefly.

Reputation

79. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

80. In *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20, Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used

in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

81. Whilst the opponent has provided no information regarding market share, the evidence illustrates annual revenue under the marks HONEST and HONEST BURGERS rising from over £10 million in the year to January 2017 to over £30 million in the year to January 2020. This illustrates a quickly expanding business. I have already established that this business had a predominantly London focus before expanding into a number of other cities around the UK in the year prior to the relevant date in these proceedings (being the filing date of the contested applications, namely, 6 February 2020), however, the opponent's marks have enjoyed publicity in the national press and press outside of London, I find that it has established the requisite reputation in the UK in respect of *restaurant services* even though it is relatively modest.

82. Keeping in mind that the opponent can only reply upon:

- this limited list of services, and;
- the mark's relatively modest reputation in respect of these services,

when considering this ground in respect of the applicant's goods and services that have been subject to a successful challenge under section 5(2)(b), the extent of success under section 5(3) will be no greater and, in all likelihood, would be successful to a lesser extent. This is because the opponent is unable to rely upon the same wide range of goods and services relied upon under section 5(2) of the Act and the extent of its reputation is insufficient to counter the lack of a wide range of goods and services to rely upon. Consequently, as the opponent's success is no greater, I do not intend to consider the ground based upon section 5(3) in respect of the applicant's goods and services where the opponent has been successful under section 5(2).

83. I will, therefore, limit my considerations to the goods and services that are only challenged under this ground or have survived the challenge under section 5(2)(b). These goods and services are:

Class 25: *Clothing; footwear; headgear.*

Class 30: *tea-based beverages; coffee-based beverages; coffee, teas and substitutes therefor*

Class 39: *Transportation information; delivery of goods; transport brokerage; warehousing information; distribution services; tracking and tracing of shipments [transport information]; transport; packaging of goods.*

Class 43: *reservation services for booking meals; providing on-line advice and information services relating to food and drink; advice concerning cooking recipes; providing information in the field of recipes and cooking from a computer database*

Link

84. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section

of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

85. 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:

The degree of similarity between the conflicting marks

86. I have already found that the opponent’s HONEST mark shares a medium level of visual and aural similarity and a low to medium level of conceptual similarity. The opponent’s HONEST BURGERS mark includes the additional word BURGERS that is absent in the applicant’s marks. However, because of its descriptive nature, this additional word will have little impact and the level of similarity will be the same or slightly lower than in respect of its HONEST mark.

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

87. The comparison is only in respect of the services for which the opponent has been found to have a reputation i.e. *restaurant services* and the applicant’s goods and services listed in paragraph 81, above. The applicant’s Class 25 goods and Class 39 services have no obvious similarity to the opponent’s goods and services, and I find they are dissimilar.

88. The goods in Class 30 have already been found to share a level of similarity, that is no more than low, with the opponent’s *restaurant services*. In respect of the Class 43 services, I also concluded that they share a low level of similarity to the opponent’s restaurant services.

The strength of the earlier mark's reputation

89. I have concluded that the opponent's marks have a modest reputation.

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

90. I have found that the opponent's HONEST mark is endowed with a reasonably low level of inherent distinctive character and that it has a modest enhanced distinctive character because of the use made of it. In respect of the opponent's HONEST BURGERS mark, the considerations are very similar, both in terms of inherent and enhanced distinctive character and I conclude that these are the same as for the HONEST mark.

Whether there is a likelihood of confusion

91. I remind myself that I am only considering whether a link exists in respect of goods and services either not challenged under section 5(2)(b) or that have survived the challenge. Consequently, there is no finding of likelihood of confusion in respect of the applicant's goods and services in issue.

92. Taking all of the above into account, the reasonably low level of inherent distinctive character and the fact that this has only been boosted to a modest level through use combined with the fact that the Class 25 goods and Class 39 services share no similarity to restaurant services, leads me to conclude that the requisite link between the respective marks will not be established.

93. In respect of the applicant's Class 30 goods and Class 43 services, I have found a low level of similarity to the opponent's services, however, I find that, after balancing all the factors and in particular the modest nature of the reputation in the opponent's marks and their low level of distinctive character, that the requisite link will not be established in respect of these goods and services also.

94. In light of this finding, it is not necessary to consider the merits of the opponent's claims of detriment and unfair advantage.

Summary

95. The grounds based upon section 5(3), insofar as it relates to the list of goods and services shown in para 83, above, fails in its entirety. In respect of the ground based upon section 5(2)(b), the oppositions have been successful in respect of the following list of goods and services:

Class 29: *Prepared meals consisting substantially of meat, poultry, game, fish, seafood, vegetables, potatoes, dairy products or dairy substitutes, nuts, eggs and/or broth (oden); meat; poultry; game; fish; seafood; meats and meat substitutes; preserved meat; dried meat; cured meat; minced meat; sausages; meatballs; prepared meat broth [soup]; meat products; artificial milk based desserts; desserts made from milk products; egg substitutes; liquid eggs; instant soup; fish and seafood spreads; fish, seafood and molluscs; fruit-based snack food; jellies, jams, compotes, fruit and vegetable spreads; milk; milk products and their substitute products; milk based beverages and preparations and powders for making them; nutritional bars; protein bars; high protein cereal bars; 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; prepared salads; dry whey; cheese; goods and dishes made from aforementioned products, included in this Class.*

Class 30: *Bread; desserts; ice, ice creams; frozen yogurts and sorbets; prepared meals and snacks on the basis of grains, flour, sesame, rice, pasta, desserts and/or sweetmeats; ...; dried and fresh pastas, noodles and dumplings; ...; cake powder; flour; farinaceous foods; savoury sauces, chutneys and pastes; prepared pizza meals; rice; sandwiches; sauces; salts, seasonings, flavourings and condiments; doughs, batters, and mixes therefor; processed grains, starches, and goods made thereof, baking preparations and yeasts; sugars, natural sweeteners, sweet coatings and fillings, bee products;*

caramels, candy, malt biscuits, chewing gum, jellies (confectionery), lollipops, toffee, candy mints, pastilles, liquorice [confectionery], gum sweets, cereal-based savoury snacks; grain-based chips, savoury biscuits, chewing candy; confectionary bars; pizza; goods and dishes made from aforementioned products, included in this Class.

Class 39: ... *delivery of food and drink, prepared for consumption; ...; delivery of foodstuffs and prepared meals;....*

Class 43: *Food and drink catering; ...; supplying of meals for immediate consumption; ...; take-out restaurant services; preparation of food and beverages; ...*

96. The applications may proceed to registration in respect of all remaining goods and services.

COSTS

97. The opponent has achieved a level of success in both oppositions and is entitled to a contribution towards its costs. I consider a reduction of about 20% is appropriate to reflect its partial success and, in these circumstances, I award the opponent the following contribution towards the cost of the proceedings:

Preparation of statements and consideration of the Applicant's statements	£400
Official fee	£400
Preparation of evidence and considering other side's evidence	£800
Preparing for and attending the hearing	£700
20% reduction	(£460)

TOTAL

£1840

98. I therefore order Ian McAnally to pay Honest Burgers Limited the sum of £1840. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of September 2021

**Mark Bryant
For the Registrar**