

**O-669-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3592121**

**BY BURTON'S FOODS LIMITED**

**AND**

**OPPOSITION THERETO**

**UNDER NO. 425250**

**BY NOT GUILTY FOOD CO LTD**

## **Background and pleadings**

1. This is an opposition against trade mark application number 3592121, which has a filing date of 8 February 2021 (“the relevant date”). The application was filed by Burton’s Foods Limited (“the applicant”) and concerns the series of two trade marks shown below:



Class 30: Biscuits; savoury biscuits; sweet biscuits; biscuits containing jam; biscuits containing a soft centre; biscuits containing chocolate; biscuits containing a flavoured centre; biscuits containing buttercream; chocolate biscuits, biscuits containing marshmallow; biscuits containing toffee; cookies; cookie bars; cookies containing chocolate; cookies covered in chocolate; preparations made from flour; rusks; bakery products; tarts; pastries; confectionery; shortbread; cakes; cupcakes; muffins; cake bars; chocolate; chocolate based products; snack biscuits; baked snack biscuits, cereal bars; desserts, puddings; food preparations for use in making desserts and puddings; dessert toppings, pudding toppings; preparations for making dessert and pudding toppings; trifle and preparations for making trifles.

3. The application is opposed by Not Guilty Food Co Ltd (“the opponent”) under ss. 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under both of these grounds, the opposition is directed against all of the goods in the application.

4. The opponent relies upon the registered trade marks listed below and upon all of the goods in their specifications, which are shown in the appendix to this decision:

(i) UK 3240120 **The Skinny Food Co** (“the ‘120 mark”)

Filing date: 28 June 2017; registration date: 3 November 2017

Registered for goods in classes 5, 29 and 30

(ii) UK 3444340 **Skinny Food Co Skinny Dips** (“the ‘340 mark”)

Filing date: 14 November 2019; registration date: 21 February 2021

Registered for goods in classes 29 and 30

5. The opponent says that the respective trade marks are highly similar and that the goods are identical or similar. This will, it says, result in a likelihood of confusion, including the likelihood of association. The application should accordingly be refused under s. 5(2)(b).

6. Neither of the opponent’s registered trade marks had been registered for five years at the relevant date. The opponent may therefore rely upon all of the goods it has identified without showing that there has been any use of the marks.

7. The opponent also relies upon the unregistered word sign **THE SKINNY FOOD CO** and the figurative sign shown below:



<sup>1</sup> The opponent contends that use of the contested mark constitutes a misrepresentation which has caused or is likely to cause

---

<sup>1</sup> The s. 5(4)(a) claim, originally wider, was limited at the hearing to those goods set out at §16 of the opponent’s skeleton argument.

damage to the opponent's goodwill. Registration of the mark should, the opponent claims, be refused under s. 5(4)(a).

9. The applicant filed a counterstatement denying the basis of the opposition. It accepts that some of the goods are identical or similar but disputes that the marks are highly similar visually and phonetically, or conceptually similar. It denies that there is a likelihood of confusion. The applicant also put the opponent to strict proof of its goodwill. The applicant denies that there would be a misrepresentation and put the opponent to proof of its claims of damage. The applicant denies that there would be passing off.

10. Both parties filed evidence. A hearing was requested and held before me, by videoconference, on 19 May 2022. The opponent was represented at the hearing by Lee Curtis of HGF Limited. The applicant was represented by Guy Tritton of Counsel, instructed by Squire Patton Boggs (UK) LLP.

## **Evidence**

### **Opponent's evidence**

11. The bulk of the opponent's evidence is provided in the witness statement of James Whiting. Mr Whiting is a Director and Co-Founder of the opponent. His evidence concerns the use which has been made of the opponent's marks/signs.

12. In addition, a witness statement is provided by Wayne Starkey, Mr Whiting's fellow Director and Co-Founder of the opponent. Mr Starkey's statement was filed in response to the applicant's evidence. He clarifies the ownership of the goodwill associated with the business conducted under the signs and responds to certain criticisms from the applicant about the invoices filed by Mr Whiting.

### **Applicant's evidence**

13. The applicant's evidence consists of the witness statement of Sarah Spittle. Ms Spittle is the Group Finance Director of the applicant. Ms Spittle's evidence mainly concerns the distinctiveness of the word "SKINNY" and includes examples of third party use of the

term, a number of trade mark searches and refused applications filed by the opponent or connected companies. There is also some evidence about the opponent's Companies House and VAT registration status.

14. None of the witnesses was cross-examined. I have read all of the evidence and will return to it to the extent I consider necessary in the course of this decision.

### **Preliminary issue**

15. This opposition was filed on 29 June 2021. At that date, the opponent was recorded on the register as the owner of both earlier trade marks, as it has been throughout these proceedings. However, in relation to the '120 mark, the opponent's name had been inserted on the register as a result of the original owner of the trade mark, White Star Key Group Ltd ("White Star Key"), filing a form TM21A. This form records a change of name. What had actually been intended was a transfer of the '120 mark into the hands of the opponent, a separate business; White Star Key had not changed its name at all. It was not until the opponent's present representative became involved that the mistake came to light and steps were taken to correct it. The trade mark was assigned to the opponent on 13 December 2021. This is significant because it postdates the launch of the opposition. The opponent advised the tribunal and the applicant when it filed forms for recording the assignment and correcting the record in March 2022 but the significance of these matters was only appreciated when the opponent again pointed out the sequence of events in its skeleton argument. Both parties filed supplementary skeleton arguments and were able to address the matter in full at the hearing. In addition to the points raised by the parties in their supplementary skeletons, I asked the parties for their comments regarding the operation of s. 38(2A)(a) of the Act. I also invited submissions regarding requests to amend the pleadings, given that, if the opposition had been properly constituted at its beginning, once the opponent became the owner of the '120 mark it would have been able to make an application that the pleadings be amended to include reliance upon that mark.

16. There is no dispute that the opponent was not entitled to rely upon the '120 mark at the date on which it filed the opposition, because it was not the owner of the mark.

17. The opponent requests substitution or joinder of White Star Key as an opponent, or that the error in the opponent's name be corrected. It says that the issue is restricted to the s. 5(2)(b) grounds, the opponent's position being that the opponent has at all relevant times been the owner of any goodwill in the signs. It argues that the requirements of the Relative Grounds Order are not absolute. Mr Curtis relied upon the decision of the Appointed Person in *Hing Kwong Yam v Asia Five Eight LLC (TAO ASIAN BISTRO TM)* (O/004/11) and on this tribunal's decision in *Peek & Cloppenburg KG & Or v Mood Clothing Concessions Limited (PREVIEW TM)* (O/269/11) in support of its case on substitution/joinder. He also pointed out that the opponent could apply for a declaration of invalidity if it is not allowed to rely upon the '120 mark in this opposition. In addition, Mr Curtis made a request at the hearing that the pleadings be amended "in temporal time". I understood Mr Curtis to mean that the matter be dealt with as a request for retrospective permission for the opponent to rely upon the '120 mark, as if the mark had not been pleaded originally.

18. Despite some criticism of the way in which the ownership issue was raised and dealt with, Mr Tritton accepted that it was an error on the opponent's part. However, he submitted that, in the absence of evidence about what has occurred, the proper course is to reject the opposition based on the '120 mark. Mr Tritton pointed to the Tribunal Manual, which indicates at 4.17, regarding substitution, that the intention at the time of filing is important. Whilst he accepted that the tribunal has the discretion to allow amendments to pleadings, he pointed out that quite what the amendments would consist of in this case is not clear.

19. I will first consider the request that White Star Key be made an opponent, whether by joinder or substitution. At the date on which the opposition was filed, White Star Key owned the '120 mark but did not own either the '340 mark or, it is the opponent's position, the goodwill in the signs.

20. The relevant section of the Trade Marks (Relative Grounds) Order 2007 ("the Relative Grounds Order") reads:

“2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right”.

21. Section 38(2A)(a) of the Act reads:

38. – [...]

(2A) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights-

(a) the rights (if plural) must all belong to the same proprietor; [...].”

22. At the opposition’s filing date, White Star Key did not own all of the earlier rights in the notice of opposition. It would not have been permissible for both White Star Key and the opponent to be opponents at the same time in an opposition based upon all of the rights pleaded. Nor would White Star Key have been able to be a sole opponent based on all of those earlier rights. Further, White Star Key now owns none of them. It is no longer entitled, under the provisions of the Relative Grounds Order set out above, to be an opponent based on any of the earlier rights, including the ‘120 mark. The position is different from the decisions in *TAO ASIAN BISTRO TM* and *PREVIEW TM* because those decisions were issued before s. 38(2A)(a) of the Act entered into force. At the time of those decisions, it was possible to have more than one opponent with differing ownership of the earlier rights; all that mattered was that the earlier rights belonged to one or other of the opponents. That is no longer the case. My concluded view accords with the initial view I gave at the hearing, which is that it would not have been possible for White Star Key to be an opponent in an opposition based upon all the rights pleaded at the time of the opposition’s filing, nor is it now possible for White Star Key to become an opponent. For completeness, I did not understand Mr Curtis to be applying for White Star Key to replace the opponent entirely. For the reasons given above, such a course would not be possible without dropping reliance on the ‘340 mark and, given the opponent’s position on ownership of the goodwill, the s. 5(4)(a) ground. Had it been necessary, I would also

have refused such a request on the grounds that there was never any intention for the opposition to be brought by White Star Key. In *The Thomson Minwax Company v Caswick Limited (CONSEAL TM)*, O/197/00, an opposition was launched by a defunct company. A request was later filed to substitute the new owner of the trade mark. The Appointed Person held that if the intention of those filing the opposition had been to identify the non-existent company rather than its successor, the opposition must be dismissed. However, if there was no reasonable doubt that the successor, rather than the defunct company, had been intended to be identified as the opponent, then the tribunal had a discretion to allow the correction of the misnomer. In this case, there is no indication that there was ever any intention for White Star Key to be the opponent. On the contrary, the intention was always for the opponent to bring the proceedings, and indeed for the opponent to own the '120 mark. That the opponent did not in fact own the '120 mark at the time does not mean that there was a misnomer of the type envisaged in *Thomson Minwax*.

23. Next, I turn to the request that the opposition based upon the '120 mark be allowed to continue because, if the proper course had been followed, the opponent could have applied to add the mark to the pleadings once it was assigned to the opponent. Mr Curtis pointed out that there would be no change to the evidence relied upon and reiterated that the opponent may file a request for invalidation if it is not permitted to rely upon the mark.

24. Rule 62 of the Trade Marks Rules 2008 reads, so far as is relevant:

“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, [...]”.

25. In *Pharmedica GmbH's Trade Mark Application (BETAMAG 12)* [2000] RPC 536, it was held that the Registrar “has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her”.



26. I accept that the discretion to allow amendments suggests that something will change. Here, the notice of opposition would remain as filed and relying on the discretion to allow amendments (rule 62(1)(e)) does look rather like trying to force a square peg into a round hole, since no actual amendment to any part of the pleadings is required. In fact, nothing in the case would change at all. On the one hand, the opponent had no standing in respect of the '120 mark when the opposition was filed and this is a belated attempt to regularise the status of the opponent in respect of that mark. As Mr Tritton pointed out, the fault is the opponent's and this issue has been raised very late. On the other hand, refusing the opponent's request to rely on the '120 mark would potentially result in further proceedings, particularly as the '120 mark may represent its best case, though I note Mr Tritton's point that the issues may be different in an invalidity. There is no suggestion that the error was anything other than a genuine mistake, arising from ignorance of the law on the part of an unrepresented party. There is, so far as I can see, no prejudice to the applicant, because the basis on which the proceedings have been run will remain unchanged. In such circumstances, the balance is in favour of allowing the opponent to rely upon the '120 mark. It appears to me that this falls within the inherent powers of the tribunal to regulate proceedings. Had the opponent filed its notice of opposition without reliance on the '120 mark, it could have applied at any time after its acquisition of the mark to add it to the grounds. Where this causes no additional burden on the applicant and raises no new issues which the applicant has been unprepared to address, I cannot see why such an application would be refused. My view is that, although this is essentially a retrospective application for such permission, the opponent should be permitted to rely upon the '120 mark.

### **Section 5(2)(b)**

27. Section 5(2)(b) of the Act reads 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”.

28. The following principles are gleaned from the decisions of the EU courts in case C-251/95 *Sabel BV v Puma AG* (ECLI:EU:C:1997:528), case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (ECLI:EU:C:1998:442), case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* (ECLI:EU:C:1999:323), case C-425/98 *Marca Mode CV v Adidas AG & Adidas Benelux BV* (ECLI:EU:C:2000:339), case C-3/03 *Matratzen Concord GmbH v OHIM* (ECLI:EU:C:2004:233). case C-120/04, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* (ECLI:EU:C:2005:594), case C-334/05P *Shaker di L. Laudato & C. Sas v OHIM* (ECLI:EU:C:2007:333), and case C-591/12P *Bimbo SA v OHIM* (ECLI:EU:C:2016:591):<sup>2</sup>

(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;

---

<sup>2</sup> 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.

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

29. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

30. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

31. It is also necessary to consider whether there is a complementary relationship between the respective goods.<sup>3</sup> In *Boston Scientific Ltd v Office for Harmonization in the*

---

<sup>3</sup> Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods: *Kurt Hesse v OHIM*, C-50/15 P, EU:C:2016:34.

*Internal Market (Trade Marks and Designs) (OHIM)*, T-325/06, EU:T:2009:428, the General Court stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

32. Specific goods must be considered identical to a more general category which includes those goods: *Gérard Meric v OHIM* T- 133/05, EU:T:2006:247.

### Comparison with the ‘120 mark

33. The applicant accepts that “biscuits; cookies; cookie bars; cookies containing chocolate; cookies covered in chocolate; preparations made from flour; pastries; confectionery; shortbread; muffins; chocolate; chocolate based products; puddings” are identical to goods in the ‘120 mark’s specification. It accepts some similarity for the remaining goods, with the exception of “rusks”. The opponent argues that the goods are identical or highly similar.

34. The ‘120 mark includes in its specification “cookies”. *Collins English Dictionary* defines the term in British English as “1. *US and Canadian* a small flat dry sweet or plain cake of many varieties, baked from a dough” *Also called (in Britain and certain other countries): biscuit*”.<sup>4</sup> That the definition is preceded by “US and Canadian” suggests that the term is a North American term. That does not mean that the term would not be understood in the UK: I think it would, chocolate chip cookies being an example of a biscuit long available in UK supermarkets. However, I do not think that the fact that the term is used in North America to characterise all types of biscuit means that the average UK consumer perceives it in the same way. I am doubtful that the UK consumer would consider “cookie” and “biscuit” to be straightforward synonyms: to my mind, the UK consumer is likely to conceptualise “cookies” as a type of biscuit which has been marketed as such in the UK, typically disc-shaped, made from a sweet dough which

---

<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/cookie> [accessed 12 July 2022]

is baked and which may include other ingredients like chocolate chips, rather than any sort of biscuit at all. “Cookies” would be included within “biscuits” but “cookie” would not be construed as including all types of sweet biscuit, e.g. sandwich biscuits, and certainly not savoury biscuits like cheese biscuits.

35. Consequently, the contested “sweet biscuits; biscuits containing chocolate; chocolate biscuits; biscuits containing marshmallow; biscuits containing toffee; snack biscuits; baked snack biscuits” would all include “cookies” of the same type. These goods are identical on the basis of the principle in *Meric*. The contested “biscuits containing jam; biscuits containing a soft centre; biscuits containing a flavoured centre; biscuits containing buttercream” are highly similar to “cookies” because they are all types of sweet biscuit, very similar in nature and purpose, eaten as snacks by the same users, are likely to be sold on the same shelves in supermarkets and may be selected as alternatives to one another.

36. The contested specification also includes another type of biscuit, namely “savory biscuits”. As I understand it, the cookies, shortbread and petit-beurre biscuits in the ‘120 mark’s specification are all types of sweet biscuit, petit-beurre being a type of French shortbread. The earlier mark’s goods are similar in nature to “savory biscuits”, being small, dry baked snacks. However, there are also differences, most obviously the absence of sugar from savory biscuits, the inclusion of salt and potentially other differences in ingredients (savory biscuits may include cheese, for example, which would not be found in cookies and shortbreads). The goods may be reasonably close together in supermarkets but there is likely to be a clear distinction between the sections, such as on opposite sides of the same aisle. There is an overlap in purpose, in that both may be used for snacking and the consumer may make a competitive choice between the goods: a savory biscuit may be a lower fat/sugar option for a snack, for example. They are similar to a medium degree.

37. As for “rusks” in the contested specification, as I understand it these are a type of hard, sweetened biscuit for babies. They have some overlap in nature with cookies, being based on similar ingredients and in a disc shape. There is some overlap in method of use

and purpose, as both can be eaten as snacks between meals, though rusks fulfil a particular purpose in weaning babies which cookies do not. Whilst a consumer, for example a parent, may purchase both cookies and rusks, the goods are unlikely to be interchangeable given that rusks are a specific weaning food. They are unlikely to be sold near one another, since baby foods are generally in a dedicated area. These goods are similar to a fairly low degree.

38. “Bakery products” in the contested specification are identical to “bread” in the ‘120 mark’s specification on the basis outlined in *Merix*.

39. “Cakes” in the contested specification are identical to “brownies” on the *Merix* principle because the latter are small dense cakes.

40. The contested “cake bars” are small cakes in a particular shape, usually an oblong. I see no reason why cake bars would not include brownies in the same shape. These goods are identical or, if not identical, highly similar.

41. “Tarts” and “trifle” in the contested specification are covered by “puddings” in the ‘120 mark’s specification and are identical. The contested “desserts” are puddings, or vice versa, and these goods are also identical.

42. Turning to the contested “cupcakes”, the ‘120 mark’s specification includes “buns”, which are small cakes, usually presented in paper cases, as are cupcakes. They may be iced, including with stiff buttercream icing. I cannot see any meaningful difference between “buns” and “cupcakes”. These goods are identical. If that is not right, they are highly similar, differing only in the proportions of icing to cake and potentially the specific composition of the icing.

43. The contested “cereal bars” are sweet snacks made principally of cereals of varying types and proportions, often with additional ingredients such as fruit. The ‘120 mark includes “flapjacks”. These are similar in nature because they are mainly composed of a cereal, which in the case of flapjacks is usually exclusively oats. Flapjacks may, like cereal bars, contain ingredients such as fruit. Both are intended to be eaten as snacks. They are identical in users and method of use. They are likely to be sold on the same shelves in

retail premises and there is a pronounced competitive relationship. They are highly similar.

44. I see no reason why the contested “food preparations for use in making desserts and puddings” would not include “preparations for making ices, ice cream, ice cream products and frozen confections”, included in the ‘120 mark’s specification. These are identical based on *Meric*.

45. The contested “dessert toppings, pudding toppings” include dessert sauces. The ‘120 mark’s specification includes “sauces”. These goods are *Meric* identical.

46. The contested “preparations for making dessert and pudding toppings” would include both dry mixes and liquid products which are used in making dessert and pudding toppings. There may be some overlap in nature with “preparations for making ices, ice cream, ice cream products and frozen confections”. The purpose is related but it is not the same. The users will coincide and there may be some overlap in channels of trade. There may be a degree of complementarity as the contested goods could be used as part of the process in making the ice cream products and frozen confections covered by the earlier term and they may be thought to emanate from the same manufacturer. They are not in competition. These goods are similar to a fairly low degree.

47. The contested “preparations for making trifles” are likely to consist of several ingredients which are to be put together to create a trifle, as they are or after mixing with a liquid. It seems to me that there is an overlap in purpose with “preparations for making [...] frozen confections” because both are intended to create a dessert, albeit the finished dessert is different. The nature of the products is also likely to be similar to a degree, consisting of a number of similar ingredients which may overlap, though I recognise that “preparations for making [...] frozen confections” will necessarily only include ingredients suitable for freezing. Method of use will be similar. The users will be the same and the goods may be sold close together. There may be a competitive relationship, with the consumer who wishes to make a dessert opting for a frozen dessert instead of a trifle. The goods are not complementary. Overall, they are similar to a medium degree.



## Comparison with the '340 mark

48. “Biscuits; savoury biscuits; sweet biscuits; biscuits containing jam; biscuits containing a soft centre; biscuits containing chocolate; biscuits containing a flavoured centre; biscuits containing buttercream; chocolate biscuits, biscuits containing marshmallow; biscuits containing toffee; cookies; cookie bars; cookies containing chocolate; cookies covered in chocolate; shortbread; snack biscuits; baked snack biscuits” are literally identical or identical on the basis of *Meric* to “biscuits” in the earlier specification. “Rusks” are a particular type of biscuit but appear to be a biscuit nonetheless and are also identical to “biscuits” on the principle outlined in *Meric*.

49. “Preparations made from flour”, “pastries”, “confectionery”, “chocolate”, “puddings” and “cakes” are contained in both specifications. These goods are literally identical. The contested “chocolate based products” is another way of expressing “products made [of] or containing chocolate”; these goods are also identical.

50. The contested “bakery products”, although worded slightly differently, are identical to “bakery goods”. “Desserts” and “puddings” are different words for the same thing. These goods are identical.

51. “Tarts”, “cupcakes”, “muffins” and “cake bars” are all types of bakery goods, which is included in the earlier specification. The contested “cereal bars” are a type of “cereal-based snack food”. The contested “trifle” is a type of pudding. “Dessert toppings, pudding toppings” are covered by the earlier mark’s “zero calorie sauces”. “Food preparations for use in making desserts and puddings” includes “preparations for making ices, ice cream, ice cream products and frozen confections”, contained in the earlier specification. These goods are all identical on the principle outlined in *Meric*.

52. For the reasons given at paragraphs 46 and 47 above, “preparations for making dessert and pudding toppings” and “preparations for making trifles” are similar to the same earlier goods to a fairly low and medium degree, respectively.

## **The average consumer and the nature of the purchasing act**

53. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

54. Mr Tritton submitted that the average consumer will be a member of the general public. He also submitted that the goods will attract an above average level of attention because they are likely to be low-calorie products and consumers will be attentive to the calorie content. I have no specific submissions from the opponent.

55. I agree that the average consumer is a member of the general public: all of the goods are foodstuffs which are readily available to end consumers. Some attention may be paid to the calorific content of the foods and there may be consideration of other dietary restrictions as well as of factors such as flavour. However, all of the goods are likely to be the subject of regular purchase and none is likely to give the consumer pause for thought because of their significant cost. Confectionery, chocolate, chocolate-based products and cereal bars are all often found at checkouts. These goods may be purchased quickly and with little reflection, resulting in a low degree of attention on the part of the consumer. The same is not usually the case for the remaining goods, which will be selected with a medium degree of attention.

56. The purchasing process is likely to be mainly visual, with the average consumer selecting the goods from shelves in retail premises, such as supermarkets, or their online equivalents. There may also be an aural component to the selection.

## **Distinctive character of the earlier trade mark**

57. In *Lloyd Schuhfabrik*, 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).

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)”.

58. Mr Curtis accepts that the word “skinny” is or is “borderline” descriptive. However, he submitted that both earlier trade marks are distinctive when taken as wholes. Mr Tritton submitted that the ‘120 mark consists of wholly descriptive words and that, while it must be considered to have minimal distinctive character because it is a registered mark, such distinctive character can only arise because of the combination of words.

59. The applicant seeks to rely on the existence of other marks containing the word “skinny” on the UK trade mark register, or refusals of such marks, in order to show that the word is non-distinctive.<sup>5</sup> This type of evidence was considered in *Zero Industry Srl v OHIM*, T-400/06, EU:T:2009:331. The General Court stated that:

---

<sup>5</sup> SS-2, SS-3.

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)”.

60. On its own, state of the register evidence is of no weight. The evidence that previous trade mark applications filed by the opponent or White Star Key have been refused is also of no weight, not least because it concerns different trade marks and the reason for refusal not known.<sup>6</sup> It is also generally not instructive to try to draw parallels between decisions in respect of different trade marks, even ones which contain an identical element, because distinctiveness is assessed by reference to the trade mark as a whole.

61. However, the applicant has provided dictionary definitions of the word “skinny”.<sup>7</sup> The dictionary at [dictionary.cambridge.org](http://dictionary.cambridge.org) defines the term as meaning “(mainly disapproving) very thin; low in fat; especially used of coffee made with low-fat milk”, whilst that at [oxfordlearnersdictionaries.com](http://oxfordlearnersdictionaries.com) defines “skinny” as “(informal, usually disapproving) very thin, especially in a way that you find unpleasant or ugly); (of clothes) designed to fit closely to the body”.

62. The applicant has also filed three refusal notices for trade marks which combine the word skinny with a descriptor (almonds, bites, whip).<sup>8</sup> The EUIPO and UKIPO took the

---

<sup>6</sup> SS-4, SS-5.

<sup>7</sup> SS-1.

<sup>8</sup> SS-7.

view that the marks were descriptive, indicating final products which would be perceived as lower fat/calorie versions of almonds, snacks or desserts. The UKIPO letter, which is dated 10 October 2019, includes web prints showing recipes for “super skinny muffins”, “skinny bread and butter pudding”, “‘skinny’ fish, pea and parsley pies”, “skinny beef pie” and “skinny beef lasagne”, all with .co.uk domains.<sup>9</sup> Four of the recipes refer to their lower calorie, lower fat or diet-friendly properties. The letter also includes a review from *Closer* magazine online titled “Our top ‘skinny’ lower calorie chocolate bars” and an advertisement from amazon.co.uk for “NOMU Skinny Hot Chocolate Powder”, the latter of which is described as a “low sugar diet drink, 20 calories only, low GI, high protein”. Prints from Instagram show recipes with the #skinnyfood hashtag dating from 2020 and later.<sup>10</sup>

63. The applicant’s evidence also includes prints from a number of websites which incorporate “skinny” in their company name (e.g. Skinny Bakery, Skinny Bars, Skinny Cook). Most of the prints show each of these websites at a point before the relevant date (2012-2020) and again in December 2021 (though the skinny-noodles web pages from 2021 are blank).<sup>11</sup> While the goods are low calorie, low fat or low sugar, the uses of “skinny” are mainly as part of the company/brand name rather than purely descriptive of the goods. There are, however, no examples of “skinny” alone being used to indicate the commercial origin of foods or drinks, though one company has produced a “SKINNI” range of low fat, low carbohydrate foods. A 2012 print from the Skinny Bakery site offers for sale a “skinny chocolate cupcake” and Oomf foods have offered “skinny oats”, which appears to be a lower calorie porridge mix, since November 2019. There are undated examples from a company called Fitty Foods which has a number of “skinny” goods (e.g. “skinny chicken curries”) and of a brand which says it is called Metcalfe’s Skinny, but the images show the word “Metcalfe’s” in larger font on the packaging, above the words

---

<sup>9</sup> Further examples are at SS-9. Most are dated only with the printing date of December 2021. A “skinny Thai green curry” recipe is shown from September 2015, modified in 2020 (p. 201). It is a .com domain but the British spelling of “favourite” is used. There are references to a “skinny” matcha/iced matcha latte from 2017 (p. 195) and “skinny” soup (p. 199) but it is not clear if these search results are from websites directed at UK users.

<sup>10</sup> SS-14. Recipes uploaded in 2020 are at pp. 246-248.

<sup>11</sup> SS-8. Three of these do not appear to relate to the UK: the WayBack Machine print for Skinny Me Chocolate references shipping in dollars; the “Skinny Pizza” prints reference USDA certification and federal and state laws; Skinny Tea’s goods are sold in dollars. See also SS-9.

“skinny popcorn” and “skinny ricecakes”. There are also some undated examples from [sainsburys.co.uk](https://www.sainsburys.co.uk) of several brands using “skinny” descriptively in relation to coffee drinks and chips and well as to indicate commercial origin (e.g. “Skinny Tan Gradual Tanner”).

64. In terms of the inherent distinctiveness of the ‘120 mark, my view is that none of the individual components of “The Skinny Food Co” is distinctive. Notwithstanding Mr Curtis’s submissions, I consider that the word “skinny” has been in widespread use to mean something low-fat for some time. The definition from the *Cambridge Dictionary* quoted above suggests that such a meaning is especially clear for coffee made with low-fat milk. *Collins* has a similar definition: “(of a beverage) made with skimmed or semi-skimmed milk: *a skinny latte*”.<sup>12</sup> That accords with my own understanding. However, it seems to me that even if “skinny” is not already in use to the same degree to describe other food and beverages, the average consumer would have no hesitation in according the word “skinny”, when followed by a word for foods or beverages, the meaning that it is low in fat or calories. It follows that the ‘120 mark will be understood as meaning a company which specialises in low fat/low calorie food. I agree with Mr Tritton that the distinctiveness of the earlier mark is in the combination of the elements. My view is that, inherently, the mark has only the minimum degree of distinctiveness required for registration, i.e. it is very low in distinctive character.

65. The same reasoning applies to the “Skinny Food Co” component of the ‘340 mark. However, there is an additional element in this mark, namely the words “Skinny Dips”. For any goods which may be used for dipping or which may have been dipped in something, “Skinny Dips” is highly allusive of the nature and purpose of the product, indicating a low fat/calorie/sugar version of such goods. In relation to such goods, any distinctiveness is in the combination of the elements and the mark as a whole is very low in distinctive character. Where the foods are not likely to be used for dipping or to have been dipped in something (e.g. cakes), “skinny dips” is more likely to be seen as evoking thinness without any specific meaning in relation to the product. Despite the propensity of the UK public to dip biscuits in tea, this is usually referred to as “dunking” and I think it

---

<sup>12</sup> <https://www.collinsdictionary.com/dictionary/english/skinny> [accessed 14 July 2022].

Acquired distinctiveness: evidence

66. As the opponent has filed evidence of the use it has made of its marks, I must assess whether their distinctiveness has been enhanced. The evidence shows that the words “THE SKINNY FOOD CO” and the mark shown below were first used in social media posts on 10 May 2018:



67. Mr Whiting’s evidence is that the trade marks are used in particular in relation to sauces, syrups, cookies, brownies, flapjacks, muffins, bread, food bars and coffee syrups. Prints from Instagram dated 10 and 16 May 2018 show the figurative sign on tomato ketchup, syrup (a number of flavours are mentioned) and cookie dough.<sup>13</sup> The handle is “skinnyfoodco”. Chocolate spreads are also visible. In these prints only the word “skinny”, as it appears in the figurative sign above, is legible but the packaging is consistent with examples elsewhere also showing the complete figurative sign.<sup>14</sup>

68. Prints from the opponent’s website dated 27 November 2020 discuss the opponent’s sweet syrups, savoury sauces, peanut butters and fruit jams.<sup>15</sup> The figurative sign is visible at the top of each page. It is not clear when the peanut butters and jams were added to the range: they are said to have been introduced to meet demand from existing customers.

---

<sup>13</sup> Whiting, §2 and exhibit JW2.

<sup>14</sup> See JW14.

<sup>15</sup> Whiting, §2 and JW1.

69. Prints from the opponent's website, theskinnyfoodco.com, said to be from before the relevant date, show the figurative mark applied to the packaging of syrups and sauces.<sup>16</sup> There is also an image of "chocolate crispies" packaging. It is not terribly clear but the word "skinny" can be seen as part of a device which incorporates five stars and other matter. On the balance of probabilities, this is likely to be a version of the figurative mark with the words positioned slightly differently. The primary branding is "#not guilty bites". A version of the figurative sign, without the stars, is visible on pancake mix which also carries "#not guilty" primary branding. The words "The Skinny Food Co" appear on the website home page and in the description of various syrups, savoury sauces, chocolate spread and peanut butter.<sup>17</sup> Jam, chocolate, "flavour drops", meat snacks, oils and jelly appear on the website. There is no image of their packaging and they do not include "The Skinny Food Co" in their descriptions. They are, however, identified as "#not guilty" products. Powders (e.g. cacao, lucuma), seeds and grains are also included but there is no image of the packaging, or of either "The Skinny Food Co" or "#not guilty", in their descriptions. The "view our products" heading on the home page identifies "zero calorie sauces", "zero calorie syrups" and "low calorie snack range". Mr Whiting also says that the trade marks are used in relation to a cookie mix product, for which an image of the packaging is provided.<sup>18</sup> However, the print is undated and there is no detail about when this product was first offered for sale.

70. Mr Whiting gives evidence that the word "SKINNY" in word or stylised form was used on syrups, sauces, a "duo bar", hot chocolate, "chocoholic drops" and chocolate spread before the relevant date. Some images are provided from what appears to be the opponent's website: the unregistered figurative sign is visible on each page. The pages themselves are not dated. The chocolate spread and syrup packaging is consistent with that described above. The hot chocolate packaging is shown below:

---

<sup>16</sup> JW5 and Whiting, §4.

<sup>17</sup> In relation to chocolate spread, see also Whiting, §7 and JW14, p. 158.

<sup>18</sup> Whiting, §6 and JW13.





71. This is an example of the low-sugar bar packaging:



72. Further prints show other goods bearing the figurative sign but these prints are not dated.<sup>19</sup>

73. Turnover is given as £1.5 million in 2017-2018, £4.6 million in 2018-2019 and £17.2 million in 2019-2020.<sup>20</sup> It is said that comparable sales were made from 2020 to the relevant date.<sup>21</sup> Eight invoices to UK customers are provided, all dated 16 May 2018.<sup>22</sup>

---

<sup>19</sup> JW3.

<sup>20</sup> Whiting, §3.

<sup>21</sup> Ibid.

<sup>22</sup> JW4.

They show sales of syrups and savoury sauces in small quantities (the maximum amount billed is £34.91). There is also an invoice to “B&M” dated 20 January 2021 which shows the sale of over 10,000 items of “Southwest sauce” at a cost in excess of £15,000.<sup>23</sup>

74. UK marketing spend was £60,000 in 2017-2018, £1.2 million in 2018-2019 and £2.5 million in 2019-2020.<sup>24</sup> There is evidence that the opponent was an exhibitor at the 2019 BBC Good Food Show, and that it has participated in other shows at unspecified dates; there are no images or advertising in evidence for any of these events.<sup>25</sup>

75. An article dated August 2019 details an agreement with the Spar shop chain to stock the opponent’s savoury sauces, syrups and milk chocolate bites in shops in the north of England.<sup>26</sup>

76. The opponent’s social media following comprised 368,000 followers on Instagram, 427,163 on Facebook, 14,700 on Twitter and 3,255 on LinkedIn, it appears at the date of Mr Whiting’s statement in November 2021.<sup>27</sup> The first three were created in 2018. The figurative sign is visible on the Instagram, Facebook and LinkedIn pages; the words “The Skinny Food Co” appear on all four.

### Assessment

77. The opponent’s business grew substantially from 2018 to 2020. Even in the food and drink market, which is undoubtedly enormous, the 2019-2020 turnover figures are not negligible. However, they are not broken down at all and there is no clear indication of what products were introduced when. This means that, whilst the opponent has offered a range of different goods, it is difficult to assess how strongly the earlier mark is associated with any given product. Syrups and savoury sauces, the latter of which all appear to be condiments, were offered from the opponent’s earliest days and are the only products for which invoice evidence is provided. They also appear to be the cornerstone of the

---

<sup>23</sup> WS5.

<sup>24</sup> Whiting, §5.

<sup>25</sup> JW10, Whiting, §5.

<sup>26</sup> JW12.

<sup>27</sup> JW6- JW9.

opponent's offering, meriting separate sections on the website and each having a number of different flavour options. The onus is on the opponent to show that the distinctiveness of the earlier marks has been enhanced. I am prepared to find, in light of the turnover figures, the inexpensive nature of the goods and three years' trading, that there has been a small enhancement of the '120 mark in relation to syrups and sauces [condiments]. I do not consider that a greater enhancement is appropriate: even a £17 million turnover is, in the food and drink sector, likely to represent a modest market share and there is only very limited evidence of advertising and publicity. It would have been in the opponent's gift to provide a breakdown showing the sales figures for the various other product categories had it chosen to. As it is, I do not consider the evidence sufficiently solid to establish acquired distinctiveness for any other goods, notwithstanding the fact that they may have been on sale for the same length of time. There is no evidence of any use of "SKINNY FOOD CO SKINNY DIPS". Although the words "SKINNY DIPS" may be highly allusive, it is also a play on words which makes some contribution to the mark. The weakness of the "SKINNY FOOD CO" element means, in my view, that the omission of the words "SKINNY DIPS" alters the distinctive character of the mark, even where "SKINNY DIPS" is highly allusive. The point is stronger where the words "SKINNY DIPS" are not at all allusive. The use of "THE SKINNY FOOD CO" alone is not a permissible variation of the '340 mark and there is no enhanced distinctiveness for the '340 mark.

78. It is not clear to me whether the comments in Mr Whiting's statement regarding the use of "skinny" in figurative form are an attempt to argue that that such use must be taken into account in determining acquired distinctiveness of the registered trade marks. If so, I reject that argument. As I have indicated, the word "skinny" is, for the goods at issue, descriptive. The distinctiveness of the trade marks is due to the word's combination with other elements. Whilst some or all of those elements are individually non-distinctive, their omission alters the distinctiveness of the trade marks as wholes because the remaining elements are no more distinctive: the use of "skinny" alone, whether as a word or in figurative form, is not a permissible variation of the trade marks.<sup>28</sup> In respect of the hot chocolate, it appears that the opponent sells other brands via its website and the

---

<sup>28</sup> See *adidas AG v EUIPO* T-307/17, EU:T:2019:427


stylisation of the mark is so different from the opponent's own that, bearing in mind the descriptiveness of "skinny", the consumer will not perceive these as the opponent's goods.

### **Comparison of trade marks**

79. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

80. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier marks	Contested marks
<p data-bbox="391 373 602 405">The '120 mark:</p> <p data-bbox="350 468 643 499">The Skinny Food Co</p> <p data-bbox="391 653 602 684">The '340 mark:</p> <p data-bbox="293 747 699 779">Skinny Food Co Skinny Dips</p>	

81. As I have done throughout this decision, I will refer to the contested marks in the singular: the differences between the marks in the series are not material and my comments can be taken to apply to each equally.

82. The overall impression of the contested mark is dominated by the words “THE SKINNY COOKIE CO”. Although “SKINNY” is presented in a larger size, followed by “COOKIE CO”, with “THE” in the smallest font, it is a descriptive word and all four words will be read as a unit, with no single word dominating. The particular presentation, namely the typeface, the position of the words and their size relative to one another, make a contribution. The lines above the words and under the word “CO” play a very weak role, even when in colour.

Comparison with the '120 mark

83. I have already discussed the distinctiveness of the '120 mark. No one part of it is distinctive. The overall impression is contained in the phrase “The Skinny Food Co” as a whole, which will be seen as a unit indicating a particular company, without any single element of the mark being more distinctive or dominant.

84. Mr Tritton submitted that there is no, or only a low degree of visual similarity. He relies in support on the decision of the General Court in *Faber Chimical Srl v OHIM* T-211/03 EU:T:2005:135, which was a case concerning a figurative representation of the word “Faber” on the one hand and the word “NABER” on the other. The GC held that there was no overall visual similarity between the marks. However, that decision made clear that the relative importance of the common elements to the mark is a key factor in the analysis. Further, the figurative element in the “Faber” mark was found to be “not secondary” and requiring “a conceptual effort of construction”, particularly the highly stylised letter “F” which “strongly accentuates its particular figurative aspect” (at [41]-[42]). This meant that the figurative element was sufficient to preclude visual similarity between the signs at issue. I do not consider the instant case to be on all fours with that decision. First, the stylisation of the letters in the present case is secondary: the typeface here is not very striking, unlike in *Faber*. Secondly, the arrangement of the words is not particularly unusual. I do not consider the assessment between the marks at issue to be comparable to that in *Faber*.

85. Both marks have the same grammatical construction and share three of their four words, i.e. “The Skinny [...] Co”, in the same order. They differ in their third word, “Food” or “COOKIE”, which do share the vowels “OO” but are otherwise quite different. There is some difference because of the stylisation of the contested mark. The marks are visually and aurally similar to a reasonably high degree.

86. Mr Tritton submitted that neither mark has any concept. Mr Curtis argued that they are conceptually very similar, as a “cookie” is a type of “food”. There is a medium degree of conceptual similarity between the marks because both evoke the idea of a company concerned with manufacturing low fat/low calorie foodstuffs, but the foodstuffs themselves are different.

#### Comparison with the ‘340 mark

87. In relation to goods for which the words “Skinny Dips” are highly allusive, the words “The Skinny Food Co” carry more weight in the overall impression of the ‘340 mark, because they will be identified as the more distinctive element in the mark. Where “Skinny

Dips” is not so allusive, the mark is likely to be perceived as having two parts (“Skinny Food Co” and “Skinny Dips”) with neither one more distinctive. Owing to its position at the start and the length of the mark, the words “The Skinny Food Co” is likely to have slightly more impact.

88. The inclusion of the words “Skinny Dips” as an additional point of difference results in the competing trade marks being visually similar to a fairly low degree at best (i.e. where the words “Skinny Dips” are highly allusive and carry less weight in the overall impression). My view is that the earlier mark will be articulated in its entirety, resulting in a very low degree of aural similarity. However, I will allow for the possibility that the words “Skinny Dips” will not be articulated, in which case there is a reasonably high degree of aural similarity, for the reasons given above. Conceptually, both marks evoke the notion of a company concerned with manufacturing low-fat foodstuffs, but there is an additional meaning in the ‘340 mark, which is a further point of difference. There is no more than a fairly low degree of conceptual similarity between the marks at issue.

### **Likelihood of confusion**

89. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

90. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting 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”).

91. This is not an exhaustive list; but indirect confusion has its limits. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C. (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made



merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. That is mere association, not indirect confusion. The Court of Appeal has emphasised that where there is no direct confusion, there must be a “proper basis” for a finding of indirect confusion.<sup>29</sup>

92. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

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

93. I have found that the ‘120 mark has a very low degree of inherent distinctive character and that it has acquired a modest amount of additional distinctiveness for syrups and sauces [condiments] but not otherwise. Even bearing in mind that enhanced distinctive character, the mark is still fairly low in distinctiveness, which points away from confusion. There are some elements in the opponent’s favour, such as the low level of attention which will be paid to the purchase of some of the goods, that there will be no more than a medium degree of attention for any of the goods, and the fact that some of the goods are identical or highly similar. There is also a good deal of visual, aural and conceptual similarity between the marks. However, it must be remembered that the distinctiveness of the earlier mark is born of the combination of words. There is also the matter of the stylisation of the contested mark. Whilst the figurative element is subordinate to the words, the specific presentation of the mark does play a role in the overall impression. My view is that despite the similarities between the marks, the differences created by the word “COOKIE”, as opposed to “FOOD”, and the presentation are sufficient to avoid confusion. Where the word “COOKIE” is not descriptive of the goods, which includes those goods identical to the sauces and syrups for which the earlier mark has some

---

<sup>29</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

acquired distinctiveness, this adds an additional distinctive and jarring element which will distinguish the contested mark from the '120 mark.

94. In making the above finding, I have considered carefully whether there would be confusion where the average consumer pays only a low degree of attention to the selection of the goods, i.e. in relation to confectionery, chocolate, chocolate-based products and cereal bars. These goods are not similar to the sauces and syrups for which there is enhanced distinctiveness (my view is that there is no overlap in any material factor other than users), so the position must be considered based on the inherent distinctiveness of the earlier marks. These are among those goods for which "COOKIE" is not descriptive. The unexpected use of an element distinctive for these goods is, taking the level of similarity between the marks in conjunction with the very low inherent distinctiveness of the earlier mark, sufficient to avoid confusion even where there is a low degree of attention. There is no likelihood of direct confusion in respect of the '120 mark.

95. The opponent's position is no stronger based on the '340 mark. A greater number of the goods are identical but the marks are less similar and the common elements are very low in distinctiveness. The differences between the marks are sufficient to avoid a likelihood of direct confusion.

96. Several examples of alleged actual confusion are in evidence.<sup>30</sup> I must consider whether these disturb my initial conclusion that there is no likelihood of confusion. Five examples are provided where biscuits bearing the contested mark have been tagged with the @skinnyfoodco handle. None is dated; one indicates it was posted 20h before the image was taken. The evidence also includes an exchange with an individual who has shared an image of goods bearing the applicant's mark on an unspecified forum. When asked if they were aware that these were not the opponent's goods, the response was "No I assumed these were yours just like the sauces [emoji] sorry!". A further exchange is shown below:

---

<sup>30</sup> JW15, WS6.

[CD]: I bloody well hope so... I only bought them in Asda because I thought they were

[Mr Starkey]: these are not ours [CD]

[CD]: Oh no! Huh? Who on earth's are they then? They are ripping you off then!

[CD]: I am so sorry for buying the wrong product. I was trying to help [emoji]

[CD]: Just tried those other cookies. Not nice. Would much rather have one decent cookie or biscuit that tastes good!".

97. There is also an exchange dated 23 February 2022 between Mr Starkey and a manager for Wigan Warriors, by this point sponsored by the opponent.<sup>31</sup> It appears that the applicant's goods had been used in a club video by mistake. The explanation given to Mr Starkey is that "it was a last-minute dash to the supermarket as our Skinny Foods parcel didn't arrive [...] I assumed they were Skinny Food Co. products as the branding was so similar".

98. Whilst it is clear that individuals have tagged the opponent company when commenting on the applicant's goods, what is not clear is how representative these mistakes are of the average consumer's response. In particular, it is not clear whether these mistakes were made with the characteristics of reasonable circumspection and observation which must be accorded to the average consumer, and indeed the "greater degree of discrimination" which one can reasonably expect from the public where the components of a given trade mark are non-distinctive. One of the commenters explicitly says that they assumed it was the same company that produces the sauces— but sauces and biscuits are dissimilar goods and the opponent is not, on the evidence before me, likely to benefit from the type of large reputation which may lead to confusion where the goods are not similar, calling into question the reasonableness of the commenter's assumption. The above are all mistakes where any confusion was related not to the purchasing act but the identification of a company on social media. There are two

---

<sup>31</sup> Reports of the sponsorship deals are at SS-13.

examples where the applicant's biscuits appear to have been bought under the mistaken impression that they were the goods of the opponent. However, the first gives no details of why the consumer thought that the biscuits were the opponent's goods. As in the example above, it may have been an assumption, in my view unreasonable, that the opponent as producer of sauces was also manufacturing biscuits. There is simply no way to know. The other was made as part of a "last-minute dash to the supermarket". The same criticism can be made of this evidence, in that there is no way to know what prompted the customer to think that the opponent was manufacturing biscuits. The "last minute dash" also suggests that a lower degree of attention was paid than might have been expected, though I acknowledge that the buyer was deliberately looking for the opponent's goods and was still mistaken. However, as has been said, where a trader adopts a largely descriptive mark, some risk of confusion is inevitable and must be tolerated. The handful of examples are insufficient evidence of relevant confusion based on the similarity between the trade marks, as distinct from confusion arising from the common non-distinctive elements.

99. I have so far considered only direct confusion. Indirect confusion is also relied upon. This can be shortly dealt with. I see no reasonable basis on which the consumer would be induced to believe that the earlier trade marks had changed to "THE SKINNY COOKIE CO" (fig.), or vice versa, when the distinctiveness rests in the combination of the elements "THE SKINNY FOOD CO" to identify one undertaking operating under that name. It is most unlikely that the consumer would recognise the differences between the marks at issue and think that the same company was using two different brands featuring different company names. On the contrary, on noticing the differences the average consumer is likely to believe that the common inclusion of "THE SKINNY [...] CO" is a coincidental choice of descriptive/allusive words by unrelated undertakings. There is no likelihood of indirect confusion.

100. The opposition based upon s. 5(2)(b) is dismissed.

#### **Section 5(4)(a)**

101. 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, or

(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”.

102. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a deputy Judge of the High Court, 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”.

103. Although it appears that there has been some use of the contested mark, there is no claim to and no evidence of any use prior to the relevant date. Consequently, the relevant date for the assessment is the filing date, i.e. 8 February 2021.<sup>32</sup>

### Goodwill

104. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described as follows:

---

<sup>32</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11.

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

105. Goodwill which is protectable under the law of passing off must be more than trivial: *Hart v Relentless Records* [2002] EWHC 1984 (Ch).

106. The claim, I remind myself, is to goodwill in respect of sauces, syrups, cookies, cookie mixes, flapjacks, muffins, bread, food bars and coffee syrups. The applicant accepts that goodwill subsists in the figurative sign relied upon but denies that there is goodwill in the word sign, or in the alternative says that any goodwill is modest. Mr Tritton submitted that any goodwill is limited to syrups.

107. For the reasons given at paragraph 77, above, I am satisfied that the opponent had at the relevant date a reasonable goodwill in connection with its business in the provision of syrups and sauces [condiments]. There is no evidence, other than Mr Whiting’s unsupported assertion, that the opponent had by the relevant date sold cookies, flapjacks, muffins or bread. The documentary evidence relating to cookie mixes and food bars is undated but Mr Whiting’s evidence that these goods were sold before the relevant date has not been challenged. The food bar shown in evidence does not bear either of the signs relied upon but I infer that it would, like the rest of the opponent’s goods, have been sold on the opponent’s website and the use of the word “skinny” in the same stylised form as in the figurative sign connects the food bar with the opponent’s business. In view of the reasonable turnover figures, I am prepared to find that the goodwill extended to cookie mixes and low sugar food bars, though any goodwill in relation to these goods was modest.

108. I agree with Mr Tritton that most of the use shown is of the figurative sign. However, there is word-only use of “The Skinny Food Co” on the website. Further, whilst the words “The Skinny Food Co” are not, for the reasons elaborated above, particularly distinctive, they are more distinctive than the typeface, including the halo which replaces the dot over

the “i” and the stars, which will be perceived as decorative. I am satisfied that the relevant public would perceive both the words alone and the figurative sign as distinctive of the opponent.

### Misrepresentation

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

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

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

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

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion”.

110. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“[...] 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”.

111. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison LJ had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

112. I have already found that there would be no confusion even where identical goods are in issue. The business in which there is goodwill is more limited than the specifications of the registered marks and is concentrated in sauces and syrups. However, even where the goods are identical, the same reasons apply to misrepresentation as they did for confusion: the relevant public will not be deceived, because they will understand that many companies wish to use descriptive or highly allusive terms and will adjust their expectations accordingly, perceiving common non-distinctive elements in the mark and word sign as coincidental choices by independent companies. The position is weaker for the figurative sign, because the stylisation makes a contribution and adds a further point of difference with the contested mark. I recognise that there is some evidence of confusion but as I have explained it is not compelling and, even if some members of the relevant



public are deceived, they are in insufficient numbers to persuade me that a substantial number of the relevant public would be so deceived. There is no misrepresentation. The opposition based upon s. 5(4)(a) fails.

### **Conclusion**

113. The opposition has failed. The application will proceed to registration for all of the goods in its specification.

### **Costs**

114. The applicant has been successful and is entitled to an award of costs. It seeks costs on the usual scale, which is contained in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Considering the notice of opposition and filing the counterstatement:	£400
Preparing evidence and considering the other party's evidence:	£800
Preparing for and attending the hearing:	£800
Total:	£2,000

**Dated this 9<sup>th</sup> day of August 2022**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**

## APPENDIX

### UK 3240120

Class 5: Nutritional supplements; dietetic foods for use in clinical nutrition; slimming pills. Dietary food supplements; nutritional supplements; mineral food-supplements; food-supplements based on vitamins; minerals and raw products from plants; health food supplements; vitamin preparations; dietetic foods and substances adapted for medical purposes; slimming aids; herbal supplements and herbal extracts; herbal beverages; detox beverages; meal replacement powders; nutritional drink mixes for use as a meal replacement; mineral supplements; nutritional powders; food supplements, tablets and capsules; carbohydrate supplements; amino acid supplements; dietetic and slimming substances; Protein Dietary supplements, for slimming purposes; dietetic sweetening syrup for slimming purposes.

Class 29: Meat, poultry: game, fish and seafood; products made principally of meat, poultry: game: fish or seafood; preserved: frozen: dried and cooked fruits and vegetables and food products prepared there from; salads: fruit salads: soup and soup preparations; processed nuts; spreads; dips; crisps; jellies: jams: eggs: milk and dairy products; butter; peanut butter; milk shakes; powdered milk; liquid food shakes; cheese and cheese products; edible oils and fats; preserves; pickles; prepared meals; nutrition food bars; products containing food supplements for sports nutrition purposes, whey proteins; milk, soya milk; vegetable protein foodstuff.

Class 30: Preparations made from cereals; flour; preparations made from flour; sandwiches; confectionery; confectionery bars; cookies; bread; pastry; ices; ice cream; preparations for making ices, ice cream, ice cream products and frozen confections; chocolate; products made or containing chocolate; flapjacks; shortbreads; honey and treacle; sugar; puddings; cheese cake; sauces; chutneys; tea products; all tea and coffee beverages; herbal infusions; herbal teas; Tea leaves; Tea mixtures; Tea essences; Tea extracts; Green tea; Herbal Teas; Herbal teas [infusions]; Tea-based beverages with fruit flavourings. Cocoa-based beverages; Flavourings, other than essential oils, for

beverages; Coffee; Artificial coffee; Vegetal preparations for use as coffee substitutes; Coffee flavorings [flavourings]; Coffee based drinks; Cocoa; Cocoa products; Cocoa-based beverages; Cookies; Brownies; Muffins Candy; Buns; Petit-beurre biscuits; Candy; flavouring syrups; food flavourings; none of the aforesaid being popcorn or snack foods containing or consisting of popcorn.

#### **UK 3444340**

Class 29: Nutritional and dietary meal replacement beverages; meal replacement bars; foods and edible preparations; for use in reducing weight; water and milk-based products for food; water and milk based beverages; nutritionally balanced low-calorie meals and dishes; calorie-counted meals and dishes. Meat, poultry: game, fish and seafood; products made principally of meat, poultry: game: fish or seafood; preserved: frozen: dried and cooked fruits and vegetables and food products prepared there from; salads: fruit salads: soup and soup preparations; processed nuts; spreads; dips; crisps; jellies: jams: eggs: milk and dairy products; butter; peanut butter; milk shakes; powdered milk; liquid food shakes; cheese and cheese products; edible oils and fats; preserves; pickles; prepared meals; nutrition food bars; products containing food supplements for sports nutrition purposes, whey proteins; milk, soya milk; vegetable protein foodstuff.

Class 30: Preparations made from cereals; flour; preparations made from flour; sandwiches; confectionery; confectionery bars; cookies; bread; pastries; ices; ice cream; preparations for making ices, ice cream, ice cream products and frozen confections; coffee and chocolate; products made or containing coffee and chocolate; flapjacks; shortbreads; honey and treacle; sugar; puddings; chocolate spreads; cheese cake; cooking sauces; zero calorie sauces; prepared meals, zero calorie dips, low calorie dips, low sugar dips, chutneys; tea products; all tea and coffee beverages; herbal infusions; herbal teas; Coffee; Artificial coffee; Vegetal preparations for use as coffee substitutes; Coffee flavourings; Coffee based drinks; Prepared coffee and coffee-based beverages; Coffee concentrates; Mixtures of coffee; Coffee [roasted, powdered, granulated, or in drinks]; Coffee based drinks; Coffee; Ground coffee; Ground coffee beans; Cappuccino. Coffee based beverages for nutritional and dietary purposes. Coffee with added vitamins,

Cookies; Candy; Buns; Petit-beurre biscuits; Candy; flavouring syrups; food flavourings, Bakery goods; Beverages based on chocolate; Beverages based on coffee; Beverages based on tea; Beverages (Chocolate-based); Beverages (Cocoa-based); Beverages (Coffee-based); Beverages consisting principally of chocolate; Beverages consisting principally of cocoa; Beverages consisting principally of coffee; Beverages made from chocolate; Beverages made from cocoa; Beverages made from coffee; Beverages made of coffee; Beverages made of tea; Beverages with a coffee base; Beverages with coffee base; Biscuits; Breakfast cake; Breakfast cereals; Cake preparations; Cakes; Cereal-based snack food; Cereals; Chocolate Spread; Chocolate bars; Chocolate beverages; Chocolate cakes; Chocolate coffee; Chocolate covered cakes; Aerated beverages [with coffee, cocoa or chocolate base]; Aerated drinks [with coffee, cocoa or chocolate base]; Beverages (Coffee-based); Beverages based on coffee; Beverages based on coffee substitutes; Beverages consisting principally of coffee; Beverages made from coffee; Beverages made of coffee; Beverages with a coffee base; Beverages with coffee base; Caffeine-free coffee; Chocolate coffee; Flavoured coffee; Ground coffee; Ground coffee beans; Instant coffee; Mixtures of coffee; Mixtures of malt coffee with cocoa; Mixtures of malt coffee with coffee; Coffee (Unroasted); Coffee [roasted, powdered, granulated, or in drinks]; Coffee bags; Coffee based beverages; Coffee based drinks; Coffee based fillings; Coffee beans; Coffee beverages; Coffee beverages with milk; Coffee capsules; Coffee concentrates; Coffee drinks; Coffee essence.