

O/0216/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3641826 AND 3641835

IN THE NAME OF YOLK LONDON LTD

FOR THE TRADE MARKS

YOLK

AND

YOLK DELIVERY

IN CLASSES 9, 35, 39 AND 45

AND

THE OPPOSITION THERETO UNDER NUMBERS 432194 AND 432195

BY IN ONE BASKET LTD

Background

1. This decision concerns the oppositions to two trade mark applications filed by Yolk London Ltd (“the applicant”). The first of these, number 3641826, is for the mark YOLK. The second application, number 3641835, is for the mark YOLK DELIVERY. Both applications have been made for the same list of goods and services in classes 9, 35, 39 and 45 and both applications were filed on 14 May 2021.

2. The applications were published on 21 January 2022 and were partially opposed by In One Basket Ltd (“the opponent”) under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). I will say more about the extent of the oppositions later in this decision. The opponent relies upon the following earlier trade mark registration for its section 5(2)(a), 5(2)(b) and 5(3) grounds to oppose some of the goods and services in classes 9, 35 and 39 of the applications (there is no opposition against the class 45 services):

3194049

Yolk

Filing date: 31 October 2016; registration date: 20 January 2017.

Class 43: *Takeaway services.*

3. Under sections 5(2)(a) and 5(2)(b) of the Act, the opponent claims that some of the applicant’s goods and services in classes 9, 35 and 39 are similar to its own services because they are commonly provided by the same undertakings and are complementary.¹ The opponent claims that the marks are identical and highly similar. It claims that these factors and the distinctiveness of its mark through the use made of it leads to a likelihood of confusion.

¹ Section 5(2)(a) is directed at the first application and section 5(2)(b) at the second application.

4. Under section 5(3) of the Act, the opponent claims that its reputation in its mark is such that the relevant public will believe that the parties' marks are used by the same undertaking or an economically linked undertaking. I will say more about the section 5(3) pleadings later in this decision.

5. Under section 5(4)(a) of the Act, the opponent claims that it has used the sign *Yolk* since 2014 in relation to *restaurant, takeaway and delivery services*. The opponent claims that its goodwill in the business distinguished by its sign entitles it to prevent the use of the application for some of the goods and services in classes 9, 35 and 39 under the law of passing off.

6. The applicant filed defences and counterstatements, denying the grounds of opposition. It requests that the opponent prove that it has made genuine use of its mark. As the earlier mark had been registered for less than five years at the application dates, there is no legal basis for this request.²

7. At this point, the two sets of proceedings were consolidated. The opponent is professionally represented by Trademark Eagle Limited. The applicant is professionally represented by Trade Mark Wizards Limited. The (identical) defences and counterstatements comprise the only documentation filed by the applicant. The opponent filed evidence and written submissions in lieu of a hearing, neither party having requested a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Evidence

8. The opponent has filed evidence from Nick Philpot, a Director of the opponent.³ His evidence is aimed at showing the use that has been made of the earlier mark leading to accrual of reputation and goodwill. Mr Philpot's evidence includes detail concerning the applicant's use of its marks and what he describes as evidence of actual confusion between the parties' marks.

² See section 6A of the Act.

³ Witness statement dated 18 August 2022 and exhibits.

Relevant dates

9. I note that some of the evidence relates to use of the earlier mark and events after the date on which the applications were filed. Unless the evidence casts light on matters prior to the application date, it is unlikely to assist the opponent because the relevant date for assessing the merits of the oppositions under sections 5(2)(a), 5(2)(b) and 5(3) of the Act is the date on which the applications were filed: 14 May 2021. I will deal with the relevant date for the section 5(4)(a) ground later in this decision.

Sections 5(2)(a) and (b) of the Act

10. Section 5(2) states:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

11. Section 5A states:

“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.”⁴

⁴ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

12. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act, several of which also apply to section 5(2)(a), are taken from the decisions of the CJEU 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.⁵

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

⁵ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

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

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the 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.”

14. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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.”

16. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They

should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.⁶

18. I note that in its written submissions in lieu of a hearing, the opponent said:

“5. The grounds of opposition are section 5(2)(a) and (b), 5(3) and 5(4)(a) of The Act in relation to all the goods and services listed classes, [sic] 9, 35, 39 of the contested Applications.”

19. That is incorrect. The full list of goods and services applied for is reproduced in the annex to this decision. The list of goods and services which were set out in Annex 3 to the opponent’s notices of opposition does not cover all the applied-for goods and services.

20. I note from the official file that the opponent filed two versions of its forms TM7 (notice of opposition) on 25 March 2022. The first attached an upside down version of its Annex 3 and the second attached Annex 3 the right way up. There was also an erroneous statement of use made in respect of the earlier mark. The Tribunal served the notices of opposition against the contested applications on 30 March 2022, saying:

⁶ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

“Extent of opposition

It is also noted that at paragraph 32 of your statement of grounds, you have stated that "the opponent would be entitled to prevent the use of the applicant's mark in relation to all the goods covered by the application" – However, within the form TM7 and at the final paragraph of the statement of grounds, you have confirmed that the opposition is only aimed at some goods and services covered by the application, namely those identified in Annex 3 in Classes 9, 35 & 39.

If you wished the opposition to be aimed at all goods and services covered by the application, this should have been clearly indicated in the form TM7 and statement of grounds.

It is therefore understood that the opposition is only aimed at the goods and services identified in Annex 3 in Classes 9, 35 & 39.

You are invited to clarify this point should you wish.”

21. Paragraph 32 of the original statements of case concerned the ground of opposition under section 5(3) of the Act and said:

“32. Additionally, or alternatively, because the Opponent’s Trade Mark has a reputation, the Opponent would be entitled to prevent the use of the Applicant’s Mark[s] in relation to all the goods covered by the Application.”

22. The day after the Tribunal sent its letter, serving the notices of opposition, the opponent filed further forms TM7. The statement of use was rectified. At the relevant places in the forms TM7 where the opponent is asked to say which goods and/or services in the applications it opposes under each of the grounds, the response was “Please see Annex 3 attached”. Paragraph 4 of the statements of case says:

“The opposition is directed against some of the goods and some of the services listed in classes 9, 35 and 39 of the Application.”

23. Paragraph 10 makes a comparison of the opponent's services with the applicant's goods and services as set out in Annex 3 to the notices of opposition. Paragraph 32, which was the paragraph highlighted by the Tribunal in its letter of 30 March 2022, was amended to read:

“32. Additionally, or alternatively, because the Opponent's Trade Mark has a reputation, the Opponent would be entitled to prevent the use of the applicant's mark in relation to all the goods and services in classes 9, 35, 39 listed in the Application upon which this Opposition is based.”

24. The upshot is that the notices of opposition still referred to Annex 3 to those notices as the pleadings, i.e. Annex 3 provided the specific list of goods and services which were opposed under all three grounds of opposition. An extract is shown below, in relation to the section 5(3) pleading against the first application:

Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?

<input type="checkbox"/>	All goods and services
<input checked="" type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>
Please see Annex 3 attached.	

25. I have checked the Intellectual Property Office's internal mail archive and the amended forms TM7 and statements of grounds which were filed on 31 March 2022. I am satisfied that attached to the opponent's email were the amended forms TM7 and the amended statements of grounds. There was no additional Annex 3. Therefore, there is only one version of Annex 3, which was firstly filed upside down and then the right way up on 25 March 2022.

26. Despite the conflicting paragraph 32, it is the notices of opposition that set out the extent of the oppositions. There is no requirement for statements of case because the various boxes on form TM7 provide the means for setting out the scope of an opposition.⁷ Where there is not enough room, parties may refer to attachments. In the present proceedings, the opponent referred to Annex 3 to its forms TM7 as providing the list of goods and services which were opposed. This is what the applicant was entitled to regard as the case it had to answer if it chose to file defences.

27. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Demon Ale Trade Mark* [2000] R.P.C. 345, at 357:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do.”

28. It is a fundamental principle of natural justice that a party should know what the case is that it has to answer. Form TM7 has been designed for all the information to be contained within the form or for attachments to be referred to, if more space is needed. It is unacceptable to create uncertainty by including conflicting material in a statement of case, which is not part of the statutory form. Furthermore, the opponent cannot expand the scope of its opposition by inserting a wider claim in its written submissions in lieu of a hearing, at the end of the proceedings, without a proper application for such an expansion to be considered. The opponent had an opportunity to review its pleadings following the Tribunal's letter of 30 March 2022. I will only consider the oppositions as having been filed against the list of goods and services which the opponent has specified in its notices of opposition, as referred to in Annex 3 to those notices. This list was repeated in its comparison of goods and services for the purposes of section 5(2)(a) and 5(2)(b) within its statements of case.

⁷ See the decision of Phillip Johnson, sitting as the Appointed Person, in *Delta Air Lines, Inc v Ontro Limited*, BL O/044/21, at paragraph 22.

29. The opponent's services to be compared with the opposed goods and services are *takeaway services*, in Class 43. The goods which are opposed in class 9 are specified in Annex 3 to the opponent's notices of opposition, and also compared with its services within its statements of case. The list of goods is repetitive. I have split it into four main groups, as shown below, followed by a final list of goods which are not repeated elsewhere. I have numbered the groups:

1) apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects;

2) apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food;

3) computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating,

controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food;

4) computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food;

5) downloadable computer software to allow users to receive and process orders via a global computer network; downloadable publications; downloadable menus; downloadable catalogues; downloadable recipe books; electronic and downloadable vouchers and coupons; e-coded loyalty cards.

30. Group 2 is a subset of group 1, being virtually the same apart from a positive limitation that the apparatus, instruments and devices are for projects in relation to delivery of food, as opposed to projects at large.⁸ Group 4 is identically worded to the list of goods in group 3.

31. There are manifest differences in nature, purpose and method of use between the opponent's services and the opposed goods in class 9.

32. *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, concerned the comparison between the applicant for cancellation's goods and services in class 9 and 42, which were 'Computer software for the production of platform-independent internet shops and internet authoring systems chiefly for the reservation, booking and payment of

⁸ I note that 'cleansing' appears in the fourth line of group 1, but is absent from group 2.

accommodation'; and 'Development and design of computer software, namely for internet shops and internet authoring systems, especially for the reservation, booking and payment of accommodation', and the registered proprietor's services in classes 39 and 42, which were 'Information services relating to transportation services, including information services provided on-line from a computer database or the internet; travel reservation and travel booking services provided by means of the world wide web'; and 'Computerised hotel reservation services'. The Board of Appeal had agreed with the Cancellation Division at OHIM that the parties' goods and services were not similar and, therefore, despite the parties' signs being identical (EASYHOTEL), there was no likelihood of confusion. The applicant for cancellation appealed and the GC stated in its judgment:

"49 In addition, the Board of Appeal examined whether the goods and services concerned may be complementary. According to its findings, complementarity had to be excluded in the present case since the public at large, for which the services covered by the mark at issue are intended, does not purchase the relevant goods and services covered by the earlier mark, which are exclusively intended for businesses which, subsequently, provide services to the public at large.

50 Finally, the Board of Appeal found, in the same context, that users of the internet who purchase travel services on-line are not likely to be aware of who provided the software that allows an internet shop to operate and are, in any event, able to distinguish between a company that provides sophisticated technology and another company that sells travel services via the internet.

51 Those findings must be upheld. They show, to the requisite legal standard, that the goods and services concerned differ in respect of their nature, intended purpose and method of use and are neither in competition with each other nor complementary. First of all, the relevant goods and services covered by the earlier trade mark are computer-related whereas the information, booking and reservation services covered by the mark at issue are different and use

computer technology only to support the transmission of information or to make it possible to reserve hotel accommodation or travel.

52 Further, the relevant goods and services covered by the earlier trade mark are especially intended for businesses in the hotel and travel sector, and the information, booking and reservation services covered by the trade mark at issue are intended for the public at large.

53 In addition, the relevant goods and services covered by the earlier mark are used to enable a software system, and, more specifically, an internet shop, to function, whereas the information, booking and reservation services covered by the trade mark at issue are used to reserve hotel accommodation or travel.

54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where 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 consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.

59 Although it accepts that the end users of the goods and services concerned are different, the applicant maintains that a likelihood of confusion cannot be ruled out in the present case since the relevant goods and services covered by the earlier mark have the sole purpose of making it possible to provide the information, booking and reservation services covered by the mark at issue. As a general rule, the public concerned by those services does not know who developed the necessary software and likewise cannot distinguish between the information on the intervener's website which comes from the intervener itself and that which derives from the software or services provided by an undertaking

specialised in computing, such as the applicant. In short, on the intervener's website the services covered by the mark at issue are indissociable from the relevant goods and services covered by the earlier mark.

60 That argument cannot be accepted. The commercial origin of the software and the computer services which enable the intervener's website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener's website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61 If, however, some of the intervener's customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener's website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62 The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and

services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned.”

33. Computer software is used in every part of modern life. This does not automatically make computer software similar to the services which use computer software to operate. If the average consumer for an undertaking is the general public, that average consumer is not likely to be interested in what software the undertaking uses and would not consider there to be a link between them. Whether there is complementarity depends on the facts of the case and the identity of the relevant public.

34. I consider that the goods in groups 1 and 2 do not cover software and that the goods are intended for businesses, not for the general public, which comprises the public for the opponent’s services. Taking into account the guidance in *Commercy*, the listed apparatus, instruments and devices are not complementary to takeaway devices, even those for food delivery. They are not in competition. There are no shared channels of trade. The goods in groups 1 and 2 are not similar to the opponents’ services.

35. The relevant date in *Commercy* was 21 September 2000. At that time, mobile ‘apps’ were not prevalent, if in use at all. By the relevant date in these proceedings, apps had become pervasive. Takeaway outlets provide apps to enable food orders to be made for collection or delivery. Such apps will be aimed at the same consumers as the takeaway service itself. The trade channels and users are the same and such apps are complementary to the food service. Apps are a type of software. For the reasons given in *Commercy*, there is no similarity between software in relation to the delivery of food unless the software is a mobile app because it is only the latter type of software which shares the same relevant public or average consumer with the opponent’s services. Other types of software for delivery of food will be used by the business and are not similar.

36. The question which I need to consider is whether the opposed goods in identically worded groups 3 and 4 cover apps and, if they do, whether such apps are similar to the opponent's services.

37. The list starts with 'computer software' and then goes on to specify what the software is for. The specification is poorly constructed, in that "in relation to the delivery of food" is preceded by a comma, rather than a semi-colon, making it less clear as to what has been the subject of the positive limitation. Making the best of it, the positive limitation applies to all the uses of the computer software. It is not clear to me that an app provided by a takeaway business would provide all the functions listed. However I find that the app would be complementary, share trade channels and users in relation to the following functions:

computer software for use in registering, creating, managing, sharing, supplying, transmitting, exchanging, reading, identifying, organising, viewing, calculating, tracking, generating, mapping, scheduling, dispatching, updating, maintaining, displaying, and processing data, information, in relation to the delivery of food.

38. The goods listed immediately above are similar to a medium degree to the opponent's services. There is no similarity between the opponent's services and the following goods in groups 3 and 4:

computer software for use in collecting, compiling, storing, summarising, transcribing, interpreting, cleansing, consolidating, engineering, projecting, forecasting, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, operating, controlling, planning, reporting, monitoring, systemising, settling, analytics, graphics, projects in relation to the delivery of food;

39. The last group of goods (group 5) is:

downloadable computer software to allow users to receive and process orders via a global computer network; downloadable publications; downloadable menus; downloadable catalogues; downloadable recipe books; electronic and downloadable vouchers and coupons; e-coded loyalty cards.

40. The applicant's "downloadable computer software to allow users to receive and process orders via a global computer network" makes a specific reference to the users and what they will use it for. The users of the software are those receiving and processing orders: i.e. a business. For the reasons given above, and taking into account the guidance in *Commercy*, the goods are not similar to the opponents' services.

41. The applicant's downloadable menus are similar to a medium degree with the opponent's services. This is because menus are integral to a takeaway business, enabling customers to see what is on offer and to make orders. The users are the same, the channels of trade identical and they are complementary. "Downloadable publications" includes downloadable menus are therefore similar on the same basis. I do not think the same analysis applies to downloadable catalogues. The natural meaning of a catalogue is a list or brochures showing items. This is not the same as a menu. Takeaway businesses do not provide catalogues for their customers. Downloadable catalogues are not similar to the opponent's services.

42. Although downloadable recipe books have food as their subject matter, that does not make them similar to takeaway services. They do not share nature, purpose or method of use. It would be counter-intuitive for a business aimed at selling its cooked food to takeaway to sell recipes so that consumers cook their own food instead of buying a takeaway. The goods are not complementary and there is no meaningful level of competition. The goods are not similar to the opponent's services.

43. Electronic and downloadable vouchers and coupons; e-coded loyalty cards are similar to a medium degree to the opponent's services. They are not limited and so could be for use in a takeaway business. Obtaining a voucher, coupon or loyalty card from the takeaway will mean the trade channels are shared. They are complementary

because consumers will expect the responsibility for vouchers, coupons and loyalty cards for use in a particular takeaway outlet to lie with the takeaway outlet.

44. The opposed services in class 35 are:

Retail and online retail services in relation to the sale of apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects, apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information, computers, computer software, computer software for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects, computer software for use in collecting, compiling, storing,

registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food; computer software, computer hardware, mobile applications, network software, computer operating programs, firmware, computer software for engaging and coordinating delivery services, order tracking software, computer software applications relating to the sale, order and delivery of groceries, computer software applications relating to the sale, order and delivery of restaurant and take-away restaurant meals, computer software for engaging and coordinating transportation services, computer software for engaging and coordinating delivery services, computer software enabling businesses in the food and beverage industry to better organise their business, computer software enabling food and beverage manufacturers, producers, distributors, wholesalers, retailers, restaurant and bar owners [including businesses in hospitality, tourism and event management], to manage their commercial, sales, purchasing, marketing, financial, legal, compliance, human resources, medical, safety, transportation, logistics, bookings, events and technical information, computer software enabling food manufacturers and restaurant owners to reduce formulation and development costs and to improve the quality of their data, computer software for the hospitality industry for ordering food and drinks, tableside ordering, table and floor management, placing reservations and bookings, payment management, cash registers, e-receipts, discounts, staff management, menu management to set and modify menus, nutritional analysis, information on allergies, stock and inventory management and to manage multiple locations, smartphone app for arranging the delivery of food and drinks, electronic point of sale (epos) systems, multi-functional electronic and digital devices for displaying, measuring, loading and transmitting information and personalized recommendations and scores related to exercise, health, well-being, physiological condition, nutrition, meal delivery services and diet, computer hardware, sensors, integrated circuits and modules, application programming interfaces (APIs), measuring, signalling, regulating and control devices,

and security devices for storage systems, data processing apparatus and appliances for management of stocks, recorded computer programmes for management of stocks, electronically controlled apparatus and instruments, namely, computerised storage and retrieval apparatus and instruments for use in the warehousing of goods, scanners, boxes and containers adapted for use with the aforementioned goods, downloadable computer software to allow users to receive and process orders via a global computer network, downloadable publications, downloadable menus, downloadable catalogues, downloadable recipe books, electronic and downloadable vouchers and coupons, e-coded loyalty cards.

45. The opposed services begin with “Retail and online retail services in relation to the sale of...”. Most of the subjects of the said retail and online retail services are the goods which are opposed under class 9. If the goods themselves are not similar to takeaway services, the retail of the class 9 goods, being a step further removed, is also not similar. For the reasons given in the comparison of the class 9 goods, I will make a comparison between the opponent’s services and the following services:

Retail and online retail services in relation to the sale of computer software applications relating to the sale, order and delivery of restaurant and take-away restaurant meals, computer software for the hospitality industry for ordering food and drinks, tableside ordering, table and floor management, placing reservations and bookings, payment management, smartphone app for arranging the delivery of food and drinks, downloadable publications, downloadable menus, electronic and downloadable vouchers and coupons, e-coded loyalty cards.

46. In *Tony Van Gulck v Wasabi Frog Ltd* (“Miss Boo”), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, cautioned that “selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35”.⁹ The objective of retail services, as set out in *Oakley*, “includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction” and “those services play, from the point of view of the relevant

⁹ BL O/391/14.

consumer, an important role when he comes to buy the goods offered for sale.” On the basis of the European courts’ judgments in *Sanco SA v OHIM*, and *Assembled Investments (Proprietary) Ltd v. OHIM*, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, Mr Hobbs concluded that: ¹⁰

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

47. Point (iii) has particular relevance to the present case. My finding of a degree of similarity between the opponent’s services and certain goods in class 9 does not mean that there is similarity between the opponent’s services and the retail of those goods. I am not comparing goods against services. It seems to me that the relevant average consumer for retail of apps would be a business seeking to purchase an app that its customers can then use to order food. The consumers are different. I can see no meaningful level of similarity within the parameters of the caselaw for section 5(2)(a)

¹⁰ Case C-411/13P; Case T-105/05, at paragraphs [30] to [35] of the judgment; and, Case C-398/07P.

and (b) between takeaway services and the specific retail services for apps in paragraph 45.

48. Again, the construction of the applicant's specification is less than clear. I do not think that downloadable publications, downloadable menus, electronic and downloadable vouchers and coupons, e-coded loyalty cards are the subjects of the retail of apps; I think it more likely that the specification covers the retail of downloadable publications, downloadable menus, electronic and downloadable vouchers and coupons and e-coded loyalty cards. I cannot see that the same consumers for a takeaway will buy downloadable menus or publications: these will be bought by the takeaway business for use in its takeaway. These are not similar. However, a takeaway could provide a retail service in relation to vouchers, coupons and e-coded loyalty cards. These are similar to a medium degree.

49. The opposed services in class 39 are:

Transportation services; delivery, collection, transport, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals; takeaway delivery services; delivery of semi-prepared food products; tracking and tracing of shipments; providing information regarding food and beverage delivery via a website on global computer networks; packing of food; packaging of food; frozen food storage services; delivery of customized gift boxes; tracking and tracing of shipments; distribution services; transportation information; delivery of goods, namely food products, prepared and semi-prepared food products, including in pre-portioned form, for enabling meals to be cooked according to specific recipes; delivery of recipe kits; storage information; provision of information, advisory and consultancy services in relation to the aforesaid services.

50. It is common for takeaways to provide a delivery service for their food to their local area, instead of customers attending the premises. There is overlap in trade channels

and there is complementarity. There is a medium degree of similarity between the opponent's services and the applicant's *transportation services; delivery, collection, transport, forwarding and courier services; food and drink delivery, collection, transport, forwarding and courier services; delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals; takeaway delivery services*. On the same basis, there is a medium degree of similarity with *collection, transport, delivery, forwarding and courier services relating to goods*, because goods includes takeaway food.

51. *Food and drink storage and storage information* does not appear to have anything in common with *takeaway services; nor does packing of food; packaging of food; frozen food storage services*. These services are not similar. There is no similarity between *collection, transport, delivery, forwarding and courier services relating to packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; delivery of customized gift boxes* and *takeaway services*.

52. A takeaway's website could have a facility for customers to track their online takeaway delivery order, which would entail the provision of *information regarding food and beverage delivery via a website on global computer networks*. There is a low degree of similarity between *transportation information, providing information regarding food and beverage delivery via a website on global computer networks* and *takeaway services* on the basis of shared channels of trade and users. On the same basis, there is a low degree of similarity between the opponent's services and the applicant's *provision of information*, where such information relates to the delivery services for which I find similarity. There is no similarity with *tracking and tracing of shipments* because the natural meaning of 'shipment' is not a takeaway. There is no similarity with *distribution services* because the natural meaning of these services is not the type of service that would deliver a takeaway. It denotes freight and logistics of larger scale supply services.

53. There is no similarity between *delivery of semi-prepared food products; delivery of goods, namely food products, prepared and semi-prepared food products, including in pre-portioned form, for enabling meals to be cooked according to specific recipes;*

delivery of recipe kits. Although the subject of the delivery service is food for the customer to cook themselves, the comparison is not between the subject goods and takeaway services: it is between the delivery of such goods and takeaway services. There is no meaningful level of similarity within the parameters of the caselaw for section 5(2)(a) and (b) between these services and takeaway services.

54. There is no similarity between takeaway services and the applicant's *advisory and consultancy services in relation to the aforesaid services*. The natural meaning of these terms in relation to the services which precede them means that they are business services, not services provided to takeaway customers.

The average consumer and the purchasing process

55. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."¹¹ 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*.

56. The average consumer for the goods and services which I have found to be similar is a member of the general public. They will pay an average degree of care and attention to the purchasing process. Purchases are likely to be made primarily visually, from a website, mobile app or the premises, although an aural aspect to selection may be present if phone calls are made to order a takeaway, or as a result of recommendations. Menus are meant to be looked at in order to make a meal choice, so these and vouchers will entail visual selection.

¹¹ *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).

Comparison of marks

57. The marks to be compared are:

The opponent's mark	The applicant's marks
Yolk	YOLK YOLK DELIVERY

58. The earlier mark is identical to the first application because the application is for the same word, YOLK, in block capitals which covers upper and lower case, as represented by the earlier mark.¹²

59. Turning to the comparison between the earlier mark and the second application, *Sabel BV v. Puma AG* 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 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.”

¹² “A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”: Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

60. 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.

61. The overall impression of the earlier mark resides in the single element of which it is composed. The later mark consists of two elements. YOLK will be read first. Although YOLK is shorter than DELIVERY, the latter is descriptive or at least allusive for the goods and services of the second application. Whilst the mark will be perceived as a whole, YOLK is the dominant and distinctive element of the mark and carries the most weight in the overall impression.

62. The common component, Yolk/YOLK is visually and aurally identical. It will be read first in the second application. Taking into account the additional word, DELIVERY, the marks are visually and aurally similar to a medium to high degree.

63. Yolk/YOLK is a common dictionary word meaning the yellow part of birds' eggs. DELIVERY is also a common dictionary word, meaning to hand over something, such as letters or goods. Yolk/YOLK will mean the same in both marks. Taking into account the additional 'delivery' concept, there is at least a medium degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

64. 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.¹³ I will begin by considering the inherent distinctive character of the earlier mark before considering the use that the opponent has made of its mark.

65. Yolk is a common dictionary word. Although it is a word for a part of an egg which is eaten, and is therefore food, it does not describe or allude to the opponent's services. One would not buy a takeaway consisting of egg yolk. As Yolk is a common word, it does not have the very highest level of distinctiveness, which is usually the

¹³ *Sabel BV v Puma AG*, Case C-251/95.

case for invented words, but its lack of descriptiveness for the services means that it has at least a medium level of inherent distinctiveness for takeaway services.

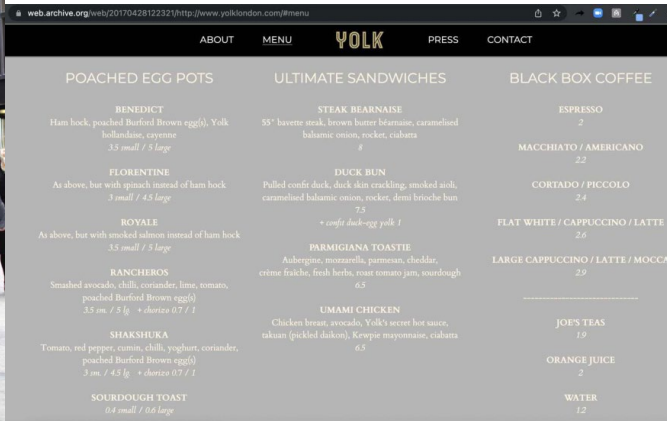
66. Distinctive character is a measure of how strongly the earlier mark identifies the services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

67. Mr Philpot states that the opponent began using YOLK in early 2014 in relation to takeaway food. From 2014 to 2017, the opponent ran pop-ups to test different menus and other aspects of its business. Mr Philpot states that the opponent served takeaway food from a portable YOLK-branded gazebo at street markets in London and at festivals. There is no information about where the festivals were, nor at how many London street markets it was based.

68. In 2017, the opponent opened a semi-permanent takeaway venue “in Broadgate” in a converted shipping container, serving takeaway food and food for delivery.¹⁴

¹⁴ Exhibits 6 and 7.



69. The opponent closed this venue in 2018, after about 15 months of continuous trade, and opened its first permanent YOLK site at “New St Square” (on a 10-year lease). A second permanent site was opened, in Broadgate, in 2019. Menus from these sites, dated November 2018 and November 2019, are shown at Exhibit 8. The addresses of the locations are given at the top of the menus. Broadgate is in London, at EC2M 2PP, and New Street Square is also in London, at EC4A 3BN.

70. Exhibit 17 comprises examples of the takeaway food packaging which Mr Philpot states has been used since 2017, such as:



71. Both sites were temporarily closed during the Covid-19 pandemic. Mr Philpot states that a third site was opened in Soho, in January 2022, and a fourth site in Canary Wharf in June 2022. The relevant date for sections 5(2)(a), 5(2)(b) and 5(3) is 14 May 2021.

72. Exhibit 5 comprises screenshots from the opponent's Facebook, Instagram and Twitter pages. The opponent joined Twitter in March 2014. The screenshots are dated 11 August 2022, fifteen months after the relevant date, showing 1187 followers on Twitter. On 11 August 2022, there were 576 Facebook followers, 560 'likes' and 36 reviews. The mark appeared as follows:



73. The opponent joined Instagram on 8 April 2014. There are no dates on the Instagram screenshots. The page says that the opponent has made 226 posts and has 3,765 followers. Since it contains text relating to Golden Square and Canary Wharf, which were opened in 2022, this evidence post-dates the relevant date. Four Facebook posts which pre-date the relevant date are shown in Exhibit 15. Screenshots from the opponent's website, using the Wayback Machine internet archive are shown in Exhibits 13 and 14, most of which are from before the relevant date. Exhibit 16 comprises reviews posted on Google by the opponent's customers. Although some post-date the relevant date, there are a several from each of the years prior to the relevant date, beginning with 2017, identified as "5 years ago", presuming the exhibit was compiled contemporaneously with Mr Philpot's witness statement. Press evidence about the opponent's business includes:

- Exhibit 18: an article in the Evening Standard, dated 20 March 2017, about the pop-ups moving to a permanent location in the City of London;
- Exhibit 19: an article from The Handbook from April 2017;
- Exhibit 20: an article from FOODISM, dated May 2017, about the opening of the opponent's Broadgate site;
- Exhibit 21: an interview with Mr Philpot by Out of Home Magazine in June 2017;
- Exhibit 22: a review of YOLK in the Londonist from 16 October 2017 and an article in Hot Dinners from September 2018.

74. The opponent has been offering its takeaway food for delivery since 2017. Mr Philpot states customers order directly from the opponent via its online ordering platform or via email and the opponent physically delivers the food itself. He gives an example order in Exhibit 28, placed by email on 12 February 2019. Screenshots of the opponent's online delivery platform are shown in Exhibit 29; however, Mr Philpot states that the platform was created in 2021. The relevant date is 14 May 2021. I note the screenshot refers to an order summary on "8 August", and the witness statement is dated 18 August 2022. It appears from an invoice dated 25 May 2021 from the platform developer that the platform was not operational prior to the relevant date.

75. Mr Philpot states that the opponent also uses third-party delivery services which include Deliveroo (to individual customers), and Caterwings, CityPantry and Feedr which deliver to large-scale corporate customers. Examples of a week's worth of Deliveroo orders from May 2018 are shown in Exhibit 25. A statement of orders delivered by CityPantry in July 2019 is shown in Exhibit 26; and similarly in relation to Caterwings in Exhibit 27, from March 2018.

76. Mr Philpot gives turnover and sales figures. Some of these post-date 14 May 2021. Of the figures which pre-date 14 May 2021, I note the following from the opponent's accounts in Exhibit 34, reproduced in Mr Philpot's witness statement:

January 2014 – January 2015 = £25,933

January 2015 – January 2016 = £54,474

January 2016 – January 2017 = £58,693

January 2017 – January 2018 = £317,751

January 2018 – January 2019 = £399,106

January 2019 – January 2020 = £825,862

January 2020 – December 2020 = £426,418 (impacted by Covid lockdowns)

77. Whilst showing a healthy increase in turnover, the opponent's trade has been localised to the central London/the City of London. The mark's inherent capacity to

distinguish the services will not have been made stronger for consumers outside of that area. Consequently, for consumers outside of London, the mark's inherent distinctiveness has not been enhanced. I find that the use is not sufficient to have a bearing on the likelihood of confusion amongst average consumers in the UK.

Likelihood of confusion

78. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. There is no likelihood of confusion in respect of goods and services which are not similar.¹⁵ The oppositions under sections 5(2)(a) and (b) therefore fail against the goods and services which I have found are not similar.

79. In respect of the first application, because the marks are identical, there is not a question of the average consumer imperfectly recalling the marks themselves. Whether there is a likelihood of confusion in respect of the first application turns upon other factors in the global assessment, including the interdependency principle, that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that the earlier mark has at least a medium level of distinctiveness. The parties' goods and services will be purchased with an average degree of attention, but no higher than that. There will be an assumption that the parties' goods and services are provided under the same mark by the same undertaking or, alternatively, an economically linked undertaking, for all of the goods and services which I have found to be similar; in short, mobile apps, menus, vouchers, loyalty cards, delivery services and information

¹⁵ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*: "22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

therefor, for a takeaway business.¹⁶ I find that the section 5(2)(a) ground succeeds against the first application to this extent.

80. The second application is not for an identical mark. The element which provides a point of difference between the marks is the word DELIVERY. This has very low or no distinctiveness for goods and services connected with takeaway services. DELIVERY may not be recalled by average consumers, who will recall the identical, dominant and distinctive element Yolk/YOLK. A likelihood of confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind.¹⁷ I find that, for the reasons given above, there will be direct confusion in relation to all of the goods and services which I have found to be similar. In case I am wrong about imperfect recollection, and the average consumer would note that the marks are different, I find that the marks will be indirectly confused. Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

“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”*.

¹⁶ See point (k) in paragraph 12 of this decision, referred to at paragraph 32 of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 and at paragraph 14 of *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207; [2021] ETMR 57.

¹⁷ *Lloyd Schuhfabrik Meyer*, at [26].

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).”

81. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.¹⁸ Arnold LJ said, of the explanation given about how indirect confusion arises in *LA Sugar*:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an

¹⁸ [2021] EWCA Civ 1207.

economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

82. Whilst the *LA Sugar* categories are non-exhaustive, I consider that category (b) is relevant to the present case. DELIVERY is a non-distinctive element added to the dominant and distinctive element Yolk/YOLK which provides the point of similarity. The assumption will be that the parties’ marks are brand variants, brand updates or indicate expansions to what goods and services are offered.

83. The opponent filed evidence intended to show that actual confusion has arisen between the parties’ marks because the applicant is providing delivery services for takeaway food. The instances of confusion took place after the trade mark applications had been filed. Having examined the evidence, it does not take the opponent any further forward than my findings on the basis of notional use, under sections 5(2)(a) and (b) of the Act.

Section 5(2(a) and (b) outcomes

84. The section 5(2)(a) and (b) grounds succeed in respect of:

Class 9: computer software for use in registering, creating, managing, sharing, supplying, transmitting, exchanging, reading, identifying, organising, viewing, calculating, tracking, generating, mapping, scheduling, dispatching, updating, maintaining, displaying, and processing data, information, in relation to the delivery of food; downloadable publications; downloadable menus; electronic and downloadable vouchers and coupons; e-coded loyalty cards.

Class 35: Retail and online retail services in relation to the sale of electronic and downloadable vouchers and coupons, e-coded loyalty cards.

Class 39: Transportation services; delivery, collection, transport, forwarding and courier services; food and drink delivery, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier

services relating to goods; delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals; takeaway delivery services; providing information regarding food and beverage delivery via a website on global computer networks; transportation information; provision of information in relation to the aforesaid services.

Section 5(3)

85. 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.

(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.”

86. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *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 on 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*).

87. Question 3 in the section of the form TM7 covering section 5(3) claims poses the following question: "Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?"

88. The opponent answered this question in the same way for both oppositions: by ticking the box 'yes'. This part of the opponent's pleadings is clearly based upon the proposition that there is a likelihood of confusion amongst the public in that the marks are used by the same or related undertakings. The next part of the form TM7 asks: "Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair." The opponent did not answer this question, nor the questions which followed about detriment to repute and distinctive character. Nor did the opponent insert anything in this part of the form, such as 'see the attached statement of case/grounds'.

89. This means that the opponent's section 5(3) case is entirely based upon there being confusion. Consequently, this ground is not made out in relation to the goods and services for which I found no likelihood of confusion.

90. One of the reasons for the Tribunal's letter of 30 March 2022 was to point out the contradiction between the statement in the forms TM7 that the goods and services which were opposed under section 5(3) were those in Annex 3, and the claim in paragraph 32 of the statements of case that the ground should succeed against all goods and services in the applications. The opponent had an opportunity at this stage to check all of its pleadings. Nothing was inserted in the boxes on the forms TM7 about unfair advantage, detriment to repute or distinctive character in the amended forms TM7. I note that, despite this, the opponent included claims regarding these three types of damage in its statements of case. As I have said earlier in this decision, the form TM7 is the formal notice of opposition and it contains places to insert all the information, which may be expanded upon or continued in attachments. It is unacceptable to write nothing at all on the form and then include claims in an attachment which relate to those places in the form where nothing has been written. I also note that the statement of grounds expressly said at paragraph 4 that the opposition is directed at some of the goods and services in classes 9, 35 and 39; yet paragraph 72 of the opponent's submissions in lieu of a hearing submits that the application should be refused under section 5(3), including all the services in class 45. For the reasons given earlier in this decision, this is unacceptable.

91. In fact, the unsatisfactory state of the pleadings does not affect the outcome of the ground under section 5(3). Apart from the pleadings being based on a likelihood of confusion, there is insufficient qualifying reputation for the ground to succeed in relation to any of the three types of damage; or, indeed to succeed in relation to the confusion claim. In *General Motors*, Case C-375/97, 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."

92. In *Spirit Energy Limited v Spirit Solar Limited*, BL O/034/20, Phillip Johnson, sitting 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).

93. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of section 10(3) of the Act (equivalent to section 5(3)). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years

prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

94. In the present case, apart from the article in the Evening Standard, which I believe is a newspaper available throughout London and areas of the South East, I have no information about the availability or readership of the other publications referred to in the opponent's evidence. As mentioned earlier in this decision, the opponent's trade prior to the relevant date (and afterwards) has been confined to a very small geographical area in central London, the City of London. I am unable to find from the evidence that sufficient numbers of the public were aware of the earlier mark even if a number of people who work in that area, or saw the outlets as tourists, were from elsewhere in the UK. There were only two permanent outlets in operation prior to the relevant date, and there is no evidence about the number of pop-ups or their duration. The high point of the turnover (such that can be attributed to prior to the relevant date) was £825,862 in 2019, when the two permanent sites were operating. The opponent's market share prior to the relevant date was very small when compared to the UK takeaway market as a whole.

95. The conditions of section 5(3) are cumulative. Without a qualifying reputation, there can be no link and no consequential damage. The section 5(3) ground fails.

Section 5(3) outcome

96. The section 5(3) ground fails.

Section 5(4)(a)

97. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

98. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

99. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

100. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

"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."

101. In a case where the contested mark is unused, it is the date when the application was made for the contested mark which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.¹⁹ The applicant has not filed any evidence. Although the opponent refers to the applicant's use of YOLK in its evidence, this all post-dates the application date, which means that the relevant date is the application date: 14 May 2021. The opponent must show that it had sufficient goodwill at that date to bring the claim.

¹⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

102. There is no evidence of goodwill in relation to restaurant services. There is a vanishingly small amount of evidence in relation to delivery services distinguished by *Yolk*, as opposed to third-party signs for delivery. This is trivial, rather than protectable goodwill. However, I find that the opponent has shown sufficient evidence of a small, protectable goodwill in relation to its takeaway business.²⁰ The sign “*Yolk*” is distinctive of that goodwill. The goodwill was local to central London; specifically, the City of London. The establishment of a local goodwill is capable of preventing registration of a trade mark under section 5(4)(a) of the Act because a trade mark application/registration is a national right. This was explained in *Caspian Pizza Ltd & Ors v Shah & Another* [2017] EWCA Civ 1874, by Lord Justice Patten:

“23. It is, I think, implicit in these provisions that opposition under s.5(4) based on earlier use of the mark does not have to be use throughout the UK or alternatively in a geographical area which overlaps with the place where the applicant for registration actually carries on business using the same or a similar mark. As the Hearing Officer explained in *SWORDERS*, the application for a national mark operates as a notional extension of the use of the mark over the whole of the country. The only requirement is that the opponent should have established goodwill in the mark over an identifiable geographical area that would qualify for protection in passing off proceedings. Reputation may be enjoyed on such a small scale that it does not generate goodwill at all: see *Knight v Beyond Properties Pty Ltd & Ors* [2007] EWHC 1251 (Ch). But goodwill which is established in a particular locality will be capable of preventing registration of a countrywide mark.”

103. 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

²⁰ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

“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]”.

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

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

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

106. Although the average consumer test is not strictly the same as the ‘substantial number’ test, in the light of the Court of Appeal's judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, 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. The trade mark application extends notionally into the same locality as the opponent's business. As a consequence, I find that a substantial number of the opponent's actual and potential customers would believe that the opponent had expanded its business

to include the goods and services for which I have found a likelihood of confusion. This is misrepresentation. The other opposed goods and services are too far removed from the services in which the opponent enjoys a small goodwill to cause deception.²¹ The section 5(4)(a) ground succeeds to the same extent as the section 5(2)(a) and (b) grounds.

107. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

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

108. In *W.S. Foster & Son Limited v. Brooks Brothers UK Limited*, Iain Purvis QC, sitting as a deputy judge of the Patents County Court observed:²²

“Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark.”

109. The facts which I have considered above lead me to conclude that use of the applications would lead to damage, such as diversion of trade and/or injurious association. I find that, as the contested marks are applications covering the whole of the UK, including central London/the City of London, the opponent was entitled to restrain the applicant under the law of passing off, at the relevant date, from using its marks. This means that the oppositions succeed under section 5(4)(a) of the Act.

²¹ See *Harrods Limited v Harrodian School Limited* [1996] RPC 697 regarding the additional burden of establishing misrepresentation and damage when the parties do not operate in a common field of activity.

²² [2013] EWPC 18.

110. Although the opponent's evidence showing how the applicant uses its marks in relation to delivery of takeaway food post-dates the relevant date, it does not take the opponent any further forward than my findings on the basis of notional use, under sections 5(2)(a) and (b) of the Act, and the outcome of the section 5(4)(a) case, based upon the opponent's goodwill and the notional use of the applications.

Overall outcome

111. The partial oppositions have been partially successful. The applications are refused for the following goods and services:

Class 9: computer software for use in registering, creating, managing, sharing, supplying, transmitting, exchanging, reading, identifying, organising, viewing, calculating, tracking, generating, mapping, scheduling, dispatching, updating, maintaining, displaying, and processing data, information, in relation to the delivery of food; downloadable publications; downloadable menus; electronic and downloadable vouchers and coupons; e-coded loyalty cards.

Class 35: Retail and online retail services in relation to the sale of electronic and downloadable vouchers and coupons, e-coded loyalty cards.

Class 39: Transportation services; delivery, collection, transport, forwarding and courier services; food and drink delivery, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services relating to goods; delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals; takeaway delivery services; providing information regarding food and beverage delivery via a website on global computer networks; transportation information; provision of information in relation to the aforesaid services.

Costs

112. I note that the Tribunal invited the parties to file a cost pro forma at the conclusion of the proceedings. This was an oversight; the parties have been represented since the outset and so any award of costs is made on the basis of the scale set out in Tribunal Practice Notice 2/2016. The applicant was about two-thirds successful in respect of the opposed class 9 goods; successful in respect of about half of the opposed class 39 services; and almost wholly successful in respect of the opposed class 35 services. This means that the applicant has had the greater share of success. Applying a broad brush to the costs assessment, I award the applicant costs of £800 for considering the identical notices of opposition, including the 24 page-long statements of case, filing the brief and identical counterstatements, and considering the consolidated evidence. This represents about a two-thirds overall success for what would have been an award of £500 for the oppositions and counterstatements and £700 for considering the evidence, if the applicant had been wholly successful.

113. I order In One Basket Ltd to pay to Yolk London Ltd the sum of **£800**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of March 2023

Judi Pike
For the Registrar

Annex: the full list of goods and services applied for

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking [supervision], life-saving and teaching apparatus and instruments; apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects; apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food and e-cigarettes; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; computers; computer software; computer software for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects; computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food and e-cigarettes; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; computer software; computer hardware; mobile applications; network software; computer operating programs; firmware; computer software for engaging and coordinating delivery services; order

tracking software; computer software applications relating to the sale, order and delivery of groceries; computer software applications relating to the sale, order and delivery of restaurant and take-away restaurant meals; computer software for engaging and coordinating transportation services; computer software for engaging and coordinating delivery services; computer software enabling businesses in the food and beverage industry to better organise their business; computer software enabling food and beverage manufacturers, producers, distributors, wholesalers, retailers, restaurant and bar owners [including businesses in hospitality, tourism and event management], to manage their commercial, sales, purchasing, marketing, financial, legal, compliance, human resources, medical, safety, transportation, logistics, bookings, events and technical information; computer software enabling food manufacturers and restaurant owners to reduce formulation and development costs and to improve the quality of their data; computer software for the hospitality industry for ordering food and drinks, tableside ordering, table and floor management, placing reservations and bookings, payment management, cash registers, e-receipts, discounts, staff management, menu management to set and modify menus, nutritional analysis, information on allergies, stock and inventory management and to manage multiple locations; smartphone app for arranging the delivery of food and drinks; electronic point of sale (epos) systems; multi-functional electronic and digital devices for displaying, measuring, loading and transmitting information and personalized recommendations and scores related to exercise, health, well-being, physiological condition, nutrition, meal delivery services and diet; computer hardware, sensors, integrated circuits and modules; application programming interfaces (APIs); measuring, signalling, regulating and control devices, and security devices for storage systems; data processing apparatus and appliances for management of stocks; recorded computer programmes for management of stocks; electronically controlled apparatus and instruments, namely, computerised storage and retrieval apparatus and instruments for use in the warehousing of goods; scanners; boxes and containers adapted for use with the aforementioned goods; downloadable computer software to allow users to receive and process orders via a global computer network; downloadable publications; downloadable menus; downloadable catalogues; downloadable recipe books; electronic and downloadable vouchers and coupons; e-coded loyalty cards; calculators; photographic films; magnetic tapes; compact discs; cassettes; cartridges; television sets; video recorders; fire extinguishing apparatus; answering machines; binoculars; camcorders; cameras; contact lenses; electrical door bells; fire alarms; spectacle frames and glasses; sunglasses; vehicle breakdown warning triangles; weighing apparatus and instruments; telephone directory databases; none of the aforesaid goods being rechargers for electric accumulators, photovoltaic cells, solar batteries, MP3 players, MP4 players, audio and video receivers, electric cables, solar panels for electricity generation, portable rechargers, automatic solar tracking sensors, battery cases, battery charge devices, chargers for electric batteries, signal lanterns, sunshine recorders, lights for photographic cameras, lights for video cameras, lanterns for optical purposes.

Class 35: Retail and online retail services in relation to the sale of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking [supervision], life-saving and teaching apparatus and instruments, apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging,

reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects, apparatus, instruments and devices for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food and e-cigarettes, apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information, computers, computer software, computer software for collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects, computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects in relation to the delivery of food and e-cigarettes, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, computer software, blank digital or analogue recording and storage media, mechanisms for coin-operated apparatus, cash registers, calculating devices, computers and computer peripheral devices, diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming, fire-extinguishing apparatus, computer software, computer hardware, mobile applications, network software, computer operating programs, firmware, computer software for engaging and coordinating delivery services, order tracking software, computer software applications relating to the sale, order and delivery of groceries, computer software applications relating to the sale, order and delivery of restaurant and take-away restaurant meals, computer software for engaging and coordinating transportation services, computer software for engaging and coordinating delivery services, computer software enabling businesses in the food and beverage industry to better organise their business, computer software enabling food and beverage

manufacturers, producers, distributors, wholesalers, retailers, restaurant and bar owners [including businesses in hospitality, tourism and event management], to manage their commercial, sales, purchasing, marketing, financial, legal, compliance, human resources, medical, safety, transportation, logistics, bookings, events and technical information, computer software enabling food manufacturers and restaurant owners to reduce formulation and development costs and to improve the quality of their data, computer software for the hospitality industry for ordering food and drinks, tableside ordering, table and floor management, placing reservations and bookings, payment management, cash registers, e-receipts, discounts, staff management, menu management to set and modify menus, nutritional analysis, information on allergies, stock and inventory management and to manage multiple locations, smartphone app for arranging the delivery of food and drinks, electronic point of sale (epos) systems, multi-functional electronic and digital devices for displaying, measuring, loading and transmitting information and personalized recommendations and scores related to exercise, health, well-being, physiological condition, nutrition, meal delivery services and diet, computer hardware, sensors, integrated circuits and modules, application programming interfaces (APIs), measuring, signalling, regulating and control devices, and security devices for storage systems, data processing apparatus and appliances for management of stocks, recorded computer programmes for management of stocks, electronically controlled apparatus and instruments, namely, computerised storage and retrieval apparatus and instruments for use in the warehousing of goods, scanners, boxes and containers adapted for use with the aforementioned goods, downloadable computer software to allow users to receive and process orders via a global computer network, downloadable publications, downloadable menus, downloadable catalogues, downloadable recipe books, electronic and downloadable vouchers and coupons, e-coded loyalty cards, calculators, photographic films, magnetic tapes, compact discs, cassettes, cartridges, television sets, video recorders, domestic electrical appliances, fire extinguishing apparatus, answering machines, binoculars, camcorders, cameras, contact lenses, electrical door bells, fire alarms, spectacle frames and glasses, sunglasses, vehicle breakdown warning triangles, weighing apparatus and instruments, telephone directory databases; none of the aforesaid services relate to the retail services of freshly farmed eggs.

Class 39: Transportation services; delivery, collection, transport, forwarding and courier services; food and drink delivery, storage, collection, transport, forwarding and courier services; collection, transport, delivery, forwarding and courier services relating to goods, packages, gifts, parcels, documents, post, mail, correspondence, advertising materials; delivery of food and drink, prepared for consumption; delivery of foodstuffs and prepared meals; takeaway delivery services; delivery of semi-prepared food products; delivery of e-cigarettes; delivery of tobacco and tobacco substitute products; delivery of cigars, electronic cigarettes and oral vaporizers for smokers; tracking and tracing of shipments; providing information regarding food and beverage delivery via a website on global computer networks; packing of food; packaging of food; frozen food storage services; delivery of customized gift boxes; tracking and tracing of shipments; distribution services; transportation information; delivery of goods, namely food products, prepared and semi-prepared food products, including in pre-portioned form, for enabling meals to be cooked according to specific recipes; delivery of recipe kits; storage information; provision of information, advisory and consultancy services in relation to the aforesaid services.

Class 45: Personal introduction agency services; social escort agency services; dating services provided through social networking; concierge services for others, namely, making requested personal, and social arrangements and reservations and providing personal information to meet the needs of customer card holders and travellers; personal shopping services; personal gift selection and gift reminder services for others; fraud detection services in the field of credit card usage; security services for the protection of property and individuals; adoption agency services; body guarding; clothing rental; crematorium services; investigations; marriage agencies; organization of religious meetings; security consultancy; legal services; providing non-medical personal assistance services for others to meet the needs of individual in the nature of planning, organizing and coordinating arranging and assisting individuals to perform daily tasks; concierge services for others comprising making requested personal arrangements and reservations, providing personal information to meet individual needs; pet sitting; house sitting; personal errand services; reminder services; advice, information and consultancy in relation to all of the aforesaid services; lifestyle management and counselling.