



Neutral Citation Number: [2022] EWHC 323 (IPEC)

Case No: IP-2021-000059

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY ENTERPRISE COURT

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 16/02/2022

Before :

HIS HONOUR JUDGE HACON

Between :

(1) **NAH HOLDINGS LIMITED**

(2) **NAH FOODS LIMITED**

- and -

(1) **KBF ENTERPRISES LIMITED**

(2) **KIERAN BENJAMIN FISHER**

Christ Pearson (instructed by **CLP Solicitors**) for the **Claimants**

Aaron Wood, Trade Mark Attorney of **Brandsmiths SL** for the **Defendants**

Judgment on the papers

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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HIS HONOUR JUDGE HACON

Judge Hacon :

Introduction

1.

This is an application by the claimants for summary judgment in a claim for trade mark infringement. The parties have agreed that I should give judgment on the papers. In this instance that means the

pleadings, a witness statement dated 19 January 2022 from Arshad Mohammed, a partner in the firm of solicitors acting for the claimants, written submissions dated 28 January 2022 from the Trade Mark Attorney acting for the defendants and written submissions dated 9 February 2022 from counsel acting for the claimants.

The Claim

2.

The claim is for infringement of eight registered trade marks. The first two, UK 00002626042 (“the 042 Mark”) and UK 00916905317 (“the 317 Mark”) are the most significant. Both are word marks: SLIM SAUCE, registered in class 30 in respect of sauce for food, pasta sauce and zero calorie sauce. The other six marks are also word marks: two each in the form of SLIM PASTA, SLIM RICE and SLIM NOODLES, each registered in respect of various food products.

3.

The first claimant is the owner of the trade marks, which are registered to the second claimant, a retailer of sauces and other foodstuffs in the United Kingdom and abroad. I need not distinguish between the claimants.

4.

The first defendant (“KBF”) trades as “Bodybuilding Warehouse” and markets foods and supplements for fitness enthusiasts. Its range includes low calorie sauces sold under the name “Slim Sauces”. The second defendant (“Mr Fisher”) is the sole owner, sole director and secretary of KBF.

5.

The claimants allege infringement of their trade marks pursuant to [s.10\(2\)](#) of the [Trade Marks Act 1994](#) (“the 1994 Act”).

6.

The use complained of is thus in respect of products identical to products in respect of which the SLIM SAUCES marks are registered and in respect of a sign which differs from the SLIM SAUCES trade marks only in that it is in the singular: SLIM SAUCE.

7.

Mr Fisher is alleged to be jointly liable for the infringing acts of KBF on the ground that he is the only individual involved in the operation and management of KBF. The defendants admit Mr Fisher’s joint liability if KBF is found liable.

The Defence and Counterclaim

8.

Aside from the Counterclaim, the defence advanced is that the word “slim” lacks distinctiveness in the relevant field, so that the average consumer would not assume any connection in trade between the claimants’ and defendants’ goods. Therefore, the defendants say, there can be no likelihood of confusion within the meaning of [s.10\(2\)](#). There is no reference to [s.11\(2\)\(b\)](#) of [the 1994 Act](#). I understand the argument to be that Slim Sauce is so descriptive that its use cannot affect the origin function of the SLIM SAUCES trade marks. It seems to me that this defence cannot succeed if the Counterclaim brought under [s.3\(1\)\(b\)](#) and (c) of [the 1994 Act](#) does not succeed.

9.

It is alleged in the Counterclaim that all the trade marks were invalidly registered on the ground they consist exclusively of signs which may serve in trade to designate characteristics of the goods within the meaning of [s.3\(1\)\(c\) of the 1994 Act](#), namely that they are low calorie products which will assist a person to slim. Alternatively, for the same reason, the trade marks are devoid of distinctive character within the meaning of [s.3\(1\)\(b\) of the 1994 Act](#).

10.

The defendants further counterclaim that with the exception of the 317 Mark the claimants' trade marks stand to be revoked for non-use pursuant to [s.46\(1\)\(b\) of the 1994 Act](#).

The Defence and Counterclaim filed out of time

11.

The first reason advanced by the claimants for summary judgment is that the Defence was filed out of time. It was filed with the Counterclaim eight or possibly ten days late on 19 August 2021.

12.

That is not a ground for summary judgment listed under CPR 24.2. I take the list to be exhaustive. The remedy available to a claimant where a Defence is not filed by the time it is due, either according to the rules or an order of the court, is provided by CPR 15.3: the claimant may apply for judgment in default. The claimants did not so apply. If they had applied for judgment in default instead of summary judgment on the date of the Application Notice, the application in default would have been dismissed, see CPR 12.3(1). The claim would have moved forward on the cases advanced in the pleadings filed. The claimants cannot circumvent CPR 12.3(1) by framing their application as an application for summary judgment.

13.

If it were necessary to grant the defendants relief from sanctions pursuant to CPR 3.9, which I doubt, I grant such relief. The breach was neither serious nor significant, given the effect of CPR 12.3(1). Following late filing of the Defence and Counterclaim, the claimants made no objection but filed a Reply and Defence to Counterclaim which suggests that they did not find the late filing either serious or significant. In his written submissions Mr Wood says that at the time the Defence and Counterclaim should have been and later was filed, the defendants had other legal representation. Mr Wood is unable to give a reason for the delay in filing. I am unable to say whether the reason was good or bad. However in all the circumstances of the case it seems to me that retrospective permission to file the Defence and Counterclaim late should be given.

Whether the defendants have no real prospect of successfully defending the claim

14.

Although the Application Notice seeks summary judgment in respect of the entirety of the claim, the written submissions from the claimants' counsel only presses the claim in relation the 042 Mark and the 317 Mark, the two SLIM SAUCES marks.

15.

The issue on infringement is whether the similarity between the SLIM SAUCES trade mark and the SLIM SAUCE sign is such that there is a risk that the average consumer might believe that the goods of KBF come from the same undertaking as the goods of the claimants or come from an undertaking economically linked to the claimants, see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, at [31]-[32], discussed in *Urbanbubble Ltd v Urban Evolution*

Property Management Ltd [\[2022\] EWHC 134 \(IPEC\)](#) at [53]-[54]. KBF's sign "Slim Sauce" is almost identical to the SLIM SAUCES trade mark and is used in relation to goods identical to those in respect of which those trade marks are registered.

16.

Obviously the word "sauce" is entirely descriptive when used for sauces. The word "slim" is not descriptive of a sauce according to any usual use of either word. It may allude to low calorie content of the sauce. But I believe it to be unlikely that the defendants will be able to establish on the evidence that SLIM SAUCES has no distinctive quality at all such that it is incapable of serving as a badge of origin for sauces and that by extension there is no risk that the average consumer might believe that the goods of KBF come from the same undertaking as the goods of the claimants or come from an undertaking economically linked to the claimants

17.

One limb of the Counterclaim is the allegation of non-use. In response to the allegation raised against the other trade marks, the Defence to Counterclaim pleads instances of use of the contested trade marks with exhibits of orders from Holland & Barrett and spreadsheets demonstrating sales. On their face, these exhibits establish genuine use of the SLIM SAUCES trade marks within the relevant periods.

18.

There is no pleaded response to this evidence of genuine use. Mr Wood says this in his written submissions:

"This Court will be aware that the test for genuine use is not simply whether the mark has been 'used', and whether it fulfils the legal tests to be classed as genuine use according to the fairly complex legal tests (including whether the scale and manner of use is warranted in the relevant sector) is a matter which cannot be resolved on the basis of the evidence presented to date;"

19.

That in my view is not enough. No positive reason is given to raise a doubt either that the claimants' evidence is what it purports to be, or that the use of the trade mark apparently evidenced was genuine. It is not even suggested that the 317 Mark should be revoked for non-use.

20.

That leaves the allegation that the SLIM SAUCES trade marks lack distinctive character under [s.3\(1\)\(b\)](#) and/or are descriptive under [s.3\(1\)\(c\)](#) of [the 1994 Act](#).

21.

The claimants take a pleading point. In paragraphs 10 to 12 of the Reply and Defence to Counterclaim they allege in relation to the SLIM SAUCES marks that "slim" in relation to food is not descriptive but aspirational - it invites the average consumer to see themselves as slim. They further allege that the use made of the SLIM SAUCES trade marks means that those marks have acquired distinctiveness. In counsel's written submissions it is pointed out that no Reply to Defence to Counterclaim has been filed and argued that the foregoing allegations stand unchallenged. Failure to serve a Reply is not taken to admit matters raised in the Defence, see CPR 16.7(1). The allegations raised in paragraphs 10 to 12 of the Reply and Defence to Counterclaim remain in dispute.

22.

The principal issue raised under [s.3\(1\)\(b\)](#) and (c) of [the 1994 Act](#) is whether the SLIM SAUCES trade marks are devoid of any distinctive character. The claimants say that I can dismiss such a possibility without evidence. I certainly believe it to be unlikely that their case under either [s.3\(1\)\(b\)](#) or [s.3\(1\)\(c\)](#) will succeed. But I am not prepared to say without evidence that there is no real prospect of the defendants succeeding under either head of the Counterclaim. There is just enough doubt for me to believe the prospect is better than fanciful, though not by much.

23.

I am reluctant to do no more than let this claim go forward with the necessary expenditure of time and money it would impose on the claimants. The rules provide for the possibility of a conditional order, see Practice Direction 24, paragraph 5. However, I do not believe that I should make a conditional order without hearing further from the parties.

24.

I invite the parties' representatives to make short submissions in writing within 7 days of this judgment as to whether a conditional order would be appropriate, if so the nature of the conditions and any relevant circumstances they may wish to draw to my attention. Each side should also provide a draft order.