

O-240-04

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2272249 IN THE NAME OF  
WANG LEI**

**AND**

**IN THE MATTER OF  
OPPOSITION THERETO UNDER NO. 91028  
IN THE NAME OF CHINA NATIONAL CEREALS OILS &  
FOODSTUFFS IMPORT & EXPORT CORPORATION**

**Trade Marks Act 1994**  
**In the matter of application No. 2272249**  
**in the name of Wang Lei**

**And**

**In the matter of opposition thereto**  
**under No. 91028 in the name of China National Cereals Oils &**  
**Foodstuffs Import & Export Corporation**

### **Background**

1. On 9 June 2001, Wang Lei applied to register a trade mark in Class 30 in respect of the following goods:

**Class 30:** Corn flakes, rice flakes, prawn crackers, fish crackers, onion flavour crackers, crispy rice.

2. The mark is as follows:



3. On 28 August 2002, China National Cereals Oils & Foodstuffs Import & Export Corporation filed notice of opposition based on the following grounds:

- 1. Under Section 5(2)(b)** because the mark applied for is a similar mark to the opponents= earlier trade marks and is sought to be registered for identical or similar goods to those covered by the earlier marks such that there exists a likelihood of confusion.
- 2. Under Section 5(3)** because use of the mark applied for would take unfair advantage or be detrimental to the distinctive character or repute of the opponents= earlier marks.
- 3. Under Section 5(4)(a)** by virtue of the law of passing off.
- 4. Under Section 56** because the opponents= earlier marks are entitled to protection as well known marks under the Paris Convention.
- 5. Under Section 3(6)** the applicant was at one time employed by the opponents and is well aware of the opponents= mark and its use in the UK, but nonetheless applied to register the mark and in doing so acted in bad faith.

4. The earlier marks relied upon by the opponents can be found as an annex to this decision.

5. The applicant filed a counterstatement in which she denies the grounds on which the opposition is based.

6. Both sides ask that an award of costs be made in their favour.

7. Both sides filed evidence in these proceedings. The matter came to be heard on 24 May 2004, when the applicant was represented by Mr Pritchard of Counsel, instructed by P H Yeung, Solicitors. The opponents were represented by Mr Fernando of Counsel instructed by Murgitroyd & Company, their trade mark attorneys.

### **Opponents= evidence**

8. This consists of a Witness Statement dated 5 June 2003, from Sandy Man, since 1991 the Managing Director of Pacific Foods Limited, a wholly-owned subsidiary of Top Glory (London) Limited, a wholly-owned subsidiary of the opponents.

9. Mr Man says that he has been involved with the import of foodstuffs into the UK for over 25 years, and that although this has not always been in the employment of the opponents (or its subsidiaries) he is familiar with their activities during this entire period. He describes the opponents= business as being involved in the world-wide supply of foodstuffs produced in China, stating that his company has the job of marketing their goods throughout Europe.

10. Mr Man goes on to describe the opponents= trade mark as consisting of a five-lobed plum flower device containing two Chinese characters, which, he says, translate from Chinese

Mandarin into English as Ared plum blossom®, accompanied by the words HUNG MEI which is a transliteration of the Chinese characters. He says that this transliteration is a guide to the non-English speaker as to how the characters would sound when spoken in Chinese.

11. Mr Man says that the mark has been used in the UK for as long as he has been in the UK (and even prior to this although does not say how he knows this to be the case) in relation to canned fruits, and since about 1985, in connection with material which, when fried, becomes a prawn cracker. He goes on to give details of the weight and value of the prawn cracker material supplied to the UK by the opponents in the years 1995 to 2002, which from a peak of 3,920 metric tonnes and US\$4.36 million in 1995, shows an almost consistent year-on-year decline to 931 metric tonnes and US\$1.03 million in 2002. Mr Man says that during the same period the opponents shipped 6,200 tonnes/US\$4 million of other products marked HONG MEI to the UK, but does not give any details.

12. Mr Man asserts that HONG MEI prawn crackers remain the most popular in the UK, but that there has been a noticeable decrease in sales in recent years, which he attributes, in part, to sales of the applicant's products.

13. Mr Man says that the opponents supply their foodstuffs to UK importers, who subsequently supply UK factories and wholesalers, who in turn supply restaurants and cash & carry supermarkets, estimating that approximately 50% of all HONG MEI prawn crackers end up in Chinese restaurants. He also estimates that approximately 90% of people who work in Chinese restaurants speak Chinese as their first language. In neither case does Mr Man give any basis for his estimates.

14. Mr Man goes on to give details of his company's promotional activities, saying that each year it produces brochures and leaflets for, inter alia, its HONG MEI products, and exhibits at international food exhibitions, although in neither case does he give any specific details by which to gauge their contribution to the likely reputation of the mark.

15. Based on his knowledge of the Chinese and English languages, Mr Man gives his views on how he considers a person fluent in Mandarin Chinese and an English speaking person would view the respective marks, and to give an assessment on their similarities. He concludes his statement saying that the applicant is a former employee of the opponents, involved in the production and export of prawn crackers, leaving the company around 1990 to set up her own business trading in such goods. Mr Man says that the applicant originally used the HONG MEI mark in relation to such goods but stopped doing so when approached by a subsidiary of the opponents.

### **Applicant's evidence**

16. This consists of a Witness Statement dated 10 September 2003, from Wang Lei, the applicant. Ms Lei says that she is currently the General Manager and majority shareholder of Dalian Kangda Foodstuffs Co Ltd (Dalian Kangda) a company that mainly trade in prawn crackers. Ms Lei says that between 1992 and 1998 she worked for Dalian Cereals Oils & Foodstuffs Import and Export Corporation (Dalian Cereals) which up until 1989 was a subsidiary of the opponents.

17. Ms Lei says that when working for Dalian Cereals she was aware of the development of HONG MEI brand prawn crackers, and that she was responsible for designing the packaging. She states that the trade mark was registered in China (see Page 1 of exhibit WL1) and that trading arrangements permitted various companies to use the mark. Ms Lei says that she left Dalian Cereals in 1999, and after a spell working for another unnamed company, in 2001 set up her own company, Dalian Kangda, mainly trading in prawn crackers under the brand name KANG MEI.

18. Ms Lei says that KANG is part of her company name and means Ahealthy and strong@, and that the trade mark KANG MEI has been registered in China by a business colleague who has granted her a licence to use it in China (See Page 2 of exhibit WL1). Ms Lei notes that both KANG MEI and HONG MEI have been registered as trade marks in China. Ms Lei also says that Ato great confusion the Opposition (which I take to mean opponents) registered their trade mark HUNG MEI@although I am not entirely clear what she is saying. Ms Lei asserts that up until the time of her trade mark application, the opponents had not imported any prawn crackers into this country.

19. Ms Lei goes on to comment on the Witness Statement given by Mr Man, namely that there is a lack of detail in relation to the figures he gives relating to turnover, market size, etc, that Page 3 of Exhibit WL1 shows the mark HONG MEI as being a trade mark of Liaoning Foodstuffs, the mark registered by the opponents is HUNG MEI and not HONG MEI as Mr Man seems to be intimating. Ms Lei says that the table of sales produced by Mr Man shows that the fall in his company sales of prawn crackers cannot be due to her company=s involvement because it was not incorporated until 2001 by which time there had already been a year-on-year decline.

20. Ms Lei comments on Mr Man=s comparison of the respective marks. She says Mr Man has given an inaccurate chronology of her involvement with Dalian Cereals (see pages 4 to 6 of Exhibit WL1), and denies that she or her company have ever used the HONG MEI trade mark.

### **Opponents= evidence in reply**

21. This consists of a Witness Statement dated 26 February 2004, from Sandy Man.

22. Mr Man says that China National Cereals Oils and Foodstuffs Imports and Exports is wholly owned by, and under the control of the central government of China. Up until 1989, Dalian Cereals Oils & Foodstuffs Import and Export Corporation, and Liaoning Foodstuffs Import and Export Corporation were wholly owned subsidiaries of China National Cereals Oils and Foodstuffs Imports and Exports, but at that date ownership was transferred to provincial governments. He says that this shows a clear relationship between these companies, and they remain associated.

23. Mr Man states that the exhibit purported to show that the applicant has a licence to use KANG MEI (Page 2 of WL1) is, in fact, an extract from the Chinese Official Register showing the mark to have been registered in the name of Shengyang Kangda Foodstuffs and Aquatic Products Company Limited, there being no reference to a licence to the applicant. He

disputes the relevance of the registrations of KANG MEI and HONG MEI in China, and refutes the assertion that they are not similar marks when transliterated.

24. Mr Man states that his company has imported prawn crackers into the UK, in support referring to exhibit SM1, which consists of three Customs Clearance, Export Authorisation Certificates, granted by China National Cereals Oils and Foodstuffs Imports and Exports, under which Liaoning Foodstuffs Imports and Exports Corporation are authorised to export cartons of HONG MEI prawn crackers to the UK. The earliest certificates is dated 26 December 2000, each being valid for three days. All are addressed to the Dalian Customs. There is no evidence that these shipments took place.

25. Mr Man refers to exhibit SM2, which consists of an extract from a report produced by Mintel International Group Limited, an independent producer of commercial intelligence, in which it states that sales of Chinese food increased in the years 1998 to 2003. Exhibit SM3 consists of details of advertising schedules, all relating to advertising undertaken after the relevant date. Exhibit SM4 consists of a photograph of packaging used by China National Cereals, Mr Man pointing to the HONG MEI trade mark. Whilst there is a logo that looks like the Plum flower blossom of the opponents' mark, apart from its shape it is not clear enough to determine that it is that mark. Nor is there anything that indicates the date on which the photograph was taken, or that the packaging was in use, in the UK, prior to the relevant date. Mr Man repeats his analysis of the respective marks, the likely way in which consumers would view them, and his views on the potential for confusion.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

## Decision

26. Turning first to the ground founded on Section 5(2)(b) of the Act. That section reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

27. An earlier trade mark is defined in Section 6 of the Act as follows:

**6.- (1)** In this Act an earlier trade mark means

- (b) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

28. In a consideration of a likelihood of confusion or deception I must take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, 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; *Marca Mode CV v Adidas AG*,
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

29. The opponents rely on four earlier trade marks, all registered in respect of the same mark, but for different descriptions of goods in different classes. I propose to consider their case on the merits of their registration in Class 30, the same goods class, and the closest goods to those of the application, for if the opponents do not succeed in respect of this earlier mark,

they will be in no better position in respect of the other three.

30. The opponent's earlier mark is registered in respect of, amongst other things **A**rice<sup>®</sup> and **A**farinaceous products for food for human consumption<sup>®</sup>. The term rice would include such an item in any form found in Class 30, so would include **A**rice flakes<sup>®</sup> and **A**crispy rice<sup>®</sup>. The term **A**farinaceous<sup>®</sup> means anything **A**consisting or made of starch<sup>®</sup> or **A**containing starch<sup>®</sup> which covers corn, corn flour, rice, rice flour and products made from such goods, and potentially, the whole ambit of the applicant's specification. In my view, the respective specifications cover identical goods, or at the very least, similar goods.

31. Although not ordinarily high price items, food is likely to be selected with a degree of care, probably with more attention being paid to the description of the foodstuff to ensure that the correct product is obtained than to the trade name, and particularly so in the case of foodstuffs with which the purchaser is unfamiliar. I am, however, aware that foodstuffs can, and do attract brand loyalty from the consumer, who, having bought a product once and found it to their liking, will make a repeat purchase of the same item, or another item bearing a brand from the same stable as that previously purchased.

32. In my experience retailers display the different branded products of the same type together, so this is one of the areas of commerce where the consumer may see marks displayed side-by-side. However, not all traders stock all of the available brands and it may well be that a consumer will see a brand in one shop, but not in another. This leaves open the possibility of the applicant's and the opponent's goods being displayed in close proximity, affording the opportunity for a direct comparison, or in different retail outlets where the consumer will have to rely on their potentially imperfect recollection.

33. There is no qualification or limitation to either the applicant's or the opponent's specifications, such as to their nature, purpose, uses etc. I must therefore notionally assume that the goods share the same channels of trade, from manufacturer, to retailer through to the end consumer. Foodstuffs, including those from different cultures must these days be considered as ordinary everyday goods that consumers from most walks of life will come into contact with, and at some time buy, and consequently, the relevant consumer of the goods in question is the public at large.

34. The respective marks both contain Chinese characters, with two words in Roman script that are a transliteration (but not a translation) of the characters placed below, the characters being contained within a flower-shaped border. Because those with a knowledge of the Chinese language, be it Mandarin or Cantonese, will understand the meaning of the characters, and accordingly have a different perception of the mark to the non-Chinese speaking person, it was submitted that the relevant consumer should be regarded as being composed of two different groups; those who are of Chinese origin, be it immigrants to the UK or their decedents who are likely to be native Chinese speakers, and non-Chinese persons resident in the UK. Within the latter group there will be persons conversant with the Chinese language, who because of this knowledge would fall within both camps.

35. I have no idea of the size of the Chinese immigrant or Chinese speaking population in the UK. It was put to me that this group composed a significant number of persons although

there is no specific evidence to support this contention. I am, however, aware that it is commonplace for towns and cities within the UK to have one or more restaurants providing Chinese cuisine, and in my experience, such establishments are run by persons of Chinese origin. The Mintel survey (exhibit SM2) shows the Chinese takeaway and restaurant market to have been over , 1 billion in 1998, and in the region of , 1.5 billion by 2002 representing 55% of the ethnic food market. By any standards this is a significant market. I am therefore prepared to accept that in considering the way in which the relevant consumer is likely to view the respective marks, that I should do so from the perspective of a consumer of Chinese origin or Chinese speaking, and also that of an Anglophone.

36. Both sides appear to accept that the border of their respective marks is a representation of a plum flower blossom which the applicant says is common in Chinese culture having been Achosen as the national flower of China by the Founder Father of Modern China, Dr Sun Yat Sin in the early 1900s@. The representations have differences in their appearance, the opponents= version having five petals and being represented with the inner-portion shaded in black with white lettering upon it, whereas the applicant=s flower has six petals with the colouration inverted to black on white.

37. That the outline is a representation of a plum flower blossom may be known to persons of Chinese origin, and scholars of Chinese culture and history, who will probably be aware of the blossoms relevance to China. Chinese speaking persons are likely to be led to the conclusion that the outline is that of the plum blossom flower by the writing. It may even be that persons with a knowledge of plants will recognise the shape although given the lack of any real detail I would say that this seems unlikely. But what matters is not whether the consumer knows that the shape is a representation of a plum flower blossom, but rather that both outlines are of a similar flower-like shape and may create the same impression in the mind of the consumer.

38. To my mind the marks will have a higher degree of similarity to the non-Chinese speaker, who will view the characters as just characters in some Far-Eastern language, possibly Chinese or Japanese. I do not consider that the difference in the respective characters will be apparent to even the circumspect non-Chinese speaking consumer, that is unless they embark on a meticulous analysis of the individual features. Whilst there is some uncertainty as to the exact transliteration and translation of the respective marks into English, to the non-Chinese speaker this is not an issue; they will not know what the characters or the words KANG MEI and HUNG MEI mean. They may assume that the words in Roman script are an indication of how the characters sound when spoken, but may just as easily see them as having no reference to the characters.

39. The non-Chinese speaking consumer will most probably relate to the marks by the words in Roman script, that is HUNG MEI or KANG MEI. Whilst HUNG and KANG have the same ANG@ending, the other letters shape the words to the extent that I would say they are not visually or aurally similar. The second word MEI is obviously common to both marks but cannot be taken in isolation. In combination with HUNG or KANG it adds to the similarity. The conceptual message of both marks will be the same, that is, Oriental. Taking all of the elements together and considering the respective marks as a whole from the perspective of the non-Chinese speaking consumer, I come to the conclusion that whilst there are differences, these are outweighed by the similarities to the extent that I would consider them to be similar

marks.

40. To the Chinese speaker, the visual differences in the respective marks will be quite perceptible. They will see not just the characters, but also their meanings. Those appearing in the opponents' mark are said to be capable of being pronounced as either HUNG MEI or HONG MEI, both meaning RED PLUM BLOSSOM. When spoken, the characters in the applicant's mark will be pronounced as KANG MEI, which is attributed the meaning of HEALTHY (or STRONG) PLUM BLOSSOM. Clearly, to the Chinese speaking consumer, the marks will be pronounced and sound quite different. A point was made that Chinese is read from right to left, meaning that the PLUM BLOSSOM element would be the first element. That may well be the case, but it does not necessarily follow that the reader will see the marks as PLUM BLOSSOM RED and PLUM BLOSSOM HEALTHY, but by virtue of the fact that the respective marks are all 'plum blossom' marks, there is some degree of conceptual similarity. Taking all of the elements together and contrasting the marks as a whole, it is clear that whilst there are similarities, to the Chinese speaking person these are outweighed by the differences, to the extent that I would say that the respective marks are not similar.

41. The opponents claim to have been using the mark HONG MEI in the UK since at least 1977 in relation to canned fruits, and since about 1985 in connection with material which when fried becomes a prawn cracker. However, the opponents' earlier marks are not HONG MEI but HUNG MEI. There is no evidence of them having carried on a trade using the mark HUNG MEI, and they do not claim to have done so. They rely on the use made of HONG MEI saying that to the Chinese speaking consumer, HONG MEI and HUNG MEI have the same meaning. That may well be the case, but it does not mean that use of one equates to use of the other, and in my view they are not the same marks. But even if they were, I do not consider that this would further the opponents' case.

42. Whilst there is some evidence that refers to the export of HONG MEI prawn crackers from China to the United Kingdom, there is no confirmation that the shipments ever took place. This documentation refers to the HONG MEI trade mark, but does not show the actual mark, nor is there any other evidence that shows actual use of the words HONG MEI in the UK let alone in conjunction with Chinese characters and a plum blossom shaped border. Even setting this aside, the position is not any better for the opponents.

43. Canned fruits are not covered by the opponents' earlier mark, and in any event, are quite different to the goods of the application so I need not say any more in respect of these goods. The opponents also claim to have shipped some 6,200 tonnes or US\$4 million of other products marked HONG MEI to the UK, but as they give no other details this is of no practical use in assessing the extent of their reputation.

44. The sale of prawn crackers by the opponents is relevant, and even without information regarding the size of the market for such goods, from the figures given the opponents appear to have conducted a significant trade. In his evidence Mr Man says that the opponents supply their prawn cracker material to UK importers, who subsequently supply UK factories and wholesalers, who in turn supply restaurants and cash & carry supermarkets. The material supplied to a factory is presumably subjected to some sort of processing or re-packaging and

may or may not bear the brand name of the original supplier; Mr Man does not say. He estimates that approximately 50% of all HONG MEI prawn crackers end up in Chinese restaurants. In my experience, prawn crackers are prepared, and like most restaurant foods, will be presented to the consumer at the table bearing no badge of origin. Although significant amounts of the HONG MEI prawn cracker material may have been imported into the UK, there is clearly a good deal of uncertainty over the amounts that actually reached the consumer in a form where the brand name will have been seen.

45. Details of the opponents' promotion of goods bearing the HONG MEI trade mark are limited to say the least, and either relate to activities outside of the UK, or lack the necessary detail by which to gauge its contribution to the likely reputation of the mark.

46. Taking the best view that I can, it seems to me that if the opponents have established a reputation in the words HONG MEI in relation to a material for making prawn crackers, this subsists primarily with factory personnel, wholesalers, retailers, restaurant workers, and to a much lesser extent the purchasing public. I do not, therefore see that the reputation is such that it warrants a wider penumbra of protection than the mark would otherwise have been afforded.

47. After a full consideration of the facts, and adopting the *Aglobal* approach advocated, I take the view that notwithstanding the commonality in the goods and areas of trade, to the Chinese speaker the differences in the respective marks are such that a consumer, familiar with the opponents' earlier mark, on seeing the mark applied for, will not be led into wrongly believing that the respective goods come from the same or economically linked undertakings. However, in respect of the non-Chinese speaking consumer, who will recall the features of the respective marks in general terms such as Oriental writing, a flower shaped border and foreign sounding words, there is a real likelihood of confusion, and particularly so when taking into account the possibility of imperfect recollection. The ground of opposition under Section 5(2)(b) succeeds.

48. Although my decision under Section 5(2)(b) effectively decides the matter, for completeness I will go on to consider the remaining grounds. Turning first to the objection based on Section 5(4)(a) of the Act. That section reads as follows:

**5(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,

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.

49. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

(a) that the plaintiff's goods or services have acquired a goodwill or reputation in

the market and are known by some distinguishing feature;

- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

50. To this I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, which are particularly relevant. In that case Pumfrey J said:

There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.

51. I have already mentioned that there is no evidence of the opponents having used the HUNG MEI trade mark in the UK. They say that they have used another trade mark, HONG MEI, in relation to the material for making prawn crackers, but as mentioned above the evidence has a number of flaws and omissions and for the reasons I have given above, does not provide support to the claim to have a reputation and/or goodwill in the UK. The ground under Section 5(4)(a) is dismissed accordingly.

52. Turning to the ground under Section 5(3). That section reads as follows:

5.- (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 Community trade mark, in the European Community) 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.@

53. I have already determined that the opponents' mark is similar to the mark applied for. However, there is no evidence that the opponents have used their earlier marks HUNG MEI, and they do not claim to have done so. Any reputation that may subsist in HONG MEI, and there is a question in relation to this mark, does not assist the opponents; it is a different mark. I have no hesitation in dismissing the ground under Section 5(3).

54. Given my findings in respect of the opponents' reputation I do see how I can find them to be in the position to claim to have a well known mark within the meaning of the Paris Convention, and the ground under Section 56 is dismissed accordingly.

55. Turning finally to the ground under Section 3(6). That section reads as follows:

A3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.@

56. In relation to the ground under Section 3(6). Although it is clear that the applicant knew of the opponents' trade marks prior to making her application, there is no evidence that in doing so Ms Lei was attempting to appropriate a right that she knew belonged to the opponents. I may have found the respective marks to be similar, but only taking into account a range of surrounding circumstances. On a straight mark for mark comparison I would say that the similarity is borderline. I therefore dismiss the ground under Section 3(6).

The opposition having been successful, I order the applicant to pay the opponents the sum of , 1,950 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9<sup>th</sup> day of August 2004**

**Mike Foley  
for the Registrar  
the Comptroller-General**