

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2198914  
BY SAN-EI GEN FFI INC  
TO REGISTER THE TRADE MARK:**

**HELLO BAR**

**IN**

**CLASSES 3, 20, 30, 33**

**AND**

**THE OPPOSITION THERETO  
UNDER No 50635  
BY GÉNÉRALE BISCUIT  
BASED UPON THE EARLIER TRADE MARK:**



**Trade Marks Act 1994**  
**in the matter of application no 2198914**  
**by San-Ei Gen FFI Inc**  
**to register the trade mark:**  
**HELLO BAR**  
**in**  
**classes 3, 20, 30, 33**  
**and**  
**the opposition thereto**  
**under no 50635**  
**by Générale Biscuit**

## **BACKGROUND**

1) On 1 June 1999 San-Ei Gen FFI Inc (San-Ei) applied to register the trade mark **HELLO BAR**. The application was published on 20 October 1999 with the following specification:

*perfumery, essential oils, natural perfumery from vegetables, natural perfumery from animals, synthetic perfumery, compound perfumery, and food flavourings from essential oils; and incenses*

*furniture*

*seasonings, miso (fermented soybean paste) for soup, Worcester sauce, ketchup, soy sauce, vinegar, essence of vinegar, soba-tsuyu (soup for soba), salad dressing, white sauce, mayonnaise, sauce for barbecued meat, lump sugar, fructose, rock sugar (not confectionery), sugar, maltose, honey, glucose for food, saccharized starch powder, thick malt syrup (not confectionery), cooking salt mixed with sesame seeds, cooking salt, ground sesame seeds, celery salts, and chemical seasonings; spices; and aromatic preparations for food (other than "essential oils")*

*alcoholic beverages except beers, Japanese liquors, western liquors; alcoholic beverages of fruit, Chinese liquors, and spiced or flavoured liquors*

The goods are in classes 3, 20, 30 and 33 of the International Classification of Goods and Services.

2) On 20 January 2000 Générale Biscuit (GB) filed a notice of opposition to this application.

3) GB is the owner of Community Trade Mark registration no 872572 for the trade mark:



In the above reproduction the words in the perimeter circle cannot be clearly seen. They are "MADE IN LU" repeated several times. GB claims the colours red (pantone 485) and yellow

(pantone 142).

4) At the time of the filing of the opposition GB's trade mark was not registered. It was an application in classes 5, 16, 25, 29, 30 and 32 of the International Classification of Goods and Services. It was registered on 25 June 2002 with class 32 having been deleted. The goods of relevance to this opposition are:

*pharmaceutical preparations, confectionery for pharmaceutical purposes, flour for pharmaceutical purposes, almond milk for pharmaceutical purposes; milk ferments for pharmaceutical purposes and lactose, medical preparations for slimming purposes, medicinal herbs, oils for medical purposes, medicinal infusions, sugar for medical purposes; salts for mineral water baths, medicated bath preparations, veterinary preparations, nutritive substances for micro-organisms, vitamin preparations, food for babies namely: lacteal flour, soups, soups in dehydrated form, milk, powdered milk, fruit sauces, vegetable puree, vegetable puree in dehydrated form, vegetable juice, gruel*

*meat, fish, ham, poultry, game, charcuterie. dried, preserved and/or cooked fruit and vegetables, fruit sauces, jams, fruit purees, jellies, soups. preserves totally or partially containing meat, fish, ham, poultry, game and/or charcuterie. dried, cooked, preserved, frozen prepared dishes, formed totally or partially from meat, fish, ham, poultry, game and/or charcuterie. savoury or sweet products for aperitifs based on flavoured or natural potatoes, potato crisps; small charcuterie items for aperitifs. milk, powdered milk, flavoured gelified milk and buttermilk. milk products, namely: milk desserts, yoghurt, drinking yoghurt, mousses, creams, dessert creams, fresh cream, butter, cheese pastes, cheese, matured cheese, matured cheese with mould, fresh unmatured cheese and cheese in brine, cream cheese, cheese made in perforated containers, fresh cheese sold as a paste or a liquid, natural or flavoured; beverages made mainly from milk or milk products, beverages made mainly from milk ferments, milk beverages containing fruit. fermented natural or flavoured milk products. edible oils, olive oil and edible fats*

*coffee, tea, cocoa, chocolate; coffee-based beverages, cocoa-based beverages, chocolate-based beverages; sugar, rice, puffed rice, tapioca. flour, tarts and pies (sweet or savoury), pizzas. natural or flavoured and/or stuffed pasta, preparations made from cereals, breakfast cereals. prepared dishes consisting totally or partially of pasta. prepared dishes consisting totally or partially of pastry. bread, rusks, biscuits (sweet or savoury), wafers, waffles, cakes, pastries. all these products being natural and/or in sauce and/or stuffed and/or flavoured. savoury or sweet products for aperitifs containing dough, biscuit or pastry batter. confectionery, ices, ices made totally or partially from yoghurt, ice cream, sorbets (ices), iced yoghurt (ices), flavoured water ices, honey, salt, mustard, vinegar, sauces (condiments), sweet sauces, sauces for pasta, spices*

The above goods are in classes 5, 29 and 30 respectively of the International Classification of Goods and Services.

4) GB is not opposing San-Ei's application in class 20. Initially GB attacked on a range of grounds. However, it eventually limited itself to one ground.

5) GB states that the goods of San-Ei in classes 3, 30 and 33 are similar or identical to the goods of its registration. It also states that the its trade mark and that of San-Ei are similar. Consequently, there is a likelihood of confusion and registration of San-Ei's trade mark would

be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

6) San-Ei filed a counterstatement in which it denied the ground of opposition.

7) Both sides seek an award of costs.

8) Both sides filed evidence.

9) After the completion of the evidence rounds I advised both sides that I believed a decision could be made without a hearing. However, the sides were advised that they retained their right to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers.

10) Both sides sent in written submissions which I have carefully considered and take into account in reaching my decision. Included in this submission of San-Ei are printouts from websites. These do not represent submissions but evidence. San-Ei has made no request to have additional evidence admitted into the proceedings. I, therefore, take no cognisance of the printouts from the Internet.

## **EVIDENCE**

### **Evidence of GB**

11) This consists of a witness statement by Linda Bray, who is a trade mark attorney.

12) The witness statement of Ms Bray represents submissions rather than evidence of fact. The sole evidence of fact is represented by definitions of the word bar:

- a long piece of wood, metal or similar material: bar of chocolate, cereal bar, bar of soap
- an establishment where alcohol and other refreshments are served
- a small shop or stall serving refreshments or providing a specified service: a snack bar

13) I would say no more about the witness statement as it is not evidence of fact. However, it helps in places to clarify the basis of the opposition. In so far as it does I will comment upon it. Ms Bray states that the class 29 and 30 goods of GB are identical or similar to San-Ei's goods in class 30. She further states that the goods of GB in class 32 are similar to those of San-Ei in class 33.

### **Evidence of San-Ei**

14) This is a witness statement by Takeo Inoue who is the general manager of San-Ei. All of Mr Inoue's statement represents submissions rather than evidence of fact and so I will say no more about it.

### **Evidence in reply of GB**

15) This is a further declaration by Ms Bray. Again part of this is submission and I will only comment upon this in so far as it further clarifies the basis of the opposition. Ms Bray states that class 3 of the application covers, amongst other things, *essential oils, food flavourings*

*from essential oils* whilst GB's registration covers, amongst other things, *salt, mustard, vinegar, sauces (condiments) and spices*. Ms Bray states that such goods are very similar.

16) Ms Bray gives evidence on the basis that as a housewife she regularly shops for food. She states that the goods of the application and those of GB's registration are sold side-by-side. She exhibits photographs of a shop called Treohans in Clapham, London. A photograph of the front of the shop shows that it has a single frontage. Underneath the name of the shop are the following words: delicatessen, health food, groceries, toiletries, video and confectionery. There are nine photographs of the inside of the shop. The photographs show various items on display.

17) Printouts from the website for Fortnum and Mason are exhibited. One page lists Christmas foods, another fresh foods and a third a Christmas hamper.

18) An extract from "The Grocer" for 8 December 2001 is exhibited. The main weight of the article is given in the following extract:

"This year has seen a flurry of activity in the meat aisles of all the major supermarket chains, with millions of packs of beef, pork and lamb carrying special money-off coupons for a number of well-known household brands, including Oxo, Bisto Gravy and Sharwood's.

Driven by British Meat, which has acted as the 'go-between' the multiple grocers and third party suppliers, these promotions are designed to stimulate meat sales by focusing on products which need meat as a 'host product', such as cook-in sauces, gravies and snacks.

As well as prompting customers to buy more meat by adding value to their meat purchases, the promotions have an added benefit in that they also drive awareness of the brand owners' products, especially those located in aisles that don't benefit from the same high footfall as meat."

The article goes on to give examples of certain of these tie-ups such as "40p off Sharwood's Hoi-Sin Sauce with every purchase of pork steaks (Asda, Tesco and Sainsbury's), to coincide with a British meat advert highlighting pork as an easy meal solution".

19) A catalogue for Oddbins for 24 September to 28 October 2002 is also exhibited. Ms Bray appears to have exhibited this catalogue to show that class 32 and class 33 goods are similar to one another.

## DECISION

### Likelihood of confusion - section 5(2)(b) of the Act

20) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

Section 6(2) deals with earlier trade marks that are not registered:

“References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

21) The effect of section 6(2) is that GB’s application could be counted as an earlier right prior to its registration. However, no final determination of this case could be made until GB’s application was registered. GB’s application is not registered in respect of the class 32 goods which were originally included in it. Consequently these goods cannot be considered.

22) In determining the question under section 5(2)(b), I 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 BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

### Comparison of goods

23) The European Court of Justice held in *Canon*, in relation to the assessment of the similarity of goods, that the following factors, amongst other things, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

24) In considering the specifications I adopt the approach of Neuberger J in *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 and give the words their natural meaning subject to their being construed within their context.

25) In considering the similarity of goods I am hampered owing to the absence of factual evidence as to the nature of certain of the goods. Certain of the goods are common or garden products which require nothing but everyday knowledge, others are not. It is to be born in

mind that the burden of proof is upon GB (*React Trade Mark* [2000] RPC 285). If I cannot come to a clear conclusion owing to an absence of evidence GB will have to live by the consequences.

26) GB spends a lot of time in making claims as to the respective goods being sold side by side in the same shops or on the Internet. The Internet evidence shows various goods appearing together for a Christmas promotion or a hamper. The shop evidence is from a small store where the shelves are quite clearly crowded. Goods such as spices or sauces are kept together, they form separate groups, however close they are to other groups of goods. The extract from “The Grocer”, like all the exhibited evidence, emanates from well past the relevant date. The article indicates that the tie-in promotions are a recent phenomenon and so might not have been prevalent at the relevant date. I also note that there is no brand connection in the promotions; the meat is branded with the supermarket name, the sauce with another brand name. Even if various products appear in the same area of a shop this is not indicative of them being similar. On GB’s premise the issue of similarity of goods could depend simply on the size of a retail outlet. The smaller the premises the closer various goods will be together. My local newsagent has chewing gum for sale next to “The South Wales Echo”, this does not lead chewing gum and newspapers to being similar. The article from “The Grocer” does not actually indicate that the tie-in goods were sold in the same area of the shops. The special offers that were linked to the meat could still have been in their normal area of the shop. The tie-in is by way of indications on the packs that the customer could claim a reduction in the price of the tie-in goods or in the case of Oxo the goods for free. As for the Christmas hampers, it is common for a wide range of unconnected food and drink products to be in such receptacles. Is it GB’s proposition that because marmalade and champagne might be found in the same hamper that they are similar?

### **Class 33 goods of the application**

27) In its evidence and submissions GB has stated that its class 32 goods are similar to the class 33 goods of the application. GB’s application did include class 32 goods when the application was applied for. At registration the class 32 goods had been dropped. Consequently, GB has no class 32 goods upon which to rely. The claim against the class 33 goods of the application, therefore, fails. I add, for the sake of completeness, that I cannot see that the other goods of GB’s registration intersect with the class 33 goods of the application.

### **Class 3 goods of the application**

28) GB has specifically indicated that it considers *essential oils, food flavourings from essential oils* of the application similar to *salt, mustard, vinegar, sauces (condiments) and spices*. Other than the general attack in the statement of grounds these are the only goods that GB identifies in class 3 as being similar to the goods of its registrations. Applying the *Canon* criteria I certainly cannot see how any of the other goods in class 3 of the application intersect with the goods of GB’s registration. I, therefore, will confine my deliberations to these goods.

29) The potential clash with *essential oils* at large will be if they are used for food flavourings. So effectively the alleged clash is between *food flavourings from essential oils* and *salt, mustard, vinegar, sauces (condiments) and spices*.

30) *Food flavourings from essential oils* are in the problematic category I refer to in paragraph 25 above. The name tells me what the goods do and from what they are derived but I do not

know in what specific form they are sold. Is it liquid, powder or both? I do not know for what specific purposes they are used. Are they used in the food industry or domestically or both? I do not know where the goods are sold. If they are sold in retailers what sort of retailers and in what section?

31) From the title of the goods I consider it reasonable to assume that *food flavourings from essential oils* are very specific goods for a clearly specific purpose. They exist solely as additives to give flavouring and are derived from essential oils. “Collins English Dictionary” (5th Ed 2000) defines essential oil as:

“n. any of various volatile organic oils present in plants, usually containing terpenes and esters and having the odour or flavour of the plant from which they are extracted: used in flavouring and perfumery. Compare; fixed oil; See also; oleoresin”

32) So the *food flavourings* that I am considering are derived from a plant and have the odour or the flavour of the plant. They were also originally volatile organic oils. This leaves me a little wiser but not a great deal. It is like Blitzer’s description of a horse as

“Quadruped. Graminivorous. Forty teeth, namely twenty-four grinders, four eye-teeth, and twelve incisive. Sheds coat in the spring; in marshy countries, sheds hoofs, too. Hoofs hard, but requiring to be shod with iron. Age known by marks in mouth”

Correct but lacking the essence of the thing. No good to anyone who has never seen a horse.

33) From this limited information I can deduce that unlike sauces these particular *food flavourings* are not accompaniments. Any ingredient that is placed in food could be said to be a food flavouring. I think that such an approach is too reductionist. Taking this on board, in my view the real issue relates to whether the goods of GB can be considered primarily as food flavourings of the same nature as San-Ei’s *food flavourings*. The only products that strike me as being primarily for flavouring food in the specification of GB’s registration are *spices*. I have considered *salt* also but this is a very specific product. It is certainly not derived from an organic oil and acts as a seasoning rather than a flavouring. I have turned again to “Collins English Dictionary” for assistance in trying to tie down the nature of a spice:

“n. 1. a; any of a variety of aromatic vegetable substances, such as ginger, cinnamon, nutmeg, used as flavourings. b; these substances collectively.”

I can, therefore, accept that *spices* and *food flavourings from essential oils* are both of plant origin and are both flavourings. Consequently, they have the same ultimate purpose. That they might have the same ultimate purpose does not mean that they are used in similar circumstances, by similar users. A word processor and a pen share the same ultimate purpose. I don’t know, owing to the absence of evidence, if they can be substituted for one another nor if they are complementary. I cannot compare the end users or methods of use, owing to the lack of explanation and evidence in relation to the goods of San-Ei. I do not know what the nature of the *food flavourings* is and so cannot make a reasoned comparison with *spices*.

34) Owing to the lack of evidence and explanation of the nature, use, uses and users of *essential oils* and *food flavourings from essential oils* I cannot find that these goods are similar to the goods of GB's registrations. In reaching this conclusion I am not, I hope, being captious. I simply don't know, in the absence of evidence, if there is a clash of goods.

### **Class 30 goods of the application**

35) *Sauces (condiments), sauces for pasta, vinegar, spices, salt, honey and sugar* in class 30 of GB's registration will encompass the following goods in the specification of the application:

*Worcester sauce, ketchup, soy sauce, vinegar, essence of vinegar, salad dressing, white sauce, mayonnaise, sauce for barbecued meat, lump sugar, fructose, rock sugar (not confectionery), sugar, cooking salt mixed with sesame seeds, cooking salt, celery salts, spices, ground sesame seeds, honey*

Consequently, I consider that the above goods are identical to the goods of the earlier registration.

36) *Seasonings* in the application will include such goods as *spices* and *salt*. Consequently, this term will encompass identical goods. Where the goods are not identical application of the *Canon* criteria will lead to the goods being highly similar.

37) *Chemical seasonings* serve the same purpose as *spices*, both sets of goods being for the seasoning of foods. However, again I do not know what the exact nature of these goods is: how they are sold, where they are sold, who the end users are, the nature of the goods, when they are used, where they are used. In the absence of evidence as to the nature of these goods I cannot come to a conclusion as to whether they are similar to the goods of the earlier registration. I, therefore, must dismiss that claim that these goods are similar to the goods of the earlier registration.

38) "Collins English Dictionary" defines miso as

"n. a thick brown salty paste made from soya beans, used to flavour savoury dishes, esp. soups. [from Japanese]"

I have used miso but doubt that I can assume that my knowledge falls within the bounds of judicial notice. If I did apply that knowledge it would not be to the advantage of GB. I, therefore, will not bring it in and will rely on the dictionary definition.

39) I cannot find any goods in the specification of GB, in any class, that would, on the *Canon* criteria, intersect with *miso (fermented soybean paste) for soup*. I, therefore, find that *miso (fermented soybean paste) for soup* is not similar to the goods of the earlier registration.

40) No explanation has been given as to what *soba-tsuyu (soup for soba)* is. However, the bracketed part of the specification identifies it as a soup. This creates a problem as soups are proper to class 29, not 30; hence soups appearing in the class 29 in the specification of GB. The effect of the decision of the Court of Appeal in *Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34 is that the class in which goods are placed has to be taken into account. This leaves me somewhat puzzled and perplexed. Again no evidence has been brought into

the proceedings that casts any light upon the issue. Do I assume that *soba-tsuyu* is a soup but has been placed in the wrong class, or that it is not a soup and is in the correct class? San-Ei have called it a soup. I feel, therefore, I must take San-Ei at its word and treat it as a soup. Consequently, as the class 29 specification of GB's registration includes *soups* at large, I must find that *soba-tsuyu* (*soup for soba*) is at least similar to the goods of GB's registration.

41) I have no idea what *saccharized starch powder* and *thick malt syrup (not confectionery)* are. Neither side has attempted to enlighten me. "Collins English Dictionary" has not been able to come to my aid. The terms do not occur in the specification of GB's registration. I, therefore, cannot assume identity or similarity from an identity of language. In the absence of evidence in relation to these goods I must, again, find that they are not similar.

42) I return to "Collins English Dictionary" to assist me in the consideration of *maltose*:

"n. a disaccharide of glucose formed by the enzymic hydrolysis of starch: used in bacteriological culture media and as a nutrient in infant feeding. Formula: C<sub>12</sub>H<sub>22</sub>O<sub>11</sub>. [C19: from malt + -ose2]"

If the *maltose* was to be used as a nutrient in infant feeding it would fall within class 5 rather than class 30. So all I know is that it is some form of starch which is, presumably, appropriate to class 30. Yet again I have no way of knowing the exact, or even inexact, nature of the goods. It is for GB to prove its case. If GB consider that *maltose* is similar to its goods it should have put in evidence to support this. It certainly could not rely on judicial notice as to the nature of the product. Again, in my position of ignorance, I must find that the *maltose* is not similar to the goods of GB's registration.

44) For *glucose for food* I again fall back on "Collins English Dictionary":

"n. 1. a white crystalline monosaccharide sugar that has several optically active forms, the most abundant being dextrose: a major energy source in metabolism. Formula: C<sub>6</sub>H<sub>12</sub>O<sub>6</sub>. 2. a yellowish syrup (or, after desiccation, a solid) containing dextrose, maltose, and dextrin, obtained by incomplete hydrolysis of starch: used in confectionery, fermentation, etc. [C19: from French, from Greek *gleukos* sweet wine; related to Greek] *glukus* sweet; *glucosic*; adj."

The definition tells me that *glucose* is a sugar. GB's specification includes *sugar* at large. Consequently, it encompasses *glucose*, as it also encompasses *fructose* – see paragraph 35 above. *Glucose for food* is, therefore, identical to the goods of the earlier registration.

45) This leaves *aromatic preparations for food (other than "essential oils")* to be considered. *Spices* could also be described as *aromatic preparations for food*. I am, therefore, of the view that *aromatic preparations for food (other than "essential oils")* if not necessarily identical to the goods of GB's registration are certainly very similar.

**46) To sum up, the following goods of the application are either identical to the goods of GB's registration or are highly similar:**

*Worcester sauce, ketchup, soy sauce, vinegar, essence of vinegar, salad dressing, white sauce, mayonnaise, sauce for barbecued meat, lump sugar, fructose, rock sugar (not confectionery), sugar, cooking salt mixed with sesame seeds, cooking salt, celery salts, spices, ground sesame seeds, honey, glucose for food, seasonings, soba-tsuyu (soup for soba), aromatic preparations for food (other than "essential oils")*

**The other goods under attack in classes 3, 30 and 33 are neither identical nor similar.**

47) In considering the similarity of the goods I have been reminded of the finding of the ECJ in *Canon*.

“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.”

This is certainly a case where evidence of similarity would have been of assistance. If the evidence of GB has any value it certainly has none in respect of the goods in class 30 of the application which I have found are not similar. There is not a shred of evidence in relation to such goods.

## Comparison of trade marks

48) The trade marks to be compared are:

**GB's registration:**

**San-Ei's application:**

**HELLO BAR**



(I have reproduced GB's registration in a large scale in order that the matter in the perimeter is clearly visible.)

49) GB's trade mark claims the colours red and yellow. There is nothing to stop San-Ei using its trade mark in pantone 485 in normal and fair use, it is not restricted by colour. Consequently, I do not consider that anything turns upon the colour claim of GB.

50) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 BV* page 84, paragraph 27).

51) The common element in the two trade marks is obviously the word HELLO. I consider that in GB's trade mark the overall impression is very much of a HELLO trade mark. In terms of position and size this is the dominant element; it puts all other parts of the trade mark in the shade. It is the element which shouts at the consumer and is likely to be the hook upon which the consumer hangs his recollection and recognition. Visually the main element that will be remembered is the word HELLO, the amount of stylisation of the rest of the trade mark is quite limited. The words MADE IN LU on the perimeter give the impression that this is simply an indication as to from where the goods originate. I have no idea if LU is a place but the nature of the wording is such as to give rise to this presumption.

52) San-Ei's application must be considered in its entirety. The public do not normally dissect trade marks. However, as said above I need to also take into account the distinctive and dominant components of the trade mark. I need to consider how distinctive the word BAR is, will it play only a minor part in the recall of the consumer? The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). I need to consider the word BAR in relation to the goods which I have found similar, these are the only goods for which the trade mark can be refused. None of the goods which I have found similar would in the normal course of events be in the shape or form of a bar. Equally none of the goods are the sort of goods that would normally be sold in a bar. Consequently, in the context of the relevant goods the word BAR cannot be discounted as being non-distinctive. On the other hand HELLO is the first word in San-Ei's trade mark and has two syllables to BAR's one. I consider that it is the dominant element, if not the dominating element.

53) Owing to the common presence of the word HELLO in the two trade marks I consider that there is a degree of visual, aural and conceptual similarity. At the same time I do not lose sight of the fact that in considering the two trade marks in their entirety that this similarity is not overpowering. **It is my view that there is a low degree of similarity between the two trade marks.**

## Conclusion

54) For me to find that there is a likelihood of confusion trade marks have to be similar. This is what the Act states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

So there can be no likelihood of confusion in respect of the non-similar goods and I will say no more about them.

55) There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). I cannot see that GB's trade mark is descriptive or allusive of the goods it encompasses. There is nothing to suggest that it is not a highly distinctive trade mark and I

make my decision based upon this premise. The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case where the goods clash they are either identical or highly similar, consequently this will mitigate the low degree of similarity between the trade marks. I also need to take into account the nature of the goods as this affects how the trade marks may be seen. The goods of San-Ei could well be sold in round containers or packaging, such as bottles. In such circumstances it is possible that the entire trade mark will not be on view to the consumer, he or she might see just the HELLO element. The goods involved are not particularly high cost items. Consequently, the average consumer is not likely to make a particularly careful and educated purchasing decision.

**56) I have experienced some difficulty in coming to a conclusion as to whether there is a likelihood of confusion. However, taking into account all the facts of the case and the relevant case law I find that there is a likelihood of confusion in respect of the following goods in class 30 of San-Ei's application:**

*Worcester sauce, ketchup, soy sauce, vinegar, essence of vinegar, salad dressing, white sauce, mayonnaise, sauce for barbecued meat, lump sugar, fructose, rock sugar (not confectionery), sugar, cooking salt mixed with sesame seeds, cooking salt, celery salts, spices, ground sesame seeds, honey, glucose for food, seasonings, soba-tsuyu (soup for soba), aromatic preparations for food (other than "essential oils")*

**The opposition fails in respect of all the goods in classes 3 and 33 and the remaining goods in class 30. San-Ei should file, within one month of the expiry of the appeal period from this decision, a form TM21 to remove the above goods from the class 30 specification of the application. This will leave:**

*miso (fermented soybean paste) for soup, maltose, saccharized starch powder, thick malt syrup (not confectionery) and chemical seasonings*

**in the class 30 specification. If no form TM21 is filed within the period set the application will be refused in its entirety.**

## **COSTS**

57) In her submissions for GB Ms Bray made various comments in relation to costs. She claims costs for having to prove title to GB's title to its trade mark. I do not consider that the attachment of a printout from the Office for Harmonization in the Internal Market website to her witness statement would have put GB to any great cost. I also note that Ms Bray did not supply a printout showing the details of GB's trade mark as registered, which differ importantly from the details of the application.

58) Ms Bray comments that in a request for an extension of time San-Ei stated that it would file evidence from third parties in the food and beverage industry to support its case. She states that no such evidence was forthcoming and so GB claims costs thrown away in preparing to meet such evidence. I do not understand how GB could prepare or take action until it had seen any such evidence. It would have had to put in evidence in reply, not new evidence. I am not swayed by this claim.

59) Ms Bray states that San-Ei sought to bring in further allegations of fact in its written submissions and that GB claims its costs in dealing with them. This refers to the website printouts. As I have indicated such matter was clearly not admissible. I do not see GB was put to any great cost in dealing with the matter.

60) I note that GB raised four grounds of opposition for which no evidence was submitted and which were only abandoned in the written submissions of Ms Bray. The grounds of opposition did not indicate which specific goods of GB were considered to be similar to which specific goods of San-Ei. The specifics of the case only came out in evidence and submissions. In her submissions of 7 October 2002 Ms Bray still continued to rely on class 32 goods in GB's trade mark. GB's trade mark was registered on 25 June 2002 without such goods. Ms Bray specifically comments on the effort GB was put to to prove its ownership of the trade mark upon which it relies (see paragraph 57 above). However, it did not go to any effort to supply the details of the trade mark as registered; leaving San-Ei to still argue over the differences between class 32 and class 33 goods.

61) I certainly do not consider that GB is deserving of any special consideration in relation to costs. GB attacked all the goods of the application in classes 3, 30 and 33. So for the most part it has lost. The loss of its class 32 goods might have affected the outcome. However, following the loss of these goods GB did not advise San-Ei nor amend the basis of its opposition but instead continued to rely upon them in written submissions. It relied upon them and so must take the consequences of such a reliance.

62) I would estimate that San-Ei has been two thirds successful, on a rough and ready basis. I have decided to award San-Ei roughly two thirds of the costs that I would have awarded if it had been completely successful.

**63) I order Générale Biscuit to pay San-Ei Gen FFI Inc the sum of £650. This sum is 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 6<sup>th</sup> day of December 2002**

**D.W.Landau  
For the Registrar  
the Comptroller-General**