

TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF APPLICATION NO 753073
IN THE NAME OF SOCIETE DES PRODUITS NESTLE SA

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70646 IN THE NAME OF
BERNARD MATTHEWS LIMITED

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF application No 753073
in the name of Societe des Produits Nestle SA**

And

**IN THE MATTER OF opposition thereto under No 70646
in the name of Bernard Matthews Limited**

Background

1. On 14 February 2001, Societe des Produits Nestle SA made an application under the Madrid Protocol, designating the United Kingdom as a country into which they sought to extend protection for their registered trade mark HANDWICH. The trade mark is protected in Classes 29, 30, 35, 39 and 42, although the opposition only stands against Classes 29 and 30. The specification for Class 29 was amended in January 2003, and taking this into account the specifications for the classes at issue stand as follows:

Class 29 Vegetables, fruit, fish and fish and seafood, all of these products also in the form of extracts, soups, jellies, spreads, preserves, cooked meals, all deep frozen or dehydrated; jams; eggs; milk; milk based products; milk product substitutes; soya milk and other soya based preparations; edible oils and fats; protein preparations for consumption; but not including cheese

Class 30 Bakery products, bread, yeast, pastry articles; biscuits, cakes, desserts, rice, pasta, foodstuffs made with rice, flour or cereals, also in the form of cooked dishes; sauces; products for flavouring or seasoning foodstuffs, salad dressings, mayonnaise.

2. On 31 July 2001, Bernard Matthews Limited filed notice of opposition against classes 29 and 30 of this designation, the grounds being in summary:

1. Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier trade mark registrations, and is sought to be registered in respect of identical or similar goods to those for which these earlier are registered such that there exists a likelihood of confusion.

2. Under Section 5(4)(a) by virtue of the law of passing off.

3. Under Section 5(3) because use of the mark applied for in respect of dissimilar goods would take advantage of, or be detrimental to the distinctive character or repute of the opponents' earlier marks.

3. The earlier marks relied upon by the opponents are as follows:

Number	Mark	Class	Specification
1203293	HAMWICH	29	Turkey ham being smoked and cured and cooked or coated in batter and breadcrumbs (other than for animals).
1314354	HAMWICH	29	Meat, meat products, poultry (not live), poultry products, all for food for human consumption, and all being ham; prepared meals containing the aforesaid goods; all included in Class 29.

4. The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Only the opponents filed evidence in these proceedings. The matter came to be heard on 31 March 2003, when the opponents were represented by Ms Helyn Mensah of Counsel, instructed by F J Cleveland, their trade mark attorneys. The applicants were not represented but provided written submissions.

Opponents' evidence

7. This consists of a Witness Statement 10 July 2002, from David M Reger, Company Secretary of Bernard Matthews Limited.

8. Mr Reger states that his company's trade mark HAMWICH, has been in continuous use in the United Kingdom since 1984, in relation to a product described as containing meat, poultry, cheese, breadcrumbs, vegetable oil, batter and other food ingredients. He sets out the details relating to his company's two earlier trade marks, and refers to exhibit DMR1 which consists of registration and renewal certificates for, the same. He sets out the ex-factory sales figures for two HAMWICH products, described as "crispy crumb" and "cheese", giving the combined tonnage and financial figures as following:

Year	Sales - Tonnage	Sales - £
1985	1,681	1,315,000
1986	1,630	2,304,000
1987	1,378	3,044,000
1988	1,273	2,856,000
1989	1,030	2,455,000
1990	921	2,482,000
1991	902	2,755,000
1992	901	2,791,000
1993	644	2,202,000
1994	562	1,958,000
1995	588	1,867,000
1996	580	2,124,000
1997	567	2,106,000
1998	332	1,295,000
1999	486	1,553,000
2000	371	1,158,000
2001	257	794,000

9. Mr Reger says that the sales figures are wholesale and that the turnover figures at retail level would be approximately 50% higher.

10. Mr Reger states that his company's food products sold under the name HAMWICH have been promoted in television campaigns, in advertisements placed in the national press and in magazines, giving the following examples:

HAMWICH CRISPY CRUM - A television campaign in October/November 1984 on the Central, Tyne Tees & Scottish television networks, details being given in a video tape shown as exhibit DMR2. A total expenditure £584,807.given

- HAMWICH CHEESE - A television campaign in Jan/Feb 1986 on TVS and Anglia, March/June 1986 on London, Granada, Yorkshire, Tyne Tees, Scottish, HTV, TSW, Border and Grampian, Jan/June 1990 on London, Granada, Yorkshire, Tyne Tees, Scottish Grampian, TVS, HTV and Anglia TSV, Total expenditure of £514.966.

11. Mr Reger gives details of advertising campaigns in the national press conducted in 1992 and 1999 at a cost of £87,425 and £67,400 respectively, and in the Sainsbury's magazine in 1998. Exhibit DMR2 consists of two video tapes that are said to have been used in television commercials featuring the goods sold under HAMWICH (1984) and CHEESE HAMWICH (1986). The tapes depict a turkey, and turkey-cheese product, both with a bread crumb coating. Exhibit DMR3 consists of various press advertisements for the same goods, but in all but one

case, an advertisement for CHEESE HAMWICH that depicts a packaging bearing a “best before” date of Nov 99, are undated. Exhibit DMR4 consists of an extract from a usage and attitude survey for the HAMWICH products conducted between 1985 and 1991.

12. Mr Reger gives a list of the main supermarkets that have sold the HAMWICH products, which includes most of the major supermarket chains. He goes on to refer to exhibit DMR5, which he describes as an extract from Bernard Matthews Food Service, which refers to the launch of the triangular and round cheese HAMWICH in August 1999 and April 1999, respectively. The exhibit gives figures under the headings “corporations” and “invoice cases”, although does not explain what these actually relate to.

13. Mr Reger says that his company has an established trade mark with a reputation for prepared food products, and is concerned by the proposed adoption of the mark applied for by the applicants, which encompasses the same foodstuffs. He goes on to say why he considers HANDWICH and HAMWICH to be visually and phonetically similar, and that taking into account his company’s long use and overlap in the channels of trade, the consumer would be misled and confused into associating the products or lead them to believe they come from the same source.

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

Decision

14. Turning first to the ground under Section 5(2)(b), that section reads as follows:

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

- (a) 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,
- (b) there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

“6.- (1) In this Act an “earlier trade mark” means—

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,

- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well known trade mark.”

16. In my consideration of a likelihood of confusion or deception 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 Schufabrik 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 Schufabrik 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 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*,

17. The opponents rely on two earlier trade marks, both for the word HAMWICH in plain script. In their written submissions the applicants say that these marks are conceptually distinct from their HANDWICH mark, the opponents' marks evoking the idea of ham or a meat product, whereas their's brings to mind the idea of a hand-held snack or sandwich with no reference to meat. They go on to say that when pronounced the emphasis in the opponents' mark will be on the prefix "HA-M", whereas with HAN-D the stress on pronunciation will be at the end of one prefix, citing two cases where it was accepted that the first syllable of a word is of most importance. They also mention that when the mark was examined, the registrar did not cite the opponents' marks against their application (a fact that has no bearing on my consideration of the issues) and that the evidence shows that the opponents use their mark in conjunction with the descriptors "crispy" and "crispy crumb". Whilst this may have some impact on the decision in respect of Sections 5(4)(a) and 5(3), in determining the objection founded on Section 5(2) I am required to undertake a notional consideration of the opponents' marks as registered, if used in a normal and fair manner in relation to the goods for which it is registered, and then to assess the likelihood of confusion in relation to the way the applicant uses (or notionally, may use) their mark discounting external circumstances. (*Origins natural Resources v Origin Clothing* [1995] FSR 280).

18. The opponents contend that the application is in respect of identical and similar goods to those covered by their earlier marks, that share the same channels of trade, to the same consumers, and being ordinary, inexpensive and easily available foodstuffs, would not require special care or attention in selection. Ms Mensah submitted that HAMWICH is a fanciful and invented word with an inherent distinctive character and acquired reputation, is conceptually similar in that both allude to "sandwiches" phonetically and aurally similar as both share the same initial syllable and suffix and that the "D" in HANDWICH would be overlooked and pronounced as HANWICH, and visually similar because the only difference is in the middle of the word with no features that would distinguish it from the mark applied for.

19. Whilst marks should be compared as a whole, it is inevitable when assessing similarity that regard will be paid to the individual elements and should be where one is dominant or particularly distinctive. Both HANDWICH and HAMWICH are composed of two discernable parts, and in both cases the first element is an ordinary English word HAM in the case of the opponents mark, and HAND in the applicants' mark. Both are conjoined to an identical suffix, WICH. It is not difficult to see the message that both parties are trying to send to the consumer; they are either

composed of ham or held in the hand, and are in the form of sandwich. But as a totality both must be considered as being invented words, albeit not particularly skillful or covert in their construction. Neither, in my view, has an element that I would consider to be the dominant; their distinctiveness rests in the whole.

20. The words have but one letter difference in their length. They share the same first syllable “HA” and suffix “WICH”, the only difference in the lettering is that the first syllable ends in the letter “M” in the opponents’ mark, compared to the letters “ND” in the applicants’ mark. This interchange of lettering occurs in the middle of the words, where in my view it is less likely to hit the eye of the consumer than, for example, if the difference had been in the initial letters. Seen as a whole, I would say the respective words have a strong visual similarity.

21. Given that the respective marks share the same first syllable, HA, and same suffix, WICH, if there is any difference orally and aurally, this must rest on the impact of the letter “ND” as compared to the letter “M”. In my view the letter “N” has a phonetic resemblance to the letter “M”, the degree of resemblance varying according to how and where it appears in a word. The opponents’ contend that when spoken, the letter “D” in HANDWICH would be all but silent, and would be pronounced and heard as if it were HANWICH. From my own knowledge and experience I would, to a certain extent, agree with this submission. Consumers do not pay regard to each and every syllable of which a word is composed, and whilst I do not go so far as to say that the letter “D” has no impact on the way in which HANDWICH is likely to be enunciated or heard, placed in the body of a word, where I consider less emphasis is placed on the pronunciation of the individual letters, much of its sound will be lost. I take the view that in normal, everyday usage, the words HANDWICH and HAMWICH would have a very similar sound.

22. Although HAM and HAND have a number of different meanings, their more common meanings, would be known to any person with a reasonable command of the English language; HAM to denote a type of meat (particularly when used in relation to a foodstuff) and HAND as being the prehensile part of the body at the end of the arm. Although it has been suggested that WICH is a reference to SANDWICH, as far as I am aware, (there is no evidence to assist me) this suffix has no particular meaning in relation to the goods at issue. Whether or not this is the case, from the references in the evidence I believe it is reasonable to infer that both parties have adopted it to convey the “SANDWICH message to the consumer, be it as something placed between bread, or that the foodstuff is composed of layers. Whilst it is, at best a passing reference, it is not one that I consider would escape the consumer when used in relation to a foodstuff, and I come to the view that there is also a degree of conceptual similarity in the respective marks.

23. The evidence shows that by the relevant date the opponents had been using HAMWICH as a trade mark for over 15 years, and on a substantial, albeit in latter years, diminishing scale. Promotion of goods sold under HAMWICH has been nationwide and high profile. This use, however, has been in respect of a limited range of goods, namely, slices of turkey ham, or turkey and pork, with and without a layer of cheese, with a batter/breadcrumbs coating. The cheese

variety is sold under the name CHEESE HAMWICH.

24. Exhibit DMR5 shows that in September 2001, the opponents were trading in other types of foodstuffs, including fish and vegetable products. Although not sold under HAMWICH, this trade could have established a connection between the opponents and such goods in the minds of the consumer, and increase the possibility of confusion. However, the exhibit relates to use after the relevant date in these proceedings, but in any event, I have no details of the extent of this trade by which I could have gauged its likely impact on the consumer. On the basis of the evidence provided I conclude that at the relevant date the opponents had a strong reputation in the name HAMWICH, but only in relation to their coated turkey-ham based product.

25. Turning to the question of whether the respective goods are either the same or similar. The opponents' earlier marks essentially cover ham, poultry and prepared meals made from these hams. The applicants removed all specific references to meat from their specification, so the question is whether any of the remaining terms includes identical goods, or goods that would be considered similar. In determining this question I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281, the "Treat" case and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The physical nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

26. I also take into account the decision in the OFREX case [1963] RPC 169, in which of Pennycuik J stated:

“What is said is that staples do not come within class 39 as an item of stationery..... In order to answer that question, the first step I think is to look at the ordinary meaning of the word “stationery”, which as defined in the Oxford English Dictionary is: “the articles sold by a stationer; writing materials, writing table appurtenances, etc”. I feel no doubt that staples are stationery, according to the ordinary meaning of the word”.

27. and in the *Treat* case:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade."

28. Ms Mensah put the opponents' case as follows:

“The opponent’s marks for HAMWICH are registered in Class 29 for (inter alia) meat and poultry (products), and prepared meals containing the same. As such the application for the International Mark is made partly in respect of identical goods insofar as the class 30 specification covers products containing meat of poultry and/or cooked or prepared good products containing the same. Fish and seafood products as covered in the specification (class 29) are goods similar to those covered by the opponent’s marks being goods of a similar nature; sold in proximity via the same outlets; to the same customers; catering for the same of similar purposes and needs. The goods in question are ordinary consumer foods which are relatively and easily available in supermarkets; they are not the kind that requires special or particular care in selection.”

29. Strictly speaking, Ms Mensah is not correct in saying that the opponents' two earlier marks are registered in respect of meat and poultry products, and prepared meals containing the same. The first is registered in respect of a breaded/battered turkey ham product, and whilst the second registration covers meat and poultry products, this is limited to being ham, or in the case of the prepared meals, being made from this ham.

30. In relation to Class 29 of the application. Ms Mensah based her arguments solely upon the premise that fish and seafood products are similar goods to meat and poultry products. This is, I believe, a sensible approach, as in my view the remainder of the goods in the specification are clearly quite different from those contained within the specifications of the opponents' earlier marks, and for which they had acquired a reputation at the relevant date.

31. The definitions for “meat” given in Collins English Dictionary include “**1.** the flesh of mammals used as food, as distinguished from that of birds and fish. **2.** Anything edible, especially flesh with the texture of meat; crab meat”. Although there is a distinction drawn between meat derived from animals and that obtained from fish, it is clear that the term meat can encompass animal, poultry, fish and seafood products. Setting aside this academic consideration of the specification and looking from a practical point of view, such goods are all forms of edible

flesh and as such should be considered to be the similar in their nature and the same in purpose. The distinction between the various types of flesh becomes even more blurred when it is prepared into a form where it is coated, such as in batter or breadcrumbs.

32. Although there is evidence that indicates that the opponents are involved in the provision of animal based foodstuffs and seafood, this originates from after the relevant date. There being no other evidence of this kind, I do not know whether this is the usual state of affairs with foodstuffs manufacturers, or whether the opponents are the exception. The meat and seafood may come together in the wholesale part of the trade channel, but again I have no evidence to assist, although I am aware that there are two well known markets in London, Billingsgate and Smithfield, that trade exclusively in seafood and meat, respectively. I know from personal experience that when the goods reach the retailer for sale to the consumer, the larger food retailers may stock both fresh fish and fresh meat, which would be sold on separate counters, and where prepared or frozen, in shelves or freezers distinct from one another. Smaller retailers may have freezer cabinets where the segregation between meat and fish products all but disappears. There are also some speciality retailers, such as delicatessen's that sell both types of goods, otherwise there are shops such as fishmongers and butchers who trade exclusively in seafood or meat, respectively.

33. Wherever goods are of the same nature or for the same purpose, they are likely to be in competition; seafood may well be eaten as an alternative to meat, particularly by the health conscious consumer or those concerned about animal welfare. It does, however, seem unlikely that seafood and meat would be considered to be complementary products. I have no evidence as to how the trade classifies these goods, but I would surmise that given the difference in their origins and their treatment at the retail end of the chain, they would be considered to be different and distinct trades.

34. On balance I would say that cuts of meat, wet fish and seafood are not similar goods, but where it has been prepared into a meal of the type for which the opponents have used their HAMWICH mark, that is, covered in a batter or crumb, and taking into account the opponents' reputation, that these should be considered as being similar foodstuffs.

35. Turning to the goods covered by Class 30 of the application. Ms Mensah submitted that insofar as the specification covers products containing meat of poultry and/or cooked or prepared good products containing the same, that these goods were identical to those covered by the opponents' earlier mark. That the respective goods are in different classes of the International Classification means that they can, at best, be no more than similar, and I would say that the fact that the goods in Class 30 of the application may contain meat or poultry does not, of itself, make them similar.

36. Ms Mensah did not specify the goods containing meat within Class 30 of the application that she considered to be identical to those covered by her clients' earlier mark, but in my view the

reference must be those of the like of pies and pasties where meat comprises a significant proportion of the product. Such goods are different in nature to meat and poultry, or slices of such meat with a coating of crumb or batter. The end-users and uses of the goods would be the same, and insofar as they are both ordinary items of foodstuffs, would be in competition for the consumer's attention, although I would not say that they are complementary. I have no evidence, but I would say it is reasonable to infer that what would ordinarily be termed as bakery products would be regarded by the trade as being different goods, and although they may meet in the trade channels, would, in my experience, be stocked on different shelves in distinct areas of a retail establishment. Although the opponents make reference to their HAMWICH being eaten as a sandwich between layers of bread, this is not how their HAMWICH products are sold to the consumer, nor would such goods be covered by their earlier marks. Taking into account that the opponents' reputation subsists in a coated turkey-ham product, on the factors before me, I come to the view that Class 30 of the application does not contain goods similar to those covered by the opponents' earlier marks.

37. Adopting the "global" view advocated, I find that the similarities are such that use by the applicants of their mark in respect of the goods covered by Class 29 of their application, specifically, prepared fish and/or seafood coated in batter or crumb, will cause the public to wrongly believe that their goods come from the opponents or an economically linked undertaking and consequently, that there is a likelihood of confusion. The ground under Section 5(2)(b) therefore succeeds. In respect of Class 30 although the respective marks are similar, the respective goods are not, and taking all other factors into account, I find that there is no likelihood of confusion.

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

“5.-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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.”

39. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039), Mr Simon Thorley QC sitting as a Deputy High Court Judge put the enquiry under Section 5(3) as follows:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants' use of the sign is:

- (a) without due cause; and
- (b). takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

40. The opponents rely on two registered trade marks. Both have an effective date prior to the relevant date in these proceedings, and therefore constitute earlier marks within the meaning of Section 6 above. I have already determined that these marks would be regarded as being similar to the mark under opposition, and that the application covers goods that are dissimilar (and similar) to the marks relied upon by the opponents.

41. The wording of Section 5(3) indicates that the basis of an objection under that section is that the opponents' reputation in an earlier trade mark is such that use of the same or a similar mark in respect of dissimilar goods by another party will lead to the distinctive character or repute of that earlier trade mark being adversely affected in some material way, or the applicants riding on its reputation to their advantage. However, in her skeleton argument Ms Mensah referred me to a decision of the ECJ, saying:

"Insofar as any of the goods objected to are (or are found to be) not similar the Opponent relies upon this ground of objection. Following the judgement of the ECJ in the recent case of *Zino Davidoff & Cie SA v Gofkid Limited*, Case C292/00 9 January 2003 (unreported) the Opponent contends that this ground is in any event applicable whether the goods in respect of which complaint is made are found to be similar or not similar."

42. Whilst I appreciate that following the *Davidoff* case it may be possible to rely on similar goods for Section 5(3) purposes, that is not the case pleaded by the opponents and there has been no request to amend the grounds. In any case, to the extent that the opponents' objection is based on the applicants' goods being similar to those for which the opponents' marks have a reputation, I do not see that this takes their case any further forward than that determined under Section 5(2)(b).

43. In *General Motors Company Ltd v Yplon SA* [1999] ETMR 122, it was said:

"The degree of knowledge acquired must be considered to be reached when the earlier trade mark is known by a significant part of the public concerned by the product or services covered by the trade mark."

44. The goods covered by the opponents' earlier trade marks, and those covered by the application are ordinary, everyday foodstuffs available to, and purchased by the general public, which defines who should be regarded as "the public concerned".

The opponents' mark HAMWICH is prima facie distinctive in relation to the goods for which it has been registered. They have made long and extensive use of the mark but only in relation to a particular coated turkey-ham based product, and whilst I have not doubt that they have established a significant reputation, it is only in respect of this item.

45. The General Motors case went on to consider how the requirements in determining whether a sign should be considered to take unfair advantage of, or be detrimental to, the distinctive character or the repute of an earlier trade mark, saying:

“It is to be noted in particular that Article 5(2) [the equivalent of Section 5(3)] in contrast to Article 5(1)(b) [the equivalent of Section 5(2)] does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “take unfair advantage of, or is detrimental”. Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say properly established to the satisfaction of the National Court.”

46. In *Barclays Bank v RBS Advanta* [1996] 10 RPC 307, Mr Justice Laddie said in relation to equivalent wording in the proviso to Section 10(6):

“At the most these final words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered mark which is above the level of de minimis.”

47. Although there is evidence that indicates that the opponents are involved in the provision of foodstuffs beyond those covered by their earlier marks this originates from after the relevant date. There is nothing that informs me as to the practices within foodstuffs industry, and on the basis of the evidence before me, I see no reason why the consumer should assume a connection between a company known for a prepared turkey-ham foodstuff, and a trader in fruit and vegetables, cereal products and the like, even if sold under a resembling mark. Consequently, I am unable to see how the applicants could derive any advantage from, or that their use would be detrimental to the opponents' reputation in the trade mark HAMWICH. In relation to the goods for which it has a reputation it will be just as distinctive as it ever was, and the ground under Section 5(3) is dismissed accordingly.

48. This leaves the ground under Section 5(4)(a). The opponents used the mark in the form in which it is registered, and in relation to a lesser range of goods, and for reasons similar to those I have expressed in relation to the ground under Section 5(3), I consider the ground under Section 5(4)(a) to add nothing to this case, a position acknowledged by Ms Mensah in her submissions.

49. The opposition having been successful, albeit in part, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of £1,600 as a contribution towards their costs. This sum reflects the fact that the opposition may have been successful, but only in relation to a part of one class of the application. 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 1st day of October 2003

**Mike Foley
for the Registrar**