

**BL O-476-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**INTERNATIONAL REGISTRATION DESIGNATING THE UNITED KINGDOM  
WO0000001291655**

**BY JOH. WILH. VON EICKEN GMBH**

**TO REGISTER THE FOLLOWING TRADE MARK:**

The logo for 'Hello! Energy' features the word 'Hello!' in a large, bold, rounded, and bubbly font. The exclamation mark is integrated into the design. To the right of 'Hello!', the word 'Energy' is written in a smaller, more standard sans-serif font.

**AND**

**OPPOSITION THERETO (No 410206)**

**BY COMME J'AIME**

## **Background and pleadings**

1. **Joh. Wilh. Von Eicken GmbH** (the holder) requested protection of International Registration (IR) WO0000001291655 for the mark:



in the UK on 28 June 2016. It was published on 09 June 2017, in accordance with the Trade Marks (International Registration) Order 2008 (SI 2008/2206 as amended). The holder requests protection for the mark in respect of the following goods:

**Class 29:** Flavored milk drinks; milk drinks containing fruit; milk drinks, also containing fruit juice; milk drinks, also containing coffee; milk drinks staggered with flavors.

**Class 30:** Granola bars and energy bars.

**Class 32:** Energy drinks; energy drinks containing caffeine; smoothies.

2. **COMME J'AIME** (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act), relying upon its earlier United Kingdom Trade Mark 3167803 for the mark **HELLO DIET**. The following goods and services are relied upon in this opposition:

**Class 29:** Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; but excluding goods containing chocolate or cocoa for sale in shops or supermarkets.

**Class 30:** Coffee, tea and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; ices; sugar,

honey, treacle; ice; but excluding goods being or containing chocolate or cocoa for sale in shops or supermarkets.

**Class 31:** Grains and agricultural, horticultural and forestry products not included in other classes; fresh fruits and vegetables; seeds; natural plants and flowers; malt.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; but excluding goods containing chocolate or cocoa for sale in shops or supermarkets.

**Class 43:** Services for providing food and drink

3. The opponent claims in its statement of grounds that all of the applied for goods are identical or highly similar to the goods and services protected under its earlier mark, and that the marks are similar.
4. The holder claims in its counterstatement that there is no likelihood of confusion for the following reasons: The holder's mark comprises three elements, namely the word 'Hello', an exclamation mark and the word 'Energy', whilst the opponent's mark comprises just two elements, namely the word 'HELLO' and the word 'DIET'. The holder's mark is a figurative mark whilst the opponent's mark is a plain word mark. The word 'HELLO' in the marks is presented differently and also is a common greeting word that no-one should have a monopoly over. The last parts of the marks are very different. The opponent's mark is very generic and so should have only limited protection.
5. The opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
6. The holder has been represented throughout the proceedings by Oliver Nils Wrede whilst the opponent has been represented by Dehns.

## **Decision**

### **Section 5(2)(b)**

7. Section 5(2)(b) of the Act is as follows:

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

(a) ....

(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.”

8. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

9. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

10. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective 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) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. The parties’ respective specifications are:

<b>Earlier mark</b>	<b>International Registration</b>
<p><b>Class 29:</b> Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; but excluding goods containing chocolate or cocoa for sale in shops or supermarkets.</p> <p><b>Class 30:</b> Coffee, tea and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; ices; sugar, honey, treacle; ice; but excluding goods being or containing chocolate or cocoa for sale in shops or supermarkets.</p>	<p><b>Class 29:</b> Flavored milk drinks; milk drinks containing fruit; milk drinks, also containing fruit juice; milk drinks, also containing coffee; milk drinks staggered with flavors.</p> <p><b>Class 30:</b> Granola bars and energy bars.</p> <p><b>Class 32:</b> Energy drinks; energy drinks containing caffeine; smoothies.</p>

**Class 31:** Grains and agricultural, horticultural and forestry products not included in other classes; fresh fruits and vegetables; seeds; natural plants and flowers; malt.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; but excluding goods containing chocolate or cocoa for sale in shops or supermarkets.

**Class 43:** Services for providing food and drink.

13. **Class 29:** The applied for goods ‘Flavored milk drinks; milk drinks containing fruit; milk drinks, also containing fruit juice; milk drinks, also containing coffee; milk drinks staggered with flavors’ are all milk based beverages intended for consumption, to quench the thirst of the consumer and for pleasure. The opponent’s earlier goods ‘milk and milk products’ in the same class, are goods which wholly encompass milk based beverages *per se* and are therefore considered to be identical.

14. The opponent’s earlier goods ‘non-alcoholic beverages’ in class 32 include an extremely wide range of beverages intended for consumption and to quench the thirst of the consumer. These goods share nature, purpose, channels of trade and end user with the applied for goods in class 29. They are therefore found to be highly similar to all of the applied for goods in class 29.

15. **Class 30:** The holder’s goods ‘Granola bars’ in class 30, are prepared foodstuffs sold in bar form, intended for quick and easy consumption and to provide energy to the consumer. Granola is a snack food consisting largely of rolled oats, with nuts, honey or other sweeteners such as brown sugar, which is usually baked



until crisp, toasted and golden brown. Granola is largely a cereal based product, and as such, the goods 'Granola bars', whilst potentially containing a number of other ingredients, are predominantly cereal based.

16. The opponent's earlier goods 'preparations made from cereals' in class 30, are foodstuffs made from cereals, including goods which may be sold in bar form. These earlier goods are considered to wholly encompass the applied for goods and are therefore found to be identical.

17. The holder's goods 'energy bars' are prepared foodstuffs sold in bar form, intended for quick and easy consumption and to provide energy to the consumer. Energy bars may comprise a number of ingredients including naturally occurring items such as fruits, vegetables, nuts and seeds, but also sugar, glucose, fructose or sucrose, all of which add calorific content to the bar, which will serve to provide the consumer with extra energy for a period of time. The opponent's earlier goods 'preparations made from cereals' and 'confectionery' are foodstuffs which can be sold in bar form and are intended to be consumed quickly and easily. These goods can be formed from a number of ingredients such as fruit, nuts, seeds, sugar and of course cereals, and will generally provide the consumer with extra energy due to the nature of their composition and calorific levels. These goods are therefore considered to be identical.

18. **Class 32:** The holder's goods 'Energy drinks; energy drinks containing caffeine' in class 32, are beverages intended to quench the thirst and also provide energy in the form of calorific content, boosted in a number of ways, including the addition of extra sugar, fructose, sucrose, glucose, fruits, vegetables, seeds and nuts. The holder's goods 'smoothies' are produced by blending a mixture of ingredients together to create a beverage which has a thicker texture than a normal water based beverage. 'Smoothies' are often blended using a mixture of fruits and are intended to be a healthy alternative to the more traditional water based drinks.

19. The opponent's earlier goods 'other non-alcoholic beverages' wholly encompass the applied for goods in class 32. These goods are therefore considered to be identical.

20. In conclusion, all of the applied for goods have been found to be identical or highly similar to some of the opponent's earlier goods.

### **Average consumer and the purchasing act**

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

23. The average consumer of beverages and snack food products is the general public, who will pay no more than a medium degree of attention to the selection of such goods, however it could be argued that the average consumer of an energy bar or drink, or a diet drink or low-calorie food product, will be more attentive when making their selection, to ensure that they purchase the correct product. When choosing such goods, it is quite common for the consumer to

check the packaging and list of ingredients more carefully than when selecting more general day to day consumables.

24. The selection of the goods at issue will be primarily a visual process within high street retail outlets and supermarkets, but may also be a combination of visual and aural selection, when that process takes place within a café or other establishment providing food and beverages to be taken away or consumed on the premises.

### **Comparison of marks**

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The marks to be compared are:

Earlier trade mark	Contested International Registration
HELLO DIET	

28. The opponent's mark consists of the plain words 'HELLO DIET'. The word 'DIET' in the mark is likely to be given less weight, as it will be perceived as potentially descriptive. The word 'HELLO' has a well-known meaning which can be said to have no particular association with the goods at issue. The overall impression given by the opponent's mark is more dominated by the greeting "HELLO".

29. The holder's mark is comprised of the word 'Hello' followed by an exclamation mark and then the word 'Energy' which will be given little weight, as it is likely to be considered descriptive. The mark is figurative, with each element presented in a slightly stylised font. The word 'Hello' forms the largest element in the mark and has no particular link to the goods at issue. The overall impression given by the holder's mark is dominated by the greeting "Hello".

**Visual similarity**

30. The marks are visually similar inasmuch as they both contain the word 'HELLO', which forms the beginning of each mark.

31. The marks are visually different in respect of the presentation of the word 'HELLO'. In the earlier mark it is presented in standard type face and capital lettering. In the holder's mark it is presented in upper and lower case and in a less standard font.

32. The marks also differ visually in the word 'DIET' of the earlier mark and the word 'Energy' in the holder's mark, both of which have no counterpart in the other marks. The International Registration also contains an exclamation mark placed

between the words 'Hello' and 'Energy' and this element has no counterpart in the earlier mark. The word 'Hello' in the later mark is presented in much larger type face than the other verbal element 'Energy'.

33. Weighing the similarities and differences, and bearing in mind my assessment of the overall impression and the dominance of the word 'HELLO' in each mark, I find the marks to be visually similar to a medium degree.

### **Aural similarity**

34. The opponent's mark is comprised of the verbal elements 'HELLO DIET' which will be enunciated as *HELL/OH/DY/AT*. The holder's mark is comprised of the words 'Hello Energy'. The mark will be articulated as *HELL/OH/EN/UR/JEE*. The exclamation mark presented between the words will not be enunciated.

35. The marks can be said to be aurally similar to a medium degree.

### **Conceptual similarity**

36. The word 'HELLO' in the earlier mark conveys the concept of a greeting being extended to the consumer. This is a fairly unusual concept within the context of foodstuffs and beverages. The only other element in the earlier mark, the word 'DIET', is a word commonly used on packaging to describe foodstuffs and beverages that are low in calories and therefore suitable for a consumer that wishes to restrict calorie intake, in order to control or lose weight. The word 'DIET' will be perceived by the average consumer, but little weight will be attached to it, over and above the obvious descriptive message relating to the calorific content of the goods to which the mark is applied.

37. The holder's mark comprises the verbal elements 'Hello' and 'Energy'. As I have found above, the word 'Hello' conveys the concept of a greeting. This is an unusual concept when applied to foodstuffs and beverages. The exclamation mark that follows the word 'Hello' merely serves to emphasise the greeting being conveyed. The word 'Energy' will be perceived as a descriptive message

informing the consumer that the goods on offer contain ingredients which are specifically intended to provide the consumer with more energy.

38. The word 'Energy' is generic when applied to drinks and snacks with added sugars intended to increase levels of energy in the consumer. This is demonstrated in fact, by the inclusion of 'energy bars' and 'energy drinks' specifically under the IR specifications in classes 30 and 32. This word is used to make clear to the consumer what is to be expected from that product. Therefore, little significance will be attached to this descriptive element in the holder's mark.

39. Whilst the words 'DIET' and 'Energy' convey nothing more than descriptive messages, those messages are clear and obvious to the consumer, they are distinguishable, and cannot therefore be dismissed entirely from this assessment. The word 'HELLO' is however, considered to be a fairly unusual concept to apply to foodstuffs and beverages.

40. It is also possible that the average consumer of the goods at issue, may perceive in both marks, a concept based on the anticipated results of consuming the goods on offer, for example, when faced with the mark 'HELLO Energy' on a beverage, the consumer may perceive a concept of welcoming energy into the body through the consumption of the drink, in other words "Hello there Energy". If this concept is perceived, it will be the same notion in both marks, namely the anticipation of a specific result (increased energy levels or reduced calorie intake) following consumption of the goods. The marks are considered to be conceptually highly similar.

### **Distinctive character of the earlier trade mark**

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or

services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. The opponent has not claimed that its earlier mark has an enhanced distinctive character through use. I therefore have only the inherent position to consider.

43. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

44. The opponent’s mark is comprised solely of the words ‘HELLO DIET’. The only common element between the marks at issue is the word ‘HELLO’, which has no obvious connection with the goods and services of the opponent, however it is a fairly common and basic word in the English language and can therefore be said to have no more than a normal degree of inherent distinctiveness. The word ‘DIET’ is descriptive and non-distinctive within the mark and must therefore be considered to be a weak element.

### **Likelihood of Confusion**

45. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 11).

46. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.



48. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

49. The average consumer in this matter will be the general public and as the goods at issue are largely day to day consumables, the level of attention paid in the selection process will be no higher than average. However, for ‘diet’ and ‘energy’ beverages and foodstuffs the consumer is likely to pay more attention and care in the selection of those goods.



irrelevant in the consumer's consideration of these marks. They are, for all intents and purposes, identical.

55. In this matter, I conclude that there is no likelihood of direct confusion between the marks as the consumer will readily appreciate the differences between them. I believe that the average consumer of the goods at issue will perceive the elements 'DIET' and 'Energy' during the selection of a food product or beverage, as they will have a clear idea, as to whether they want to take on extra energy reserves, perhaps prior to taking some exercise, or wish to limit their calorie intake, at that particular moment in time.

56. I must however, consider the potential for indirect confusion between the marks.

57. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but

the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. In my opinion, the marks at issue can be said to fall under the second category put forward by Mr Purvis above. The consumer who is aware of the brand ‘HELLO DIET’ will, when faced with the holder’s mark, assume that this mark is simply a brand extension from the ‘HELLO’ range of food and drink products.

59. The word ‘HELLO’ has been found to be the dominant element within each mark, forming the beginning of each mark and, in the case of the holder’s mark, the much larger verbal element visually. The exclamation mark in the holder’s mark will carry little or no weight in the consumers appreciation of the whole. It is also well established that when trade marks consist of a combination of words and figurative components, it is by the word component(s) that the trade mark is most likely to be referred.

60. I believe that the visual, aural and conceptual similarities created by the common word ‘HELLO’ will lead to indirect confusion on the part of the average consumer, who will believe the marks to be brand variants of each other and originating from the same or a related undertaking. Whilst I accept that indirect confusion should not be reached merely because the marks share a common element, and that what is required by the average consumer is an instinctive reaction that leads them to the conclusion that the identical services come from the same (or related) trade origin, that instinctive reaction is present in this case.

## **Conclusion**

61. There is a likelihood of confusion between these marks. The opposition succeeds in full. The International Registration is, subject to appeal, refused.

## **Costs**

62. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee	£100
Preparing the statement of case and considering the counterstatement	£200
Preparing written submissions	£200
Total	£500

63. I therefore order Joh. Wilh. Von Eicken GmbH to pay COMME J'AIME the sum of £500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 1st day of August 2018**

**Andrew Feldon**

**For the Registrar**

**The Comptroller-General**