

## TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF two applications for the registration of a trade mark (Nos. 158196 and 158197) and in the matter of an opposition thereto.

LIDL STIFTUNG & CO. KG

Applicant

SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

Opponent

### The applications

1. On 18 October, 1993, Lidl Stiftung & Co. KG, a Kommanditgesellschaft organised and existing under the laws of the Federal Republic of Germany, of Heiner-Fleischmann-Str. 2, 74172 Neckarsulm, Germany, (now of Stiftsbergstrasse 1, D-74167, Neckarsulm, Germany) Manufacturers and Merchants made applications (Nos. 93/4962 and 93/4963) to register the mark shown below as a Trade Mark in Part A of the Register in Classes 29 and 30 in respect of specifications of goods that were amended in the course of the examination of the applications to read as indicated below. The applications claimed priority of an application for registration filed in Germany on 8 July, 1993.



Appln. No.	Class	Goods
93/4962	29	Meat, fish poultry and game, all aforementioned goods also deep frozen; meat extracts; meat, sausage, fish, fruit and

vegetable preserves, preserved, dried and cooked fruits and vegetables; meat broth preparations or concentrated soups, including meat extracts and bouillon cubes, granulated bouillon; soups (cooked), vegetables extracts for use as additives for food and meat - all being goods included in Class 29.

<b>Appln. No.</b>	<b>Class</b>	<b>Goods</b>
93/4963	30	Cooked dishes, substantially made from meat, fish, game, rice, farinaceous pastes and/or vegetables, all aforementioned goods also deep frozen; sauces (condiments); spices; pizza covered with vegetables, mushrooms, meat, fish, sausages and/or cheese - all being goods included in Class 30.

2. The applications were accepted for registration in Part A of the Register and advertised accordingly under Nos. 158196 and 158197, respectively, in Journal No. 1754 on 22 February, 1995. The advertisement carried notings to the effect that registration of the mark would give no right to the exclusive use of the words “CHEF” and “CUISINE” and that the use of the mark would be limited to the colours shown in the representations accompanying the applications.
3. Notices of Opposition to the registration of the mark pursuant to Section 26 of the Act were filed on 22 January, 1996 by Société des Produits Nestlé S.A., a Société Anonyme organised and existing under the laws of Switzerland, of Case Postale 353, 1800 Vevey, Switzerland. The Applicant filed counter-statements on 29 May, 1996 and evidence was, in due course, filed by the parties under Rules 37 and 38 of the Trade Marks Rules, 1963.
4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 10 May, 2004. The parties were notified on 15 November, 2004 that I had decided to dismiss the opposition and to allow the applications to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

## **Notices of Opposition**

5. In its Notices of Opposition the Opponent itemises a number of facts and grounds of opposition, which may be summarised as follows:

- (i) The Opponent is the proprietor of a number of trade mark registrations (see Appendix A).
- (ii) The trade mark for which the Applicant seeks registration so nearly resembles the Opponent's registered marks that registration would be contrary to the provisions of Section 20 of the Trade Marks Act, 1963, particularly having regard to the fact that the goods in respect of which the Applicant seeks registration are the same goods or the same description of goods as those in respect of which the Opponent's marks are registered.
- (iii) The Opponent's trade marks have been used extensively in Ireland for many years and have acquired a reputation such that the use by the Applicant of the mark propounded for registration would be likely to lead to deception or confusion and registration would therefore be contrary to the provisions of Section 19 of the Act.
- (iv) The Applicant is not the proprietor of the mark in relation to the goods of the applications and does not have a present and definite intention of using the mark as a trade mark for those goods; registration is therefore precluded by virtue of Sections 2 and 25 of the Act.
- (v) Registration of the mark would be contrary to the provisions of the EC Harmonisation Directive (Council Directive 89/104/EEC).
- (vi) Registration of the mark would prejudice and embarrass the Opponent in the conduct of its business and registration should be refused in exercise of the Controller's discretion.

## **Counter-Statements**

6. In its Counter-Statements the Applicant denies all of the grounds of opposition raised against its applications and admits only the Opponent's statement of its ownership of the trade mark registrations listed in Appendix A. The Applicant states that its mark is visually and phonetically different from those of the

Opponent and that the respective marks are not confusingly similar. It also denies that the Opponent's marks have been used extensively, or at all, in Ireland.

### **The evidence**

#### *Rule 37*

7. Evidence submitted by the Opponent under Rule 37 consisted of a Declaration (and 2 exhibits) dated 28 January, 1997 of Roman Vuille, Head of Patents in the legal department of Société des Produits Nestlé S.A. Mr. Vuille makes a number of averments which I would summarise as follows:

- (i) The trade mark CHEF was first used in Ireland in approximately 1925 and use has continued since that date.
- (ii) The mark has been used on the following goods: sauces, ketchup, salad cream, mayonnaise, pasta sauces, curry sauces, tex mex sauces, beetroot, pickles, gherkins and malt and distilled vinegars. Sample labels and product photographs are exhibited to show how the mark is used – see Appendix B.
- (iii) Use of the mark has been in both the retail and foods service sectors.
- (iv) Turnover in goods sold under the mark since 1987 has been £58,841,000.
- (v) £1,070,000 has been spent on advertising and making the mark known in Ireland since 1987. Brochures and photographs showing how the mark has been publicised are exhibited.
- (vi) Goods have been sold under the mark throughout the entire territory of the State and have been exported to Northern Ireland and Great Britain.

#### *Rule 38*

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and exhibits DN1 and DN2) dated 30 June, 2000 of Deirdre Naessens, Trade Mark Attorney of Cruickshank & Co. In addition to expressing opinions on the merits of the opposition against the present applications, Ms. Naessens makes the following statements of fact:

- (i) A number of trade marks which include the word CHEF have been accepted and/or registered by the Irish Patents Office, most of which

registrations are subject to a disclaimer of the word CHEF. A list of registrations and applications is exhibited and particular emphasis is placed on Registrations Nos. 149706 and 149707, CHEF FRANCISCO in the name of H.J. Heinz Company.

- (ii) The Applicant's mark is registered in a number of countries throughout Europe and co-exists with the Opponent's marks in a number of territories, including Spain, Portugal, Germany, Hungary, Benelux, France, Austria and Greece.
- (iii) The Applicant's trade mark CHEF SELECT co-exists with the Opponent's marks in the United Kingdom.
- (iv) The Applicant uses its trade mark in a way that is substantially different from the manner in which the Opponent uses its marks. Copy labels from the Applicant's products are exhibited.

#### **The hearing**

9. At the Hearing the Opponent was represented by Mr. Paul Gallagher, SC instructed by Messrs. Tomkins & Co. and the Applicant by Ms. Mary Rose O'Connor, Trade Mark Agent of Cruickshank & Co.

#### **The issues**

10. The Opponent did not file any evidence in support of its assertions that the Applicant is not the proprietor of the mark for which it seeks registration and that the Applicant did not have a *bona fide* intention of using the mark in relation to the goods of the applications. The opposition under Sections 2 and 25 of the Act is therefore not supported and I dismiss it accordingly. As to the claim that registration of the mark would be contrary to the provisions of Council Directive 89/104/EEC, the fact is that these applications were made prior to the enactment in the State of legislation giving effect to that Directive and opposition to them on the basis of non-conformity with the Directive is unsupportable. Nor has the claim that registration of the Applicant's mark would prejudice and embarrass the Opponent in the conduct of its business been substantiated and the question of discretionary refusal of the applications does not arise.

11. Of the grounds of opposition cited in the Notice of Opposition filed, only those under Sections 19 and 20 of the Act remain for consideration and I have, accordingly, confined my consideration of the matter to these sections.

*Section 19 – would the mark be disentitled to protection in a court of law?*

12. Section 19 of the Act reads as follows:

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

13. The Opponent argues that the present mark would be disentitled to protection in a court of law by reason of its being likely to cause confusion among consumers who, having come to know the Opponent’s mark as used on its goods, will be caused to wonder whether goods of the Applicant bearing the opposed mark are not those of the Opponent. The Applicant denies that there is any real likelihood of confusion because, it says, its mark is sufficiently different from those of the Opponent.

14. The test for an objection under Section 19 was formulated by Evershed J in *Smith Hayden & Co. Ltd.’s Application* [1946] 63 RPC 97, as follows:

*“having regard to the reputation acquired by the [earlier mark], is the Court satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.”*

15. That statement was considered by Lord Upjohn in *BALI Trade Mark* [1969] RPC 472, who asserted that the reference to the “*reputation acquired by*” the earlier mark should, more correctly, have been to the “*user of*” it. He went on,

*“... it is not necessary ... to prove that there is an actual probability of deception leading to passing-off.... It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the Court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the Register.”*

16. The first thing to be established in the context of an objection to registration under Section 19 is whether there has been use by the Opponent of the mark or marks on which it relies as the basis for the objection. On this point, I think that there can be no doubt but that the Opponent has used the trade mark shown at Appendix B and, indeed, that the use in question has been substantial and sustained over many years. The exhibits attached to Mr. Vuille’s Declaration, filed as Opponent’s evidence under Rule 37, are mostly undated and serve only to show the manner in which the trade mark has been used and promoted without proving actual use over a given period of time. Nevertheless, Mr. Vuille has averred to the fact that the trade mark CHEF has been used in Ireland since 1925 and he has given particulars of turnover and advertising expenditure on a very large scale for the six years immediately preceding the filing of the present applications. The Applicant has not seriously challenged the fact that the Opponent has used the word CHEF as a trade mark although it has referred to the fact that the mark as used does not accord exactly with any of the Opponent’s registered marks. That fact is not of any relevance to the consideration of the opposition under Section 19, which is concerned essentially with the rights accruing to the proprietor of a trade mark by virtue of the use made of the mark, regardless of whether or not it is a registered mark. In any event, I agree with the assertion made at the hearing on behalf of the Opponent to the effect that the mark that has been used is substantially the same as the Opponent’s registered marks in that it creates the same overall impression, i.e., the word “chef” and the device of a chef.

17. The Opponent’s use of its mark having been established, the question then turns to whether use by the Applicant of the mark put forward for registration would be

likely to cause confusion among consumers. That question requires consideration of (i) the look and sound of the respective marks, (ii) the goods to which they are to be applied, (iii) the nature and the kind of customers likely to buy the goods and, (iv) all the other surrounding circumstances of the trade in those goods<sup>1</sup>. If, having undertaken that consideration, I am satisfied that the use by the Applicant of its mark would cause confusion, then I am bound to refuse the application for registration.

### ***The marks***

18. While the submissions made on behalf of the parties at the hearing centred mainly on the respective words CHEF (of the Opponent) and LE CHEF DE CUISINE (of the Applicant), I am satisfied that I should look, not only at the respective words or word combinations, but at the marks as a whole, including their figurative elements. The Applicant's mark is as shown at paragraph 1 above and the mark used by the Opponent is replicated in Appendix B.
  
19. Visually, these marks create a somewhat similar impression owing to the fact that the relative positioning of the figurative and word elements is similar in each case. In the Applicant's mark, the words LE CHEF are given considerably more prominence than the words DE CUISINE with the result that the verbal content of the marks can also be said to be similar on first impression. There are, of course, obvious differences between the marks insofar as the Applicant's mark contains a chef's hat only while the Opponent's depicts a person in chef's clothing, albeit that the hat is the most prominent item of clothing visible. The manner of presentation of the most prominent words in each mark is also different; LE CHEF is presented in manuscript style in the Applicant's mark while the Opponent's CHEF is in block capitals. Also different is the fact that the Applicant's mark contains the device of an ellipse, which frames all but the uppermost part of the chef's hat, whereas there is no similar framing or outlining of the Opponent's mark.

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<sup>1</sup> Parker J in *Application of Pianotist Co. Ltd.* [1906] 23 RPC 774



20. The visual comparison of the marks must, I think, also include consideration of the extent to which the marks are similar in the messages that they convey to the potential consumer. In the modern parlance, reference is made to the conceptual or connotative similarity of marks and, while this is not specifically mentioned among the criteria specified in *Pianotist*, I think it must be assumed that this is an element that must be considered in comparing the “look and sound” of one mark with that of another.
21. In the present case, I think it is fair to say that the main message conveyed by each of the respective marks is the sense of something related to a chef. To that extent, the marks are conceptually or connotatively similar. However, I perceive two main differences between them from a conceptual aspect. Firstly, the use in the Applicant’s mark of the words LE and DE CUISINE, gives it a French flavour, which is reinforced by the use of the red, white and blue colours of that country’s flag. Of course, the word CHEF appearing in the Opponent’s mark is also a French word but I think it is fair to say that it does not have a purely French connotation in view of the fact that the word itself has passed into the English language.
22. Secondly, the Opponent’s mark contains a representation of a person, who is to be understood as being the chef that gives the mark its name, whereas there is no person shown in the Applicant’s mark. In my view, this is a significant difference between the marks. The use in a trade mark of an image of a person sets it apart, conceptually, from marks that do not contain such an image as the products so branded are apt to be identified with the character depicted in the mark, notwithstanding that the character in question is not a real person who is known to the relevant consumers. It is interesting to note that the Opponent’s mark appears always to have included the device of a person dressed as a chef even though the manner of presentation of the person in question may have changed over the years or may be changed in relation to different products; so, for example, the individual shown in the mark appearing at Appendix B is a little different from the person shown in the Opponent’s registered marks; in addition, the Opponent’s evidence includes among the depictions of its trade mark one in which the chef character wears sunglasses and another in which he wears a Santa hat. Notwithstanding

these variations in the manner of presentation of the Opponent's mark, the overall identity of the mark is preserved, largely because that identity comes from the prominent and central depiction of a representation of a person within the mark. The mark that the Applicant seeks to have registered does not have that element and its identity and character differ accordingly.

23. As to the respective sounds of the marks and their aural similarity, this depends to a great extent on whether the Applicant's mark is spoken in its entirety, i.e. LE CHEF DE CUISINE, or whether, because of the prominence given to the words in question, it is simply referred to as LE CHEF. I think it is only fair to assess the Applicant's mark from an aural aspect on the basis of the mark as propounded for registration and that it would not be reasonable to ignore some of the words forming part of the mark, notwithstanding their relative lack of prominence within the mark as a whole. The words in question (DE CUISINE) are not made so small within the mark that they cannot be seen and they are also linked, in terms of their meaning, to the more prominently displayed LE CHEF. If asked to "name" products bearing the Applicant's mark, I think the average consumer would say that they are called "le chef de cuisine" and that name bears only a low level of aural similarity to the Opponent's mark CHEF.

24. Aural resemblances between trade marks are relevant in the context of assessing the likelihood of confusion between them insofar as such resemblances may give rise to instances of confusion based on mishearing in, say, the ordering of the goods in question over the telephone by a retailer from a supplier or if the ultimate consumer has to ask for the products by name at the point of purchase. In the modern era, it is the case that the goods in relation to which the respective trade marks of the parties to these proceedings are used are mainly selected by the consumer from supermarket shelves without the need for communication, prior to selection, with a shop-assistant. The significance of any aural similarity between marks for these types of goods is reduced accordingly and I have not given it particular weight in making an overall assessment of the likelihood of confusion between these marks.

### ***The goods***

25. The goods covered by the applications are listed at paragraph 1 above. The goods in relation to which the Opponent's mark has been used are listed at paragraph 7(ii) above. The first thing to note in this regard is that the Applicant seeks registration in respect of some goods, viz. sauces (condiments), that are identical with those on which the Opponent has used its mark. I think it is the correct approach for me to first of all consider the likelihood of confusion in the context of those goods. If that is established, then I can proceed to consider the other goods covered by the applications; if, on the other hand, I find that there would be no appreciable likelihood of confusion if the Applicant's mark were used in relation to sauces, then I could not hold that there would be any such likelihood if it were used in relation to the other goods of the application.

### ***The customers and the circumstances of trade in the goods***

26. The customers for these goods are consumers generally and, as I have already noted, the goods are probably most often purchased in supermarkets and other retail grocery outlets where they are selected by the consumer who can usually choose between a number of different brands that are displayed together. These goods are everyday food items and would be among the items making up the regular weekly or fortnightly shopping of most consumers. I do not think that the average consumer may be expected to pay particular care or attention to the purchase of sauces insofar as he would be unlikely to apply much thought or consideration to the purchase. Having said that, brand identity is important in relation to these goods as consumers know their own tastes and are careful to select products that they like and to avoid those that they dislike.

### ***Likelihood of confusion***

27. In light of the foregoing, I propose to consider the following question: *having regard to the long-standing and substantial user by the Opponent of its trade mark in relation to sauces, would the use of the Applicant's mark on those same goods be likely to cause confusion among a substantial number of consumers?* In considering that question, I have had regard to the fact that confusion may arise not only through the Applicant's products being mistaken for those of the Opponent because of the similarity of the respective trade marks (direct

confusion) but also through consumers assuming that there is a connection in the course of trade between the Applicant's and the Opponent's products in that they share a common commercial origin (indirect confusion). This latter concern was the basis on which the High Court (Kenny J) refused to allow the registration of the trade mark PAXTONA in relation to cigarettes in light of the earlier registration of the mark PAX for the same goods<sup>2</sup>. The learned judge assessed the potential for confusion between the marks as follows:

*"I think it unlikely that any smoker would accept cigarettes marked with the word "Pax" if he asked for "Paxtona" but if he asked for "Pax" and was told that they were not in stock and was offered "Paxtona", I think he would believe that the two brands came from the same manufacturer and so he would be inclined to take "Paxtona".*

28. In the present case, I have concluded that there is not sufficient likelihood of direct confusion between the respective marks to warrant refusal of the applications for registration. I do not think that the average consumer is likely to purchase a bottle or jar of sauce put on the market by the Applicant under the trade mark that it seeks to have registered in the mistaken belief that he is choosing one of the Opponent's products. While there are, undoubtedly, a number of similarities between the respective marks, I think they are sufficiently different, on an overall assessment, to obviate the possibility of confusion on the part of a reasonably observant and circumspect consumer. I acknowledge that the selection and purchase of the items in question may appear to be done fairly perfunctorily by shoppers as they browse the supermarket shelves while performing the regular chore of grocery shopping. Notwithstanding the routine and mundane nature of that chore, however, I think the average consumer will still readily distinguish between these marks and will not absentmindedly reach for the Applicant's product, thinking it to be the Opponent's. Given the obvious differences between the marks, particularly on a visual comparison, I think a person would have to pay very scant attention indeed to the selection of the

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<sup>2</sup> PJ Carroll & Co. Ltd. -v- Philip Morris Inc. [1970] IR 115

relevant items in order to be confused and I am not satisfied that I should regard that as the normal behaviour of the average consumer of these goods.

29. As to the question of indirect confusion, whereby consumers may mistakenly assume a link between the products of the Applicant and the Opponent, that requires consideration of a somewhat different scenario from that just discussed. This is not the confusion of a person who, through lack of sufficient attention, purchases the Applicant's product thinking it to be the Opponent's; this is, rather, the confusion of a person who, on perceiving the Applicant's trade mark as used in relation to its goods, recalls the Opponent's products and wonders whether it might not be the case that two products are connected. Such a person might, for instance, wonder whether the Applicant's LE CHEF DE CUISINE products were not some new line of sauces from the makers of CHEF sauces. It was suggested at the hearing that a person might well think that the CHEF sauce range was being expanded to include somewhat more exotic or continental flavours and that the LE CHEF DE CUISINE mark was being used to convey, simultaneously, both their connection with the CHEF range and the fact that they were a new line.
30. For largely the same reasons that I do not think the marks are likely to be directly confused, one with the other, neither do I think it likely that this form of association leading to confusion will occur among a substantial number of consumers. The use in the Applicant's mark of LE CHEF DE CUISINE instead of CHEF and the fact that the chef character is not present make it unlikely, in my view, that the average consumer would assume any connection between the respective products.
31. Images and words relating to chefs have an obvious connection with foodstuffs and, when used in trade marks for such products, are likely to be perceived by consumers, first and foremost, as making an allusion to the goods in question. It seems to me, therefore, that there would need to be a more obvious or striking resemblance between the Applicant's mark and that of the Opponent for it to be reasonable to conclude that consumers are likely to assume a connection between the two. I think it more likely that that they will simply perceive the use in the Applicant's mark of the words and images of which it is composed as being

intended to associate with the relevant products desirable notions that may influence consumers to purchase them, e.g. the notion of *haute cuisine*.

32. For the reasons that I have outlined, I find that the use of the Applicant's mark in relation to sauces would not be likely to cause deception or confusion, notwithstanding the earlier use by the Opponent of its trade mark in relation to those same goods. That finding must apply, *a fortiori*, in respect of the other goods covered by the applications for registration. I have decided, therefore, to dismiss the opposition to registration of the mark under Section 19 of the Act.
33. Before finishing with this aspect of the matter, I should refer to a view urged on me by Mr. Gallagher for the Opponent at the hearing. That is that the Opponent's mark has, through long and sustained user, become extremely well-known in relation to the goods on which it has been used and that it has become something of a "household name". For that reason, Mr. Gallagher argued that the use by another undertaking of a similar mark in relation to the same or similar products is bound to cause confusion, including association in the minds of consumers of the later mark with the earlier one. I should say that I think there is merit in that argument and that I have taken account of the extent and longevity of the use of the Opponent's mark in determining this matter but, for the reasons I have given, I have concluded nevertheless that confusion is unlikely.

*Section 20 – should the applications be refused in light of the Opponent's earlier registrations?*

34. Section 20 of the Act prohibits the registration of marks that are identical with or closely resemble existing registered marks. The relevant part of the Section reads as follows:




“(1) ..... no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

35. The registered trade marks on which the Opponent bases its opposition under this Section are shown at Appendix A. Those registrations cover a wide range of goods included in Classes 29 to 32, including a number that are also included in the present applications for registration.
36. Given that the mark which the Applicant seeks to have registered is not identical with any of the Opponent's registered marks, the question to be decided for the purposes of Section 20 of the Act is whether it so nearly resembles any of those marks as to be likely to deceive or cause confusion. I have already stated (at paragraph 16 above) that I regard the mark that the Opponent has given evidence of using as being substantially the same as its registered marks or, more correctly, a combination of them. I do not think that there is any greater similarity between the Applicant's mark and any of the registered marks than there is between the Applicant's mark and the mark that the Opponent has used. As to the other factors to be taken into account when considering the likelihood of confusion, viz., the respective goods, the nature of the customers for those goods and all the surrounding circumstances of the trade in those goods, I do not think that any different or additional factors arise for consideration in these regards than those that I have already considered in the context of the opposition under Section 19.
37. For the foregoing reasons, I am satisfied that the factors that I have already taken into account in considering the opposition under Section 19 of the Act are also relevant to the consideration under Section 20. There is nothing substantially different about the Opponent's registered trade marks or the goods for which they are registered that would lead me to a different conclusion than that which I have already come to with regard to the objection under Section 19 as to the likelihood of confusion if the Applicant's mark were to be used in a normal and fair manner as a trade mark for the goods of the applications. Accordingly, I have decided to dismiss the opposition under Section 20 for the reasons that I have already given in relation to the opposition under Section 19.

Tim Cleary  
acting for the Controller  
1 December, 2004

APPENDIX A

Opponent's Trade Mark Registrations

No.	Mark	Class	Date
52877 – 52880	CHEF	29 - 32	26/11/1937
52887 – 52890		29 - 32	26/11/1937
52892 – 52895		29 - 32	26/11/1937
123236 – 123238		29, 30 and 32	02/10/1985



## APPENDIX B

**Manner in which the Opponent's trade mark is most commonly used as evidenced by sample labels and photographs exhibited by the Opponent**

