

O-194-14

**IN THE MATTER OF REGISTRATION NO. 2626843 IN THE NAME OF UNITED
PAPER PRODUCTS LIMITED IN RESPECT OF THE FOLLOWING TRADE MARK
IN CLASS 16:**



**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500039 BY ACCROL PAPERS LTD**

BACKGROUND AND PLEADINGS

1) United Paper Products Ltd (“the proprietor”) is the proprietor of the above mark (“the registration”). It applied for the registration on 3 July 2012 and the registration procedure was completed on 25 January 2013. The registration covers the following goods in Class 16:

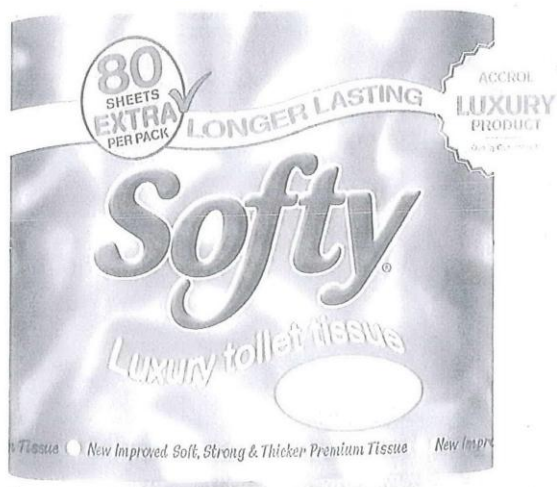
Toilet paper; toilet rolls; paper products.

2) On 6 June 2013, Accrol Papers Ltd (“the applicant”) applied for the registration to be declared invalid under Section 47(2) of the Act. The grounds of the application are as follows:

i) The registration offends under Section 5(2)(b) and Section 5(3) because it is similar to two earlier marks in the name of the applicant and in respect of similar or identical goods. The applicant claims that its marks have a reputation. The relevant details of these two earlier marks are shown below:

Relevant details	Specification of goods
<p>2293048</p> <p>SOFTY</p> <p>Filing date: 18 February 2002 Date of entry in register: 26 July 2002</p>	<p>Class 16: Paper, cardboard and goods made from these materials; toilet tissue, kitchen towels, facial tissue.</p>
<p>2446541</p> <p>TRIPLE SOFTY</p> <p>Filing date: 13 February 2007 Date of entry in register: 1 February 2008</p>	<p>Class 16: Toilet rolls, kitchen towels, facial tissues of paper, bathroom tissues, toilet tissue, towel rolls of tissue paper, wipes made of tissue (other than impregnated or for medical use).</p>

ii) Use of the registration would be contrary to the law of passing-off. The earlier unregistered signs relied upon are shown below:



3) The applicant filed a counterstatement denying the claims made. It claims that:

- at the time it applied to register its mark, the applicant's mark 2446541 SOFTY was recorded as "expired";
- there are other "softy" branded products on the market;
- customers are aware what products belong to which manufacturer because of the use of barcodes and company details appearing on the packaging;
- there are differences when comparing the registration with the applicant's two unregistered marks.

4) Both of the applicant's earlier marks have registration dates that are more than five years before the date on which the application for invalidation was filed and may be the subject of a request for proof of use¹. However, the proprietor does not put the applicant to such proof and, as a consequence, the applicant is entitled to rely upon these earlier marks in respect of their full list of goods.

5) Both sides filed evidence in these proceedings. The evidence will be summarised only to the extent that it is considered appropriate. I will not summarise the submissions, but I will keep them in mind when reaching my decision. A hearing took place before me on 9 April 2014, with the applicant represented by Mr Michael Smith of Counsel, instructed by Taylors Solicitors. The proprietor was not represented and did not attend but it did file written submissions that I will take into account.

APPLICANT'S EVIDENCE

6) This takes the form of a witness statement by Mr Majid Hussain, Managing Director of the Applicant. He explains that because of an administrative error, the applicant's registration 2293048 SOFTY was allowed to expire, but when the error was identified, the mark was restored to the register on 30 January 2013. As a result of this, it was not notified to the proprietor at the time its mark was examined.

7) He states that the applicant has been selling toilet rolls, kitchen towels and facial tissues under the brands SOFTY and TRIPLE SOFTY since about 2002. In 2006, sales in the UK under these two marks were approximately £3 million and had increased to £14 million by 2012. Mr Hussain has chosen not to provide more detail regarding these sales because he explained that to provide such evidence would mean that the Applicant was obliged to disclose its customer list, which is confidential to the Applicant.

8) Mr Hussain states that the applicant's goods are publicised extensively in the trade press. At "Annex 1" he provides copies of three pages from the website www.accrol.co.uk illustrating SOFTY toilet tissue and paper towels. These are undated but were printed on 30 September 2013.

9) The same annex also includes:

¹ See Section 47(2A) and (2B). These sub-sections are an addition to the original Act, by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force 5th May 2004.

- three extracts from trade magazines where the applicant company is discussed. The first of these mentions the “premium toilet roll brand” TRIPLE SOFTY and dated August 2012, the second, dated July 2012, notes that the company provides both own-label and branded lines “such as ... Softy”. The third is undated and is an advert for the applicant company and features as two of a number of products, SOFTY toilet tissues and paper tissues;
- Undated product guides relating to numerous products including SOFTY and TRIPLE SOFTY toilet tissue

PROPRIETOR’S EVIDENCE

10) This is a witness statement by Mr Kemal Gondas, managing director of the proprietor. He provides background information regarding the proprietor and reiterates that it conducted due diligence searches that identified the applicant’s mark but showing it as expired. He denies that there are any similarities between the respective marks.

DECISION

Relevance of applicant’s marks being expired at time of filing

11) The proprietor relies on a defence that the applicant’s earlier mark 2293048 SOFTY was recorded as “expired” on 20 February 2012 and at the time it filed for its mark, namely 3 July 2012. The applicant’s mark was subsequently restored and renewed on 29 January 2013. The relevant parts of the Act are:

43. - (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of a renewal fee.

(2) Provision shall be made by rules for the registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration. Failing this, the request may be made and the fee paid within such further period (of not less than six months) as may be prescribed, in which case an additional renewal fee must also be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with the above provisions, the registrar shall remove the trade mark from the register. Provision may be made by rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(6) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

and

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

...

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.

12) As the proprietor has stated in its written submissions, Section 43 provides for a trade mark to be renewed and requires that a request for renewal must be made before the expiry of the registration. However, as Mr Smith pointed out at the hearing, under Section 6(3) of the Act, a mark falling into Section 6(1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year. At the time the proprietor filed its mark, the applicant’s mark had been expired for less than a year. Further, there is no suggestion, by the proprietor, that there was an absence of a *bona fide* use of the mark during the two years preceding the expiry. Consequently, this mark constituted a valid earlier mark for the purposes of Section 5(2) and Section 5(3). I note that the mark was subsequently restored and renewed and now stands as a registered mark.

13) It is not known why this valid earlier mark was not notified to the proprietor at the time it filed its mark. However, regardless of this, I am not bound by the results of such notification searches and I must consider the grounds pleaded based upon the facts before me. In the absence of a challenge to the earlier mark, I must consider it as a valid earlier mark. Therefore, I dismiss this defence.

13) I now turn to consider the applicant’s pleaded case.

The Legislation

14) The case has proceeded to final determination on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) ...

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b)

15) I will begin by considering the grounds based upon Section 5(2)(b) of the Act. The applicant's earlier mark 2293048 SOFTY represents its best case and Mr Smith, at the hearing, confirmed that this was also the applicant's view if I was to find in its favour regarding the Section 6(1) point (which I have). I will, therefore, limit my considerations to the likelihood of confusion between the proprietor's mark and this one.

16) Section 5(2)(b) reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

17) In reaching my decision under this ground I bear in mind that the CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Comparison of goods

18) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'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.'

19) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

20) I also bear in mind the following guidance of the General Court ("the GC") in *Gérard Meric v OHIM (MERIC)*, T-133/05:


"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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

21) The applicant's list of goods includes *paper, ... and goods made from these materials*. This is self evidently identical to the proprietor's *paper products*. Further, applying the guidance in *MERIC* the proprietor's *toilet paper* and *toilet rolls* are covered by the applicant's broad term *goods made from these materials* (the "material" being paper). In addition, *toilet paper* and *toilet rolls* are self evidently identical to the applicant's *toilet tissue*.

22) Taking all of this into account, I conclude that all of the proprietor's goods are identical to those of the applicant's earlier registration.

Comparison of marks

23) The proprietor, in its written submissions, compares its mark with the packaging of the applicant (as relied upon for the purposes of the grounds based upon Section 5(4)(a). However, for the purposes of Section 5(2)(b), the comparison is a notional one based upon the word SOFTY, being the earlier mark relied upon by the applicant and the more complex mark of the registration. For ease of reference, the respective marks are:

Applicant's mark	Proprietor's trade mark
SOFTY	

24) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details . The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

25) There cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of the them and is deemed to be reasonably well informed and reasonably circumspect and observant . The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

26) The applicant's mark consists of a single word and, as such, cannot be readily divided into separate components. Its distinctiveness lies with its entirety.

27) The registration mark, on the other hand, does readily divide into numerous elements. It consists of the device of a “cartoonised” elephant, the words *softy touch* in blue, three feathers and a wavy top and bottom border appearing with the words *softy touch*. All these are presented between two blue wave-like top and bottom

borders. Other elements are also present, namely the indication 6 ROLLS in a simple oval border and the words *Luxury super soft toilet rolls*. These latter elements are descriptive in nature and do not constitute distinctive or dominant elements. The wave-like elements are suggestive of the goods themselves and are not the distinctive dominant elements. Rather, the distinctive and dominant elements are the words SOFTY TOUCH. However, I also recognise that elephant device is a distinctive element of the mark and I must keep this in mind. In reaching this conclusion, I do not ignore the visual impact that the other elements of the mark possess.

28) Beginning with a comparison of the visual similarities between the marks, there is one obvious similarity, namely the appearance of the word SOFTY in both marks. All other elements present in the proprietor's mark are absent in the applicant's mark. Taking all of this into account, I conclude that the respective marks share a moderate level of visual similarity.

29) Aurally, the registration mark is likely to be articulated as *softy touch*. The other elements are unlikely to be expressed. Clearly, the applicant's mark will be expressed as *softy*, therefore the aural comparison is between *softy* and *softy touch*. The applicant's mark SOFTY is wholly contained within the element of the registration mark that will be expressed, namely SOFTY TOUCH. However, the TOUCH element of the registration mark is absent in the applicant's mark. Taking account of all of this, I conclude that the respective marks share a relatively high level of aural similarity.

30) Conceptually, the applicant's mark alludes to something that is soft. The proprietor's mark alludes to something that is soft to touch and the reference to "soft toilet rolls" in the mark serves to identify that that "something" is in fact toilet rolls. The addition of a device of three feathers reinforces this concept. The elephant device does not clearly match this concept, but it may convey strength or size. Taking all of this into account, conceptually the respective marks share a moderate level of similarity.

31) In summary, I have found that the respective marks share a moderate level of visual and conceptual similarity and a relatively high level of aural similarity. This combines to give the marks a moderate to moderately high level of similarity overall.

Average consumer and the purchasing act

32) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

33) The goods involved are the same for both parties and consist of everyday paper products such as toilet tissue, paper towels, tissues etc. Such goods are common purchases for all consumers and the level of attention will be at the lower end of the

scale. Purchases will normally be visual in nature the goods being chosen from a supermarket or other shop shelf or from a web page selection where the goods are bought online. However, I do not ignore that aural considerations may sometimes apply where, for example, larger quantities may be ordered over the telephone by, for example, large organisations.

Distinctive character of the earlier trade mark

34) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

35) The word SOFTY appears to be a made up word where the letter "Y" has been added to the adjective "SOFT" to create an illusion of a noun. Mr Smith argues that the addition of this letter was sufficient to create a mark with a medium to high level of distinctive character. I do not agree. The adjective SOFT is a highly relevant description of the goods in question and whilst the addition of the letter "Y" gives it distinctive character, this is only on the low side.

36) The applicant has provided evidence that it has made substantial sales under its mark. This evidence is far from overwhelming. It is limited to a number of undated pages from the applicant's website and also mostly undated product guides. The one exception is a page that is dated (by reference to special offer prices valid between 12 March and 1 April 2012) but shows the brand *Velvet* and not the mark in question. However, the following page has a hand written page number "2" suggesting it is part of the same piece of promotion and this second page does show goods marked with the TRIPLE SOFTY mark. Finally, there are dated extracts from several trade journals referencing the two marks relied upon by the applicant. In addition, Mr Hussain states that turnover in respect of both marks was £3 million in 2006 rising to £14 million in 2012. This turnover information lacks detail and it is not possible to ascertain what proportion of sales relates to which earlier mark. I note that the other side has not challenged the scale of use, and I accept that it does illustrate a level of sales, if somewhat imprecisely. These goods are purchased by ordinary consumers on a regular basis and it is self evident that the market for such goods is enormous and, when viewed in this context, the applicant's share is small. Consequently, if its mark's distinctive character is enhanced through use it is not to any significant degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

37) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

38) It is well established that colour is immaterial where the earlier mark is registered in black and white (see *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd* - O-246-08 (AP) and *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2011] FSR 1(HC)). Consequently, in my analysis of likelihood of confusion, it is not necessary for me to consider colour.

39) The proprietor, in its written submissions, claims that there “are other softy ... brand products in the market”. However, no further information or evidence is provided on this point. In the absence of corroboratory evidence, I am unable to assess the impact of such a claim and I conclude that such an unsupported argument does not influence the outcome of these proceedings.

40) It also contends that the respective parties’ customers will be aware of what product originates from which trader because of the appearance of bar codes and company details on packaging. I dismiss this argument. The average consumer of the respective parties’ goods, identified earlier as the normal consumer, will not pay any attention to bar codes, or the information contained therein. Further, the level of intention involved during the purchasing process is not high for these goods and it is my view that the consumer will not pay attention to any company details that may appear on packaging. It is the trade mark that will assist the consumer in making its choice.

41) I have found that the distinctive character of the earlier mark is on the low side. In this respect, I am mindful of the guidance of the GC in *NEC Display Solutions Europe GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-501/08:

35 That conclusion cannot be called into question by the applicant’s assertion that the word ‘more’ has no distinctive character. It should be borne in mind, that weak distinctive character of an element of a compound mark does not necessarily imply that that element cannot constitute a dominant element where – owing, in particular, to its position in the sign or its size – it may make an impression on consumers and be remembered by them (Case T-153/03 *Inex v OHIM – Wiseman (representation of a cowhide)* [2006] ECR II-1677, paragraph 32, and Case T-7/04 *Shaker v OHIM – Limiñana y Botella (Limoncello della Costiera Amalfitana shaker)* [2008] ECR II-3085, paragraph 44).

42) The words SOFTY TOUCH in the registration mark are likely to be the elements most readily recalled. Whilst I recognise that it is not a rule that words speak louder than devices (*L&D SA v OHIM* [2008] E.T.M.R. 62 (CJEU)), in this case, it is likely to be so despite the allusive nature of the words. It is the SOFTY TOUCH element of the mark that the consumer’s eye will be drawn to and it is how it will refer to it. The other word elements serve a purely descriptive purpose. The device of an elephant, as I have already commented may be seen as an allusion to strength or size. As such, none of these elements are likely to displace the words SOFTY TOUCH in the mind of the consumer. Consequently, the words SOFTY TOUCH in the registration mark are the dominant elements because of their prominent position and size within the mark.

43) I keep this in mind, together with the fact that I have found that the average consumer for the respective goods is the ordinary consumer who will normally purchase these goods after visually browsing choices. Further, the level of attention is at the lower end of the scale and this will result in an increased likelihood of confusion compared to where the consumer makes a more considered purchase. The respective goods are identical and the respective marks share a moderate to moderately high level of similarity.

44) At the hearing, Mr Smith submitted that brand loyalty is an attractive force that will lead the consumer to the applicant's goods and that if there is an additional product on the market also using SOFTY as part of its mark, these loyal consumers will be confused. I dismiss this argument and keep in mind the following comments of Iain Purvis, sitting as the Appointed Person in *Bonjorno Cafe*, BL O-382-10:

15. I do not accept that a generalized concept of "brand loyalty" is of any real assistance in assessing likelihood of confusion. First of all it is very hard, in my view, to identify particular categories of product or service as inspiring more brand loyalty than others. Secondly, even if were established that there was a high degree of brand loyalty in a particular field, I do not see how this would advance matters. We are concerned with the likelihood of confusion, not the degree of disappointment which would be caused by an incident of confusion. Questions of likelihood of confusion are always to be approached from the point of view of the "reasonably observant and circumspect" consumer. I do not understand how brand loyalty can be said to affect the consumer's observation skills or his circumspection. Thirdly, it is rather odd to assume that the concept of "brand loyalty" associated with a general class of products or service tends to reduce the likelihood of confusion, when we are also told by the European Court [*Sabel v Puma* [1998] RPC 199 at 22-24] to assume that a high reputation associated with a specific brand of products or services tends to increase the likelihood of confusion.

45) It is very evident that the visual differences between the two marks will be sufficient so that they will not be confused with each other (so called "direct confusion"). However, balancing all the factors together, there is a likelihood of indirect confusion where the average consumer is likely to believe that the goods bearing the respective marks originate from the same or linked undertaking. The low level of distinctive character of the word SOFTY and words SOFTY TOUCH does not outweigh all the other factors. Consequently, I find that the invalidation, insofar as it is based upon Section 5(2)(b), succeeds in its entirety subject to the considerations below.

Concurrent Use

46) Having found that a *prima facie* likelihood of confusion exists, the only factor that can save the proprietor is the existence and effect of concurrent use. The proprietor states that its products are already on the market, but with different wholesalers to those used by the applicant. However, there is no information regarding the scale of the proprietor's use or how long it has been used on the market alongside the applicant's mark. Therefore, I am not satisfied that the parties have traded in

circumstances that suggest consumers have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin (see to that effect the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18).

47) The proprietor must provide cogent evidence that the effect of concurrent trading has been that the relevant public has shown itself able in fact to distinguish between goods bearing the marks in question without confusing them as to trade origin. Whilst it is clear that both parties share the same consumers, it is not possible for me to conclude that the extent and duration of trade has been sufficient to satisfy me that any apparent capacity for confusion has been adequately tested and found to exist.

48) Therefore, my *prima facie* finding regarding likelihood of confusion remains undisturbed and I find there is a likelihood of confusion in respect of all of the goods subject to these proceedings and the invalidation, insofar as it is based upon Section 5(2)(b), succeeds.

Summary

49) The application for invalidation, based upon Section 5(2)(b) of the Act, has succeeded in respect of all of the goods of the registration. Consequently, there is no need to consider the remaining grounds as they do not materially improve the opponent's position.

COSTS

50) The invalidation having been successful, the applicant is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place. I award costs on the following basis:

Official fee	£200
Preparing statement of case and considering statement of case in reply	£300
Preparing and filing evidence and considering other side's evidence	£500
Preparing and attending hearing	£500
TOTAL	£1500

51) I order United Paper Products Ltd to pay Accrol Papers Limited the sum of £1500. 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 2nd day of May 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**