

**O-491-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3116107 BY  
ACCROL PAPERS LTD TO REGISTER:**

**Super Thirst  
&  
SUPER THIRST**

**AS A SERIES OF TWO TRADE MARKS**

**IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO. 405742 BY  
SOFFASS SPA**

## **BACKGROUND**

1. On 1 July 2015, Accrol Papers Ltd (“the applicant”) applied to register **Super Thirst** and **SUPER THIRST** as a series of two trade marks. The application was published for opposition purposes on 16 October 2015 for the following goods in class 16:

Toilet rolls, paper kitchen towels, facial tissues.

2. The application is opposed by Soffass S.p.A (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition under all grounds is directed against all of the goods in the application. Under section 5(2)(b) and 5(3) of the Act the opponent relies upon the goods (shown below) in the following United Kingdom trade mark registration:

No. 2047526 for the trade mark: **THIRST POCKETS** which was applied for on 5 December 1995 and entered in the register on 16 August 1996:

**Class 16** – Paper towels, facial tissues, disposable paper products; wipes, napkins, all made from paper or from paper-like materials.

3. In relation to its objection based upon section 5(3) of the Act, the opponent claims that the similarity between its trade mark and the application is such that the relevant public will believe that they are used by the same undertaking or that there is an economic connection between the users of the competing trade marks. It further states:

### **In relation to unfair advantage**

“The opponent has established an extensive reputation in its THIRST POCKETS trade mark in the United Kingdom and beyond through substantial use and promotion since around 5 December 1995...Use by the applicant of the mark SUPER THIRST (a series of two) in relation to the goods covered by the

application would unfairly trade off, or ride on the coat-tails of, this significant reputation. Additionally, the applicant, though use of the SUPER THIRST (a series of two) mark, will benefit from the power of attraction, reputation and prestige of the opponent's earlier registration, and exploit the marketing effort expended by the opponent over many years of use and promotion."

#### **In relation to detriment to reputation**

"The opponent has established a good reputation and is known for providing high quality paper towels under its THIRST POCKETS trade mark. Use and registration of the application could tarnish or otherwise cause detriment to this reputation, particularly if a consumer purchases the applicant's goods believing them to be related to the opponent or the opponent's goods and is then dissatisfied."

#### **In relation to detriment to distinctive character**

"Use and registration of the application would reduce the uniqueness and distinctiveness of the opponent's earlier THIRST POCKETS registration, and prevent the opponent from properly distinguishing its goods from those of its competitors, thereby inevitably and substantially reducing the distinctiveness of that earlier mark. Additionally, the applicant has no due cause whatsoever to use or register the trade mark SUPER THIRST (a series of two) in the United Kingdom."

4. Finally, in relation to its objection based upon section 5(4)(a) of the Act, the opponent relies upon the same trade mark and goods mentioned above. It states:

"The opponent, or its predecessor in title, has used the trade mark THIRST POCKETS in the United Kingdom since at least as early as 5 December 1995 in relation to various goods in class 16, and over that period of time has acquired

significant goodwill and reputation in the mark. The application is for a highly similar mark, and covers identical goods...

It is submitted that any use of the trade mark SUPER THIRST (a series of two) by the applicant in respect of any of the goods covered would constitute a misrepresentation to actual or potential consumers, and that there is a real likelihood that damage to the opponent would result from such a misrepresentation in the form of lost sales or damage to reputation.”

5. The applicant filed a counterstatement (which contains the only comments made by it in these proceedings). Having indicated that it did not want the opponent to provide proof of use, it states:

“Superthirst is already a well established name in its own right and has been established since 2008. Superthirst is a totally different name, has totally different packaging and is a different product and would not lead to any confusion on the part of the public.”

6. The opponent filed evidence, accompanied by written submissions. No hearing was sought, nor were any written submissions filed in lieu of attendance at a hearing.

## **Evidence**

7. The opponent’s evidence consists of two witness statements. The first, comes from Emi Stefani, the co-founder and Chairman of the board of Sofidel S.p.A. Mr Stefani explains that the opponent, Sofidel UK and Intertissue “are all related companies organised within the wider Sofidel Group.” He states that Sofidel, through its subsidiaries, manufacture and market tissue paper for hygienic and domestic use. Mr Stefani states:

“3. I believe that the trade mark THIRST POCKETS was first used in the United Kingdom since at least as early as 5 December 1995 by the first owner of the trade mark registration...”

8. Mr Stefani explains that the trade mark THIRST POCKETS is used in relation to a product “which is commonly known as “kitchen paper towels” in the UK market.” That said, it has, he states, multiple practical uses and he lists seven examples such as “a kitchen table top surface wipe”, “a baby wipe” and “a temporary food container.” Exhibit ES2 consist of a copy of an Agreement dated 31 March 2013 between SCA Capital NV (“the assignor”) and the opponent (“the assignee”). Clause 2 of the Agreement indicates, inter alia, that the assignor assigns to the assignee:

“all its right, title and interest in the UKI Trade Marks, including but not limited to: (a) all statutory and common law rights attaching to the UKI Trade Marks, together with the goodwill of the business relating to the goods and services in respect of which the UKI Trade Marks are registered or used; and (b) the right to sue (and to retain damages recovered) in respect of any infringement or unauthorised use of the UKI Trade Marks whether occurred before, on or after the date this Agreement...”

The Agreement indicates that the term UKI Trade Marks “means the trade marks, trade mark registrations and applications for registration set out in Schedule 1 attached to this Agreement.” I note that the trade mark relied upon by the opponent in these proceedings is specifically mentioned at item 27 of the schedule.

9. Exhibit ES3 consists of data provided by Nielsen B.V. which Mr Stefani describes as “a leading global information and measurement company, which provides market research, insights and data about what people watch, listen to and buy”. The table provided shows data relating to “market size”, sales of THIRST POCKETS (provided in either £ or €) and “% share” for fifteen 52 week periods the first of which ends on 27 January 2007 and the last of which ends on 26 March 2016 i.e. after the material date.

Although “market size” and “% share” figures are provided, there is no explanation of the specific market to which these figures relate. Of the “% share” figures provided, I note that some relate to “Total UK”/“Total UK in Euro” whereas others relate to “Grocery Mults only.” Notwithstanding those observations, the sales of “THIRST POCKETS” were as follows:

| <b>52 week period ending</b> | <b>Sales</b> |
|------------------------------|--------------|
| 27 January 2007              | £35,385, 802 |
| 26 January 2008              | £35,680, 353 |
| 24 January 2009              | €41,475,599  |
| 23 January 2010              | €47,378,609  |
| 31 December 2011             | €48,668,653  |
| 29 December 2012             | €55,766,166  |
| 12 October 2013              | £51,826,200  |
| 29 March 2014                | £46,638,928  |
| 28 March 2015                | £39,166,908  |

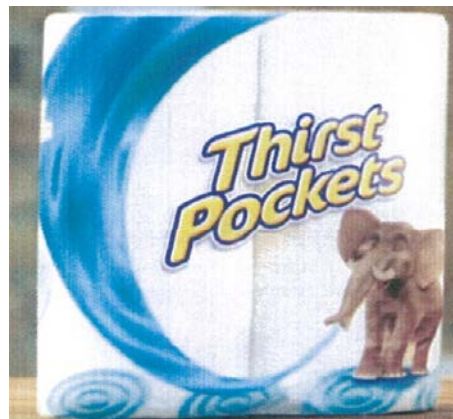
I note that market share ranged from a high of 15.7% in the period ending December 2012 to a low of 11.24% in the period ending March 2015.

10. Mr Stefani explains that exhibit ES4 consists of “a spreadsheet showing the UK sales of THIRST POCKETS... in 2013, 2014, 2015 and 2016.” He points to sales in 2013, 2014 and 2015 to UK retailers of £16,942,325, £25,246,550 and £20,504,426 respectively.

11. Exhibit ES5 consist of a collection of “selected and non-exhaustive” invoices issued between 30 July 2013 and 15 April 2016 by Intertissue to a wide range of retailers in the UK, for example, Waitrose Ltd, Sainsbury’s Supermarket Ltd, Tesco Stores Ltd, The Co-operative Group, Asda Stores Ltd, Ocado Retail Ltd, Lidl UK GmbH, Amazon EU SARL UK Branch and WM Morrisons Supermarkets PLC, all of which contain

references to either “KT THIRSTPOCKETS”, “KT THIRST POCKETS”, “KT THIRST P” or “KT THST PKTS”.

12. Exhibit ES6 consists of what Mr Stefani describes as “a collection of screenshots from television commercial adverts, televised across several UK television and cable channels.” He states that, inter alia, the exhibit contains “a set of commercials shown at the beginning and end of the commercial breaks in the UK television show ALL STAR FAMILY FORTUNES as shown on the UK television channel ITV.” Below is an example of how the trade mark appears in an advertisement; as far as I can tell, none of the pages are dated.



13. Exhibit ES7 consists, inter alia, of invoices from the advertising company Creative and Commercial of Pratt Mews, Camden, London addressed to the opponent. Of the eight invoices provided (dated between 30 August 2013 and 1 July 2015), five specifically refer to “Production of advert for Thirst Pockets”. In his statement, Mr Stefani indicates that the total cost of producing these advertisements amounted to £457,520.

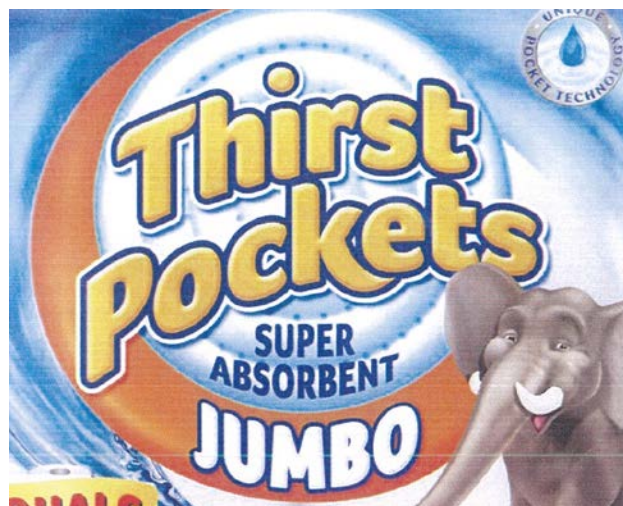
14. Exhibit ES8 consists of invoices dated 15 November and 16 December 2013 issued by ZenithOptimedia of Percy Street, London to the opponent. The invoices relate to the television advertising of THIRST POCKETS on a wide range of well-known television channels (such as Sky 1, various ITV channels, E4, 5\* and Alibi) in November and December 2013. The invoices amount to £1,069,390.

15. Exhibit ES9 consists of invoices dated between 10 March 2014 and 25 September 2014 issued by Mediaedge CIA UK Limited of Paris Garden, London to the opponent. All of the invoices, which relate to online campaigns or television advertising, mention THIRST POCKETS. They are said to amount to a little under £1.9m. Exhibit ES10 consists of further invoices issued by Mediaedge to the opponent between 10 April 2015 and 15 June 2015. All of the invoices relate to television advertising and all mention THIRST POCKETS. They amount to a little over £700k.

16. Mr Stefani's final exhibit, ES11, consists of images of the opponent's "Thirst Pockets" trade mark as it appeared on its own website, as well as on the websites of ocado.com, sainsburys.co.uk, waitrose.com and tesco.com. The pages were printed on 4 and 9 May 2016. Mr Stefani states:

"16...In particular, it should be noted that we already use SUPER to describe the qualities of our product, such as "SUPER ABSORBENT". Thus the words SUPER and THIRST are often seen together in close proximity on our products."

An example of what Mr Stefani is referring to as it appears on the ocado website is shown below:





17. Mr Stefani concludes his statement in the following terms:

“18. I truly believe that as a result of the use made of it by my firm, the mark THIRST POCKETS is well known to the general public and to buyers and users of kitchen paper towels in the United Kingdom, and is uniquely associated with Soffass S.p.A. and the wider SOFIDEL group and that it distinguishes the kitchen paper towels sold by Soffass S.p.A. from kitchen paper towels sold by other traders.”

18. The second statement comes from Mark Bhandal, a trade mark attorney at Forresters, the opponent’s professional representatives. Mr Bhandal explains that on 9 May 2016, he conducted a number of Internet searches. The first, was a Google search for the words “super thirst kitchen paper towels.” Mr Bhandal states that although his search “did not find and show any SUPER THIRST goods”, he notes the second, third and fourth hits retrieved related to the “THIRST POCKETS kitchen paper towels” of the opponent.

19. The second, third and fourth searches (for the words “super thirst”) were conducted on amazon.co.uk, ocado.com and morrsions.com respectively. Mr Bhandal describes the third and fourth searches as being in relation to “internet grocery shopping website(s).” Whilst none of these searches found any SUPER THIRST goods, Mr Bhandal points to the third and fourth hits (of the second search) which I note relate to the opponent’s “Thirst Pockets” kitchen rolls, that the third search retrieved six results, all of which I note relate to the opponent’s “Thirst Pockets” kitchen rolls/towels and that the fourth search retrieved two results, both of which I note relate to the opponent’s “Thirst Pockets” kitchen towels.

20. That concludes my summary of the evidence filed to the extent I consider it necessary.

## DECISION

21. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which read 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,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

22. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

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

23. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark completed its registration process more than 5 years before the publication date of the application in suit, it is, in principle, subject to proof of use, as per section 6A of the Act. In its Notice of opposition, the opponent states that its earlier trade mark has been used upon all of the goods I have mentioned above. In its counterstatement, however, the applicant has not put the opponent to proof of use, the consequence of which, is that the opponent can rely upon all the goods it has identified.

## **The opposition based upon section 5(2)(b) of the Act**

24. I will deal first with the opposition based upon section 5(2)(b) of the Act.

### **Section 5(2)(b) – case law**

25. The following principles are gleaned from the decisions of the EU courts 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 greater 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 will 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

26. As I mentioned above, the opponent is entitled to rely upon all of the goods it has identified. The competing goods are as follows:

| The opponent's goods   | The applicant's goods                               |
|--|---|
| Paper towels, facial tissues, disposable paper products; wipes, napkins, all made from paper or from paper-like materials. | Toilet rolls, paper kitchen towels, facial tissues. |

27. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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).”

28. The identical term “facial tissues” appears in both parties’ specifications. As the applicant’s “toilet rolls” and “paper kitchen towels” would be included within the terms “disposable paper products” and “paper towels” respectively (which appear in the opponent’s specification), these goods are also to be regarded as identical on the principles outlined in *Merica*.

## **The average consumer and the nature of the purchasing decision**

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. In its submissions, the opponent states:

“23. Furthermore, these products are fast moving consumer goods for everyday purchases and they have a low price. The average consumer is highly unlikely to make a lengthy and considered purchase for such an item and its level of attention is likely to be lower than normal.”

31. The average consumer is a member of the general public who is likely to purchase the goods at issue on a fairly regular basis. As such goods will, typically, be self-selected from the shelves of a retail outlet such as a supermarket or from the pages of a website, visual considerations will dominate the selection process. Although I do not discount aural considerations, they will, in my view, be a much less significant feature of the process. Given the low cost of the goods and the likely frequency of purchase, I

agree with the opponent that the average consumer is likely to pay a lower than normal degree of attention during the selection process.

### **Comparison of trade marks**

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

33. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

| <b>Opponent’s trade mark</b> | <b>The applicant’s trade marks</b> |
|------------------------------|------------------------------------|
| THIRST POCKETS               | Super Thirst<br><br>SUPER THIRST   |



34. The application consists of a series of two trade marks. Each trade mark consists of two separate words presented in normal type face. As they differ only to the extent that the first trade mark in the series is presented in title case and the second trade mark in capital letters, when conducting the comparison I will, for the sake of convenience, refer to the trade mark presented in upper case. For the avoidance of doubt, the conclusions I reach in relation to this trade mark in the series apply equally to the trade mark presented in title case. In its submissions, the opponent states:

“16...It is submitted that the word THIRST is the dominant and distinctive component of both marks. THIRST is an unusual word to use in relation to paper towel products. It is a clever word to use from a marketing perspective as it is an allusive suggestion of a quality of the product, in that it has absorbent qualities. However, it is unusual to use it as a reference to an inanimate object. The word is more likely to be used in relation to the needs of a human being, animal or even plant life. It is therefore distinctive in relation to the goods at issue.

17. The remaining part of the contested mark is the word SUPER. This is a very commonly used adjective. It has been used so extensively, especially in relation to low priced consumer goods, that it no longer carries any weight...The average consumer is thus more likely to recognise the “THIRST” part in SUPER THIRST to be the dominant and distinctive component, and the most memorable and recognisable when recalling a product with imperfect recollection.

18. Further, the “POCKET” part of the earlier mark alludes to a technical function of the product and the average consumer is likely to pay less attention to the second part of the mark...”

35. The applicant’s trade mark consists of two English language words the meanings of which will be very well-known to the average consumer. I agree with the opponent that when considered in relation to the goods at issue, the use of the word “THIRST” is unusual; I also agree that the use of the word “SUPER” is ubiquitous. However, as the

word “SUPER” serves to qualify the word “THIRST” which accompanies it, in my view, the applicant’s trade mark “hangs together”. While that is the overall impression it is likely to convey to the average consumer, I accept that the word “THIRST” is likely to have the higher relative weight in the combination created and is likely to make the greater contribution to the trade mark’s distinctiveness.

36. As to the opponent’s trade mark, I have already commented upon the word “THIRST” above. As to the word “POCKETS” which accompanies it, the opponent argues the average consumer will see this as an allusion to a technical function of the goods and, as a consequence, will pay less attention to it. I agree that it is most likely that the average consumer will construe the word “POCKETS” in the manner the opponent describes i.e. as an allusion to goods having pocket like features. However, as the word “THIRST” qualifies the word “POCKETS”, once again, in my view, the words “hang together” and the overall impression conveyed by the opponent’s trade mark stems from the combination it creates. Given its positioning and its less allusive credentials, like the applicant’s trade mark, I think the word “THIRST” is likely to have the higher relative weight and make the greater contribution to the trade mark’s distinctive character.

37. When considered from a visual perspective, the competing trade marks share the identical word “THIRST” (as the first word in the opponent’s trade mark and the second word in the applicant’s). They differ in that the first word in the applicant’s trade mark and the second word in the opponent’s trade mark i.e. “SUPER” and “POCKETS” respectively find no counterpart in the other parties’ trade mark. Considered overall, I find that the competing trade marks are visually similar to a medium degree. As the pronunciation of both parties’ trade marks is entirely predictable, I reach the same conclusion in relation to the degree of aural similarity.

38. Finally, the conceptual comparison. The message conveyed by the applicant’s trade mark will, when considered in the context of the goods at issue, be seen as products with an exceptional ability to absorb, for example, liquids. Although the word “THIRST”

in the opponent's trade mark will convey the same conceptual message as it does in the applicant's trade mark, when combined with the word "POCKETS", the message it conveys is less easy to discern. The opponent suggests that the word "POCKETS" will be construed as an allusion to a technical function of the goods. As I mentioned earlier, that is likely to be correct. If it is, the opponent's trade mark is likely to be understood by the average consumer as relating to goods with an ability to absorb, for example fluids and which incorporate, for example, cavities or hollows in their construction. However, even if the combination "THIRST POCKETS" creates no concrete conceptual picture in the average consumer's mind, the presence of the word "THIRST" in the opponent's trade mark will, inevitably, evoke the same concept as the identical word which appears in the applicant's trade mark. I consider the competing trade marks to be conceptually similar to a high degree.

#### **Distinctive character of the opponent's earlier trade mark**

39. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

40. I have already concluded that both components of the opponent's trade mark have allusive rather than descriptive qualities. Considered absent use, I agree with the opponent that when considered as a whole, its trade mark has "the normal distinctiveness associated with a registered mark" (paragraph 20 of its submissions refer). That, however, is not an end to the matter, because the opponent claims that:

“20...the mark has, through use since 1995 and through to this day, acquired an additional distinctive character through the use made of it.”

41. Although the opponent states that its earlier trade mark has been used since 1995, the evidence it provides only relates to the use that has been made of its trade mark since January 2006; I have summarised this evidence in some detail above. Although the market in which the opponent competes is not explained, in reaching a conclusion on this point I remind myself of: (i) the low cost of the goods on which the “Thirst Pockets” trade mark has been used (referred to by both Mr Stefani and Mr Bhandal throughout their statements as “kitchen paper towels”), (ii) the high level of turnover achieved (which although part of the £20.5m sales figure for 2015 cannot be taken into account) in the years 2013 and 2014 alone was in excess of £42m, (iii) the nature of many of the UK retailers to which the goods have been sold and (iv) the amounts spent and methods used by the opponent to promote its “Thirst Pockets” trade mark (primarily television advertising). Having done so, I am satisfied that in relation to “kitchen paper towels”, the above factors combine to enhance the distinctiveness of the opponent’s “Thirst Pockets” trade mark from the “normal distinctiveness associated with a registered mark” mentioned above to a trade mark with a high degree of acquired distinctive character.

### **Likelihood of confusion**

42. 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 this trade mark 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. Earlier in this decision, I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who is likely to purchase the low cost/frequently selected goods at issue by predominantly visual means and who will pay a lower than normal degree of attention whilst doing so;
- whilst the overall impression conveyed by the competing trade marks stems from the combinations they creates, the word “THIRST” is likely to have the higher relative weight and make the greater contribution to the trade marks distinctiveness;
- the competing trade marks are visually and aurally similar to a medium degree and conceptually similar to a high degree;
- while the opponent’s trade mark is, absent use, possessed of a normal level of distinctiveness, the use that has been made of it since (at least) 2006 in relation to “kitchen paper towels” has built upon its inherent credentials elevating it into a trade mark with a high degree of acquired distinctiveness.

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 stated:

“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.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

44. In reaching a decision on the likelihood of confusion, I must weigh all of the above conclusions. Having done so, I have no hesitation concluding that even if the opponent had not filed evidence, the identity in the goods, the lower than normal degree of attention paid by the average consumer during the purchasing process (making him more prone to the effects of imperfect recollection), the medium degree of visual and aural similarity, the high degree of conceptual similarity and the "normal distinctiveness" the opponent's trade mark possess (but to which the word "THIRST" is likely to have the higher relative weight and make the greater distinctive contribution) would have been sufficient for me to find there was a likelihood of direct confusion i.e. the competing trade marks would be mistaken for one another and the opposition would have succeeded accordingly. However, I have also concluded that the opponent's "Thirst Pockets" trade mark has a high degree of distinctive character by virtue of the use that has been made of it in relation to "kitchen paper towels". The fact that such goods are identical to the applicant's "paper kitchen towels", or, given the obvious overlap in (at least) users, nature and trade channels (including being found in the same aisle of a supermarket), are similar to a high degree to the remaining goods in the application i.e. "toilet rolls" and "facial tissues", simply strengthens the opponent's position still further.

45. In reaching the above conclusion, I have not overlooked the applicant's comments in its counterstatement to the effect that it has used its Superthirst trade mark since 2008 and that its product "has totally different packaging and is a different product." In relation to the latter, the comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, are relevant. The Court stated that:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

46. In relation to the former point, as the applicant has not filed any evidence in these proceedings, its comment regarding its use of its trade mark cannot assist it.

#### **Conclusion under section 5(2)(b)**

**47. The opposition based upon section 5(2)(b) succeeds in full and, subject to any successful appeal, the application will be refused.**

#### **The objections based upon section 5(3) and 5(4)(a) of the Act**

48. Having reached a very clear conclusion under section 5(2)(b) of the Act (on the basis of both the inherent and acquired distinctive character of the opponent's earlier trade mark), I see no reason to consider the opponent's alternative positions under sections 5(3) and 5(4)(a) of the Act and decline to do so.

## Costs

49. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

|   |              |
|---|--------------|
| Preparing a statement and considering<br>the applicant's statement: | £300         |
| Preparing evidence  | £700         |
| Written submissions:  | £300         |
| Expenses:   | £200         |
| <b>Total:</b>   | <b>£1500</b> |

50. I order Accrol Papers Ltd to pay to Soffass S.p.A. the sum of **£1500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25th day of October 2016**

**C J BOWEN**  
**For the Registrar**