

O-418-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2513410
BY
W.D. IRWIN & SONS LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



IN CLASS 30

AND

**THE OPPOSITION THERETO
UNDER NO 99440
BY
HEYGATE & SONS LIMITED**

Trade Marks Act 1994

**In the matter of application 2513410
by W.D. Irwin & Sons Limited
to register a series of two trade marks:**



**in class 30
and the opposition thereto
under no 99440
by Heygate & Sons Limited**

1. On 10 April 2009, W.D. Irwin & Sons Limited (hereafter 'WD') applied to register the above series of two trade marks for *Bread and bread products*. These goods are in class 30¹. Nothing in this decision turns upon the marks being a series, so, for the sake of convenience, I will refer to the marks in the singular.

2. Heygate & Sons Limited (which I will refer to as 'Heygate') filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon three earlier trade marks, as follows:

1585356 BIG SOFTEE

Application date: 16 September 1994
Completion of registration procedure: 29 August 1995

Class 30: *Flour, bread, bread products; buns, rolls; filled rolls and filled bread products; all included in class 30.*

2490817

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.



"for the perfect soft bite"

Application date: 21 June 2008

Completion of registration procedure: 31 July 2009

Class 30: *Flour, bread, buns, rolls and bakery products; filled rolls and filled bread products.*

2490819



"The Roll with Soul"

Application date: 21 June 2008

Completion of registration procedure: 21 November 2008

Class 30: *Flour, bread, buns, rolls and bakery products; filled rolls and filled bread products.*

3. The earliest of Heygate's marks completed its registration procedure on 16 September 1994, which is more than five years before the date on which WD's application was published in the *Trade Marks Journal*. Heygate's mark is therefore an earlier trade mark which is subject to the proof of use provisions². Heygate made a statement of use in its notice of opposition in respect of *flour and bread*; however, WD stated in its notice of defence that it did not require Heygate to provide proof of use. This means that Heygate is entitled to rely upon *flour and bread* in relation to this earlier mark without having to prove its use by way of evidence³ in these proceedings. Its other two marks are not subject to the proof of use provisions because they were registered less than five years before the application was published.

4. Section 5(2)(b) of the Act states:

“(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.”

Heygate claims that the goods of both marks are ‘virtually identical’, as are the ‘softee’ word elements, which would cause a likelihood of confusion. WD filed a counterstatement denying a likelihood of confusion. It claims that the application is a variation of a mark WD used in Northern Ireland forty years ago. The counterstatement lists the differences between the application and the earlier marks and makes submissions regarding the meaning of BIG SOFTEE. I will come back to its arguments in more detail later.

5. Only WD filed evidence. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. In making my decision, I have

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

³ Rule 17(5)(d) states: “where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use (for the purposes of rule 20 this is the “statement of use”).” Rule 20(2)(c) states that where “(c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant, the person opposing the registration (“the opposer”) shall file evidence supporting the opposition.”

taken into account the evidence of both parties and the submissions made in WD's counterstatement.

Evidence

6. WD's evidence comprises two witness statements. The first is from Mr Michael Murphy, who has been the commercial director of WD since 2008. Mr Murphy states that WD added the 'softee' element to its registration for IRWIN's and device (2513641) "to capitalise on the large amount of goodwill which exists in the IRWIN'S trade mark along with the word SOFTEE which alludes to a feature of the bread product for which the mark is used, i.e. that the bread is very soft". Mr Murphy exhibits documents at WDI2 to show that softness in bread is a desirable feature sought by the bakery trade. These include pages from Hovis' website showing bread and rolls packaging which include the words 'soft white'; and a picture of a Kingsmill loaf – "Our Deliciously Soft White Loaf". Mr Murphy states that WD had also used the words Big Softee in the UK on bread products, use which ceased in 1983. Mr Murphy states that the mark applied for has been used in the twelve months prior to his witness statement being made (26 May 2010) and that no instances of confusion have been brought to WD's attention. This is not particularly relevant though because: i) this is after the relevant date, which is the date of application and ii) "Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark"⁴, such as trade may have taken place in different localities with no overlap in the local customer base.

7. The second witness statement is from Ms Cherrie Ann Stewart, WD's trade mark attorney in these proceedings. Ms Stewart exhibits, at WDI5, the Old English and modern German meanings of 'softe', and states (or submits) that the addition of another 'e' (to make 'softee') would be a common misspelling of the word 'softe'. Ms Stewart exhibits at WDI6 a dictionary reference from www.merriam-webster.com for the word 'soft', definition number three, as "a soft object, material, or part, <the soft of the thumb>." The inclusion of this is to support her submission that "in English, the suffix "ee" is often added to nouns to mean a person or object somehow associated with the object denoted by the noun and that "if the suffix "ee" is added to the word 'soft' the resulting word, 'softee', would mean that the object to which it is applied, e.g. bread, is being associated with being soft." This appears to be an alteration of the adjective 'soft' rather than the noun.

8. Ms Stewart exhibits at WDI7 examples of the word SOFTEE being used in trade to allude to the softness of a product. She cites the example of SOFTEE LEATHER as a generic term meaning "very soft and flexible upper leather" and that products made from this type of leather can be referred to as softee. Page

⁴ The European Limited v The Economist Newspaper Ltd [1998] FSR 283 Millett LJ; see also Tribunal Practice Notice 4/2009.

32 of the evidence is a print from the website of a firm of butchers named James Chapman which also sells bakery items. The page was printed on 25 May 2010. Amongst the lists of baps, rolls, cobs, tins and low GI bread are:

“Softee
Brown Softee”

Page 34 is a print from the website of “Flemings, Manufacturers of quality food products” (also printed on 25 May 2010). There is a heading for:

“Chocolate, Caramel Softee and Do-Nut Fil

- Flemings Softees are soft fudge style icings for fillings and toppings – ideal for a wide range of bakery and confectionery applications.
- Softees are ready-to-use straight from the pail when stored at ambient temperature, 18-24C, saving preparation time.
- Softee may be slightly heated if required.
- Freeze-thaw stable.”

It is not clear from this evidence whether James Chapman or Flemings use ‘softee’ as a trade mark or as a descriptive term. The pages relating to ‘softee leather’, ‘softee dog beds’ and ‘softee nappies’ would appear to have no direct relevance to the bakery area of trade, although there may be significance in the fact that other areas of trade use the term descriptively, so making softee apt as a description in a variety of trading fields. It is possible that trade mark use is involved in some of the pages exhibited.

Decision

9. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be

reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe

that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

10. In terms of specification coverage and the comparison between similar elements in the marks, Heygate’s strongest case rests with its earlier mark 2490819, so I will begin by considering the position in relation to this earlier mark compared to the application.

Comparison of goods

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ stated at paragraph 23 of its judgment:

“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 purpose⁵ and their method of use and whether they are in competition with each other or are complementary.”

Heygate’s goods	WD’s goods
<i>Flour, bread, buns, rolls and bakery products; filled rolls and filled bread products.</i>	<i>Bread and bread products</i>

12. Both specifications contain *bread*, which is clearly identical between the specifications. The only other term in WD’s specification is *bread products*. This term *per se* does not appear in Heygate’s specification, but *bread products* would appear to fall within the scope of Heygate’s *bakery products*⁶. This makes the goods identical. There is identity of all WD’s goods with those of Heygate.

⁵ The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

⁶ The General Court (previously the Court of First Instance) said in *Gérard Meric v OHIM*, Case 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 Vedral 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).”

Average consumer and the purchasing process

13. The average consumer for bread and bakery goods is the general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. I consider that the average consumer will pay only a moderate amount of attention when purchasing bread and bakery goods which are inexpensive, everyday consumer goods (it is hard to think of a food item which is more 'everyday' than bread). The purchasing process is largely a casual and visual process of self-selection.

Comparison of trade marks

14. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

15. The marks to be compared are:

Heygate's mark	WD's mark
	

The largest elements in Heygate's mark are the words BIG SOFTEE and the device of a filled roll. Subordinate to these elements are the coloured circle

which would be seen more as a background; the ears of wheat protruding from the filled roll; and the slogan “The Roll with Soul” at the very bottom of the mark, which is represented in a much smaller size than BIG SOFTEE. The filled roll, in the context of the goods, although a dominant element, is not distinctive given the goods covered by the earlier mark. BIG SOFTEE is the most dominant feature of Heygate’s mark. These words (despite the font of BIG being slightly different to that of SOFTEE) form a single element rather than being two separate standalone words. For the reasons I will come to, I do not consider the words to lack distinctive character. In view of all this, the BIG SOFTEE element is the dominant distinctive element in Heygate’s mark. The other elements will not, though, be completely ignored as they are not negligible in its overall impression (*Shaker di L. Laudato & C. Sas v OHIM*).

16. WD’s mark is also represented on a coloured background, with an ear of wheat. Neither of these are dominant elements and neither are distinctive in the context of bakery goods. “Since 1912” is not a dominant element and, again, is non-distinctive: it will be seen as simply the date from which the applicant has been trading, or, alternatively, the date from which the particular product has been sold. This leaves IRWIN’S SOFTEE which is by far the dominant element(s). SOFTEE has connotations of softness (I will come back to this in more detail shortly), and is, therefore, at the very least, low in distinctive character in the context of the goods. IRWIN’S is the possessive form of the surname IRWIN. Surnames, by their very nature, act as signals to distinguish the origin of goods and services. Although it is IRWIN’S SOFTEE and thus they are not completely separate standalone elements, IRWIN’S will be seen, effectively, as the house mark i.e. it is the softie product from Irwin. Given all this, I consider IRWIN’S to be the dominant and distinctive component of WD’s mark. As above, the other elements will not, though, be completely ignored as they are not negligible in its overall impression (*Shaker*).

17. Of the word elements, only SOFTEE is common to both marks; in both marks it is positioned beneath the other word component (which is different in each mark) on an upwards slant. This is the high point of visual similarity between the marks. In relation to the other elements, the words BIG and IRWIN’S are not at all similar. Furthermore, although they are subordinate components, the application does not include the filled roll device or a slogan, while the earlier mark does not include a date and although both marks include ears of wheat, these are incorporated into the marks in different ways. Both marks are presented on a background of differing shape. There are more points of visual difference than there are similarities; I conclude that the marks are visually similar only to a low degree.

18. The aural comparison is between BIG SOFTEE THE ROLL WITH SOUL and IRWIN’S SOFTEE SINCE 1912. There is a great deal of aural difference owing to the amount of words which are alien to each mark (the only common factor being SOFTEE). The SOFTEE components will be identical in sound; however,

BIG and IRWIN'S are entirely different in sound and these are the elements which will be heard first. If all the words in the marks were pronounced there would be virtually no aural similarity. Although I should guard against an artificial dissection of the marks, in my view, the only words likely to be used if the marks were referred to orally will be BIG SOFTEE and IRWIN'S SOFTEE, given the nature of the other verbal elements. For these reasons, there is a low degree of aural similarity between the marks.

19. WD has sought, in its evidence, to demonstrate that SOFTEE is a term of art for things that are soft. I feel the evidence falls short of this, especially in relation to the goods under consideration. Softee is not a dictionary word (it is not in Collins English Dictionary). However, non-dictionary words can be evocative of an idea. The General Court has considered how trade marks or parts of trade marks may have a conceptual connotation despite not being in themselves dictionary words. In *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-189/05* the CFI referred to a "suggestive connotation". In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* it referred to the "evocative effect" and in *Hipp & Co v OHIM T-221/06* the perception of words that consist of parts with concrete meanings.

20. The comments of the GC are apposite in relation to SOFTEE: it is suggestive of something which is soft. When juxtaposed with the possessive surname it has the meaning of something which is soft sold by IRWIN. It is a separate entity to the name; this separation between the surname and the 'soft' article is in contrast to BIG SOFTEE, which is highly reminiscent of the phrase BIG SOFTIE or BIG SOFTY. This is a well-known expression relating to someone who has a sentimental or emotional tendency. I consider that the various spellings of SOFTEE, SOFTY or SOFTIE will go largely unnoticed by the average consumer once the word is perceived in connection with BIG to form the whole phrase. Since the meaning is of someone soft, BIG SOFTEE still has connotations of softness, so sends a dual message of someone soft and softness.

21. Even if the sentimental significance is not perceived immediately, SOFTEE is still evocative of something which is soft. The word BIG then operates to qualify the relative size of the soft article. If the conceptual hook of Heygate's mark is a sentimental person, there is low conceptual similarity with WD's mark on account of the dual message, as explained above. If the conceptual significance of Heygate's mark is that it is a large soft article, there is a degree of conceptual similarity with WD's mark in that it also refers to a soft article; however, the soft article is one that is qualified with a surname which bears no resemblance conceptually to the word BIG. There is only a low degree of conceptual similarity in this scenario, with such similarity based on a not particularly distinctive concept. As with my comparison on a visual and aural basis, there are other elements in both marks which do not constitute the

dominant elements: the ears of wheat, which are a common idea, and the date and slogan which are not. On an overall assessment, the level of similarity between the marks is low.

Distinctiveness of Heygate's mark

22. It is necessary to consider the distinctive character of Heygate's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁸. There is no evidence of use which could enhance the earlier mark's distinctive character, so I have only its inherent nature to consider. WD's evidence in relation to the meaning of softie is inconclusive so I approach Heygate's mark on the conceptual basis which I have already outlined. If softie is evocative of soft, in relation to bread and bakery products softness is a characteristic which is considered desirable. Softie is likely to be perceived as a semi-descriptive term: its meaning in the context of the goods will be easily grasped, as will the reference to size. The device elements will not contribute distinctive character; the slogan THE ROLL WITH SOUL will be seen as a secondary mark (it is almost a separate entity). The level of distinctive character of the mark will be low. I consider that the words BIG SOFTIE will be seen by the average consumer as a reference to a sentimental person, but with the dual message of softness. The distinctive character of the mark will be average, factoring in all the other elements of the mark. If I am wrong in my assessment that the sentimental person/softness meaning will be grasped and that the significance of BIG SOFTIE is, instead, simply the relative size of a soft bread product, the distinctive character of the mark, as a whole, will be low.

Likelihood of confusion

23. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The goods of the parties are identical. I keep in mind the whole mark comparison, the dominant and distinctive elements within the marks, and the effect which the predominantly visual, casual purchasing process has upon the weight of these elements. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

them in his mind. I have found that the level of similarity between the marks, considered as wholes, is low; further, that the conceptual similarity is low whether or not the dual message or the semi-descriptive message is perceived. The only elements which are similar in the marks are low in distinctive character for the goods. The differences between the marks outweigh the similarities, such that there will be no likelihood of direct confusion.

24. I must also have regard to a scenario where, although the average consumer will be able to differentiate between the marks, there are, nevertheless, components of the marks which will lead the consumer to a belief or expectation that the same or a linked undertaking is responsible for the goods sold under both marks. This would amount to confusion in an indirect sense. In this case, the element which could cause such an economic association would be the SOFTEE element. However, I find that the connotation of softness, in relation to bread products, combined with the other elements of the marks (including a surname which serves as a natural indicator of trade origin) leads me to conclude that there is also no likelihood of indirect confusion. The opposition based upon the earlier mark 2490819 fails.

25. That brings me on to consider whether, in establishing a likelihood of confusion, Heygate would be in any better a position in relation to the other two of its earlier marks. BIG SOFTEE (1585356 word only) is for a more limited specification (flour and bread). The words are the same words which I found to be the dominant and distinctive elements of 2490819. For the reasons I have already given, the other elements of the 2490819 were subordinate (although not negligible) and did not affect my assessment of the similarity between the marks, which was essentially between BIG SOFTEE and IRWIN'S SOFTEE. This would also be the comparison to be made in respect of the word-only BIG SOFTEE mark. Bearing this in mind, in connection with a more limited specification which may only have yielded identical and similar goods (but not entirely identical goods, as with 2490819), Heygate cannot be in a better position with regard to its word only mark. The BIG SOFTIE device mark is, apart from the SOFTIE element, identical in composition and specification coverage to the device mark which I have analysed. Given that my conclusions in comparing BIG SOFTEE with IRWIN'S SOFTEE, where the SOFTEE element was identical, Heygate cannot be in a better position with regard to its BIG SOFTIE device mark.

26. The opposition fails.

Costs

27. WD has been successful and is entitled to an award of costs on the following basis⁹:

Considering the other side's statement

⁹ As per the scale in Tribunal Practice Notice 4/2007.

and preparing a counterstatement:	£300
Preparing evidence and considering and commenting on the other side's evidence:	£500
Total:	£800

28. I order Heygate & Sons Limited to pay W.D. Irwin & Sons Limited the sum of £800. 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 02 day of December 2010

**Judi Pike
For the Registrar,
the Comptroller-General**