O/0313/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003711691
IN THE NAME OF SEALY UNITED KINGDOM LIMITED
FOR THE FOLLOWING TRADE MARK:

MemorySense

IN CLASS 20

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 507542 BY SLEEPEEZEE LIMITED

BACKGROUND AND PLEADINGS

1. Sealy United Kingdom Limited ("the proprietor") applied to register the trade mark **MemorySense** ("the contested mark") in the UK on 19 October 2021. The mark was registered on 25 March 2022 in respect of the following goods in class 20:

> *Mattresses; mattress bases; beds; bedding; non-metal bed fittings and bedding accessories.*

2. On 16 July 2024, Sleepeezee Limited ("the applicant") applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon sections 3(1)(b), 3(1)(c) and 5(4)(a) of the Act.

3. In its statement of grounds, in respect of its claim under 3(1)(b), the applicant writes as follows:

> "The mark MEMORY SENSE does not possess the requisite distinctive character in respect of the registered goods. Both words possess meanings that are directly associated to the registered goods and their combination does not generate any degree of inherent distinctiveness. Accordingly, the mark should have been refused at examination for being devoid of distinctive character because the mark MEMORY SENSE cannot carry out the essential function of a trade mark to guarantee brand origin."

4. In support of its objection under section 3(1)(c), the applicant submits as follows:

> "The elements MEMORY and SENSE of the mark are entirely descriptive of the registered goods, and their combination does nothing more than describe the characteristics of the kind, quality, and intended purpose of the registered goods. Accordingly, the mark MEMORY SENSE is exclusively descriptive and should have been refused at examination."

5. Finally, in support of its s. 5(4)(a) ground, the applicant claims to have used the sign MEMORY SENSATIONS throughout the UK since 2016 in respect of *mattresses; mattress toppers; mattress bases* and *parts and fittings for all the aforesaid goods*,

having acquired goodwill in the same. The applicant submits as follows:

> "… As a result of the goodwill, any use by the Applicant of the mark MEMORY SENSE in relation to the Contested Goods, would constitute a misrepresentation to the public, which is likely to cause damage to the CA's business.
>
> The CA submits that the respective marks contain the identical word element MEMORY at the beginning of the mark, with the element SENS- being contained in the second element of the CA's mark SENSATIONS. The words SENSE and SENSATIONS share aural, visual and conceptual similarities. The marks are therefore visually, aurally and conceptually highly similar.
>
> The CA requests that the Registration should be invalidated in its entirety, in accordance with the provisions of Section 5(4)(a) and an awards of costs made in its favour."

6. The proprietor filed a counterstatement denying each of the claims made. I reproduce its counterstatement below:

> "1. The Registrant submits the claim under Section 5(4)(a) should be dismissed in its entirety. It is denied that the Cancellation Applicant has acquired goodwill through use of 'MEMORY SENSATIONS' in the UK. The Cancellation Applicant is put to strict proof of the claimed goodwill. However, should it be found the Cancellation Applicant has acquired goodwill in the 'MEMORY SENSATIONS' mark, then the Registrant denies that use of its UK trade mark No. 3711691 would constitute a misrepresentation, and further the Registrant denies that damage would occur to the Cancellation Applicant's business.
>
> 2. The Registrant submits the claim under Section 3(1)(b) should be dismissed in its entirety. The Registrant denies that its UK trade mark No. 3711691 does not possess the requisite level of distinctive character.
>
> 3. The Registrant submits the claim under Section 3(1)(c) should be dismissed in its entirety. The Registrant denies that its UK trade mark No. 3711691 is

exclusively descriptive.

4. The Registrant submits the invalidation action should be rejected in its entirety.

5. The Registrant seeks an award of costs in its favour."

7. The proprietor is represented by Bates Wells & Braithwaite London LLP and the applicant by Potter Clarkson LLP. Only the applicant filed evidence during the evidential rounds. Neither party requested a hearing, though both elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

8. The applicant's evidence takes the form of a witness statement from its Head of Marketing, Ms Amy Curtis, and seven accompanying exhibits (AC1-AC7). Ms Curtis has held this position since 2019. Her statement is dated 21 October 2024 and goes to the goodwill enjoyed by the applicant.

9. I take the following from Ms Curtis' evidence:

- The applicant company (Sleepeezee Holdings Ltd) was founded in 1924 and manufactures and wholesales beds, mattresses and related goods. The company uses over 300 expert craftspeople to make its products by hand to "exacting standards".

- Its company holds a Royal Warrant[1], meaning a mark of recognition for those who have supplied goods or services to royal households.

- Ms Curtis explains that the applicant uses its trade marks primarily used in respect of beds and mattresses, though they are also used in relation to goods such as pillows, bedding and pet beds.

- The applicant has, to date, raised over £300,000 to support charities including Macmillan Cancer Support and the British Support Foundation.

[1] Sleepeezee received a Royal Warrant to the Queen in 1963 and to the Prince of Wales in 1985.The applicant's evidence indicates that there are "around 800 Royal Warrant holders across all industries".

- Amongst the exhibits detailing the applicant's history is a quote from one of its ambassadors, Dame Jessica Ennis-Hill, who states that "Their beds are designed to give the very best sleep." Readers are invited to "Shop the Jessica range".

- Its website also invites visitors to "Follow us", with links to its account on platforms Facebook, LinkedIn, Instagram, Twitter, TikTok, Pinterest and YouTube.

- In the pages of a brochure from the Royal Warrant Holders Association (RWHA) published in 2014, amongst the listed bed and mattress products is the "Memory Technology Collection" which includes the "Memory Sensation 1000" and "Memory Sensation 800" mattresses available in various sizes and fabrics. I enclose an example product page below:

- Ms Curtis explains that the applicant uses a range of "MEMORY-formative names to denote the memory foam quality of the mattress, as this is a recognized term to consumers". Examples include "Memory Ultimate", "Lasting Memory" and "Memory Plus".

- The applicant's MEMORY SENSATION mattress (of which there are two models) has been sold since at least 2012 in the UK and, over the years, has been described as MEMORY SENSATION or MEMORY SENSATIONS (or both). Annual UK sales of

the applicant's MEMORY SENSATION mattresses are shown in the table below:

Year	Annual Sales United Kingdom - GBP
2016	56,033.56
2017	38,108.17
2018	33,702.56
2019	22,423.45
2020	14,582.00
2021	25,214.80
2022	37,462.00
2023	30,623.00
2024	10,452.00
TOTAL	**268,601.54**

- Invoices showing sales of the applicant's MEMORY SENSATION mattresses are enclosed[2] bearing dates between 2016 to 2024. The invoices are made out to various retailers and there are several instances of repeat sales to the same retailer (including, for example, Comfort Beds Company Ltd and Fitzgerald Bed Centre). For the most part, the relevant goods on each invoice is the applicant's MEMORY SENSATION 800 mattress.

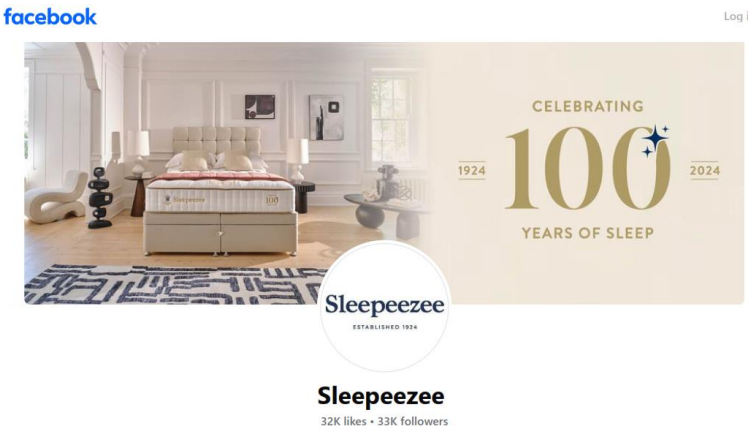
- Ms Curtis encloses examples of the applicant's MEMORY SENSATION mattresses available for sale via third party sites.[3] The screenshots are undated, originating from *bedfactorydirect.co.uk* (Memory Sensation 800 Mattress); *Furniture Mill* (4ft Small Double Sleepeezee Memory Sensation 800 Mattress); *Fitzgeralds Beds* (Sleepeezee Memory Sensation 800 Divan Set), *Your New Mattress* (Sleepeezee Memory Sensations 800 Mattress), *The Sleep Shop* (4ft6 Double Sleepeezee Memory Sensation 800 Mattress), *Bridge Bedding Centre* (Sleepeezee Memory Sensations 800 Divan Set) and *Bed Factory Direct* (Sleepeezee Memory Sensations 800 Mattress – Double).

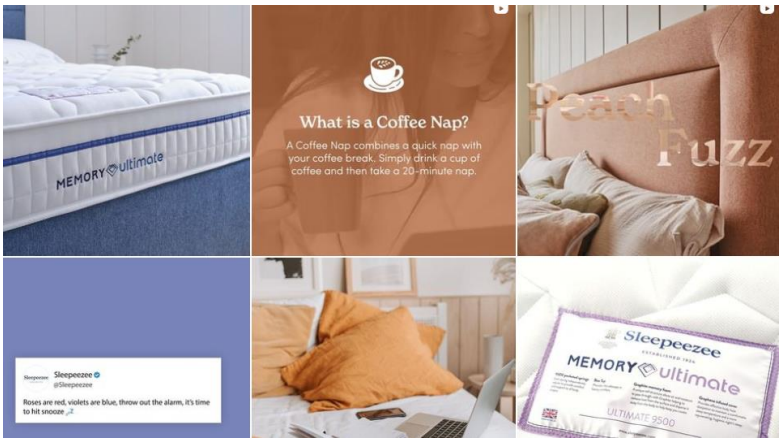
- The MEMORY SENSATION range is stocked at UK retailers such as Comfort Beds Company Ltd, Dreamland Bedding Centre and Mattressonline.co.uk Ltd. Ms Curtis explains that each retailer is responsible for their individual marketing and advertising to the end consumer.

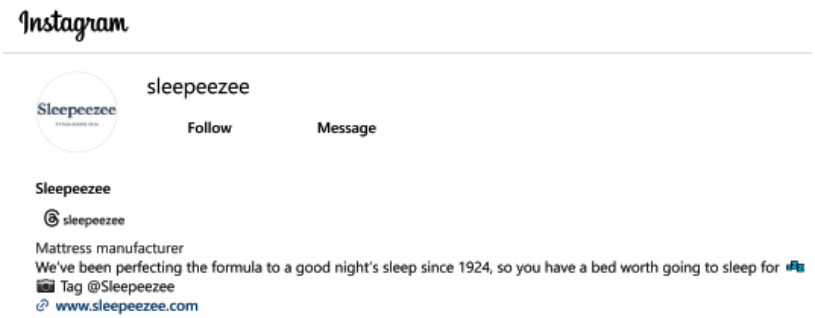
[2] See Exhibit AC2
[3] See Exhibit AC4

- As for its promotional engagement, the applicant claims to have “widely promoted” its products within the UK, which includes “significant advertising campaigns”. At Exhibit AC5, Ms Curtis encloses a record of various specification sheets for the MEMORY SENSATION products (ranging from 2012 to 2017) and extracts from a RWHA brochure in 2014 and 2015 promoting the applicant’s MEMORY SENSATION goods. Ms Curtis explains that the brochure is circulated annually amongst all Royal Warrant holders.

- The applicant advertises its brands through social media platforms including Facebook and Instagram. I cannot identify any use of the sign in the exhibited pages. I reproduce examples of its platforms below:







- Ms Curtis also directs me to the applicant's Sleepeezee Trustpilot site which shows a 4.3 star rating from 1, 171 reviews (75% of these giving 5 out of 5 stars). In broad terms, the reviews comment positively on the quality of the products and the delivery process.

10. The applicant also filed a witness statement from Ms Sarah Talland of Potter Clarkson LLP alongside five supporting exhibits (ST1 to ST5). Ms Talland's statement is dated 21 October 2024. I take the following from her evidence:

- At ST1, Ms Talland encloses the results of a Google search for "memory sense". Amongst the results[4] are links to third party sites offering for sale mattresses including those sold under the applicant's Sleepeezee brand (Memory Sense 2300 or 2800 Mattress, for example)[5]. There is also a mattress sold by Cousins Furniture called Cousins Bespoke Memory Sense 1000 Rolled mattress.

- A further Google search for "memory sense mattress" shows a number of listings from both the applicant and third-party brands offering mattresses for sale, including Claremont MemorySenseFoam Mattress and EVYA Memory Sense + Pocket Sprung Mattress.

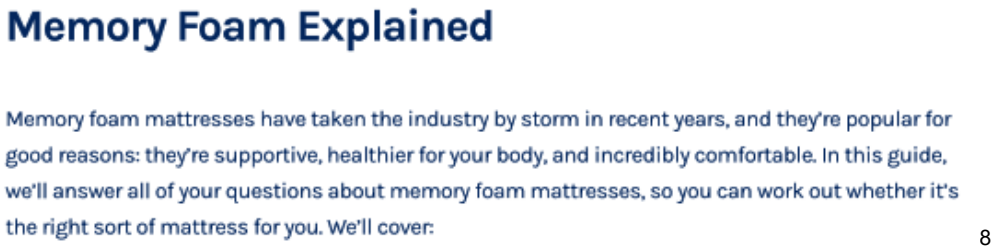
- Third party use of the term "Memory Sense" is exhibited at ST4. Screenshots from a website advertising for EVYA set out information regarding its Memory Sense+ Pocket Sprung Mattress. The information explains that "EVYA memory sense + foam features premium high density cisco elastic response…" and "EVYA memory sense + foam

[4] Some results are related to entirely different fields of activity, with links to articles such as "What is Sense Memory and How Should Actors Use It?" and "Sensory memory"
[5] Sold via Furniture Village

works in harmony with your body". A further screenshot from Cousins Bespoke advertises its "Memory Sense Super king 3 inch mattress topper", a foam-filled mattress topper from its Memory Sense range.

- Various definitions of SENSE are enclosed at Exhibit ST5.[6] Examples show its use in various ways, including as countable and uncountable nouns, verbs and singular nouns. From the respective dictionaries, the first-listed definitions are "your **senses** are the physical abilities of sight, smell, hearing, touch, and taste" and "an ability to understand, recognize, value, or react to something, especially any of the five physical abilities to see, hear, smell, taste, and feel". As for its use as a verb, the definitions show that it can mean "to feel or experience something without being able to explain exactly how", with suggested synonyms such as *perceive* or *understand*.

- Ms Talland describes Exhibit ST5 as "examples of the widespread use of 'memory' and 'memory foam' for mattresses". It comprises an article from *Dormeo* headed "Memory Foam Explained", a *Time4Sleep* article titled "The memory foam mattress explained", a *Telegraph* article listing "the best memory foam mattresses of 2024" and a page from *Mattresses online* with a heading "Memory Foam Mattresses" and a selection of products listed beneath. I reproduce a sample of these pages below[7]:



Memory Foam Explained

Memory foam mattresses have taken the industry by storm in recent years, and they're popular for good reasons: they're supportive, healthier for your body, and incredibly comfortable. In this guide, we'll answer all of your questions about memory foam mattresses, so you can work out whether it's the right sort of mattress for you. We'll cover:

[8]

UK NEWS WEBSITE OF THE YEAR 2024

The Telegraph

The best memory foam mattresses of 2024 for relieving pressure while you sleep

[9]

[6] *Collins* and *Cambridge* dictionaries
[7] It is not clear when the articles were published.
[8] *www.dormeo.co.uk*
[9] 25 April 2024; The article lists the "best memory foam mattresses in 2024" which include Tempur Original Elite Memory Foam Mattress and Emma Original Memory Foam Mattress.

10

11. That concludes my summary of the applicant's evidence, insofar as I consider it necessary.

DECISION

12. Section 47(1) of the Act states:

> "The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> […]
>
> (5) Where the grounds of invalidity exist 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.
>
> […]

[10] *www.mattress online.co.uk*

(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."

13. Sections 3(1)(b) and 3(1)(c) read as follows:

"3(1) The following shall not be registered –

(a) […]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of product of goods or of rendering of services, or other characteristic of goods or services,

(d) […]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

14. The relevant date for assessment under sections 3(1)(b) and 3(1)(c) is the date of filing of the contested mark, i.e. 19 October 2021.

15. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still to be objectionable under section 3(1)(b).[11]

16. The position under the above grounds must be assessed from the perspective of

[11] *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25]

the average consumer, who is deemed to be reasonably observant and circumspect.[12] In the present case, the relevant public is likely to predominantly comprise members of the general public, though I keep in mind that the goods may also be selected by businesses such as hotels, for example. Generally speaking, I find at least a medium degree of attention will be applied to the goods' purchase, with the consumer considering factors such as compatibility and materials when approaching their selection.

Section 3(1)(c)

17. I will begin with the application under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*[13] as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728

[12] *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04
[13] [2012] EWHC 3074 (Ch)

[2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-

2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended

purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

18. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.[14]

19. I begin by acknowledging that much of the evidence pertaining to the nature of MEMORY/SENSE post-dates the relevant date for assessment (search engine results and articles, for example). Nonetheless, I have no doubt that the consumer will be familiar with both words the contested mark comprises. The definition of the word SENSE was set out in the applicant's evidence and marries with my own interpretation, and likely that of the consumer. MEMORY is an ordinary dictionary word with a

[14] See *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

definition which will also be easily interpreted by the consumer meaning, broadly speaking, the recalling of past feelings or experiences. The evidence seems to show that the word MEMORY is quite frequently adopted by traders in respect of goods such as mattresses, and certainly indicates that the term MEMORY FOAM is likely to be recognized by the average consumer, used to describe a material used in mattresses, said to relieve pressure (amongst other things). On review of the lists of memory foam goods (predominantly mattresses) shown in evidence, it seems that the use of "memory" in respect of such goods will likely signal to consumers that memory foam is used in the mattress itself. To my mind, it is therefore largely the effect of combining MEMORY with the word SENSE which will be pivotal to my assessment. I keep in mind the findings of the Court of Justice of the European Union ("CJEU") in *Campina Melkunie BV and Benelux-Merkenbureau,*[15] set out below:

> "39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.
>
> 40 However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.
>
> 41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within

[15] Case C-265/00

the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts."

20. I must also acknowledge that there is evidence of MEMORY SENSE being adopted by third parties in respect of mattresses (Cousins Bespoke Memory Sense 1000 Rolled mattress or EVYA Memory Sense + Pocket Sprung Mattress, for example). There are also thumbnails of sponsored "product sites" supplementing search engine results, showing listings for "Claremont Memorysense Foam Mattress…" and "Eaglesfield MemorySense Foam PowerPac…" (as these are thumbnails only, the goods' full description appears incomplete and I have no meaningful information concerning these listings). There is also evidence showing the words used in respect of the same goods but the words are not necessarily positioned in the same order or alongside one another. In this regard, I keep in mind the principle behind section 3(1)(c), which is to keep descriptive signs relating to one or more characteristics of the goods or services free to use by all traders offering such goods and services. However, the evidence of these words in combination is rather light and, in my view, does not clearly establish whether the words are used in each instance as part of brand names or purely descriptively.

21. I bear in mind that, for the purpose of the present ground, the average consumer needs to be able to perceive immediately a description of one of the characteristics of the goods at issue. To my mind, "MEMORY" and "SENSE", together, do not create an immediately interpretable concept. The consumer may admittedly have an idea as to what is being suggested but "MEMORY/SENSE" does not play an entirely descriptive role. I have already found on the basis of the applicant's evidence that MEMORY can be used in a descriptive manner in this field, likely signaling to consumers that the goods will be made (at least in part) with memory foam. I am not however satisfied that SENSE, in the present context, is necessarily *descriptive*. The addition of SENSE, broadly speaking, will introduce a vague idea of feelings or perceptions, for example,

but I do not consider this an addition of simply another descriptive element. The mark's MEMORY element will suggest that the goods incorporate memory foam, or will at least replicate the effects of memory foam, and the words in combination may create an allusion toward an ability to perceive or recall the user's requirements (to enhance personal comfort, for example). Whilst this may be viewed as a nod toward what could be viewed as a *desirable* quality concerning the nature of the goods, this is not sufficient. In the present case, I find the mark's elements create a totality which would not impress an immediately clear meaning but rather would provoke further thought. With all this in mind, notwithstanding the descriptive role MEMORY can play, I am left with the view that the mark is, at most, merely suggestive or allusive and is not one which provides a description of the relevant goods. I am also not satisfied, on the basis of the evidence before me, that there was any particular need to keep the mark free for the legitimate future use by other traders at the relevant date. The words may be adopted to create some allusive impression but the third party evidence concerning these goods is not, to my mind, conclusive and is not sufficient to dispel the primary finding I have reached. I make this finding in respect of all terms for which the mark is registered. The ground fails.

Section 3(1)(b)

22. I now turn to the application under section 3(1)(b) of the Act. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*[16] as follows:

> "29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).

[16] (C-265/09 P)

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel* v *OHIM*, paragraphs 36 and 38; and *Audi* v *OHIM*, paragraph 37)."

23. Whilst this ground of objection is independent of the other grounds, I reach much of the same conclusion. The applicant's claim is that both words MEMORY and

SENSE possess meanings that are "directly associated" to the relevant goods, and that their combination "does not generate any degree of inherent distinctiveness". It is difficult to anticipate how the words can be "directly associated" to the relevant goods beyond the suggestion that the words play a descriptive role. Nonetheless, as indicated above, I find the combination of the words Memory and Sense does award the mark some distinctiveness, given that the combination creates a notion which is not immediately clear or tangible and one which I have already found not to be, in its totality, descriptive of the goods but instead, at most, allusive toward a potentially desirable characteristic. Whilst I accept that both MEMORY and SENSE can be used allusively, and MEMORY even descriptively, in the context of the relevant goods I find the proprietor's mark as a whole is capable of serving as a trade mark and possesses the requisite level of distinctive character. In light of these considerations and my wider findings concerning the mark's elements, this ground fails.

Section 5(4)(a)

24. Section 5(4)(a) of the Act states as follows:

> "5(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, where the condition in subsection (4A) is met,
>
> aa) […]
>
> 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".

25. Subsection (4A) of section 5 of the Act states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

26. In *Discount Outlet v Feel Good UK*,[17] Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borde*n [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

27. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

[17] [2017] EWHC 1400 IPEC

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

28. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,*[18], Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

29. As the proprietor has not made a claim that it has used the contested mark prior to the date of the application for the contested mark, the relevant date for assessing the applicant's claim under section 5(4)(a) is the filing date of the mark at issue, namely, 19 October 2021.

Goodwill

30. The first hurdle for the applicant is showing that it had the necessary goodwill in the sign relied upon as at the relevant date.

31. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*[19] in the following terms:

[18] BL O-410-11
[19] [1901] AC 217 (HOL)

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

32. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*[20], Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

33. However, in *Minimax GmbH & Co KG v Chubb Fire Limited,*[21] Floyd J. (as he then was) stated that:

[20] [2002] RPC 19 (HC)
[21] [2008] EWHC 1960 (Pat)

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

34. In *Hart v Relentless Records,*[22] Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

35. The applicant claims to enjoy goodwill in the sign MEMORY SENSATIONS in respect of mattresses; mattress toppers; mattress bases and parts and fittings for all the aforesaid goods. I do not intend to reproduce my summary of the evidence here but will instead refer to it as and where necessary. Goodwill arises as a result of trading activities. The evidence shows that the applicant's MEMORY SENSATION (or

[22] [2002] EWHC 1984 (Ch)

MEMORY SENSATIONS) goods have been sold since at least 2012 in two different models, with combined annual sales between 2016 and 2021 surpassing £190,000[23]. I have no figures before me to show how much the applicant invested into the promotion or advertisement of these goods, though Ms Curtis explains that UK retailers were responsible for their own respective marketing efforts. She does submit, however, that the sign was "widely promoted" in the UK and "significant advertising campaigns" undertaken. As for any tangible evidence of promotion, the applicant has enclosed extracts of the RWHA brochures from 2014 and 2015 which were circulated amongst its members though, in my view, this signifies a fairly limited degree of exposure. In regard to its social media engagement, though there are screenshots of the applicant's accounts under the name of its Sleepeezee brand, I cannot see any reference to the relied-upon sign specifically. Whilst I have little context to measure the significance of the sales figures provided, given the unit prices displayed in the enclosed invoices it seems clear that a reasonable number of the applicant's MEMORY SENSATION goods were purchased in the years leading up to the relevant date. Furthermore, the invoices show custom from a wide range of retailers, and several instances of repeat engagement, spanning several years of trading. The reviews on the applicant's Trustpilot page are generally positive and show an overall rating of 4.3 out of 5 stars, though this appears to relate to the Sleepeezee brand at large. With all this in mind, I am satisfied that the applicant had acquired a moderate level of goodwill in its business at the relevant date.

36. As for whether the sign relied upon is distinctive of that goodwill, whilst I have already acknowledged that aspects of the evidence concern the applicant's wider Sleepeezee brand, the evidence shows consistent sales of the applicant's MEMORY SENSATION goods over several years (prior to and beyond the relevant date) sold through a variety of retailers across the UK. I am satisfied that the sign was distinctive of the applicant's goodwill at the relevant date.

Misrepresentation

37. In *Neutrogena Corporation and Another v Golden Limited and Another,*[24] Morritt L.J. stated that:

[23] I accept that a portion of the total 2021 sales may have been made after the relevant date
[24] [1996] RPC 473

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc*. [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

> "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."
And later in the same judgment:

> "[…] for my part, I think that references, in this context, to "more than de minimis" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in University of London v. American University of London (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

38. I keep in mind the judgment in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited,*[25] whereby the differences between "Office Cleaning Services Limited" and "Office Cleaning Association," even though the former was well-known, were held to be enough to avoid passing off. Lord Simmonds stated:

> "Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small

[25] [1946] 63 RPC 39

differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a Page 9 of 9 trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

39. Having carefully considered the nature of the earlier sign and contested mark, and being mindful of the above, when considering the applicant's MEMORY SENSATION(S) against the proprietor's MemorySense, I do not find it likely that the relevant public, when faced with the contested mark, will be minded to conclude that there is a connection between the user of that mark and the user of the earlier sign. To my mind, the respective Sense and SENSATION elements are sufficiently distinct, albeit allusive, and the shared MEMORY element weakly distinctive, such that use of the proprietor's mark is not likely to give rise to a misrepresentation, even where the matter is considered in respect of identical or highly similar goods. I do not consider that a substantial number of consumers (be it on professional terms or members of the public) will be deceived into purchasing the proprietor's goods in the mistaken belief that they are the goods of the applicant. To my mind, the similarities are more likely to be attributed to mere coincidence. The opposition based upon s. 5(4)(a) therefore fails.

CONCLUSION

40. The application for a declaration of invalidity has failed on all grounds. The proprietor's mark will, subject to any successful appeal, remain registered.

COSTS

41. The proprietor has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice ("TPN") 1 of 2023. In line with that TPN, I award costs to the proprietor as follows:

Considering the other side's statement and preparing a counterstatement:	£300

Considering the other side's evidence and

preparing written submissions in lieu:	£600
Total:	**£900**

42. I order Sleepeezee Limited to pay Sealy United Kingdom Limited Limited the sum of £900. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of April 2026

Laura Stephens
For the Registrar