

O/0734/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO0000001804978

BY BETT1.DE GMBH

TO PROTECT THE FOLLOWING INTERNATIONAL REGISTRATION:

FLIP

IN CLASS 20

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 451222

BY BENSONSFORBEDSRETAIL LTD

BACKGROUND AND PLEADINGS

1. bett1.de GmbH (“the holder”) is the holder of the international trade mark registration 1804978 (“the holder’s mark”), shown on the front cover of this decision. The holder’s mark is registered with effect from 09 July 2024 but benefits from a priority date of 30 January 2024. On 09 July 2024 the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. It was accepted and published for opposition purposes on 06 September 2024 in respect of the following goods:

Class 20: *Mattresses; beds, mattresses, pillows and cushions; mattress toppers; mattress bases; slatted bases for beds; cushions (upholstery); foam mattresses.*

2. On 06 December 2024, BensonsforBedsRetail Ltd (“the opponent”) opposed the protection of the holder’s mark in the UK on the basis of Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the holder’s goods.

3. Under Section 5(2)(b), the opponent relies upon its two earlier trade marks shown below:

UK00003885591

FLIP BY SLUMBERLAND

Filing date: 06 March 2023

Date of entry in register: 26 May 2023

Class 20: *Mattresses, pillows and cushions; mattress bases; mattress toppers; mattress and pillow protectors; inflatable mattresses [airbeds]; parts and fittings for the aforesaid goods.*

UK00003885598



Filing date: 06 March 2023

Date of entry in register: 26 May 2023

Class 20: *Mattresses, pillows and cushions; mattress bases; mattress toppers; mattress and pillow protectors; inflatable mattresses [airbeds]; parts and fittings for the aforesaid goods.*

4. By virtue of their earlier filing dates, the two trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. Neither of these earlier marks had been registered for more than five years at the filing date of the holder’s mark, and, as such, are not subject to the use conditions under Section 6A of the Act.

5. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are highly similar, and the goods are identical or similar.

6. Under Section 5(4)(a), the opponent relies upon the sign ‘FLIP’ which it claims to have used throughout the UK from at least February 2024 in relation to *mattresses*. The opponent claims that use of the holder’s mark on its class 20 goods would be contrary to the law of passing off.

7. The holder filed a defence and a counterstatement in which it denies the opponent’s claims, whilst admitting that some of the goods at issue are identical. In particular, the holder argues that the coinciding element of the marks/signs, namely the word ‘FLIP’, is not the dominant element because it is shorter, and because the orange device in the figurative earlier mark suggests a mattress that can flip on both sides.

8. Both parties filed evidence during these proceedings.

9. The opponent is represented by Hansel Henson Limited. The holder is represented by Womble Bond Dickinson (UK) LLP.

10. A hearing took place before me, by video conference, on 15 July 2026. At the hearing, Mr Jamie Muir Wood of Counsel (instructed by Womble Bond Dickinson (UK) LLP) appeared for the holder, and Ms Charlotte Blythe of Counsel (instructed by Hansel Henson Limited) appeared for the opponent.

Relevance of EU Law

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

12. The opponent's evidence came in the form of a witness statement from Lisa Richards dated 6 May 2025 and accompanied by 16 exhibits, being those labelled LR1-LR16. Ms Richards is the Head of Marketing of the opponent's company, and her evidence is aimed at supporting the opponent's claims for passing off under Section 5(4)(a) and enhanced distinctiveness under Section 5(2)(b).

13. The holder did not file any evidence during the evidence rounds. However, it filed written submissions dated 2 July 2025.

14. I do not intend to summarise the evidence and submissions in full here. However, I confirm that I have taken all filed documents into account and will refer to them to the extent that I deem necessary below.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a) ...

(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.”

16. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. The competing goods are as follows:

The applicant's goods	The opponent's goods
Class 20: <i>Mattresses; beds, mattresses, pillows and cushions; mattress toppers; mattress bases; slatted bases for beds; cushions (upholstery); foam mattresses.</i>	Class 20: <i>Mattresses, pillows and cushions; mattress bases; mattress toppers; mattress and pillow protectors; inflatable mattresses [airbeds]; parts and fittings for the aforesaid goods.</i>

19. The terms *Mattresses; pillows and cushions; mattress toppers; mattress bases* are identically contained in both specifications. In its counterstatement, the holder also accepted that its *foam mattresses* are identical to the opponent's *Mattresses* and that its *slatted bases for beds* are identical to the opponent's *mattress bases*. I also find that the holder's term *cushions (upholstery)* is identical to the opponent's *cushions*. This leaves the holder's term *beds*. Although the holder initially argued that the term *beds* in the application is only similar to the opponent's terms *mattresses* and *inflatable mattresses [airbeds]*, at the hearing Mr Wood conceded that “*beds are identical [to the opponent's goods] on the Meric principle*”. I agree with Mr Wood, and I find that the holder's term *beds* encompasses the opponent's term *inflatable mattresses [airbeds]*, and that these goods are also identical. Accordingly, all of the holder's goods are identical to the opponent's goods.

Average consumer

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

21. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor* (Rev1) [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

22. The average consumer of the parties' goods in class 20 is a member of the general public. In his skeleton argument, Mr Wood states that the average consumer is likely to pay an above average degree of attention during the selection of the goods, given that the goods are ones that will be used on a daily basis, and due to the need for comfort during sleep. At the hearing, Ms Blythe agreed that the level of attention will be higher than normal due to the price of the goods at issue, and because the goods are not everyday purchases. It seems therefore to be common ground between the parties that the goods at issue will be selected with an above average (but not high) degree of attention. I agree with this approach, and I will proceed on this basis.

23. In regard to the way the goods will be selected, they are most likely to be the subject of selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative or a selection is made further to word-of-mouth recommendations.

Comparison of marks

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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.”

25. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for mark	The earlier marks
	

Overall impression

The holder's mark

26. The holder's mark is a figurative mark consisting of the word 'FLIP' presented in a standard font, in capital letters, in bold. Whilst the boldness of the letters has a visual impact, it is both banal and minimal, and the overall impression of the mark derives from the word 'FLIP'.

The opponent's word-only mark

27. The opponent's word-only mark consists of the three words 'FLIP', 'BY' and 'SLUMBERLAND', presented in capital letters in a standard font. The mark has no other aspect to it.

28. In his skeleton argument, Mr Wood, for the holder, argued that the term 'FLIP' in the earlier marks, particularly in the figurative mark, points to the fact that products sold under those marks, particularly mattresses, can be flipped (i.e. they are double-sided). Nevertheless, Mr Wood also recognised that the word 'FLIP' is not descriptive for the goods for which the opponent's marks are registered (which include mattresses) because the holder itself applied to register the word 'FLIP' as a trade mark in relation to the same goods – this implies that the word 'FLIP' has a minimum degree of distinctiveness in the context of the goods for which the opponent's marks are protected including *mattresses*. Further, Mr Wood stated that the element 'SLUMBERLAND' is allusive, but not descriptive of the earlier goods, although he did not expand on the meaning of this word.

29. Ms Blythe, for the opponent, for her part, argued that the structure of the opponent's word-only mark makes clear that 'FLIP' is a sub-brand of the over-arching brand 'SLUMBERLAND' and that both 'FLIP' and 'SLUMBERLAND' play an independent distinctive role within the mark as a whole. Further, she submitted that the word 'FLIP' is the dominant element of the mark being the specific brand indicator and appearing first in the mark.

30. Admittedly, neither the word 'FLIP' nor the word 'SLUMBERLAND' is particularly distinctive in the context of the registered goods, which all are used for sleeping. The word 'FLIP' has different meaning, including the following (Collins online dictionary):

1. If you flip a device on or off, or if you flip a switch, you turn it on or off by pressing the switch quickly.
2. If you flip through the pages of a book, for example, you quickly turn over the pages in order to find a particular one or to get an idea of the contents.
3. If something flips over, or if you flip it over or into a different position, it moves or is moved into a different position.

4. If you flip something, especially a coin, you use your thumb to make it turn over and over, as it goes through the air.

31. As it can be seen, the meaning to which Mr Wood refers as being relevant, in the sense that it relates to a characteristic of the goods (namely that of being double-sided), is that set out at 3. Whilst the correct terminology for that meaning to be conveyed is 'flip over', I do not consider that the absence of the word "over" would prevent the consumer from perceiving "flip" to mean that the goods can be moved and rotated into different positions (i.e. flipped over). Having said that, I agree with Mr Wood that such meaning would apply more directly to the registered term *mattresses*. This is because mattresses that are double-sided are less uncommon than, for example, pillows that are double-sided, although there is no evidence that double-sided mattresses are the norm – in this connection, there is nothing to support Mr Wood's contention that (a) double-sided mattresses have two sides which might be for the summer and for the winter and (b) it is a well-known fact that mattresses can be double-sided.

32. Whilst I accept that mattresses can be flipped and rotated regularly to enjoy even wear and extended use (i.e. for durability), I do not accept that it is common for mattresses to have a specific function that is achieved by the mattress being double-sided – in this connection the evidence shows that the opponent's mattresses are double-sided to support the growth of children, which is not the same function as that mentioned by Mr Wood, namely that of dual season. Accordingly, I find that the word 'FLIP' in the opponent's mark has a low to medium degree of distinctiveness in relation to mattresses because it might allude to the goods being double-sided, and a medium degree of distinctiveness in relation to the other goods. Turning to the word 'SLUMBERLAND', its meaning (Collins online dictionary) as "*the state or domain of sleep*" has, indeed, some allusive connotations in relation to the goods for which the opponent's marks are registered, all of which are used for sleeping.

33. Lastly, bearing in mind the meaning of the preposition 'BY' as "*If you say that something such as a book, a piece of music, or a painting is by a particular person, you mean that this person wrote it or created it*" (Collins online dictionary), the words 'BY SLUMBERLAND' in the opponent's mark are likely to be understood as a unit

saying that goods sold under the sign 'FLIP' are 'designed by' and/or 'provided by' an undertaking called 'SLUMBERLAND'.

34. Accordingly, both verbal elements 'FLIP' and "SLUMBERLAND' have allusive connotations in relation to the goods concerned. Further, they are both presented as having independent trade mark significance within the mark. Lastly, the words 'BY SLUMBERLAND' are likely to be perceived as a unit indicating the undertaking who designs or provides the goods under the brand 'FLIP'. Taking into account all of these circumstances, I consider that although the word 'FLIP' appears first, the unit created by the words 'BY SLUMBERLAND' is equally important resulting in both components making a roughly equal contribution to the overall impression of the opponent's mark.

The opponent's figurative mark

35. Similar considerations to those which I have made in relation to the opponent's word-only mark apply to the opponent's figurative mark. The only difference here is that due to its large size and prominent position, the word 'FLIP' plays a slightly greater role in the overall impression of this mark, whilst the figurative element will be perceived as evoking the idea of a semicircle that is flipped over – this will, in turn, reinforce the meaning of the word 'FLIP' and consequently the word 'FLIP' itself. Accordingly, even if the figurative element of the mark and the way the verbal elements are presented will contribute to the overall impression, it will be to a much lesser extent than the words 'FLIP' and 'BY SLUMBERLAND' which remain the first and second most distinctive elements of the mark, respectively.

Visual and aural similarity

36. Visually and aurally, the holder's mark and the opponent's word-only mark coincide in the verbal element 'FLIP' which is the only verbal element of the holder's mark and the first verbal element of the opponent's mark. The marks differ in that the opponent's mark contains the additional words 'BY SLUMBERLAND' which have no counterpart in the holder's mark.

37. The fact that the letters in the holder's mark are presented in bold and in a slightly stylised font does not constitute a point of visual distinction, since the opponent's mark may notionally be presented in the same font and thickness, being that it is a word-only mark which is *"not limited by any features such as fonts or capitalisation appearing on the Register"*.¹

38. Overall, I consider these marks to be visually and aurally similar to a medium degree.

39. Turning to the opponent's figurative mark, the position in regard to the aural similarity is the same (i.e. the marks are similar to a medium degree), because neither the stylisation nor the figurative element of this mark will be articulated. As regards the visual similarity, admittedly, these elements will have a visual impact, however, that is counterbalanced by the more prominent position of the coinciding element 'FLIP' – hence, I consider that the visual similarity is only marginally reduced to a slightly below medium degree.

Conceptual similarity

40. Conceptually, in his skeleton argument, Mr Wood for the holder argued that *"conceptually, the earlier mark focus on 'SLUMBERLAND', which is absent from the application. To the extent there is a conceptual meaning, it differs between the signs"*. As it will be recalled, I have concluded that the coinciding element 'FLIP' is co-dominant in the opponent's word-only mark, and slightly more dominant, due to its size and prominent position, in the opponent's figurative mark. I have also concluded that the coinciding element 'FLIP' remains independently distinctive in both earlier marks. Further, I find that the meaning conveyed by the coinciding element 'FLIP' is the same in all marks and that the words 'BY SLUMBERLAND' are likely to be perceived as a unit indicating the undertaking who designs or provides the goods under the brand 'FLIP'. Overall, I consider these marks to be conceptually similar to a medium degree.

Distinctive character of the earlier mark

¹ *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, at [15].

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

43. At the hearing Ms Blythe, for the opponent, argued that the distinctiveness of the earlier marks has been enhanced through the use made of those marks by the opponent in relation to “*mattresses*”. Before I turn to consider whether the evidence

filed by the opponent is sufficient to sustain its claim of enhanced distinctiveness, I will consider the inherent position.

44. The opponent's word-only mark consists of the words 'FLIP BY SLUMBERLAND'. Since it is the distinctiveness of the common element that is the key, I shall focus on the distinctiveness of the coinciding word 'FLIP'.

45. As it will be recalled, Mr Wood argued that the word 'FLIP' is weakly distinctive especially in relation to mattresses because it denotes a characteristic of the goods, namely that they can be flipped, though he accepted that it cannot be descriptive because his own client applied for the plain word 'FLIP' in relation to, *inter alia*, mattresses. I have already addressed this submission above and I have concluded that the word 'FLIP' in the opponent's mark has a low to medium degree of distinctiveness in relation to mattresses, and a medium degree of distinctiveness in relation to the other goods. Furthermore, bearing in mind the presence of the other verbal and figurative elements of the marks, they are distinctive to a medium (i.e. the word-only mark) and above medium (i.e. the figurative mark) degree, respectively.

46. Turning to the evidence of use, the relevant date for assessing whether the distinctiveness of the opponent's earlier marks has been enhanced through use is the priority date claimed in the application, namely 30 January 2024.

47. Although I have reviewed the opponent's evidence in full, for ease of reference, I will adopt most of the summary provided by Ms Blythe in her skeleton arguments:

- a) Ms Richards states that the opponent is a British bedroom furniture retailer with over 170 stores across the UK and the third largest market share of 7.5% of the UK bedroom furniture market in 2024 – however nothing further has been filed to support this statement.
- b) One of the opponent's most successful own brands of mattresses is 'SLUMBERLAND', under which various mattress sub-brands are offered. One of the mattresses offered under the 'SLUMBERLAND' range is the 'FLIP' mattress. At the relevant date, the opponent's 'SLUMBERLAND'

range included the following brands: 'DUO', 'FLIP', 'NATURALS', 'CLIMA', 'CONTROL', and 'LATEX'.² The 'FLIP' mattress is a specialist mattress designed to support the changing height and weight of growing adolescents.

- c) The 'FLIP' mattress was launched on 14 February 2023 and was in all stores by 1 March 2023, 11 months before the relevant date in this case.
- d) In the period 14 February 2023 to 30 January 2024 (i.e. the relevant date), the opponent sold 2,614 'FLIP' mattresses for a sum of £1,025,824. The mattress was referred to as both 'FLIP' solus and 'FLIP BY SLUMBERLAND', in both word and logo form.
- e) In that same period, the opponent spent £120,000 on marketing, largely on social media, Mumsnet and SEO. The opponent also promoted its FLIP mattress on its own social media channels and via paid influencers; through its own customer database; and, via press releases. The following table is provided which sets out the number of impressions and engagements generated by social media posts:

Date	Social Media Post	No of impressions	Engagements
2 March 2023	FLIP Launch Page 1 of Exhibit LR08	6948	29
3 March 2023	Influencer Geri Sammut-Alessi Page 6 of Exhibit LR08	n/a	852
8 March 2023	FLIP – Mattress Explosion Page 2 of Exhibit LR08	n/a	18
17 March 2023	Influencer – Athomewithdidi Page 3 of Exhibit LR08	30,000	798
17 August 2023	FLIP – Good Housekeeping Institute Award Page 4 of Exhibit LR08	2015	16
22 August 2023	FLIP - Reviews post Page 5 of Exhibit LR08	1324	9

² LR01

- f) The 'FLIP' mattress was endorsed by the Good Housekeeping Institute on 1 August 2023 and won Product of the Year on 14 December 2023.

48. Mr Wood made a number of criticisms to the opponent's evidence. First, he argued that it focuses on the narrow window around the launch of the product, namely in or around March 2023. Second, he argued that given the number of units sold, which are just over 2,500 and the number of stores where the goods were sold (which are around 170) there were, on average, 15 sales per store which is not significant for the purpose of establishing goodwill. Third, Mr Wood criticised the evidence about a marketing email which, he said, is unsupported (because there is nothing to show that it was sent out to any member of the public). Fourth, Mr Wood submitted that the press coverage exhibited in evidence is not from major press outlets, but from specialist publications. Lastly, Mr Wood said that the use shown is not use of the word 'Flip' as a brand, but to illustrate the instruction to switch the firmer to softer side - this is functional descriptive use, rather than trade mark use.

49. I shall start by saying that since the opponent relies on the same evidence to support both the claim for passing off and that for enhanced distinctiveness, these criticisms equally apply to the assessment of both claims. As regards the criticism that the use of the word 'FLIP' is descriptive or functional, I reject it – as I have previously explained the word might be allusive but is not descriptive and it is clearly used as a brand. I accept that the sale of 2,614 mattresses through 170 stores over an 11-month period for a sum of just over £1million is not particularly impressive. Certainly, the fact that the goods were sold in so many stores indicate a good geographical spread of use, however, the number of units sold, and the revenue generated by these sales appears to be relatively small even considering that these are not frequent purchases. In addition, the duration of the opponent's use is relatively short, being it less than one year, and there is no information about the market share held by the opponent under the earlier marks. In this connection, whilst the evidence indicate that the opponent had the third largest market share of 7.5% of the UK bedroom furniture market in 2024, this is not specific to the earlier marks, which are only one of the many sub-brands used by the opponent. Lastly, whilst the size of the promotional investment specifically related to the earlier marks is not insignificant, being it over £100K, and the product was awarded the Product of the Year on 14 December 2023, when all of the other

factors are weighed in, the evidence is insufficient to establish anything more than commercial use, and definitely not enhanced distinctiveness.

Likelihood of confusion

50. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

52. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

53. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

54. Earlier in this decision I found that:

- The holder's mark and the opponent's word-only mark are visually, aurally and conceptually similar to a medium degree. The holder's mark and the opponent's figurative mark are visually similar to a slightly below medium degree and aurally and conceptually similar to a medium degree.
- The parties' goods are identical.
- The average consumer is a member of the general public who will select the goods mainly visually, with an higher than medium degree of attention (but not high).
- The opponent's word-only mark is inherently distinctive to a medium degree. The opponent's figurative mark is inherently distinctive to an above medium degree. The coinciding element 'FLIP' is distinctive to a low to medium degree in relation to mattresses, and a medium degree in relation to the other goods for which the earlier marks are protected.

55. Weighting all of these factors, I conclude that even considering the lower than medium degree of distinctive character of the coinciding element 'FLIP', it is not so low to avoid confusion. Further, the element 'FLIP' is independently distinctive within the earlier marks, and the non-coinciding elements between the marks are either equally distinctive or even less distinctive.³ In those circumstances, it is highly likely that the average consumers seeing the holder's mark 'FLIP' without the words 'BY SLUMBERLAND' will assume that the opponent sometimes uses 'FLIP' with the house mark ('SLUMBERLAND'), and sometimes without, thus leading them to think that the holder and the opponent are the same or economically linked undertakings. Thus, I find that the perception of 'FLIP' as a sub-brand of 'SLUMBERLAND' means that the average consumer seeing 'FLIP' on identical goods is likely to believe that it has some connection with 'FLIP BY SLUMBERLAND'.

56. There is a likelihood of confusion. The opposition under Section 5(2)(b) is successful in its entirety.

³ Peninsula Face2Face BL-O/0368/23

Section 5(4)(a)

57. Section 5(4)(a) states:

“(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.”

58. Subsection (4A) of Section 5 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.”

59. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, 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 Borden* [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)."

60. 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:

- (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.”

The relevant date for Section 5(4)(a)

61. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), sitting 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.’ ”

62. The holder did not file any evidence in these proceedings. Hence, the only relevant date I need to consider is the priority date of the contested mark, which is 30 January 2024.

Goodwill

63. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

“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.”

64. As regards the proof of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of 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 than 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.”

65. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[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.”

66. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), 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.”

67. I can deal with this ground very briefly. I have set out the evidence of use above. In addition, I have concluded that the element ‘FLIP’ retains its own independent distinctiveness within the earlier marks and will be perceived as having its own trade mark significance. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous

to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).” (emphasis added)

68. Mr Wood’s main criticism in relation to goodwill was that there is no use of ‘FLIP’ *solus*. However, I think this criticism misses the point. I say this because I consider that use by the opponent of the independently distinctive sign ‘FLIP’ within the verbal element ‘FLIP BY SLUMBERLAND’ in both the word-only mark and the figurative mark, is sufficient to give rise to a moderate goodwill associated with that sign because it will be perceived as independently indicative of the goods in relation to which it has been used, namely mattresses. Although the case law I have cited relate to registered trade mark relied upon under Section 5(2) and 5(3), in my view the same principle applies to signs which are relied upon under Section 5(4)(a). Further, mattresses are either identical or similar to the goods for which the holder seeks protection, because they are all goods used for sleeping, having a similar purpose, targeting the same users and being sold through the same trade channels. In addition, the goods are complementary. In those circumstances, given the identity between the holder’s mark and the opponent sign ‘FLIP’, and the identity or similarity of the goods, misrepresentation and damage are inevitable – in any event Mr Wood accepted that if goodwill is established misrepresentation and damage will follow.

69. The opposition under Section 5(4)(a) is successful in its entirety.

OUTCOME

70. The opponent has been successful under both ground and, subject to any appeal of my decision, the holder’s mark will be refused protection in the UK.

COSTS

71. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £2,300, calculated as follows:

Preparing opposition and considering the counterstatement:	£300
Filing evidence:	£1,000
Preparing for and attending a hearing:	£800
Official fees:	£200
Total:	£2,300

72. I therefore order bett1.de GmbH to pay BensonsforBedsRetail Ltd the sum of £2,300. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of August 2026

TERESA PINTO
For the Registrar