

O-0817-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3532452

IN THE NAME OF LYNCH FURNISHINGS LTD

TO REGISTER

Snugglemore

AS A TRADE MARK IN CLASSES 20 & 24

AND

OPPOSITION THERETO (UNDER NO. 422545)

BY

JOHN COTTON GROUP LIMITED

BACKGROUND

1) On 11 September 2020, Lynch Furnishings Ltd ('the applicant') applied to register 'Snugglemore', as a trade mark, in respect of the following goods:

20: Pillows.

24: Curtains, table linen; blankets; bed throws; kitchen textiles; Duvets; mattress protectors; bed toppers.

2) The application was published in the Trade Marks Journal on 23 October 2020 and notice of opposition was later filed by John Cotton Group Limited ('the opponent'). The opponent claims that the trade mark application offends under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following European (EU) trade mark registration¹:

- **EUTM 399691**

SNUGGLEDOWN

Class 20: Furniture; pillows, bolsters and cushions (none being for surgical or curative purposes); mattresses (other than for childbirth purposes) and sleeping bags, all filled wholly or principally with down; beds and bedding (other than bed clothing); parts and fittings for all the aforesaid goods.

Class 22: Fibrous textile materials, artificial textile fibres, stuffing, padding and/or filling materials.

¹ Although the UK has left the European Union, the opponent may rely upon its EU trade mark in these proceedings because the applicant's mark was filed on 11 September 2020, which fell before 'IP Completion Day' (31 December 2020). For further information see Tribunal Practice Notice 2/2020 on the IPO website.

Class 24: Quilts, duvets, pillowcases, quilt covers and duvet covers; eiderdowns, bed covers, bed sheets, bed spreads, blankets, mattress covers, bed clothing (not for wear), towels; textile piece goods.

Filing date: 21 October 1996

Date of entry in register: 10 September 1998

4) It is claimed that the respective goods are identical or similar and that the respective marks are similar such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

5) It is also claimed that the earlier mark enjoys a reputation in the UK in respect of all the goods covered by the opponent's registration and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark.

6) The trade mark relied upon by the opponent under sections 5(2)(b) and 5(3) of the Act is an 'earlier mark', in accordance with section 6 of the Act (as it read before IP Completion Day²). Further, as it completed its registration procedure more than five years prior to the application date of the contested mark, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act.

7) Under section 5(4)(a) of the Act, the opponent relies upon use of the sign, SNUGGLEDOWN, which is said to have been used 'as early as 1950' throughout the UK in relation to 'Pillows, duvets and bedware'. It is claimed that use of the applicant's mark, in respect of the goods applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with its earlier sign.

² Prior to IP Completion Day, on the date the applicant's mark was filed, the relevant part of Section 6 of the Act read: 'In this Act an "earlier trade mark" means— (a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,...' (my emphasis)

8) The applicant filed a counterstatement. I note, in particular, the following statements made therein:

- The applicant does not put the opponent to proof of use of its earlier mark³.
- There is no evidence of confusion between the opponent's mark and the applicant's mark, despite the applicant having traded for the last 5 years.
- The respective businesses are quite different with a different offering.
- There are a number of other brands that contain the prefix 'SNUGGLE' such as 'SNUGGLEWARM' in class 20 and 'SNUGGLETOES' in class 24 which sell similar goods to the opponent.
- It is conceded that '...SNUGGLEDOWN has an excellent and longstanding reputation....
- The applicant denies, with explanation, the opponent's claims of damage under Section 5(3) and the claim of passing off under Section 5(4)(a).

9) The opponent is represented by Mathys & Squire LLP; the applicant is without legal representation. The opponent's evidence in chief consists of a witness statement in the name of Stephen Swalwell with 5 exhibits, and a witness statement in the name of Gary Johnston with 2 exhibits. That evidence was also accompanied by submissions⁴. The applicant's evidence consists of a witness statement in the name of Rita Lynch with 3 exhibits, and a witness statement in the name of Sean Jackson with 2 exhibits. The applicant also filed submissions⁵. I have read all the evidence and will refer to it when it is appropriate to do so. Neither party requested a hearing nor filed submissions in lieu. I now make this decision based upon all the papers before me.

DECISION

10) In the light of the applicant's comments in the counterstatement about the way in which both parties currently use their marks and the nature of their businesses, it is

³ As per Q7 of Form TM8 where, in answer to the question 'Do you want the opponent to provide "proof of use"?', the applicant ticked 'NO'.

⁴ Dated 26 August 2022

⁵ Dated 26 October 2022

necessary for me to explain what the correct approach is that I must take when assessing the similarity between the parties' goods and the overall likelihood of confusion.

11) The first point to make is that, as I noted earlier, the opponent is not required to provide 'proof of use'. The opponent is therefore entitled to rely upon all of the goods covered by its registration without having to show that it has actually used its mark in relation to any of those goods. The second point is that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's goods, as registered, and the applicant's goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods that those marks have been used in relation to thus far. Further, I must consider all of the circumstances in which the mark applied for might be used if it were registered⁶. This is because trade mark registrations are items of property which may be sold by the applicant and/or opponent to third parties in the future and may therefore be used in a different way, or upon/in relation to different goods, than those used by the current proprietors of those marks. Further, even if the trade marks are not sold to third parties, the applicant and/or opponent themselves may decide to change/adapt the way they market their goods in the future. In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

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

The actual goods which either party may currently be providing in the marketplace is therefore not relevant to my assessment of the likelihood of confusion under section 5(2)(b).

⁶ As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66]

Section 5(2)(b)

12) This section of the Act states:

“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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods

14) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

17) In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

18) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, where the GC held 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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

19) The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 20: Furniture; pillows, bolsters and cushions (none being for surgical or curative purposes); mattresses (other than for childbirth purposes) and sleeping bags, all filled wholly or principally with down; beds and bedding (other than bed clothing); parts and fittings for all the aforesaid goods.</p>	<p>20: Pillows. 24: Curtains, table linen; blankets; bed throws; kitchen textiles; Duvets; mattress protectors; bed toppers.</p>

Class 22: Fibrous textile materials, artificial textile fibres, stuffing, padding and/or filling materials.

Class 24: Quilts, duvets, pillowcases, quilt covers and duvet covers; eiderdowns, bed covers, bed sheets, bed spreads, blankets, mattress covers, bed clothing (not for wear), towels; textile piece goods.

20) I will begin by comparing the applicant's goods in class 20 with the opponent's goods before moving on to compare the applicant's goods in class 24 with the same.

Class 20

21) The applicant's 'pillows' are, self-evidently, identical to the opponent's 'pillows'.

Class 24

22) The applicant's 'duvets' and 'blankets' are, self-evidently, identical to the same goods in the opponent's specification.

23) The applicant's 'mattress protectors' are a kind of mattress cover. The former goods therefore fall within the opponent's 'mattress covers'. Those goods are, therefore, identical in accordance with the *Merit* case law set out above.

24) The applicant's 'bed throws' and 'bed toppers' fall within the opponent's 'bed clothing (not for wear)'. Those goods are therefore identical, as per *Merit*.

25) To my mind, the ordinary meaning of the applicant's 'kitchen textiles' is finished textile goods for use in the kitchen, such as tea towels. The opponent's specification includes 'towels', which covers 'tea towels'. The applicant's 'kitchen textiles' are therefore identical to the opponent's goods.

26) Turning to the applicant's 'curtains', I note that the opponent's specification includes 'duvet covers'. It seems to me that these represent the opponent's strongest case against 'curtains'. While their respective intended purpose and methods of use differ, the respective goods are likely to be made of the same materials and share trade channels. Indeed, my own experience, as an average consumer of both parties' goods, tells me that both curtains and duvet covers may be sold as a co-ordinating set (for use in bedrooms) or at least be sold in close proximity in retail stores. I find a medium degree of similarity between the opponent's 'duvet covers' and the applicant's 'curtains'.

27) That leaves the applicant's 'table linen'. The opponent submits, without any explanation, that those goods are identical, or similar, to its 'textile piece goods'. The applicant disputes this. It submits that the term 'textile piece goods' refers to fabric meterage sold on rolls or smaller cut lengths from rolls. The applicant has filed no evidence in support of this contention but, it does, in any event accord with my own view of the ordinary and natural meaning of that term. The opponent's 'textile piece goods' does not, therefore, cover what I would describe as 'finished articles' made from textiles but, rather, covers pieces of textile material which may be sold by the metre or in pre-cut dimensions. The applicant's 'table linen' refers, in my view, to finished articles (table cloths, napkins and the like) which are, therefore, not identical to the opponent's 'textile piece goods'. That leaves the question of whether there is, nevertheless, similarity between the respective goods. The applicant's 'table linen' and the opponent's 'textile piece goods' are both made from textiles and they may sometimes share trade channels. However, their respective nature is, otherwise, different. Their methods of use and intended purpose are also different. However, there may be a limited degree of competition between them with a consumer choosing between purchasing finished items of table linen or buying textile piece goods to make their own. Bearing all of this in mind, I find a low degree of similarity between the applicant's 'table linen' and the opponent's 'textile piece goods'.

Average consumer and the purchasing process

28) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29) The average consumer for the goods at issue is the general public. The average consumer is likely to take into consideration various factors when selecting the goods, such as the kind of material from which the goods are made and/or their type of filling (feather or man-made filled duvets and pillows, for example), their softness/plumpness, warmth/tog rating, dimensions and/or aesthetic appeal. On the whole, I find that a medium degree of attention is likely to be paid during the purchase for all of the goods. They are all likely to be sought out primarily by eye on websites or shelves in physical stores and so I would expect the purchase to be mainly visual. However, I bear in mind that the goods may sometimes be the subject of discussions with sale representatives, for example, and therefore aural considerations are also borne in mind.

Distinctive character of the earlier mark

30) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). 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).”

31) The earlier mark is ‘SNUGGLEDOWN’ (word only). I would expect the mark to be immediately recognised, by the average consumer, as a conjoining of the two well-known English words, ‘SNUGGLE’ and ‘DOWN’. Mr Johnston provides a dictionary definition of the word ‘SNUGGLE’. That definition states: ‘To move yourself into a warm and comfortable position, especially one in which your body is against another person or covered by something’⁷. I have no doubt that the average consumer will be aware of that meaning. Bearing this in mind, I find that the earlier mark, as a whole, immediately brings to mind the concept of snuggling down into something for comfort and warmth. In the context of the opponent’s duvets, blankets,

⁷ Exhibit GJ2

pillows, bed clothes (not for wear), duvet covers and mattress covers, that is not a particularly distinctive concept, owing to the allusive message that it sends as regards the intended purpose and method of use of such goods. Bearing this in mind, together with the lack of any other embellishments or stylisation present in the mark which may have served to elevate its distinctiveness, I find that the inherent distinctiveness of 'SNUGGLEDOWN' (and the word 'SNUGGLE' *per se*) in relation to the aforementioned earlier goods, is low. I also find that its distinctiveness is fairly low in relation to 'towels' and 'textile piece goods', given that those goods may also be purchased, to some extent, on the basis of their comfort and/or warmth.

32) I now turn to consider the evidence of use which has been filed by the opponent. This comes from Mr Swalwell who identifies himself as the Group Company Secretary of the opponent. The most relevant information in Mr Swalwell's evidence is, as follows:

- The opponent is a manufacturer and wholesaler of pillows, duvets, mattress protectors and related soft furnishings which are distributed throughout the UK and Europe. 'Current' prints are provided from the opponent's website, www.johncotton.co.uk, which are said to show the 'commercial interests' of the opponent. The prints provide detail about various awards won by the opponent's company, the number of pillows and duvets produced every year (20 million and 10 million, respectively) and the various brands provided by the opponent, including 'snuggledown (plus device)', 'slumberdown (plus device)' and others.⁸
- A print from the opponent's website, www.snuggledown.co.uk, from June 2000, is provided which is said to show that the opponent's 'Snuggledown' products have been available and promoted in the UK for at least the last twenty years. The print consists of a single page entitled 'The Snuggledown story'. The page refers to the opponent providing 'quality' duvets and pillows⁹.
- 'Snuggledown' products are said to be sold through licensed retail outlets and independent retailer stockists in the UK. Some of those include 'major' retailers such as TK Maxx, Costco, Next and Debenhams, who sell the

⁸ Exhibit SS1

⁹ Exhibit SS2

opponent's pillows under the earlier mark. Prints from the websites of those 'major' retailers are provided which are said to show the opponent's 'Snuggledown' goods. The prints are dated 25 November 2020 and show various pillows, duvets and mattress toppers being advertised for sale under the name 'Snuggledown' and the goods themselves all bear 'Snuggledown (plus device)'¹⁰.

- Prints from Amazon.co.uk are provided which are said to show customer reviews dating back to 2007 for 'Snuggledown' goods. The exhibit shows five reviews from the UK for 'Snuggledown' products. They are dated March 2011 (pillow), November 2019 (duvet), August 2018 (mattress topper), June 2020 (mattress topper) and April 2007 (Orthopaedic pillow)¹¹.
- It is said that the opponent's sales for 'Snuggledown' products have been in excess of £35 million since 2016. The following tables are provided showing a breakdown of that figure¹²:

**Snuggledown Branded Sales Value
Last five years**

Year	Value
2016	£5,976,675
2017	£8,508,514
2018	£7,111,761
2019	£6,478,332
2020	£7,242,628
Total	£35,317,911

Customers
T K Maxx
Costco
Next
Debenhams
Waitrose
AIS & Independents

¹⁰ Exhibit SS3

¹¹ Exhibit SS4

¹² Exhibit SS5

33) I accept that the opponent has used the earlier mark prior to the relevant date and, it would seem, for some considerable time before that date in relation to duvets, pillows and mattress covers. The applicant's comments in the counterstatement also suggest that it accepts this to be the case. As to the scale of that use, the sales figures between 2016 and 2020 appear to be consistently substantial. However, I bear in mind that the market for the relevant goods is likely to be large and I have not been provided with any indication of the market share which is held by the earlier mark in that market. Furthermore, there is no evidence before me of any significant promotion of the earlier mark. Nevertheless, considering the evidence before me in the round, I find that the earlier mark's inherent distinctiveness is likely to have been enhanced to a medium degree by the relevant date in relation to duvets, pillows and mattress covers. I make this finding despite much of the use showing the mark used together with a device element. That use is sufficient, in my view, to have enhanced the distinctiveness of the word 'SNUGGLEDOWN' *per se*. There is no evidence showing use in relation to any of the other goods relied upon and the mark therefore remains of a low/fairly low degree of distinctiveness in relation to those.

Comparison of marks

34) 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 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.”

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

35) The marks to be compared are:

Opponent's marks	Applicant's mark
SNUGGLEDOWN	Snugglemore

I have already said that the earlier mark will be recognised, immediately, as consisting of the two well-known words, 'SNUGGLE' and 'DOWN', conjoined. The contested mark is likely to be recognised, immediately, as the two words 'Snuggle' and 'more', conjoined. Both parties' marks will be read through instantly as a unit, with no word dominating the other.

36) Dealing first with the visual comparison between the marks, the first point to make is that both marks are word-only marks which protect the word itself. Both marks may, therefore, notionally be used in upper, lower, title case or any other standard case. The opponent submits that the marks are visually highly similar. It points out that both marks consist of the common prefix, 'SNUGGLE', both marks are also eleven letters in length overall and the ninth letter in the respective marks is the same ('O'). I agree that those points of coincidence combine to result in a strong degree of visual similarity between the marks overall; I consider them to be notably similar to the eye. Notwithstanding that the respective eighth, tenth and eleventh letters are different, I agree with the opponent that there is a high degree of visual similarity between the marks.

37) Aurally, the respective marks each consist of three syllables. The first and second syllables of the marks are clearly identical. The respective third syllables,

which will pronounced as 'D-OWN' and 'M-OAR', are different. I find a medium degree of aural similarity between the marks.

38) Turning to the conceptual position, I have already touched upon the conceptual meaning that will be grasped, immediately, from the earlier mark i.e. to snuggle down into something (for comfort and warmth). The immediate conceptual message that will be grasped from the contested mark is to snuggle more often/for longer. Overall, I find a medium degree of conceptual similarity between the marks, albeit that that concept is not a particularly distinctive one in the context of the relevant goods.

Likelihood of confusion

39) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

40) The applicant's evidence purports to show that there has been no confusion between the parties' marks even though there has been concurrent use of the respective marks since November 2016. However, in *Roger Maier and Another v ASOS*¹³, Kitchen L.J. stated that:

'80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a

¹³ [2015] EWCA Civ 220

likelihood of confusion. But conversely, the absence of actual confusion despite side-by-side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.’

The evidence of Ms Lynch and Mr Jackson falls far short of satisfying me that the respective marks at issue have been used side-by-side, and on such a scale, so as to show that there is no likelihood of confusion. Firstly, the applicant’s sales figures for the period prior to the relevant date (being the filing date of its mark) are very small and are also not broken down by type of goods¹⁴. Secondly, Mr Jackson’s evidence indicates that the contested mark is used together with a device element (of a stylised representation of a pillow)¹⁵; that is not the mark which has been applied for. The mark applied for is the plain word, Snugglemore. The use of the contested mark with such a device may have been a factor in making confusion less likely. Thirdly, Ms Lynch states that the applicant has not, and has no intention of, providing its goods through the same retailers as the opponent’s goods. If the parties have not provided their goods through the same/similar outlets, this clearly does not show that the average consumer has been exposed to both marks in the same outlets and been able to distinguish between them. Finally, it must be borne in mind that confusion will not usually come to light if the deception is complete and/or customers have no reason to complain about the goods. It cannot therefore be ruled out that there has been some low level of confusion. For all of these reasons, the applicant’s evidence does not assist it.

41) The applicant also draws attention, in its submissions, to a number of other marks which it says are on the register which contain the prefix, SNUGGLE, in classes 20 and/or 24. However, there is nothing before me to indicate that any of those marks are actually in use in the UK. Their mere presence on the register tells

¹⁴ Exhibit SJ1

¹⁵ Exhibit SJ2

me nothing about the situation in the marketplace and the average consumer's ability to differentiate between them. Having said that, I have already acknowledged that the term 'SNUGGLE' is lowly distinctive in relation to the goods at issue before me, given the strong allusive message that it sends, and I will bear that in mind in my assessment of the likelihood of confusion.

42) I have found that some of the respective goods are identical and others are similar to a medium or low degree. Further, the marks are visually highly similar and aurally and conceptually similar to a medium degree. The average consumer is the general public who are likely to pay a medium degree of attention during a mainly visual purchase. The earlier mark also has a medium degree of enhanced distinctiveness in relation to duvets, pillows and mattress covers but only a low/fairly low degree of inherent distinctiveness for the other relevant earlier goods. In this connection, I remind myself that the low/fairly low distinctiveness of the earlier mark as a whole and the low distinctiveness of the common prefix, 'SNUGGLE', does not, of itself, preclude a likelihood of confusion¹⁶. Furthermore, the test is whether a "sufficiently significant"¹⁷ proportion of relevant consumers are likely to be confused (it is not necessary that all relevant consumers be confused).

43) Bearing all of the above factors in mind, together with the interdependency principle, I find that the similarities between the marks (and particularly the high degree of visual similarity between them) is such that, notwithstanding the low distinctiveness of the 'SNUGGLE' prefix, and the low/fairly low degree of inherent distinctiveness of the earlier mark (as a whole) for certain of the earlier goods, there is likely to be a 'sufficiently significant' proportion of average consumers who misremember the endings of the marks, leading them to mistake one mark for the other where identical goods are concerned. I do not, however, consider that there is a likelihood of confusion (whether direct or indirect) in relation to the respective goods that are similar only to a medium or low degree, bearing in mind, also, that the earlier mark has no enhanced distinctiveness in relation to the relevant earlier goods in those circumstances. **The opposition under section 5(2)(b) of the Act**

¹⁶ *L'Oréal SA v OHIM*, Case C-235/05 P,

¹⁷ *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, [37]

succeeds against all of the contested goods, with the exception of ‘curtains’ and ‘table linen’.

Section 5(3)

44) Section 5(3) of the Act provides:

“(3) A trade mark which-

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

45) The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora* and *Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

46) The applicant concedes that the opponent has a 'longstanding and excellent reputation' under the earlier mark. It does not, however, specify the precise goods for which such a reputation is conceded. Bearing in mind this concession and the evidence before me, I proceed on the basis that the earlier mark had a reasonable reputation at the relevant date in relation to duvets, pillows and mattress covers. I find no reputation for any of the other goods relied upon.

Link

47) Whether the public will make the required mental 'link' between the contested mark and each of the earlier marks must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) The degree of similarity between the conflicting marks

I have already assessed this under section 5(2)(b). The marks are, visually, highly similar and aurally and conceptually similar to a medium degree.

ii) The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The contested 'pillows', 'duvets' and mattress protectors' are identical to the goods in which the earlier mark has a reputation.

The contested 'blankets', 'bed throws' and 'bed toppers' are highly similar to the opponent's duvets, pillows and mattress covers given the obvious shared intended purpose, methods of use, nature and that they are likely to share trade channels.

The contested 'kitchen textiles', 'curtains' and 'table linen' are not similar to the opponent's 'duvets', 'pillows' and 'mattress covers'. Although they may sometimes be made of the same/similar materials, their precise nature differs and so too does their respective intended purpose and method of use. I also cannot see any real competitive relationship in play, in the sense described in the case law, and neither are they in competition.

The relevant public is the general public.

iii) The strength of the earlier mark's reputation

The earlier mark had a reasonable reputation at the relevant date.

iv) The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The earlier mark has a low degree of inherent distinctiveness in relation to 'duvets' 'pillows' and 'mattress covers' which had been enhanced to a medium degree at the relevant date as a consequence of the use made of it.

v) Whether there is a likelihood of confusion

I have already found there to be a likelihood of confusion between the goods in which the opponent has a reputation and the contested 'duvets', 'pillows', mattress protectors'. I also consider there to be a likelihood of confusion between the opponent's relevant goods and the applicant's 'blankets', 'bed throws' and 'bed toppers' given the obvious high degree of similarity between the respective goods

and weighing that against all other relevant factors that have already been determined under section 5(2)(b). There is, however, no likelihood of confusion in respect of the contested 'curtains', 'kitchen textiles' and 'table linen' given the lack of similarity between those goods and the earlier goods in which the opponent enjoys a reputation.

Conclusions on link

48) Weighing all of the above factors, I do not consider that the opponent's mark would be brought to mind when faced with the contested mark on 'curtains', 'kitchen textiles' and 'table linen' bearing in mind, in particular, the dissimilarity between those goods and the opponent's 'duvets', 'pillows' and 'mattress covers'. The requisite link is therefore not established in relation to those contested goods. Without a link being made in respect of those goods, there can be no damage.

49) Turning to the position in relation to the contested goods for which I have found a likelihood of confusion, it is implicit in this finding that a link would be made between the respective marks. It logically follows that, if the average consumer is confused into purchasing the applicant's goods because they believe them to be those of the opponent, this constitutes an unfair advantage being gained by the applicant. Damage is therefore made out in respect of the contested 'pillows', 'blankets', 'bed throws', 'duvets', 'mattress protectors' and 'bed toppers'.

50) I add here that, in the event that I am found to be wrong to have found a likelihood of confusion in respect of the applicant's 'pillows', 'blankets', 'bed throws', 'duvets', 'mattress protectors' and 'bed toppers', I find that there would, in any event, be a link made between the respective marks in respect of those goods, bearing in mind the closeness of the respective goods, the similarity between the marks and the reasonable reputation enjoyed by the earlier marks for 'duvets', 'pillows' and 'mattress covers'. In my view, such a link with the earlier mark will cause the 'excellent'¹⁸ reputation enjoyed by the earlier mark to transfer to the applicant's mark causing the latter to become more attractive to the relevant public and give the

¹⁸ The applicant has conceded that the opponent's mark has an 'excellent' reputation.

applicant more custom than it otherwise would have enjoyed and make its job of marketing its goods easier. As this would come without paying any compensation to the opponent, and without the applicant expending the money necessary to create a market for its own goods in the UK, I find that this constitutes unfair advantage.

51) The opposition under section 5(3) of the Act succeeds against all of the contested goods, with the exception of ‘curtains’, ‘kitchen textiles’ and ‘table linen’.

Section 5(4)(a)

52) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b) [.....]

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

53) The opponent relies upon use of the sign, ‘SNUGGLEDOWN’, under this ground in relation to ‘pillows, duvets and bedware’. That sign is identical to its registered mark which is relied upon under section 5(2)(b). Bearing in mind that the evidence before me only shows use on pillows, duvets and mattress covers (and no other ‘bedware’), the opponent is clearly in no better position under this ground than under section 5(2)(b). I therefore decline to deal with this ground because it obviously offers the opponent no stronger prospect of success.

OVERALL OUTCOME

54) The opposition succeeds against all of the contested goods with the exception of 'curtains' and 'table linen'.

COSTS

55) The opponent has had a greater degree of success than the applicant. I estimate the ratio of success to be roughly 80%:20% in the opponent's favour. Using the guidance in Tribunal Practice Notice 2/2016, but allowing for the applicant's degree of success, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Official fee (Form TM7)	£200
Preparing and filing evidence and considering the applicant's evidence	£500
Filing written submissions	£300
Total:	£1300 x 0.8
Overall total:	£1,040

56) I order Lynch Furnishings Ltd to pay John Cotton Group Limited the sum of **£1,040**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of August 2023

**Beverley Hedley
For the Registrar,
the Comptroller-General**