O/0979/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003680199
BY NANTONG HEDIAN TRADING CO., LTD.
TO REGISTER:

Dr.sleep

AS A TRADE MARK
IN CLASS 24

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 430129
BY COMFASLEEP LTD

BACKGROUND AND PLEADINGS

1. Nantong Hedian Trading Co., Ltd. ("the applicant'") applied to register the trade mark shown on the cover page of this decision in the UK on 11 August 2021. The application was accepted and published in the Trade Marks Journal on 15 October 2021 in respect of the following goods:

> **Class 24:** *Duvet covers; quilt covers; mosquito nets; non-woven textile fabrics; bed linen; bed linen and table linen; mattress covers; bed throws; bed covers; covers for cushions; bed clothes; household linen; sleeping bag liners; indoor and outdoor curtains; blankets for household pets; cloth; bed linen and blankets; felt; bath linen, except clothing; quilts.*

2. On 12 January 2022, Comfasleep Ltd ("the opponent") filed a notice of opposition on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at the applicant's mark in its entirety. The opponent relies on the following series of two trade marks:

> Sleep Doctor
>
> Sleep Dr
>
> UK registration no. 3373787
> Filing date 8 February 2019; date of entry in register 3 May 2019
> Relying on the following goods:
>
> **Class 20:** *Bath pillows; bed bases; bed chairs; accent pillows; adjustable beds; air bed lounger; air beds, not for medical purposes; air cushions; air cushions in the nature of furniture [not for medical purposes]; air cushions, not for medical purposes; air mattresses; air mattresses for use when camping; air mattresses, not for medical purposes; air pillows, not for medical purposes; bamboo pillows; massage divans; massage tables; maternity pillows; mattress bases; mattress*

cushions; mattress pads; mattress (straw -); mattress toppers; mattresses; mattresses made of flexible wood; mattresses [other than child birth mattresses]; mattresses (spring -); scented pillows; sleeping bag pads; sleeping baskets, non-metallic, for domestic animals; sleeping mats; sleeping mats for camping [mattresses]; sleeping pads; sofa beds; sofas; soft furnishings [cushions]; accent pillows; air mattresses; air mattresses for use when camping; air mattresses, not for medical purposes; air pillows; air pillows, not for medical purposes; maternity pillows; mats for infant playpens; mattress bases; mattress cushions; mattress pads; mattress (straw -); mattress toppers; mattresses; mattresses made of flexible wood; mattresses [other than child birth mattresses]; mattresses (spring -); pillowforms; pillows; sleeping mats; sleeping mats for camping [mattresses]; sleeping pads.

("the opponent's registration")

3. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to its own mark and the respective goods are identical or similar. The applicant filed a defence and counterstatement denying the claims made.

4. The opponent represents itself; the applicant is represented by CEJR. Neither party filed evidence or submissions. No hearing was requested. No submissions in lieu were filed by either party. This decision is taken following a careful consideration of the papers.

RELEVANCE OF EU CASE LAW

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

SECTION 5(2)(B): LEGISLATION AND CASE LAW

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

> "(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 or association with the earlier trade mark."

7. Section 5A of the Act is as follows:

> "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."

8. Given its filing date, the opponent's registration qualifies as an earlier trade mark pursuant to section 6 of the Act. The opponent's registration did not complete its registration process more than five years before the application date of the applicant's mark. The condition of use, therefore, does not apply to the registration. Therefore, the opponent can rely on all the goods in its registration.

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 THE GOODS

10. The goods to be compared are as follows:

The applicant's goods	**The opponent's goods**
Class 24 *Duvet covers; quilt covers; mosquito nets; non-woven textile fabrics; bed linen; bed linen and table linen; mattress covers; bed throws; bed covers; covers for cushions; bed clothes; household linen; sleeping bag liners; indoor and outdoor curtains; blankets for household pets; cloth; bed linen and blankets; felt; bath linen, except clothing; quilts.*	Class 20 *Bath pillows; Bed bases; Bed chairs; Accent pillows; Adjustable beds; Air bed lounger; Air beds, not for medical purposes; Air cushions; Air cushions in the nature of furniture [not for medical purposes]; Air cushions, not for medical purposes; Air mattresses; Air mattresses for use when camping; Air mattresses, not for medical purposes; Air pillows, not for medical purposes; Bamboo pillows; Massage divans; Massage tables; Maternity pillows; Mattress bases; Mattress cushions; Mattress pads; Mattress (Straw -); Mattress toppers; Mattresses; Mattresses made of flexible wood; Mattresses [other than child birth mattresses]; Mattresses (Spring -); Scented pillows; Sleeping bag pads; Sleeping baskets, non-metallic, for domestic animals; Sleeping mats; Sleeping mats for camping [mattresses];*

	Sleeping pads; Sofa beds; Sofas; Soft furnishings [cushions]; Accent pillows; Air mattresses; Air mattresses for use when camping; Air mattresses, not for medical purposes; Air pillows; Air pillows, not for medical purposes; Maternity pillows; Mats for infant playpens; Mattress bases; Mattress cushions; Mattress pads; Mattress (Straw -); Mattress toppers; Mattresses; Mattresses made of flexible wood; Mattresses [other than child birth mattresses]; Mattresses (Spring -); Pillowforms; Pillows; Sleeping mats; Sleeping mats for camping [mattresses]; Sleeping pads.

11. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon,* Case C-39/97, the court stated at paragraph 23 that:

> "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."

12. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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

13. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that "complementary" means:

> "… 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 the responsibility for those goods lies with the same undertaking."

14. It is permissible to group goods together for the purpose of comparison where they are *"sufficiently comparable for registration in essentially the same way for the same reasons";*[1] I deem this to be the case in respect of the following goods in the applicant's specification, which are all types of bed coverings: "*duvet covers", "quilt*

[1] *Separode* Trade Mark, BL O/399/10, paragraph 5

covers", "bed linen", "bed covers", "bed linen and blankets", "bed throws", "bed linen[…]", "bed clothes", "mattress covers", "quilts" and *"household linen".*

15. I consider that these goods are similar to *"pillows"* in the opponent's specification. The applicant's goods are all used to make a bed comfortable so that a person can sleep in it, therefore, I consider that both parties' goods overlap in purpose. In addition, the goods will overlap in users and trade channels. They will also coincide in physical nature, as all of the goods will be made from textiles. I do not consider that the goods are in competition but there may be some complementarity between some of the goods, such as bed clothes and the opponent's goods. I consider the goods to be similar to a medium degree.

16. I compared *"non-woven textile fabrics", "cloth"* and *"felt"* in the applicant's specification to the closest clash that I was able to identify in the opponent's specification, being *"pillows"*. Whilst I recognise that the applicant's goods are materials that can be used in the production of pillows, I bear in mind that *"the mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar".*[2] This is because, in particular, their nature, intended purpose and the customers for those goods may be completely different.[3] In the present case, I do not consider that the goods will overlap in nature, intended purpose or users, nor in trade channels. I do not consider that the goods are in competition, nor are they complementary. Taking this into account, I consider the goods to be dissimilar.

17. I find that *"covers for cushions"* in the applicant's specification is similar to *"soft furnishings [cushions]"* in the opponent's specification. A cushion cover is used to protect the cushion from wear and tear, but it may also have a decorative function. I consider that the goods will share the same users and trade channels. The goods may overlap in physical nature, as the cushions are likely to have a fabric outer part in which the cushion filling is inserted. I consider that there may be a level of competition between the goods, as average consumers may chose to purchase a cushion that is

[2] *Les editions* Albert Rene v OHIM, Case T-336/03, paragraph 61
[3] *Ibid*

complete with an internal filled cushion and decorative cover or may purchase a cushion cover to go over an existing cushion. I also consider that they are complementary. Taking all the above into account, I find them to be similar to a high degree.

18. I consider that *"sleeping bag liners"* in the applicant's specification and *"sleeping bag pads"* in the opponent's specification are similar. A sleeping bag liner is used to line sleeping bags, in order to keep a sleeping bag clean and for extra warmth. A sleeping bag pad provides insulation and cushioning for sleeping outdoors. The goods will share the same users and trade channels. I consider that there will be some overlap in purpose as the opponent's goods provide insulation and the applicant's goods also provide extra warmth. I do not consider that the nature of the goods will overlap. I do not consider that the goods are in competition. I do not consider that the goods are complementary; this is on the basis that whilst customers may be of the view that the responsibility for the goods lies with the same undertaking, I do not consider the connection is so close that they are indispensable/important for the use of the other. I consider the goods to be similar to a medium degree.

19. I have been unable to find any similarity between *"indoor and outdoor curtains", "[…] table linen"* and "*mosquito nets"* in the applicant's specification and any of the opponent's goods. Therefore, I find these goods to be dissimilar.

20. I consider that "*blankets for household pets"* in the applicant's specification are similar to "s*leeping baskets, non-metallic, for domestic animals"* in the opponent's specification. Both parties' goods can be used to make domestic animals comfortable whilst sleeping, therefore, I consider that there is an overlap in purpose. However, the nature of the goods will differ. I consider that the goods will be sold in the same pet-oriented stores and, therefore, will share the same trade channels. I also consider that they will overlap in users. I consider that there may be an element of competition, as a pet blanket may be placed on an armchair, sofa or even within a car. However, I am not of the view that the goods are complementary because one is not sufficiently important for the use of the other. Taking this into account, I consider the goods to be similar to a medium degree.

21. The final term to consider in the applicant's specification is *"bath linen, except clothing".* I am of the view that these goods are similar to *"bath pillows"* in the opponent's specification. Bath linen will include goods such as towels and flannels. A bath pillow will be inflatable or made of material that is compatible with the wet environment in which it will be used. The goods differ in purpose and nature and are not in competition or complementary. However, I consider that the goods will be sold in the same stores and will overlap in users. I find the goods to be similar to a low degree.

22. When there is no similarity between the goods, there is no likelihood of confusion to be considered.[4] Therefore, the opposition fails in relation to the following goods that I have found to be dissimilar:

> **Class 24**: *non-woven textile fabrics; cloth; felt; indoor and outdoor curtains; mosquito nets; […]table linen.*

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

23. In Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

[4] *eSure Insurance Limited v Direct Line Insurance Plc,* [2008] EWCA Civ 842 CA, paragraph 49

24. I consider that the average consumer is a member of the general public. They will purchase the goods through specialist retailers, either in store or online, or in general department stores. The goods will be purchased relatively frequently and vary in price. The average consumer is likely to consider factors such as aesthetics and quality, as well as reviews.

25. I consider that the purchasing process will be largely visual. The average consumer will see items in store or online and may also have seen advertisements on television, newspapers and magazines, social media and the internet. However, the average consumer may also discuss their purchases with sales staff. Therefore, I do not discount that there will be an aural component to purchase the goods, given that advice may be sought from retail assistants. In my view, the average consumer will pay a medium degree of attention when purchasing the goods.

COMPARISON OF THE MARKS

26. 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 in *Bimbo* that:

> "it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."

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

28. The respective marks are shown below:

Applicant's mark	**Opponent's registration**
Dr.sleep	Sleep Doctor Sleep Dr

29. The opponent's registration consists of a series of two marks as shown above. The first mark in the series comprises of two words 'Sleep Doctor', while the second mark consists of the two words 'Sleep Dr'. Both marks are presented in title case, in a standard font without any other elements to contribute to the overall impression.

30. I consider that the mark 'Sleep Dr' in the opponent's registration is the best case for the opponent out of both marks. Consequently, I will proceed on the basis of the 'Sleep Dr' mark in the decision. If necessary. I will address the other mark in the series later in my decision.

31. The applicant's mark consists of two conjoined elements, where the full stop creates a natural break between 'Dr' and 'sleep', which would lead the average consumer to perceive the mark as comprising of two separate words. The mark is presented in a standard font without any other elements that contribute to the overall impression.

32. Visually, both marks contain the exact 7 letters, presented in a different order in each of the marks. The applicant's mark is ‘Dr. sleep’, while the opponent’s mark is ‘Sleep Dr’. This can be further compared as being the same two words, presented in reverse order. In view of the same shared letters and the two words that they form contained within each of the marks the marks are visually highly similar, notwithstanding the reversal of word order and the small differences of the full stop and lower case “s” in the applicant’s mark.

33. The full stop in the applicant's mark creates a natural break between the words; both parties’ marks will be spoken as separate words, ‘Dr.sleep’ and ‘Sleep Dr’ respectively. The words ‘Dr’ (doctor) and ‘Sleep’ would be pronounced identically in each of the respective marks, but in a reversed order. In my view, the marks are aurally similar to a medium degree

34. Conceptually, both the words ‘Dr’ – as a standard, familiar abbreviation for Doctor and ‘Sleep’ in the parties’ marks are words that can be found in any recognised English dictionary. I do not consider that the full stop will add anything conceptually. To my mind, both marks strongly allude to a doctor who specialises in sleep disorders. Consequently, I consider that the marks convey the same message and are therefore conceptually identical. Alternatively, if the reversed order means that the applicant’s mark means that the Dr will be perceived as a professional title, the marks are anyway conceptually highly similar based on the content of the two shared words.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

35. 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 1-2779, 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)."

36. Registered trade marks possess varying 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 a high inherent distinctive character, such as invented words which have no allusive qualities.

37. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use and has not filed evidence to support such a claim. I have, therefore, only the inherent position of the earlier mark to consider.

38. The earlier mark consists of the word 'Sleep Dr'. It is my view that the terms will be perceived as allusive in relation to the goods upon which they will be displayed, as they are goods involved in sleep. Consequently, I find the marks to have a degree of inherent distinctive character that is lower than medium but not low.

LIKELIHOOD OF CONFUSION

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment of all the relevant interdependent factors, including that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and services and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. I have found the marks to be visually similar to a high degree, aurally similar to a medium degree and conceptually at least highly similar. I have found the opponent's registration to have a degree of inherent distinctive character that is not low, but lower than medium. I have found the average consumer to be the general public, I have found that the goods are likely to be selected visually, although I do not discount an aural component. I have concluded that the degree of attention paid during the purchasing process for the goods will be medium. I have found the goods at issue to vary in similarity from between low to high degree.

41. It is settled case law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. In this present case, the relevant public would be likely to recall the words 'DR' and 'SLEEP', but, as a result of imperfect recollection, be less certain about the order of those words. Keeping in mind the global assessment of the competing factors in my decision, and in particular the high degree of conceptual similarity of the marks, I find that there is a likelihood of direct confusion for all of the those goods

where there was considered to be similarity. Given that the opposition has been wholly successful under this ground and the other mark in the opponent's registration does not put the opponent in any better position, I will not consider it further.

CONCLUSION

42. The opposition has succeeded for the following goods which will be refused:

> **Class 24**: *Duvet covers; quilt covers; bed linen; bed linen[…]; mattress covers; bed throws; bed covers; covers for cushions; bed clothes; household linen; sleeping bag liners; blankets for household pets; bed linen and blankets; bath linen, except clothing; quilts.*

43. The opposition has failed for the following goods which will proceed to registration:

> **Class 24:** *non-woven textile fabrics; cloth; felt; indoor and outdoor curtains; mosquito nets; […] table linen.*

COSTS

44. The opponent has enjoyed the greater degree of success overall and is entitled to an award of costs. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited it to indicate whether it intended to make a request for an award of costs. The opponent was informed that, if so, it should complete a Pro Forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the opposition. The opponent was informed that *" if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".*

45. The opponent did not file a completed Pro Forma. That being the case I award the opponent the sum of £100 in respect of the official fee only.

Official fee	£100
Total	**£100**

46. I, therefore, order Nantong Hedian Trading Co., Ltd. to pay Comfasleep Ltd the sum of £100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 19th day of October 2023

A Klass
For the Registrar

the Comptroller-General