O/1127/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3723506
IN THE NAME OF ONCE UPON A DUA LTD
TO REGISTER AS A TRADE MARK

Dream Big Make Dua Move Mountains

IN CLASSES 16, 20, 21, 24,
25, 27 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 431686
BY DREAMS LIMITED

BACKGROUND AND PLEADINGS

1. On 19 November 2021, Once Upon A Dua Ltd[1] ("the applicant") applied to register trade mark number UK3723506 for the mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 10 December 2021, in respect of goods in classes 16, 20, 21, 24, 25, 27 and 28.

2. The application is opposed by Dreams Limited ("the opponent"). The opposition was filed on 8 March 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in class 24 of the application only, being "*Baby blankets*".[2] The opponent relies upon the following four marks:

DREAMS
UK trade mark registration number 917963494
Filing date: 1 October 2018
Registration date: 15 February 2019
Registered in classes 3, 9, 10, 11, 14, 20, 21, 24, 35, 38 and 42
Relying on all goods and services in classes 20, 24 and 35 only.
(the '494 mark); and

DREAM COACH
UK trade mark registration number 918169119
Filing date: 19 December 2019
Registration date: 22 May 2020
Relying on all goods and services as registered, in classes 20, 24 and 35.
(the '119 mark); and

[1] I note that form TM21A was received on 16 May 2022, requesting the recordal of a change of the applicant's company name from "No Ordinary Souk Ltd" to "Once Upon A Dua Ltd". The new details have been recorded accordingly in these proceedings.
[2] The opposition was originally filed against all goods in classes 20 and 24, however, in an email sent on 18 July 2023, attaching the opponent's submissions in lieu of a hearing, the opponent confirmed that the opposition against the class 20 goods had been withdrawn, and that it wished to proceed against the class 24 goods of the application only.

DREAM BIGGER

UK trade mark registration number 3453941

Filing date: 24 December 2019

Registration date: 20 March 2020

Relying on all goods and services as registered, in classes 20, 24 and 35.

(the '941 mark); and

UK trade mark registration number 918191994

Filing date: 4 February 2020

Registration date: 24 June 2020

Relying on all goods and services as registered, in classes 20, 24 and 35.

(the '994 mark).

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's '494 mark, its '119 mark and its '994 mark were each converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[3]

4. Each of the marks relied upon by the opponent qualifies as an earlier mark under section 6(1) of the Act. As none of the marks had completed the registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

[3] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

5. The opponent submits that the contested mark is highly similar to the opponent's earlier marks. It submits that the "DREAM" element of the application mark is identically reproduced within the opponent's marks and that the additional words within the application mark are insufficient to distinguish the marks as a whole. It further submits that the competing goods are identical, or at least highly similar. It submits that there is a risk of confusion and/or association between the marks such that the application should be refused pursuant to section 5(2)(b) of the Act, and requests an award of costs in the opponent's favour.

6. The applicant filed a counterstatement denying the claims. It submits that the marks are dissimilar, and that the goods at issue are dissimilar, and that there is no risk of either confusion or association between the respective marks. It submits that the application should be allowed to proceed to registration.

7. Subsequent to the filing of the counterstatement, a preliminary indication was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008. That indication was that the opposition would fail. The opponent gave notice that it nevertheless wished to proceed to evidence rounds.[4] The preliminary indication, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision.

8. Only the applicant filed evidence. Only the opponent filed written submissions in lieu of a hearing which will be referred to as and where appropriate during this decision. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

9. In these proceedings, the opponent is represented by Lane IP Limited and the applicant is unrepresented.

EVIDENCE

[4] As per form TM53, filed on 7 July 2022.

10. The applicant filed evidence in support of the defence in the form of the witness statement of Mohammed Ashrafuz Zaman, dated 8 February 2023, which is accompanied by three exhibits, labelled OUAD1 – OUAD3. Mr Zaman is the director of the applicant company, a position he has held since 2021.

11. I have taken the evidence into account in reaching my decision and I will refer to the relevant material as necessary throughout the decision.

DECISION

12. Although the UK has left the European Union, 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. Therefore, this decision contains references to the trade mark case-law of the European courts.

My approach

13. The applied-for mark is a word mark. I note that in its written submissions in lieu of a hearing, the opponent identifies the earlier '941 mark, "DREAM BIGGER", which is also a word mark, as its best case from a visual perspective. It also submits that aurally, there is an additional phonetic similarity, as well as an additional layer of conceptual similarity, between the contested mark and the '941 mark. As such, it submits that overall, there is a heightened degree of similarity between the '941 mark and the contested mark.[5]

14. I further note that the specification of the goods and services relied on are identical in the '119 mark, the '941 mark, and the '994 mark, although the specification differs slightly under the '494 mark, which contains additional/different terms in classes 24 and 35.

[5] See paragraphs 19, 24, 30 and 36 of the opponent's written submissions in lieu, dated 18 July 2023.

15. Given the opponent's submissions, and the identical specifications in three of the four marks relied upon, I do not consider that assessing the opponent's '119 mark or the composite word and device '994 mark would improve the opponent's position. I will therefore proceed by making my comparisons in relation to the earlier '494 mark and '941 mark only. I will return to consider the position in respect of the remaining earlier marks should I consider it necessary to do so.

Section 5(2)(b)

16. Section 5(2)(b) is relied on and 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".

17. Section 5A states:

> "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."

18. I am guided by the following principles which 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 Office for Harmonisation in the*

Internal Market (Trade Marks and Designs) ("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 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 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 goods and services

19. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

20. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

"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 für 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".[6]

21. The opponent is relying on goods and services in classes 20, 24 and 35, as listed in Annex A of this decision. The opposed goods are "*Baby blankets*" in class 24.

[6] Paragraph 29

22. The identical term "*bed blankets*" is contained in the class 24 specification of both the earlier '494 mark and the '941 mark. I consider that the average consumer would construe the term "*blanket*" as a cover which is usually used on a bed. As such, the applicant's "*baby blankets*" are encompassed by the opponent's broad term "*bed blankets*", rendering them identical as per the guidance outlined in *Meric*. I also agree with the opponent that as "*baby blankets*" are textile goods, that under the *Meric* principle, they would also be covered by the wider term "*textiles*" for which both the '494 mark and the '941 mark enjoy protection, and are thus identical.

The average consumer and the nature of the purchasing act

23. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

24. The opponent submits that the goods at issue are relatively cheap everyday items, where the level of attention of the average consumer would be low.

25. The average consumer for the competing goods will be the general public, with the goods in common sold through a range of channels, including general retailers and their online equivalents. In bricks and mortar stores, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer, and a similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. The selection process will be a predominantly visual one, although aural considerations will play a part. Although I do not consider the goods to be everyday purchases, the cost is likely to be relatively low, although I recognise that this will vary, dependent on factors such as the material used, the size, the manufacturing process (i.e. handmade versus machine made) and the quality of the goods. Considered overall, I find that the level of attention paid during the selection of the goods to be to a medium degree.

Comparison of 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 SA v OHIM* Case C-591/12P, 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."[7]

27. 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.

28. The applicant's mark comprises the words "**Dream Big Make Dua Move Mountains**", presented in a standard typeface in sentence case, with no other elements to contribute to the overall impression.

29. The opponent's '494 mark consists of a single word, "**DREAMS**" presented in a standard typeface in capital letters, with no other elements to contribute to the overall impression; the earlier '941 mark comprises the words "**DREAM BIGGER**", also presented in a standard typeface in capital letters with no other elements to contribute to the overall impression.

[7] Paragraph 34

30. The overall impression of each mark therefore rests in the word or combination of words that make up the respective marks. I note that the registration of a word mark gives protection irrespective of capitalisation (see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17). In *dm-drogerie markt GmbH & Co. KG v OHIM,* Case T-304/10, the GC noted that in the case of word signs which are relatively short, the differences between marks of different lengths will be more easily grasped by the average consumer.[8] Meanwhile, in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I acknowledge that this is not always the case.

Visual comparison

31. The opponent directs me to *Medion AG v Thomson* Case C-120/04 (LIFE V THOMSON LIFE) and submits that the "DREAM" element plays an independent distinctive role within the overall marks.[9] The applicant's mark consists of six words, compared with only one word in the '494 mark and two words in the '941 mark, which contributes to a visual disparity between the marks. All three marks contain the word "DREAM" or the plural of the word, "DREAMS", which is positioned at the start of all three marks. The second word of the contested mark is the adjective "Big", while the second and final word of the '941 mark is the comparative adjective "BIGGER". Considering both the position of the word/s in common, as well as the length of the respective marks, I consider the contested mark and the '494 mark to be visually similar to a low degree, while it is visually similar to the earlier '941 mark to a low to medium degree.

Aural comparison

32. I would expect the applicant's mark to be articulated in its entirety as eight syllables, DREEM-BIG-MAKE-DOO-AH-MOOV-MOUN-TINS. The earlier '494 mark will be pronounced as one syllable, DREEMS, while the '941 mark will be voiced as three syllables, DREEM-BIG-UH. The common element to all three marks is therefore

[8] At [42].
[9] Opponent's written submissions in lieu, dated 18 July 2023, at [20].

the first syllable DREEM, albeit that the '494 mark is pluralised with the sibilant "s" sound at the end. The '941 mark also shares the same second syllable "BIG". Given that the remaining six syllables voiced in the applicant's mark are not present in either of the earlier marks, overall, I consider it to be aurally similar to the '494 mark to a low degree, while it is aurally similar the earlier '941 mark to a low to medium degree.

Conceptual comparison

33. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

> "… In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the Larousse dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it."[10]

34. The applicant has made no submissions regarding the message it considers its trade mark to convey. The opponent submits that as all three marks contain the word DREAM, the respective marks refers to the concept of a dream, irrespective of any additional elements of the contested mark.[11] It further submits that the "MAKE DUA" element of the contested mark is a well-known reference to Islamic religious practice/prayer, and would be given no trade mark significance by consumers.[12] Earlier in the decision, I found the average consumer for the goods at issue to be the general public. In *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08[13], Anna Carboni, sitting as Appointed Person, found that apart from terms which are too notorious to be the subject of serious dispute, it was not sufficient to assume a term as being commonly understood by the average consumer without evidence to support such a

[10] Paragraph 8.
[11] See the opponent's written submissions in lieu of a hearing, dated 18 July 2023, paragraph 28.
[12] Ibid, at [17].
[13] At [36 – 38].

finding. I consider the same in the case before me, and while I accept that there may be a proportion of consumers who recognise the meaning of the "MAKE DUA" element as referring to Islamic religious practice, the type of goods at issue are not targeted towards a particular niche market. Therefore, I do not consider that a significant proportion of the average consumer would automatically make any such link.

35. When taken in isolation, I consider that the average consumer will understand the "DREAM" element in each of the marks as referring to its normal and everyday meaning as per the definition provided by the opponent as being "*a series of thoughts, images, and sensations occurring in a person's mind during sleep*".[14] To my mind, the average consumer will perceive the earlier '494 mark in this way, or they may perceive it in the alternative as referring to daydreams, or to ambitions or goals which they hope to attain. Meanwhile, I consider that a significant proportion of consumers will interpret the opponent's '941 mark "DREAM BIGGER" in its entirety as motivational, imploring them to focus on a higher goal. I consider that the applicant's mark suggests the general idea that by having high aspirations, greater goals can be achieved. I find this regardless of whether or not the concept of "DUA" would be recognised.

36. While there is some overlap between the marks by way of the shared "DREAM" element, the overall message conveyed by the competing marks is not the same. Where the '494 mark is perceived as referring to a daydream, although it shares in common with the contested mark the idea of conscious thoughts, the concept conveyed by the contested mark of achieving greater goals through having bigger dreams is absent from the earlier mark. Overall, I find the marks to be conceptually similar to a low degree.

37. The earlier '941 mark "DREAM BIGGER" and the "Dream Big…" element of the contested mark share similar concepts of conscious thoughts/high aspirations, the word "bigger" being a comparative adjective of the word "big". However, the contested mark goes one step further, and suggests that more can be achieved through have such high expectations, and again, this idea is absent from the '941 mark. Therefore, I consider the marks to be conceptually similar to a medium degree.

[14] As footnote 10.

Distinctive character of the earlier marks

38. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

39. 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 *WindsurfingChiemsee* 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)."

40. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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. In its statement of grounds, the opponent submits that as a result of the use made of the opponent's marks for many years, they have an enhanced distinctive character in the United Kingdom. However, no evidence of use has been provided to support the submission. Therefore, I only have the inherent characteristics of the marks to consider. The opponent further submits that the marks are distinctive to at least a normal degree in relation to the goods covered.

The '494 mark

41. The mark is made up of the ordinary, dictionary defined word "DREAMS". While the word cannot be said to be descriptive of the goods at issue, being *bed blankets* and *textiles*, to a significant proportion of consumers, the word "DREAMS" is likely to be seen as allusive when considered within the context of such goods, given that blankets are used on beds, and beds being the place you are likely to have dreams. Consequently, I consider the mark to be at the lower end of the spectrum of inherent distinctive character, but not of the very lowest degree.

The '941 mark

42. Earlier in this decision, I found that the average consumer would interpret the mark "DREAM BIGGER" in its entirety as meaning to focus on a higher goal. As such, the mark is one step removed from the concept conveyed by the '494 mark as it is more likely to be seen as a conscious thought process rather than an involuntary action. Overall, I consider the mark to be inherently distinctive to a medium degree.

Likelihood of confusion

43. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. 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 and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

44. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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).”

45. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

46. Earlier in this decision, I found the contested goods to be identical to the opponent’s goods, as per the principle outlined in *Meric*. I considered the average consumer would be the general public who would pay a medium level of attention when selecting the goods. Those goods would be selected through predominantly visual means, although aural considerations would also play a part. I found the contested mark to be visually, aurally and conceptually similar to the ‘494 mark to a low degree; and visually and aurally similar to the ‘941 mark to a low to medium degree, while conceptually similar to a medium degree. I considered the earlier ‘494 mark to be at the lower end of the spectrum of inherent distinctive character, but not of the very lowest degree; I considered the earlier ‘941 mark to be inherently distinctive to a medium degree.

47. I cannot agree with the opponent that the “DREAM” element of the contested mark plays an independent, distinctive and dominant role within the mark as a whole. Although the word “DREAM(S)” is present in all three marks, in the contested mark in particular, it should not be interpreted in isolation. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, Arnold J. (as he was then) considered the impact of the CJEU’s judgment in *Bimbo,* Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*:

“…

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. **It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components**. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."[15]
(**My emphasis**).

48. I acknowledge the witness statement submitted by the applicant in which it claims that the parties' goods target different market audiences.[16] However, I must make my assessment based on how the goods might fairly be used now or in the future. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

"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."

49. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU confirmed that weak distinctive character of the earlier trade mark

[15] *Whyte and Mackay Limited v Origin Wine UK Limited and Dolce Co Investing* [2015] EWHC 1271 (Ch).
[16] See point 14 of the witness statement of Mohammed Ashrafuz Zaman, dated 8 February 2023.

does not preclude a likelihood of confusion.[17] In making my decision, I acknowledge the guidance of Emma Himsworth K.C., sitting as Appointed Person in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, Case O/0368/23, on the correct approach to assessing the likelihood of confusion where the common element is not considered to be high in distinctive character (at [44]).

50. Considering the visual nature of the selection process, and the medium level of attention paid by the average consumer, while bearing in mind 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, I consider it unlikely that they would mistake the contested mark for either of the earlier marks. To my mind, the average consumer will notice the differences between the marks. I therefore find that there is no likelihood of direct confusion.

51. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

52. The opponent submits that there is a risk of indirect confusion as the contested mark will be seen as logical sub-brands for its DREAMS/DREAM BIGGER for blankets.[18]

53. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

[17] Paragraph 45.
[18] Paragraph 49 of the opponent's written submissions in lieu of a hearing dated 18 July 2023.

> “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.”

54. With regard to the earlier ‘494 mark, keeping in mind the global assessment of the competing factors in my decision, and in particular the low degree of visual, aural and conceptual similarity between the marks, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive, however, I do not see anything which would lead the average consumer into believing that one mark is a sub-brand of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

55. Turning to the earlier ‘941 mark, I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, including the degree of visual, aural and conceptual similarity between them, as identified above, all of which play a part. Given the identity of the goods at issue, notwithstanding the medium degree of distinctive character of the earlier mark, I consider that a significant proportion of consumers would assume that the additional words in the contested mark represents either a sub-brand of the opponent’s “DREAM BIGGER” mark, or that there is an economic connection between the undertakings. I also consider that the difference between the words “DREAM BIGGER” and “DREAM BIG…”, may be imperfectly recalled, further contributing to indirect confusion between the marks. Overall, I find that there is a likelihood of indirect confusion.

CONCLUSION

56. The opposition under Section 5(2)(b) has been successful. Subject to any successful appeal, the application will be refused for the contested goods in class 24, being "*baby blankets*". I note that the class 24 specification contains no additional terms.

57. The application may proceed to registration for the remaining, unopposed goods, being classes 16, 20, 21, 25, 27 and 28 in their entirety.

COSTS

58. The opponent has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. Applying the guidance in that TPN, I award the opponent the sum of £700, which is calculated as follows:

Official fee:	£100
Preparing a statement and considering the counterstatement:	£200
Filing written submissions in lieu of a hearing:	£400
Total:	**£700**

59. I therefore order Once Upon A Dua Ltd to pay Dreams Limited the sum of £700. 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 27th day of November 2023

Suzanne Hitchings
For the Registrar,
the Comptroller-General

Annex A

Goods and services relied upon by the opponent under the '494 mark and the '941 mark

Class 20 (Identical in both the '494 mark and the '941 mark)
Furniture; bedroom furniture; mirrors; beds; water beds; divans; bedsteads; headboards; bedding, other than bed linen; pillows; mattresses; open spring and pocket spring mattresses; memory foam and latex mattresses; futons; air cushions and air pillows; air mattresses; bed casters not of metal; bed fittings not of metal; chairs; armchairs; cabinets; chests of drawers; desks; footstools; cots and cradles; parts and fittings for all the aforesaid goods.

Class 24 (The '494 mark)
Textiles; fabrics and textiles for beds and furniture; bed linen; duvets; bed covers; bed blankets, bed clothes; covers for duvets; mattress covers; covers for pillows and pillow cases; covers for cushions; bedspreads; covers for hot water bottles; furniture coverings of textile; quilts; parts and fittings for all the aforesaid goods.

Class 24 (The '941 mark)
Textiles; fabrics and textiles for beds and furniture; bed linen; duvets; bed covers; bed blankets, bed clothes; covers for duvets; mattress covers; covers for pillows and pillow cases; covers for cushions; bedspreads; furniture coverings of textile; quilts; parts and fittings for all the aforesaid goods.

Class 35 (The '494 mark)
Retail services relating to the sale of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated soaps, perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, scents, fragrances, oils for perfumes and scents, perfumeries, room scenting sprays, scented fabric refresher sprays, scented linen sprays, scented oils, scented room sprays, air fragrance preparations; Retail services relating to the sale of air fragrance reed diffusers, air fragrancing preparations, aromatics for fragrances, cleaning and fragrancing preparations, Cushions filled with fragrant substances,

cushions impregnated with fragrant substances, fragrance for household purposes, fragrance preparations, fragrance refills for non-electric room fragrance dispensers, fragrance sachets, refills for electric room fragrance dispensers, room fragrances, room fragrancing products; Retail services relating to the sale of Scientific, measuring, checking (supervision), life-saving and teaching apparatus and instruments, data processing equipment, computer software, computer hardware, mobiles apps, downloadable software applications, wearable monitors, monitoring instruments, monitoring apparatus, other than for medical purposes, monitoring units [electric], electronic sensors, bio-sensors, movement sensors; Retail services relating to the sale of sensors for scientific use to be worn by a human to gather human biometric data, electronic tracking apparatus and instruments, wearable activity trackers, measuring apparatus and instruments, computer software in the field of tracking, monitoring and analysing of sleep, movement and heart rate, electronic devices for tracking, monitoring and analysing of sleep, movement and heart rate [other than for medical use]; Retail services relating to the sale of mobiles apps in the field of tracking, monitoring and analysing of sleep, movement and heart rate, downloadable software applications in the field of tracking, monitoring and analysing of sleep, movement and heart rate; Retail services relating to the sale of medical and surgical apparatus and instruments, namely medical devices for sensing, measuring, diagnostic and treatment purposes in the field of sleep including wearable medical devices to be worn while sleeping, Pulse rate monitors, medical devices for measuring sleep, precision sensors for medical use, sensor apparatus for medical use; Retail services relating to the sale of apparatus for lighting, lighting, light bulbs, lamps and light sources, lighting connected to alarm clocks, luminaires, controllable light sources and lighting apparatus, filters for lighting appliances; Retail services relating to the sale of horological and chronometric instruments, clocks, alarm clocks, electronic alarm clocks, alarm clocks which use light to wake-up users, alarm clocks with in-built lights; Retail services relating to the sale of furniture, bedroom furniture, mirrors, beds, water beds, divans, bedsteads, headboards, bedding, pillows, mattresses, open spring and pocket spring mattresses, memory foam and latex mattresses, futons, air cushions and air pillows, air mattresses, sleeping bags, bed casters not of metal, bed fittings not of metal, chairs, armchairs, cabinets, chests of drawers, desks, footstools, cots and cradles; Retail services relating to the sale of household or kitchen utensils and containers, articles for cleaning purposes, scent sprays [atomizers], air fragrancing

apparatus, aerosol dispensers, not for medical purposes, perfume burners, perfume vaporizers, perfume sprayers, plug-in diffusers for mosquito repellents, plug-in diffusers for air fragrancing; Retail services relating to the sale of textiles, fabrics and textiles for beds and furniture, bed linen, duvets, bed covers, bed blankets, bed clothes, covers for duvets, mattress covers, covers for pillows and pillow cases, covers for cushions, bedspreads, covers for hot water bottles, pyjama cases, furniture coverings of textile, eiderdowns, quilts, parts and fittings for all the aforesaid goods; all the aforesaid provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order or catalogues or by means of telecommunications; information, advisory and consultancy services relating to all of the aforesaid.

Class 35 (The '941 mark)

Retail services connected with the sale of furniture, bedroom furniture, beds, water beds, sofa beds, divans, bedsteads, headboards, bedding, pillows, mattresses, open spring and pocket spring mattresses, memory foam and latex mattresses, futons, parts and fittings for all the aforesaid goods, all provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order or catalogues or by means of telecommunications; retail services connected with the sale of air cushions and air pillows, air mattresses, sleeping bags, bed casters not of metal, bed fittings not of metal, chairs, armchairs, cabinets, chests of drawers, desks, footstools, cots and cradles, parts and fittings for all the aforesaid goods, all provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order or catalogues or by means of telecommunications; retail services connected with the sale of textiles, fabrics and textiles for beds and furniture, bed linen, duvets, bed covers, bed blankets, covers for duvets, mattress covers, parts and fittings for all the aforesaid goods, all provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order or catalogues or by means of telecommunications; retail services connected with the sale of covers for pillows and pillow cases, covers for cushions, bedspreads, furniture coverings of textile, eiderdowns, quilts, parts and fittings for all the aforesaid goods, all provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail

order or catalogues or by means of telecommunications; information, advisory and consultancy services relating to all of the aforesaid.