

BL O/162/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3468296

BY

EDCAN LTD

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION THERETO (NO. 420440)

BY

DREAMS LIMITED

Background and pleadings

1. EDCAN Ltd (“the applicant”) applied to register the trade mark:



in the UK on 19 February 2020. The application was accepted and published in the Trade Marks Journal on 28 February 2020, in respect of the following goods:

Class 20: Bamboo pillows; Beds, bedding, mattresses, pillows and cushions; Memory foam pillows; Blackout blinds [indoor].

Class 24: Covers for pillows; Pillow covers; Pillowcovers; Blackout curtains.

Class 25: Eye masks.

2. Dreams Limited (“the opponent”) opposes the class 20 and class 24 elements of the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The class 25 element of the application is unopposed. An initial pleading under Section 5(3) of the Act was later withdrawn by the opponent.
3. The opposition is based on earlier European Union Trade Mark (EUTM) 17963494, which was filed on 1 October 2018 and registered on 15 February 2019, for the mark **DREAMS**.
4. The EUTM relied upon is registered in several goods and services classes, however the opponent relies only the goods and services in classes 20, 24 and 35 for the purposes of this matter, namely:

Class 20: 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: 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 35: 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.

5. In its statement of grounds, the opponent claims that the contested mark is highly similar to the earlier mark, as the element 'DREAMS' is identically reproduced within the contested mark. It adds that whilst the contested mark contains the additional word 'MARTIAN' and a device element, this is insufficient to distinguish the marks as a whole, and the inclusion of 'DREAMS' as a separate distinctive element of the mark means that the respective marks are visually, phonetically and conceptually similar.
6. The opponent also states that the goods at issue are identical or at least highly similar to those covered under the opponent's earlier mark. Both cover various bedding, pillows and fabric goods. Both marks specify "bedding", "mattresses", "pillows" and "covers for pillows".
7. The Opponent claims that as a result of use made of the earlier mark, it has an enhanced distinctive character. It stated that evidence supporting this claim would be submitted at a later date, but in fact no evidence was subsequently filed.
8. In view of the above, the opponent claims that there is a risk of confusion and/or association between the marks at issue.
9. In its counterstatement, the applicant argues that the marks at issue are different. It states that the earlier mark is made up of a single six letter word whereas the contested mark comprises two words and a circular device that is highly stylised. It adds that its mark is 'much busier', and the relevant consumer will easily note the differences between the marks.
10. The applicant also claims that the word 'MARTIAN' is the dominant and distinctive element in its mark, as it is the first element that will be seen by the relevant consumer. It adds that the device element in the contested mark is also a dominant and distinctive element in the later mark due to the distinctive colours and detailed design therein. It claims that the relevant consumer will note the stylisation of the contested mark and remember the 'sheep device under a starry sky'.
11. The applicant states that the word 'MARTIAN' will conjure up the notion of fictional inhabitants of the planet Mars and claims that this meaning will be clear to consumers. As such, the applicant claims that its mark conveys the notion that the

relevant consumer will have dreams containing Martians or that Martians will be the ones dreaming. This provides a different conceptual meaning to that of the opponent's earlier mark, it claimed.

12. The applicant also claims that the device element in its mark is larger than the word elements and as such the eye is naturally drawn to it. It adds that, as the word 'DREAMS' in its mark is the last thing that will be perceived, as it appears last in the mark, that element is lost in the mark and is negligible.
13. Therefore, the applicant states, the marks are visually, phonetically and conceptually dissimilar and there is no likelihood of confusion or association.
14. Turning to the goods and services at issue, the applicant admits that its goods in class 20 are identical to those of the opponent, with the exception of 'cushions' which are not included in the earlier mark. It states that cushions are decorative items and do not replace 'pillows' or any other bedding because they are not meant to be slept on. The applicant also admits that its class 24 goods are identical to that of the opponent's class 24 goods, with the exception of 'blackout curtains' which it claims are dissimilar to any of the opponent's goods or services, as the opponent's earlier mark does not cover any curtains or any window coverings.
15. Neither party filed further submissions or evidence.
16. The opponent requested a hearing, which took place on 10 February 2021, at which it was represented by Mr Philip Harris of Counsel, instructed by Lane IP Limited. The applicant was represented by Ms Alison Wilson of Murgitroyd & Company.

Hearing – Preliminary issues

17. Prior to the hearing both parties submitted skeleton arguments with authorities.
18. I began the Hearing by raising a preliminary issue concerning the nature of some of the attachments that were submitted with Ms Wilson's skeleton argument. In my opinion a large number of the attachments were evidential in nature and could not therefore be taken into account, having been submitted in an incorrect format and outside of the appropriate time frame. Ms Wilson accepted this point and as a result, I will take note only of the information provided under her skeleton argument that

pertains to earlier marks which contain the word ‘Dreams’, and the earlier decision of the Tribunal which she referred me to, in respect of the ‘Easy Dream Beds’ application.¹

19. I also noted that in her skeleton Ms Wilson had made no mention of the good ‘cushions’ in her client’s class 20 specification, which initially it had been argued in the counterstatement of the applicant, were not similar to e.g. pillows. I also noted that she had raised arguments regarding the term ‘Blackout blinds [indoor]’ in class 20, which initially had been conceded as identical to the opponent’s earlier goods. Ms Wilson confirmed that ‘cushions’ were now conceded as being identical to the earlier goods in class 20.

20. Regarding the newly raised comments in respect of ‘Blackout blinds [indoor]’ in class 20, I asked if Ms Wilson was requesting an amendment to her pleadings. Ms Wilson confirmed that this was the case and after a brief discussion between the parties, Mr Harris agreed to consider this issue during the hearing rather than adjourn proceedings.

21. I do not propose to set out in detail everything that was submitted to me during the hearing at this point, however I will refer to comments made by both parties, where appropriate and relevant, throughout my decision.

Decision

Section 5(2)(b) of the Act

22. Section 5(2)(b) of the Act states:

“(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

¹ BL O/455/14

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.”

23. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

24. In the judgment of the 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”.

25. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

26. The parties' respective specifications are:

Earlier mark	Application
<p>Class 20: 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.</p> <p>Class 24: Textiles; fabrics and</p>	<p>Class 20: Bamboo pillows; Beds, bedding, mattresses, pillows and cushions; Memory foam pillows; Blackout blinds [indoor].</p> <p>Class 24: Covers for pillows; Pillow covers; Pillowcovers; Blackout curtains.</p>

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 35: 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,

<p>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</p>	
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<p>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</p>	
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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

<p>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.</p>	
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27. The applicant made a number of concessions regarding the goods and services at issue, in its counterstatement and in Ms Wilson’s skeleton arguments. I refer to paragraphs 14 and 19 above for the detail on this.

28. As a result of the concessions made, during the hearing Mr Harris needed only to address me on the goods ‘Blackout blinds [indoor]’ in class 20 and ‘Blackout curtains’ in class 24 of the contested application, as everything else in the contested mark has been conceded as identical to the earlier goods.

29. Mr Harris submitted that goods such as blackout blinds and blackout curtains are the kind of goods that will be sold within the same retail establishments as bedding, beds, mattresses, pillows etc. He told me that it was not uncommon in retail outlets that specialise in the sale of such goods, to find staged areas resembling a bedroom, with items, such as curtains or blinds, on display, to give the potential consumer a clear idea of how a bedroom may look if a certain range of goods were purchased. Mr Harris suggested that the goods at issue would be purchased by the same consumers, through the same channels of trade, and should be considered to be complementary.

30. I agree with the submissions that Mr Harris put forward in this regard. I find that the average consumer of beds, mattresses, bedding, pillows etc might expect that a provider of such goods would also be likely to provide other ancillary goods such as curtains and blinds, to complete a room. It is the case, as Mr Harris asserted, that retail outlets that specialise in goods such as beds, bedding, mattresses etc, do produce mocked-up rooms, where much of the furniture one would expect to find in a bedroom is present, and this can include goods such as blinds and curtains. I find that the users and channels of trade may be the same and these goods may be complementary in nature, where the consumer intends to match e.g. bedding with curtains for an aesthetic effect. I find these goods to be similar to at least a low degree to the opponent's earlier goods.

31. In conclusion, all of the contested goods have been found to be either identical or similar to at least a low degree.

Average consumer and the purchasing act

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

33. 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.”

34. To my mind, the average consumer of goods such as beds, bedding, mattresses, pillows and pillow covers, cushions, blinds and curtains, will be a member of the general public.
35. The average consumer will generally purchase the goods at issue from specialist retail outlets and specialist websites online, although many of the goods can also be purchased from large supermarket chains. The selection of these goods will be largely a visual process, with the average consumer having taken time in the selection of the appropriate product through research online, perusing catalogues and other printed matter, but also aurally, through discussion with sales assistants and appropriate experts.
36. Mr Harris stated that the average consumer of the goods at issue is deemed to be reasonably well informed, observant and circumspect. He suggested that, in the context of the goods at issue, there are different groups of consumers involved and some will pay differing levels of attention depending on their interest in the matter. Mr Harris also referred me to the decision in *LIVING DREAMS* and to paragraphs 21 and 22 of that decision, where it was found: "The average consumer is going to be a member of the public, selecting or shopping online, using visual cues, such that the level of attention may be above average but not of the highest degree."²
37. Ms Wilson stated that the relevant case law regarding the average consumer is clear that the average consumer perceives a mark as a whole: "they do not salami slice the mark into its different elements". In this instance Ms Wilson suggested that the average consumer would display a higher than normal level of attention in order to ensure that the goods selected were precisely those required by the individual.
38. Having considered the submissions put forward by both parties, and taking note of the finding in *LIVING DREAMS*, I agree that the level of attention involved in the selection and purchase of the goods at issue may be slightly higher than normal. The goods at issue are generally everyday items, however the selection of a mattress or a bed may be one that involves a little more care than the selection of e.g. a cushion. On balance, I find that the level of attention paid by the average consumer will be slightly higher than average but will not be particularly high.

² BL O/731/18

Comparison of the marks

39. 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.”

40. 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.

41. The respective trade marks are shown below:

Earlier mark	Contested trade mark
<p style="text-align: center;">DREAMS</p>	

42. The opponents mark consists of the single word 'DREAMS' presented in a standard typeface. The overall impression of that mark lies therefore in its totality.
43. The applicants mark is a complex mark containing figurative elements and words. I find that the word 'MARTIAN', appearing at the top of the mark and presented in a light green colour, is likely to catch the eye first. The word 'DREAMS' will also be perceived fairly quickly. There are several device elements in the contested mark, all of which play a role in the mark to some degree. I find the green triangular element at the centre of the mark to be a prominent and quite striking aspect and one which will be perceived quickly. The circular design and the 'stars' background elements are noted, and the image of a black sheep with a white head is also fairly prominent as it appears right at the very centre of the mark.
44. Overall, I find the verbal combination 'MARTIAN DREAMS' and the figurative elements of a green triangle containing a black sheep, to be of roughly equal weight. Those elements are, in my opinion, co-dominant and equally distinctive, where the verbal elements are considered as a unit. Where the term 'DREAMS' is perceived as an isolated or independent term, which I think is unlikely, I find that word to be less distinctive given the nature of the goods at issue, e.g. beds and bedding, given the obvious association between dreaming and such goods. In conclusion, I find that the overall impression in the contested mark lies in the combination of the term 'MARTIAN DREAMS' and the figurative elements at the centre of the mark, namely a green triangular background and a black sheep.

Visual similarity

45. Visually, the respective marks are similar inasmuch as they share the word 'DREAMS', albeit that that word appears in the contested mark in a slightly stylised manner. The marks differ visually in respect of the figurative elements and the word 'MARTIAN' within the contested mark, all of which have no counterpart in the earlier mark. As the contested mark is predominantly made up of figurative elements not found in the single word mark of the opponent, these marks are visually similar to no more than a low degree.

Aural similarity

46. Aurally, the earlier mark will be pronounced as the single syllable 'DREEMS'. The contested mark will be pronounced as 'MAR/SHUN/DREEMS'. The marks at issue share identically the sound 'DREEMS' however this element, whilst making up the entirety of the earlier mark, comprises the final element of the contested mark. The beginnings of the contested mark have no phonetic counterpart in the earlier mark. The marks are therefore considered to be aurally similar to no more than a medium degree.

Conceptual similarity

47. During the hearing Ms Wilson suggested that the word 'MARTIAN' in the contested mark would conjure up the concept of space age inhabitants from the planet Mars, beaming light down on to sheep. She stated that the relevant consumer would therefore have dreams containing Martians or that a notion of Martians having dreams would be conveyed. That being the case, she claimed that the contested mark conveyed a different conceptual meaning than the earlier mark entirely.

48. Mr Harris claimed that the word 'MARTIAN' in the contested mark simply indicated what the dreams are going to be about. He suggested that the marks at issue were fundamentally conceptually identical. Mr Harris then referred me to the *Ice Breaker* decision, which he said confirmed that when you have the same word in both marks, a degree of conceptual similarity cannot be denied.³ He noted that in paragraph 42 of that case the court found:

"Since the prefix ice has a certain evocative force it must be regarded as limiting in the present case the conceptual difference between the marks in issue"

49. In that regard, Mr Harris asserted that, where there might be a conceptual difference between the marks due to the inclusion of the word 'MARTIAN', the presence of the identical element 'DREAMS' in both marks has the effect of limiting the conceptual differences.

³ T-112/09

50. The contested mark contains several elements that may convey a conceptual message. The earlier mark consists of a single word which is the common element 'DREAMS' that will be readily understood to be the plurality of the word 'dream' which is defined as "an imaginary series of events that you experience in your mind while you are asleep".⁴
51. The other elements within the contested mark convey: the notion of beings from the planet Mars, commonly referred to as Martians; a sheep, which is recognised widely in the UK; and several other design features, including a green triangular strip, and stars that may evoke the night sky. These elements have no counterpart in the earlier mark and therefore generate a difference between the marks conceptually.
52. Notwithstanding the differences between the marks, and taking account of the finding in *Ice Breaker*, as the common element is conceptually identical, the marks at issue can be said to be conceptually similar to a higher than medium degree.

Distinctive character of the earlier trade marks

53. 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

⁴ <https://www.collinsdictionary.com/dictionary/english/dream>

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).”

54. The opponent initially claimed that its earlier mark had acquired an enhanced degree of distinctive character through the use made of it, however no evidence was provided to support this claim. I must therefore assess the mark purely on its inherent distinctive character.

55. In her submissions Ms Wilson stated that the opponents mark is wholly descriptive of its goods and services, and she referred me to the earlier decision of the Tribunal in *Pure Imports v Dreams Limited*, where it was stated at paragraph 15 of that decision:

“from an inherent perspective, the word DREAMS is not particularly distinctive for retail services relating to beds and mattresses. It has clear suggestive connotations (dreams are what one has in bed whilst asleep), although, I accept that it is not directly descriptive. I consider its level of inherent distinctiveness to be of a low to moderate level.”⁵

56. Mr Harris also referred me to the same section in *Pure Imports*. Mr Harris asserted that this finding supported his position that, whilst the word ‘DREAMS’ may “have some reference to aspirations or what one thinks of at night and so on, it does not directly describe any of the goods or services in question”.

57. Ms Wilson has claimed that the word ‘DREAMS’ is non-distinctive within the context of the goods at issue, however it is not open to me to make that finding. In *Formula One Licensing BV v OHIM*, the CJEU found that:

“41. [...] it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be

⁵ BL O/455/14

noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)".⁶

58. I agree with the argument put forward by Mr Harris on this issue. I conclude that the word 'DREAMS' is likely to be perceived as a somewhat allusive or suggestive term when considered within the context of the goods at issue. However, the term cannot be said to be entirely descriptive. Therefore, I find the earlier mark to be inherently distinctive, but to no more than a medium degree.

Likelihood of Confusion

59. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

⁶ C-196/11P

60. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

61. Ms Wilson referred me to a number of earlier marks that exist on the register that incorporate the word 'DREAMS', which she claims is used as a descriptor in those marks. Mr Harris submitted that this information essentially amounts to evidential material that should be dismissed.

62. I agree with Mr Harris in this regard. The information pertaining to other 'Dreams' marks 'cluttering' the register, to use Ms Wilson's expression, is state of the register evidence which, even if it had been provided at the appropriate point in proceedings, would have had no bearing on my considerations in this matter.

63. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the Court of Justice of the European Union found that:

"65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered."

64. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that

regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

65. Ms Wilson also stated that the element ‘DREAMS’ is: “lost within the contested mark as a whole and has almost become negligible when you are confronted with the contested mark as it is so busy”.

66. Mr Harris told me that there was a likelihood of direct and indirect confusion between the marks at issue. He added that the suggestion from Ms Wilson, that the word ‘DREAMS’ in the contested mark was negligible and non-dominant or non-distinctive, was wholly incorrect. He told me that in his view, the verbal elements ‘MARTIAN’ and ‘DREAMS’ in the contested mark were of equal prominence. He added that, in his submission, the word ‘DREAMS’ was the subject matter of that mark, as in the *LIVING DREAMS* and *COSY DREAMS* decisions, and that, as the word ‘MARTIAN’ served effectively as the adjective for ‘DREAMS’, it is in the word ‘DREAMS’ that the emphasis would lie.⁷

67. Mr Harris claimed that as with the *LIVING DREAMS* and *COSY DREAMS* decisions, the contested mark is a ‘DREAMS’ mark fronted by a mere descriptor. As such, he argued that: “there is every possibility of direct confusion, certainly amongst some of the groups of consumers within the overall group of average consumers”.

68. With regard to indirect confusion, Mr Harris stated that this was a case where indirect confusion might arise because the contested mark has every appearance of being a sub brand of the ‘DREAMS’ product. He added: “Given its cartoonish nature, it is entirely possible that a consumer seeing that and being aware of the ‘DREAMS’

⁷ COSY DREAMS decision BL O/232/20

brand would think that this is, for example, a whimsical version of the brand intended for, for example, children”.

69. I have previously found the following:

- the goods are identical or similar to at least a low degree;
- the marks are visually similar to no more than a low degree; aurally similar to no more than a medium degree, and conceptually similar to a higher than medium degree.
- the average consumer will be a member of the general public;
- the level of attention paid by the average consumer will be slightly higher than average but will not be particularly high;
- for the goods at issue, the visual and aural assessments will both be important, however the visual assessment will play a greater role;
- the earlier mark can be said to be inherently distinctive, but to no more than a medium degree.

70. Taking all of the aforesaid into account, I find that direct confusion is unlikely to occur. The visual differences between the marks are significant and will not go unnoticed. The average consumer will not mistake one of these marks for the other, even taking account of the identity in some of the goods, the issue of imperfect recollection, and the principle of interdependency which Mr Harris referred me to during the hearing. Where the goods at issue may be aimed at the children’s market, the level of attention paid during the selection and purchasing act may be said to be slightly higher than average, in which case the differences in the mark will be even more obvious to the consumer.

71. Having found that direct confusion is unlikely to occur, I now go on to consider the matter in respect of indirect confusion.

72. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...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).”

73. These examples are not exhaustive but provide helpful focus.

74. I find that the additional matter in the contested mark, over and above the shared element ‘DREAMS’, to be of a nature such that the average consumer would be unlikely to consider the contested mark, as a whole, to be an obvious or logical brand extension of the opponent’s ‘DREAMS’ range. The word ‘MARTIANS’ and the co-dominant figurative elements in the contested mark cannot be said to be non-distinctive, or even weak, additions to the earlier ‘DREAMS’ brand. Nor can it be said that the common element is strikingly distinctive. In fact much has been said on the distinctiveness of the word ‘DREAMS’ by both parties, and whilst it has been found to be distinctive given its fairly allusive but not entirely descriptive nature, that word is

distinctive, within the context of the goods at issue, to no more than a medium degree.

75. In *Duebros Limited v Heirler Cenovis GmbH*, James Mellor Q.C., sitting 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.⁸

76. In my opinion, it is unlikely, given the complex nature of the contested mark and the level of inherent distinctive character in the word 'DREAMS' being no more than a medium degree, that the contested mark would bring the opponent's earlier mark to mind, or vice-versa. However, in the event that that did occur, it can be said to be no more than mere association. I conclude therefore, that indirect confusion is unlikely to occur.

Conclusion

77. As I have found that there is no likelihood of direct or indirect confusion, the opposition is dismissed. Subject to appeal, the contested application will be registered for all of the applied for goods.

Costs

78. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016.

79. I award costs to the applicant as follows:

Considering the statement of grounds and preparing a counter statement	£200
Preparing for and attending a hearing	£800
<u>Total</u>	<u>£1000</u>

⁸ BL O/547/17

80.I therefore order Dreams Limited to pay EDCAN Ltd the sum of £1000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of March 2021

Andrew Feldon

For the Registrar

The Comptroller-General