

O-455-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3007181  
BY PURE IMPORTS LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 35:**



**AND**

**OPPOSITION THERETO (NO. 400744) BY DREAMS LIMITED**

## **Background and pleadings**

1. This dispute concerns trade mark application 3007181 which was filed by Pure Imports Limited (“the applicant”) on 23 May 2013. The mark was published in the Trade Marks Journal on 23 August 2013. The mark and the services for which registration is sought are:



Class 35: Retail services connected with the sale of beds, divan beds, mattresses and parts and fittings for all the aforesaid goods; information and advice in relation to the aforesaid services.

2. Dreams Limited (“the opponent”) opposes the registration of the mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies on a number of earlier UK and Community Trade Marks (“CTMs”) but, by the time of the hearing, it was accepted by the opponent that the following two marks represented its strongest case:

i) CTM 011424538: **DREAMS**



ii) CTM 011582764:

3. Both these marks are registered for, inter alia, class 35 retail services relating to the sale of beds, mattresses, parts and fittings and associated advisory services. The opponent argues that the respective services are identical and that the marks are similar, so leading to a likelihood of confusion. The opponent initially relied upon a family of marks claim, but, again, by the time of the hearing this argument was dropped. The opponent does, however, maintain that the likelihood of confusion is increased on account of its marks having enhanced distinctiveness through use and, additionally, that the use of its marks in a dark blue colour scheme further increases such likelihood, the applied for mark having a similar colour scheme.

4. The applicant filed a counterstatement denying the claims made. In summary, its arguments are based upon the differences in the overall impressions of the respective marks coupled with its submission that the word DREAM is low in distinctive character, factors which combine to enable the average consumer to differentiate between the marks. Attached to its counterstatement were various exhibits (lists of other DREAM based trade marks and details of other businesses using the word DREAM in trade), but, as much of this is repeated in evidence, I will not detail this here.

5. Both sides filed evidence. The evidence was provided by the parties' respective trade mark attorneys, Mr Rob White for the opponent and Ms Kate McCormick for the applicant; one of the opponent's directors (Ms Kim Zaheer) also provided evidence. The evidence will be summarised to the extent that it is considered necessary. A hearing took place before me on 26 September 2014, with the opponent represented by Mr Michael Edenborough QC, of Counsel, instructed by Avidity IP and the applicant by Ms McCormick of Trade Mark Direct.

## **Decision**

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

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

..

(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.”

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

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of services**

8. This is the one aspect of the case where there is no great dispute. The services sought to be registered by the applicant are:

Class 35: Retail services connected with the sale of beds, divan beds, mattresses and parts and fittings for all the aforesaid goods; information and advice in relation to the aforesaid services.

9. Both earlier marks cover the following services in class 35:

**Class 35: 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, 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 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**

10. The parts of the specification I have highlighted in bold demonstrate that the services of the earlier mark cover everything in the applicant's specification. The services are, therefore, identical.

### **Average consumer and the purchasing act**

11. 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*. 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.”

12. The average consumer in this case is a member of the general public who wishes to avail themselves of a retail service for the purchase of a bed or mattress. Mr Edenborough was keen to stress the distinction that had to be made between the retail service and the actual goods. He submitted that whilst the degree of care and consideration that goes into the selection of a bed or mattress may be higher than the norm, it did not follow that the same (higher) degree of care and consideration would go into the selection of an appropriate retail service provider. Ms McCormick argued to the contrary. Whilst some of her submissions appeared to elide retailing with the goods themselves rather than making the distinction Mr Edenborough had elucidated, it was clear from her submission that she felt the selection of a service provider was just as important (as the goods) on account of various considerations that would need to be taken into account when deciding whose retail service to use e.g. whether they deliver, what the aftercare support was etc. In his reply submissions, Mr Edenborough felt that the factors highlighted were not, in the scheme of things, that important. My view falls somewhere between the two. It is clear that the purchase of a bed or a mattress will be subject to reasonably high degree of care and consideration on account of the reasonably high cost of the item(s), the infrequency of purchase and the desire to get the right product in terms of comfort etc. However, as Mr Edenborough submitted, the conflict relates to the retail service connected with such goods. Nevertheless, whilst I expect more attention to be paid to the selection of the goods as opposed to the retail service provider, the selection of the retailer will still be somewhat higher than the norm as, in line with Ms McCormick's submission, factors such as delivery options, finance options, knowledge of the field and reliability (of the retailer) will be important. So although not the highest level of consideration, a reasonable amount of care will still be deployed.

13. The selection will, in my view, be primarily be through visual media because the service provider will be selected through perusal of websites, brochures, advertisements etc, but I will not ignore aural similarity altogether.

### **Distinctive character of the earlier trade mark(s)**

14. The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s), based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

15. 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. In relation to the stylised earlier mark, it is so dominated by the word DREAMS that its level of inherent distinctive character is not materially greater.

16. I must, though, consider the use of the marks. In his first witness statement Mr White provides market share data. In a marketing publication dated 1 April 2013 it is stated that the opponent has a 19% share of the online bed retail market (the stylised version of DREAMS is shown in the article). In a report in what appears to be a trade publication dated August 2011 the opponent is said to have a market share of between 18-22% of the retail market for beds. The rest of Mr White’s first witness statement contains various photographs and signage used by the opponent. The stylised version of the mark appears throughout this, although, the word DREAMS is used in plain script in some contexts (e.g. in a web address and in various sub-texts). In his second witness statement Mr White (in response to a

criticism made by the applicant) provides further market data on which the articles in his previous witness statement were based. The report (The Sticky Eyes Intelligence Report) certainly supports the high market share data (data which goes back to March 2011). He also states (again in response to a criticism from the applicant) that the photographs of the opponent's stores provided in his previous witness statement were taken in the UK in either November 2012 or November 2010 in High Wycombe.

17. Ms Zaheer's evidence provides more detail about the opponent's use. Without going into full details, it shows a consistently high turnover (ranging from £108 million to £256 million), high advertising spend (£10 to £30 million on print and TV)) and market share (recent years peak at 17% in 2010). Various promotional materials are provided showing DREAMS mainly in stylised form, but, also, plain use in domain names and other textual entries e.g. "the dreams difference", "reasons to buy from dreams", "made exclusively for dreams". As I will come back to, the use shown most often depicts the mark in a dark blue colour scheme.

18. Ms McCormick was critical of the evidence. She felt that the market data evidence was unclear, that it may not represent the true position as of the relevant date (there is a suggestion in the evidence that 2012 may have been a bad year for the opponent) and that the evidence did not necessarily go to the distinctiveness of the word DREAMS alone. I reject all these submissions. In terms of the latter point, not only is there ample evidence, as Mr Edenborough pointed out, of the word DREAMS being used in plain text, even if this were not the case it is nevertheless clear that a mark may be distinctive (or in this case become more distinctive) on account of its use as part of another mark (as per the judgment of the CJEU in *Have A Break*). The circumstances here are of a mark used significantly by the opponent, a mark which is strongly dominated by the words DREAMS. Consumers encountering the opponent's use can be left in no doubt that as well as the stylised mark indicating trade origin, the word DREAMS per se is also performing the essential distinguishing function. In terms of the strength of use, the turnover and advertising figures are extremely significant (even in 2012), so even if I did have any doubts about the market share data (which, in any event, I do not) such doubts would have been alleviated. The evidence as a whole presents a compelling picture of a market leader (I accept probably the market leader) in the field of bed and mattress retailing, which identifies itself to the public with reference to the two earlier marks relied upon. I struggle to see how I could come to any conclusion other than that the two earlier marks have an enhanced level of distinctive character through use – the marks, including the word DREAMS per se, are highly distinctive of the opponent in relation to the relevant services.

19. In relation to colour, although neither earlier mark is registered with regard to colour, it is clear from the judgment of the CJEU in *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12, that if the earlier mark(s) have been used extensively in a particular colour or combination of colours then that may be a relevant factor to take into account in assessing whether there is a likelihood of confusion; the CJEU stated:

"2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of

colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

3. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.”

20. Whilst the above is noted, and whilst I have found that much of the use shown in the evidence depicts the earlier mark (particularly the stylised earlier mark) in a dark blue colour scheme, I do not consider that this will materially affect whether there is a likelihood of confusion. This is because it is difficult to gauge from the evidence what impact the use of colour would have had on members of the public and whether it has become particularly associated with the opponent, particularly in circumstances where the colour does not appear particularly striking.

### **Comparison of marks**

21. 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.”

22. 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. As stated earlier, Mr Edenborough identified his best case(s) as lying with the two earlier marks identified below, shown, for ease of reference, alongside the applicant’s mark:

Applicant's mark	Opponent's marks
	<p data-bbox="810 275 1043 320"><b>DREAMS</b></p> 

23. In terms of the applied for mark, the overall impression is made up of a figurative element composed of a humanised cartoon moon accompanied by three stars, with the words Easy Dream Beds alongside, those words being one above each over. The words and the figurative element each take up roughly half of the mark. Although the word Beds is clearly descriptive in relation to the services at issue, it is not negligible because the preceding words qualify the word Beds, creating a complete phrase. Mr Edenborough argued that the dominant and distinctive element in the mark was the word Dreams on account of the word beds being descriptive (for obvious reasons), the word Easy<sup>1</sup> being descriptive (of services that were easy to use) and that there was little distinctiveness in the device element. Whilst noted, I consider that this represents an attempt to artificially salami slice the mark. The words in the mark will be seen as a complete phrase. The figurative element makes a roughly equal contribution to the overall impression, as do the words. There is no single element which strongly dominates the others. The words may take on slightly more significance, but I cannot put it higher than that. The dark blue colour scheme forms part of the overall impression, although, for similar reasons to those mentioned at paragraph 20, it is not a striking aspect of the mark.

24. The opponent's word mark DREAMS has only one element so that is what its overall impression is based upon. In terms of the other earlier mark, the overall impression is made up of the word DREAMS, together with some additional stylistic/figurative elements. It is possible that the figurative element contained in the letter D of Dreams will be seen as a moon, however, some may see it simply as a stylistic embellishment mirroring the curve of the letter. Either way, although not completely negligible, it does not play a significant role in the overall impression. In this mark the prominence of the word DREAMS is such that it has much greater relative weight in its overall impression than the other elements, strongly dominating the mark.

25. From a visual perspective, the aspects of the marks which I have said contribute to the respective overall impressions bring forward a number of differences; the main ones being the addition of a visually significant device element and that the word DREAM is part of a whole phrase (Easy Dream Beds) rather than being used alone, as it is (or in that case it is DREAMS not DREAM) in the opponent's mark. I do not place any real weight on the colour of the applied for mark as creating a difference.

<sup>1</sup> In relation to the word EASY, Mr White's evidence contains state of the register evidence showing various EASY based marks. This is noted, but Mr Edenborough did not heavily rely on this, suggesting that it was self evident that the word EASY is not distinctive. He also highlighted that in the applicant's first counterstatement (which was subsequently amended) it suggested that the word EASY was low in distinctiveness.

Even though I have found that the use of the earlier mark in colour does not materially improve the opponent's case, it would be wrong to count the colour of the applied for mark against it. The earlier mark(s) is registered without regard to colour so the best course of action is to consider the marks as drained of colour, so, in the case before me, the impact of colour is neutral. In terms of visual similarities, the respective marks include the word DREAMS or DREAM within them. As I have stated, some consumers may see the moon device in the letter D of the earlier mark which could be said to create visual similarity with the applied for mark's moon device. However, the impact of the moon in the overall impression of the earlier stylised mark is very weak and the actual representations are strikingly different. Overall, I consider that any visual similarity is of only a low degree.

26. From an aural perspective, the marks are DREAMS against EASY DREAM BEDS. There is more aural similarity than visual similarity, but still some important differences. I consider there to be moderate level of aural similarity.

27. From a conceptual perspective, the earlier marks' concept will be based upon the word DREAMS which, in the context of the services at issue, will be taken as a reference to the subconscious activity that one often partakes of whilst asleep. In terms of the applied for mark, Mr Edenborough felt that it would be seen as a reference to beds obtained by the use of an easy to use retail service, so the concept would be based primarily on the word DREAMS. Ms McCormick submitted that it would be seen as a reference to a dream (as in most desired) bed that was, in some unspecified way, easy. In my view both representatives have taken the concept out of context. As I have said, the average consumer is likely to see the three words of the applied for mark as a complete phrase. The most meaningful concept, when the nature of the service is considered, is that the retail service will provide beds which are easy to dream in (so suggesting a good night's sleep). As both marks refer to the concept of dreaming, there is a clearly some conceptual similarity.

### **Likelihood of confusion**

28. 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.

29. Confusion can be direct or indirect. The difference between the two forms of confusion was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

30. I think it clear that this is a case in which indirect confusion has the better prospect of success. This is because, notwithstanding that identical services are in play, and notwithstanding that the earlier mark has a high degree of enhanced distinctive character, the differences between the respective marks easily outweigh the similarities so meaning that the average consumer, paying the reasonable degree of care and attention I described earlier, will not directly mistake one mark for the other. The question then resolves to whether the presence in the applied for mark of the word DREAM will signal to the average consumer that the services offered under that mark are being offered by the same or an economically linked undertaking as the service provider responsible for the earlier DREAMS marks, or vice versa.

31. Here I think it useful to bring in some of Ms McCormick's evidence relating to other DREAM based marks. She provides a list of over 150 marks in classes 20 and/or 35 (mainly CTMs or UK marks) in which the word DREAM or DREAMS appears. The marks range from EASY DREAM, DREAMLAND, TO CATCH A DREAM, CHILDHOOD DREAMS, DREAM MASTER, DAYDREAM, DREAM ENERGY, DREAM TYME. More seem to be registered in class 20 (and other goods classes) than for retail services in class 35. She then goes on to provide 25 web prints showing use in trade:

- A print from Amazon.co.uk for a duvet sold under the trade mark DREAMLAND.
- A print from Jones & Tomlin for a pillow using a sub-brand DREAMREST.

- A print from AIS, a retailer, which sells its own range of DREAMWORLD beds.
- A print from Mattresses World for a mattress called the DREAMNIGHT TOPAZ.
- A print from the website of a bed manufacturer called SLUMBER DREAM.
- A print from another bed manufacturer called SWEET DREAMS.
- A print from what appears to be a Canadian website for a NORDIC DREAM bed.
- A print from JYSK for a waterproof bed sheet called SGL NIGHT DREAMS.
- A print from a retailer of various sleep products called DREAMTYME.
- A Google results page showing five DREAMAWAY mattresses, also shown is a DREAMS NEWPORT BUKBED which appears to be offered by the opponent.
- A print from another bed manufacturer called DREAMWORLD BEDS.
- A print from the website of Mamas & Papas showing a DREAMPOD SLEEPBAG (something babies are put in to keep warm).
- A print from the website of DREAMTIME showing some pillows. It also contains the rubric "It's What Dreams Are Made Of".
- A print from the website of DUSKY MOON which manufactures and sells a bed guard called DREAM TUBES.
- A print from the website of SNUG showing the DREAMLAND pillow (as per the Amazon print). A further print from the same website shows a DREAMLAND mattress topper.
- A print from the website SAFE DREAMS a manufacturer of cot bumpers.
- A print from the website of DREAMGENII who make children's bedding.
- A print from the website DREAM WELL who specialise in adjustable beds. The page uses the rubric "Capture the dream".
- A print from the website of LECOCO FURNITURE, which sells a DREAM GEL DOUBLE BED.

- A print from the website Mattress Shied which sells mattresses manufactured by SUPER DREAM MATTRESS CO.
- A print from the website TO CATCH A DREAM which sells (it has a store in Harrogate) bedsteads, bedroom furniture etc.

32. Mr Edenborough criticised the above evidence because it fails to show what impact any of the above will have had on the average consumer. There was nothing to show whether the average consumer had been exposed to multiple businesses using DREAM in trade names and that, consequently, there was no evidence to show that the average consumer had become used to distinguishing between different undertakings using the word DREAM/S in the course of trade. Whilst I do not necessarily disagree with Mr Edenborough's point, the evidence does though confirm my own take on matters in that, from an inherent perspective, the word DREAM/S is not the most striking word that could be used in the context of bed related goods and services and, further, that it would not surprise the average consumer to find different undertakings using that word(s), together with other words, in a purely promotional purpose and/or, in allusive trading names. In the normal course of events, that would, in my view, have put pay to the claim of indirect confusion in that the common presence of DREAM/S will be put down simply to a coincidental and unsurprising use of a not very distinctive word. However, what must be added to the mix is the high level of distinctive character of the earlier mark(s) on account of their use.

33. Whilst this has been fully borne in mind, I do not consider that this changes the position. The word DREAMS per se is distinctive of the opponent. It does not follow (in this case) that the distinctiveness of the word DREAMS per se means that its presence (or in this case the presence of DREAM) in another mark will automatically mean that the consumer will make a same stable assumption. It depends on context and the nature of the common word. I come to the view that despite the word DREAMS per se being highly distinctive of the opponent, the use of the applied for mark will not lead to indirect confusion; the average consumer will instead assume it is a different undertaking simply making use of the suggestive word DREAM as part of a longer trading name.

34. Mr Edenborough did make a point about Google drop-down suggestion boxes in that when the letters D-R-E-A-M were entered into a Google search box, the search engine may suggest the applicant's name to the user. There is, of course, no evidence of this, furthermore, the submission lacks credibility as the full text of the applicant's mark is EASY DREAM BEDS so the auto-complete is unlikely to suggest the applicant because the EASY part of the mark is before the word DREAM not after it. In coming to this view I have also borne in mind the fact that both the applied for mark and the stylised earlier marks have a moon in them. Ms McCormick's evidence included details of other traders making use of the moon devices, her submission being that this shows that they are common in trade and that little importance will be given to them in terms of indicating a shared trade origin. Mr Edenborough felt this submission was somewhat surprising given Ms McCormick had previously submitted that the device aspect of the applied for mark was distinctive and memorable. I think the point here is that the shared presence of a moon device in marks relating to bed retailing is not something that strongly points to

a shared trade origin. What matters, of course, is the respective overall impressions and, for the reasons I have given, I do not consider that the marks are close enough for either direct or indirect confusion to apply.

35. Mr Edenborough also relied upon the principle of initial interest confusion, a principle that was held to be a relevant form of confusion by Mr Justice Arnold in *Och-Ziff Management Europe Ltd & Anor v Och Capital LLP & Anor* [2010] EWHC 2599 (Ch). This involves the use of a similar (or indeed identical) trade mark which in some way lures the consumer to, perhaps, a website or physical premises, in circumstances where the average consumer realises before making a purchase that the respective undertakings are not related, but by then the harm has already been done (in this case that the average consumer is in the store or on the website and may go on to fully avail themselves of the service). I reject this submission. For initial interest confusion to arise there must be at least a fleeting aspect of confusion – for the reasons already given I do not consider that there is. **The opposition is dismissed.**

### **Costs**

36. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

*Preparing a statement and considering the other side's statement - £300*

*Filing and considering evidence - £500*

*Attending the hearing - £500*

**Total - £1300**

37. I therefore order Dreams Limited to pay Pure Imports Limited the sum of £1300. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22nd day of October 2014**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**