O/0988/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3997013
IN THE NAME OF DFFRNT DREAM LTD
TO REGISTER THE FOLLOWING TRADE MARK:

DFFRNT DREAM

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 446994
BY FLICK FASHIONS LIMITED

Background and pleadings

1. DFFRNT DREAM LTD ("the applicant") applied to register the trade mark shown on the front page of this decision ("the applicant's mark") in the UK on 30 December 2023, under number 3997013. It was accepted and published in the Trade Marks Journal on 19 January 2024 in respect of the following goods:

> *Class 25:* *Clothing.*

2. FLICK FASHIONS LIMITED ("the opponent") opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at all the goods. The opponent relies upon the following trade marks and the following goods for which they are registered:

> (i) **DREAM**
> UK registration no. 2216417
> Filing date: 7 December 1999
> Registration date: 27 April 2001
> Goods registered:
> Class 25: Clothing; swimwear; footwear; headgear.
> ("the DREAM mark")
>
> (ii) **DREAMS**
> UK registration no. 2060937
> Filing date: 13 March 1996
> Registration date: 25 October 1996
> Goods registered:
> Class 25: Articles of clothing; swimwear, footwear and headgear.
> ("the DREAMS mark")

3. The opponent's marks qualify as 'earlier trade marks' in accordance with section 6 of the Act. They had been registered for more than five years at the filing date of the applicant's mark and are, therefore, subject to the use requirements in section 6A of the Act. Although the opponent indicates in its notice of opposition that it is relying on all goods, I note that it only made a statement of use for *clothing* for both marks.

4. In its statement of grounds, the opponent contends that the competing marks are highly similar and that the applicant's goods are identical to the opponent's goods. It argues that therefore there is a likelihood of confusion, including a likelihood of association.

5. The applicant filed a counterstatement, denying the ground of opposition. It also indicated that it would require the opponent to provide proof of use of its marks.

6. The opponent is professionally represented by Stratagem Intellectual Property Management Limited, whereas the applicant is not represented. Only the opponent filed evidence in these proceedings. No hearing was requested. Neither party filed written submissions in lieu, though I note that the opponent filed submissions in the evidence rounds. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

8. The opponent's evidence of a witness statement provided by Tahir Sharif (as amended on 26 September 2024) and 13 exhibits (FF1-FF13). Mr Sharif is the Executive Director of the opponent, which is a position that he has held since 1983. He provides evidence of use of the opponent's mark.

9. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Proof of use

10. Section 6A of the Act reads as follows:

"(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

11. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's mark is the five-year period ending with the filing date of the applicant's mark, i.e. 31 December 2018 to 30 December 2023.

12. In *easyGroup Ltd v Nuclei Ltd & Ors*[1], Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 V*erein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode* GmbH [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

[1] [2023] EWCA Civ 1247

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the

goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

13. Moreover, section 100 of the Act states that:

> "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

14. In the witness statement, Mr Sharif states that the opponent has been selling clothing and related goods bearing the opponent's DREAMS mark since 1982. The opponent primarily sells the goods as wholesale suppliers to retailers in the UK and some EU countries. The opponent also sells clothing and related goods through an Essex-based outlet, as well as direct to customers via its website.

15. In Exhibit FF1, Mr Sharif gives the following UK sales figures for clothing bearing the opponent's DREAMS mark:

Year	Sales figures
2018	£1,144,005.62 [£16,428.39 for December]
2019	£980,045.16
2020	£916,335.34
2021	£1,178,363.59
2022	£1,889,003.70
2023	£1,403,110.90

16. In the witness statement, Mr Sharif states that these sales figures have been provided from the company records produced by the opponent's accountant based on invoices to consumers. The table in Exhibit FF1 breaks down the UK sales figures by month. The relevant period began on 31 December 2018. I have therefore included the specific figure for December 2018 above in addition to the overall figure for 2018 given by Mr Sharif as the other months that year were before the relevant period. However, whilst the first day of the relevant period began in December 2018, I am mindful that even the sales figures for December 2018 are likely to include sales made before the relevant period started. Although I cannot be sure of what proportion of the sales from December 2018 ought to be discounted, I am mindful that the figures for 31 December 2018 alone are likely to actually be much lower than the £16,428.39 shown above.

17. Exhibit FF2 shows a variety of clothing bearing the DREAMS mark on the label and/or tag. The items shown are women's jumpers, dresses, jeans, trousers, tops, and shirts. Exhibits FF3 shows further examples of clothing such as bearing the DREAMS mark on the label and on the tag attached. In addition to this, the product codes (and in some instances, the invoice numbers) are provided alongside the images.

18. Exhibits FF4 and FF5 show a variety of different clothing items accompanied by their style code. In the witness statement, Mr Shafir states in that these items are sold

under the DREAMS mark. The items of clothing shown are all women's clothing items, including skirts, cardigans, leggings, tops, and dresses. Some of these clothing items are also accompanied by invoice numbers corresponding to the invoices shown in Exhibits FF6, FF7, FF8, FF9, and FF10. The invoices cover the relevant period, with Exhibit FF6 showing invoices from 2019, Exhibit FF7 showing invoices from 2020, Exhibit FF8 showing invoices from 2021, Exhibit FF9 showing invoices from 2022, and Exhibit FF10 showing invoices from 2023. The invoices were issued to UK-based customers, with a range of different locations shown across the UK such as Essex, Warwickshire, West Yorkshire, Devon, Newcastle, Dumfriesshire, Cambridgeshire, Mid Glamorgan, Roxburgshire, and London.

19. I note that some of the invoices bear the opponent's "flick" branding, as shown below:

20. Whilst the invoices bearing the "flick" branding do not also show the DREAMS mark on them, I can see that the product codes listed on the invoice correspond to the goods which bear the DREAMS mark on the label and/or tag.

21. Exhibit FF11 shows photos of the opponent's trade stand at various trade fairs. In the witness statement, Mr Sharif explains that the opponent has attended trade exhibitions in 2018 to 2024, such as Birmingham NEC Spring Fair Moda and Autumn Fair Moda, The Scotland Trade Fair, Top Drawer (London), and Harrogate Fashion Week. The photos show various items of women's clothing (such as dresses, skirts, tops, and tunics) being displayed alongside a stylised version of the DREAMS mark. Exhibit FF12 shows printouts of the exhibitor information for trade fairs at Birmingham NEC. These give the opponent's stall information for its attendances at the Spring Fair 2023 and Spring Fair 2024.

22. Exhibit FF13 shows screenshots of the opponent's website (www.flick.co.uk). These show women's clothing (such as jackets, trousers, tops, and dresses) being offered for sale through the opponent's website, which, in the witness statement, Mr Sharif states are further examples of DREAMS-branded clothing which have been sold during the relevant period. The screenshots do not have the date within the web

address, but the screenshot on page 8 shows the copyright notice which states 2023. It is considered that whilst Exhibit FF13 shows use within the relevant period, it is not clear whether it was available within the relevant period prior to 2023.

Forms of the mark

23. Throughout the exhibits, the DREAMS mark appears on the labels and tags in the following manner:

24. It is my view that that stylisation of the DREAMS mark is an acceptable variant. Whilst the typeface is reasonably stylised, I am of the view that it does not alter the distinctive character of the DREAMS mark. In *Dreamersclub Ltd v KTS Group Ltd*[2], Mr Philip Johnson, as the Appointed Person, found that the use of the same opponent's DREAMS mark qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word

[2] BL O/091/19

mark. Rather, it constituted an expression of the registered word mark in normal and fair use on the basis that "the fact it has been presented in what might be called a cursive typeface and not as a plain word mark must be disregarded" [14]. I therefore find that the stylised version of the DREAMS mark is an acceptable variant of the registered mark.

25. The invoices in Exhibits FF5 to FF10 show use of the DREAMS mark as follows:

26. I find that this use of the mark is an acceptable variant due to the use of the very basic typeface which does not alter the distinctive character of the mark. I also note that the mark is accompanied by the word "LONDON". It appears in a much smaller font size and is placed underneath the much larger word "DREAMS". It is my view that the addition of the word "LONDON" would be seen as a non-distinctive reference to where the company is based. As such, it does not alter the distinctive character and therefore constitutes an acceptable variant of the opponent's DREAMS mark.

27. All of the evidence submitted shows the DREAMS mark, rather than the DREAM mark. In its submissions, the opponent argues that the DREAMS mark could be "heard as the possessive "DREAM'S" and in such an event the use of either would effectively amount to use of the identical mark". It is my view that it is highly improbable that the average consumer will understand the word "DREAMS" as the singular possessive "DREAM'S", given that nothing follows this word to qualify what belongs to the singular dream and therefore "DREAM'S" in abstract would be meaningless. However, at paragraph 18 of *Dreamersclub Ltd v KTS Group Ltd,* the Appointed Person found that "the pluralisation of DREAM into DREAMS cannot be held to alter the distinctive character of the word mark DREAM. Accordingly, the use of the stylised DREAMS would also be use of the mark DREAM". I therefore find that the use of the opponent's DREAMS mark is sufficient for showing use of the opponent's DREAM mark.

Sufficient use

28. The evidence is not without its limitations. For example, although the opponent has indicated that it attends trade exhibitions to promote the brand, there are no details

as to the spend on marketing activities to promote the mark in the UK. There are also no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent's mark.

29. However, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[3] The evidence establishes that sales were made during the relevant period to a number of different customers across the UK. In addition to this, whilst there is no indication of market share, the sales figures provided by Mr Sharif show that just over £6 million was generated through the sale of goods bearing the opponent's mark in the UK between 2019 and 2023. These sales figures are supported by the invoices, which show sales during the relevant period to a number of different customers across the UK, as well as the financial records showing sales in between 2018 and 2023. These documents show that the sales were geographically widespread in this territory. On the face of it, the figures provided seem modest in the context of the UK market for women's clothing, which I understand to be very large. However, as the authorities cited above show, use does not need to be quantitatively significant for it to be considered genuine. Taking the evidential picture as a whole, i.e. the turnover figures, evidence of sales and the evidence of the websites (which appears to show use in 2023 within the relevant period), I am satisfied that there has been genuine use of the DREAMS mark.

Fair specification

30. In determining a fair specification for the opponent's marks, I remind myself that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.[4] I must consider how the average consumer would fairly describe the goods shown in evidence.[5] All the sales figures, invoices, clothing photos, and other evidence show the mark in conjunction with women's clothing. For the purposes of the opposition, the opponent is relying on *clothing*. Whilst I accept that the goods shown in evidence would fall within the wider

[3] *New Yorker SHK Jeans GmbH & Co. KG v OHIM,* Case T-415/09
[4] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10
[5] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

category of *clothing*, it is a very broad category which would include items of clothing belonging to other sub-categories of clothing (such as babies' onesies) which differ from the type of clothing offered by the opponent and that there is no evidence of the opponent providing. Furthermore, whilst I recognise that this alone is not determinative, Mr Sharif himself states on page 3 of the witness statement that the opponent "deals primarily in ladies' fashion wear", and I note that the cloaked version of the opponent's website link referred to on page 1 of the witness statement shows the description of the website as "Wholesale Women's Clothing Online". In addition to this, page 4 of Exhibit FF12 states that the opponent's business "has been designing and manufacturing womenswear…". I am of the view that the opponent has not shown use of the marks on subcategories of clothing such as men's clothing or children's clothing. Taking into account the evidence filed, it is my view that the average consumer would fairly describe the goods offered as being women's clothing. I therefore find that the opponent may only rely upon *women's clothing* for the purposes of this opposition.

My approach

31. Given that the opponent's DREAM mark is identical to the word "DREAM" in the applicant's mark, I consider the opponent's DREAM mark to be its strongest case. In the event that the opposition fails on the basis of the opponent's DREAM mark, the opponent's DREAMS mark will not improve its position. As such, I will determine the opponent's claim on the basis of the opponent's DREAM mark only, referring to it as "the opponent's mark" from this point onwards.

Section 5(2)(b)

32. Section 5(2)(b) of the Act is as follows:

> "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".

33. 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.”

34. 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 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

35. In *Gérard Meric v OHIM*[6], the General Court ("GC") confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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."

36. The goods to be compared as follows:

---

[6] Case T- 133/05

The opponent's goods	The applicant's goods
Class 25: Women's clothing.	Class 25: Clothing.

37. In its statement of grounds, the opponent submits that the goods are identical. In its counterstatement, the applicant argues that "the specified goods under the applicant's mark, which pertain to general clothing, are distinct from the opponent's goods, which are focused specifically on swimwear. While both fall under the broader category of apparel, the distinct market segments and specific nature of the goods reduce the likelihood of confusion amongst consumers".

38. Firstly, the opponent's mark is registered for several goods in class 25, including *clothing* at large. Whilst I have found in the fair specification based on the opponent's use of the mark that it may only rely on *women's clothing*, the opponent's goods are not limited to swimwear. I must therefore clarify that these matters will have no material bearing on the comparison which follows, nor can they in law. This is because, although the applicant has suggested that the opponent's goods are primarily swimwear, when assessing the likelihood of confusion, it is necessary to consider all the circumstances in which a mark might be used.[7] Furthermore, since the way in which goods are marketed may vary over time and depend upon the parties' wishes (or those of any potential successors in title), it is not appropriate to take into account the way in which the goods are currently marketed.[8] As a result, even though the applicant has suggested the ways in which its mark may be used and that the opponent's use is primarily in relation to *swimwear*, the following comparison must take into account only the goods in the application to register the applicant's mark and the opponent's goods framed by the fair specification. Any differences between the actual goods provided by the parties, their target markets, or how they reach those markets, are not relevant unless those differences are apparent from the competing specifications.

[7] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06
[8] Devinlec Développement Innovation Leclerc SA v OHIM, Case C-171/06P

39. As the opponent's narrower term *women's clothing* falls within the applicant's wider term *clothing*, it is my view that the goods are identical as per the principle in *Meric*. Even if *swimwear* was taken into account as per the applicant's arguments, it is considered that the goods would still be identical.

Average consumer and the purchasing act

40. 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 in question: *Lloyd Schuhfabrik Meyer*[9].

41. 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*[10], Birss J (as he then was) 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

42. The average consumer for the goods will be members of the general public as well as trade customers. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods, although this may be slightly higher for trade customers. The goods are likely to be self-selected from shelves within retail outlets, via online retailers, or in catalogues. In *New Look Limited v OHIM*[11], the GC stated that:

---

[9] Case C-342/97
[10] [2014] EWHC 439 (Ch)
[11] Joined cases T-117/03 to T-119/03 and T-171/03

> "50. […] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

43. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

Comparison of marks

44. 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 Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*[12], 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."

45. It would be wrong, therefore, to dissect the trade marks artificially, 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.

---

[12] Case C-591/12P

46. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
DREAM	DFFRNT DREAM

47. In the submissions, the opponent argues that "it is clear that "DREAM" will be regarded as being a dominant and distinctive element within the applicant's mark. The element "DFFRNT" meaningless". In the counterstatement, the applicant argues that the "inclusion of the distinctive element "DFFRNT" significantly alters the overall impression of the mark".

48. The opponent's mark is a plain, word mark written in uppercase. The word "DREAM" is defined in the Cambridge Dictionary in several ways, such as a noun meaning "a series of events or images that happen in your mind when you are sleeping" or as a verb "to dream" as meaning "to imagine something that you would like to happen". It is my view that a significant portion of consumers will understand the opponent's mark as being the imperative form of the verb instructing or encouraging the reader to "dream". As a word-only mark with no other elements, the overall impression lies in the word "DREAM".

49. The applicant's mark is a plain word mark written in uppercase. Neither party has made any submissions suggesting what the verbal element "DFFRNT" means. Whilst there may be some individuals who see this verbal element as being a string of random letters, it is my view that these consumers would not constitute a significant proportion of consumers. Instead, due to the established principle that consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them (*Usinor SA v OHIM*[13]), it is my view that the average consumer will read "DFFRNT" as "DIFFERENT" with its vowels omitted. The Cambridge Dictionary defines the adjective "different" as "not the same". As such, I am of the view that the two verbal elements "DFFRNT" and "DREAM" combine to form a unit, i.e. "DIFFERENT DREAM", with the former verbal element qualifying the noun "DREAM". I therefore disagree with the opponent that the term "DREAM" is more dominant within

[13] Case T-189/05

the applicant's mark. Instead, I find that overall impression of the mark lies in the combination of both verbal elements.

Visual similarity

50. In the submissions, the opponent argues that the marks are similar due to the comment element "DREAM" which it submits is "easily picked out from the applicant's mark". In its counterstatement, the applicant argues that the competing marks are not visually similar.

51. The competing marks are similar because the applicant's mark contains the word "DREAM" as its second verbal element, which is identical to the opponent's mark. The competing marks differ as the applicant's mark contains "DFFRNT" as its first verbal element. The beginnings of words tend to have more visual and aural impact than the ends[14], which, in my view, results in the visual difference created by the additional verbal element 'DFFRNT' being more significant. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the applicant's mark is visually similar to the opponent's mark to a low to medium degree.

Aural similarity

52. In its submissions, the opponent argues that the competing marks are similar. In relation to the additional verbal element "DFFRNT" in the applicant's mark, it states that "since there are no vowels, it is highly likely that this element of the mark would not be pronounced at all". In its counterstatement, the applicant argues that the competing marks are not aurally similar.

53. The opponent's mark is similar to the applicant's mark because of the identical word "DREAM". The marks differ as the applicant's mark also contains the verbal element "DFFRNT". As stated previously, it is my view that a significant portion of consumers will understand "DFFRNT" as the word "DIFFERENT", and they will therefore pronounce it in the ordinary way. The beginnings of words tend to have more visual and aural impact than the ends as per *El Corte Ingles*, which, in my view, results in the aural difference created by the additional verbal element 'DFFRNT' being more significant. Bearing in mind my analysis of the marks' overall impressions, I am of the

[14] See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

view that the applicant's mark is aurally similar to the opponent's mark to a low to medium degree.

Conceptual similarity

54. In its submissions, the opponent argues that the competing marks have a high level of conceptual similarity due to the comment element "DREAM". In the counterstatement, the applicant argues that the competing marks are not conceptually similar.

55. The marks are conceptually similar as they both refer to the concept of dreaming, albeit in slightly different capacities. As stated previously, the opponent's mark will be understood an aspirational statement or instruction encouraging the reader to "dream", i.e. imagine something happening. The word "DREAM" in the applicant's mark will be understood by a significant portion of consumers as the noun "DREAM". The marks differ as the applicant's mark also contains the verbal element "DFFRNT". As previously explained, I am of the view that although some consumers may view this string of letters as a random assortment of consonants, these consumers will not constitute a significant proportion. Instead, it is my view that the average consumer will understand this verbal element as the word "DIFFERENT", and they will therefore understand it as an adjective which qualifies the proceeding noun "DREAM". On this basis, the two verbal elements will combine to form a unitary meaning, i.e. a dream that is not the same. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the applicant's mark is conceptually similar to the opponent's mark to a low to medium degree.

Distinctive character of the earlier trade mark

56. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*[15], 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

[15] Case C-342/97

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)."

57. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

58. Although the opponent has filed evidence of use, I do not consider this evidence to be sufficient for the purposes of demonstrating that the opponent's mark had an enhanced degree of distinctive character at the relevant date of 30 December 2023. Whilst I acknowledge that the evidence demonstrates genuine use of the opponent's marks, and sales of DREAMS-branded goods into the UK, it is considered that the evidence does not show what share of the relevant market was held by goods sold under the opponent's marks. On the face of it, the sales figures are likely to only represent a small proportion of the relevant UK market. In addition to this, the evidence contains no figures in relation to advertising spend in the UK. Although Mr Sharif mentions in his witness statement that the opponent's attendances at trade exhibitions "give significant exposure… to customers throughout the UK and beyond", there is no information about how widely these trade events are attended. Furthermore, there are no details about any other advertising activities that it conducts, so it is my view that this is not sufficient to demonstrate the extent to which the average consumer of the

goods within the UK has been exposed to the opponent's marks. Taking all of these factors into account, it is my view that the evidence submitted does not support the establishment of enhanced distinctiveness. I therefore only have the inherent position to consider.

59. It its submissions, the opponent argues that "the opponent's earlier marks have no meaning in relation to the specified goods and is therefore of at least normal distinctiveness". In the counterstatement, the applicant submits that the word "DREAM" is "a common English word that lacks inherent distinctiveness".

60. As stated above, it is my view that the word "DREAM" will be viewed by a significant portion of consumers as an aspirational statement or instruction encouraging the reader to "dream", i.e. imagine something happening. As a common dictionary-defined word that has an aspirational quality but is not directly descriptive or meaningful in relation to the goods, it is considered that the opponent's mark has a low to medium level of inherent distinctiveness.

Global assessment – conclusions on likelihood of confusion

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

62. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

63. In its statement of grounds, the opponent argues that there is a likelihood of confusion between the competing marks due to the similarity of the marks and the identity of the goods. In the counterstatement, the applicant argues that "the inclusion of "DREAM" in both marks does not inherently lead to confusion, particularly given the unique and distinctive nature of "DFFRNT" in the applicant's mark".

64. Earlier in this decision I found that the applicant's goods are identical to the opponent's goods. The average consumer of the class 25 goods will be the general public and trade customers. The average consumer is likely to pay a medium amount of attention when purchasing the goods. I have found the marks to be visually similar to a low to medium degree, aurally similar to a low to medium degree, and conceptually similar to a low to medium degree. The opponent's mark has a low to medium level of inherent distinctive character.

65. The overall impression lies solely in the word "DREAM" in the opponent's mark, whereas the verbal element "DFFRNT" and the word "DREAM" contribute equally with within the applicant's mark's overall impression. The addition of the verbal element "DFFRNT" at the beginning of the applicant's mark constitutes a significant difference between the competing marks and it is unlikely that the average consumer would overlook this additional verbal element. It is my view that this difference, especially in the context of its placement at the beginning of the mark, is likely to be sufficient to prevent the average consumer from mistaking one mark for the other. I therefore find that there is no likelihood of direct confusion, notwithstanding the identical nature of the goods.

66. This leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*[16], Mr Iain Purvis Q.C., as the Appointed Person, explained 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

[16] BL O/375/10

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)."

69. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[17], Arnold LJ approved Mr Purvis's formulation but added:

"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

[17] [2021] EWCA Civ 1207

> be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

70. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*[18]). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks.

67. I also consider the relevance of *Medion v Thomson*[19] and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*[20], Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*[21] on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the

[18] BL O/547/17
[19] Case C-120/04
[20] [2015] EWHC 1271 (Ch)
[21] Case C-591/12P

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."

68. It is my view that the average consumer, paying a medium level of attention, would notice the differences between the marks but would not assume an economic link between the two undertakings. This is on the basis that the word "DREAM" is not so strikingly distinctive that the average consumer would assume that only the opponent was using it. Furthermore, it is my view that the applicant's mark will be understood as a unit with neither of the verbal components being an independent element which has a distinctive significance independent of the whole. As the applicant's mark will be understood as a unit, there is no sharing of an independent distinctive element which would give rise to indirect confusion. Furthermore, the visual, aural, and conceptual differences between the marks are not consistent with a brand extension or sub-brand of a house mark, so the average consumer is unlikely to interpret it in this manner. For instance, I see no reason why an undertaking would take the word "DREAM" and add the verbal element "DFFRNT", resulting in a different mark. Whilst I acknowledge that the categories in *L.A. Sugar* are not exhaustive, I can see no other basis for concluding that the average consumer would perceive the marks to be from the same, or economically linked, undertakings. Rather, it is my view that consumers would perceive the similarities between the marks as purely coincidental; in my view, they would be attributed to different undertakings using similar aspirational language relating to dreams. I therefore find that there is no likelihood of indirect confusion between the competing marks, notwithstanding the identity of the goods.

Final remarks

69. The opposition under section 5(2)(b) has failed its entirety. Subject to any successful appeal, the application will continue to registration.

Costs

70. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a counterstatement: £250

Considering the other side's evidence: £500

71. I note that the applicant considered and responded to the opponent's evidence. However, the relevant part of the scale covers preparing evidence and considering and commenting on the other side's evidence. The applicant did not file any evidence of its own and, as such, I have awarded a below-scale figure for this activity

72. I therefore order FLICK FASHIONS LIMITED to pay DFFRNT DREAM LTD the sum of £750. 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 23rd day of October 2025

K SERRAVALLE
For the Registrar