

O-366-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2648155 FOR REGISTRATION OF THE
TRADE MARK

REBOUND
Memory Foam Mattresses

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 400328

BY JOHN COTTON GROUP LIMITED

Background

1. On 9 January 2013, Joseph International Limited (“the applicant”) applied for the registration of the trade mark shown on the cover page of this decision in respect of the specification of goods recorded as follows:

Class 10:
Ortheapeodic mattresses

2. The application was published in the *Trade Mark Journal* on 1 March 2013. Following the publication, notice of opposition was filed by John Cotton Group Limited (“the opponent”). The opposition is founded on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), an objection under section 3(6) having been withdrawn during the course of proceedings. The opponent relies on the following:

Mark and No	Dates	Specification relied upon
1493284 REBOUND (ss5(2) and 5(3))	Filing date: 4 March 1992 Date of entry in register: 26 February 1993	Class 20 Pillows, cushions and sleeping bags; all included in Class 20 Class 24: Bed linen; duvets and duvet covers; bed sheets and pillow cases; cushion covers and table covers; sleeping bags; all included in Class 24
2448045 REBOUND (ss5(2) and 5(3))	Filing date: 28 February 2007 Date of entry in register: 15 August 2008	Class 22 Wadding; wadding for mattresses; wadding for sleeping bags; wadding for duvets
REBOUND (s5(4)(a))	Date of first use: 1994	Use throughout the UK on wadding; wadding for mattresses; wadding for sleeping bags; wadding for duvets; pillows, cushions and sleeping bags; bed linen; duvets and duvet covers; bed sheets and pillow cases; cushion covers and table covers

3. The applicant filed a counterstatement in which, essentially, it denied all the claims made. It also requested the opponent to prove use of its marks. I will return to this in due course. Only the opponent filed evidence. Neither party sought a hearing nor did they file written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the written material before me.

The objection under section 5(2)(b) of the Act

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

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

6. In these proceedings, the opponent is relying on the trade marks as set out in paragraph 2 above. Each of them is an earlier mark under the above provisions. In its counterstatement, the applicant requested the opponent to prove use of both of its earlier marks, however, given the interplay between the publication date of the applied for mark and the dates of entry in the register of the earlier marks, the requirement to prove use set out in section 6A of the Act is relevant only to the opponent’s mark no 1493284. Section 6A of the Act reads:

“6A (1) This section applies where-

an application for registration of a trade mark has been published, there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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-

within the period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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)

(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.

(7)....”

7. Also of relevance is section 100 of the Act which states:

“100. 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.”

8. The relevant period in which the opponent is required to prove use of its earlier mark no 1493284 is 2 March 2008 to 1 March 2013.

9. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

The opponent's evidence

10. This consists of witness statements from Stephen Swalwell, the Group Secretary of the opponent company and Laura West who states she is a part-qualified trade

mark attorney with Mathys & Squire LLP, the opponent's legal representatives in these proceedings.

11. Mr Swalwell states his company began trading in 1916 in Mirfield, West Yorkshire. He states it is a leading manufacturer and wholesaler in Europe of pillows, duvets, mattress protectors and related soft furnishings and also sells raw materials in semi-finished form for making up into finished products.

12. Mr Swalwell states:

“My company developed a product in 1992 which became very popular in the retail of the aforementioned goods due to its good quality and affordable price. We named this product ‘REBOUND’ and have since used the mark for use in the production of a number of bedding items in various well-known retail outlets. Products have been sold since this date under the REBOUND brand, albeit often branded differently by each re-seller due to the trading agreements we operate.”

He goes on to state:

“My company's products are sold to consumers through licensed retail outlets and independent retailer stockists in the United Kingdom, of which there are a number. All of these outlets, ranging from small stockists with single outlets to major retail outlet chains such as Tesco, Matalan, Sainsbury's and Dunelm Mill, sell my company's products under the REBOUND brand.”

13. Mr Swalwell states his company has “made significant sales of its REBOUND branded products throughout the United Kingdom for a number of years. Since 2009, in excess of £25million has been attributed to this brand”. At SS6 is what he says is a “breakdown of total sales figures for these products” since 2009. The information is as follows:

2009	£3.1m
2010	£4.2m
2011	£5.2m
2012	£4.0m
2013	£4.7m
2014	£3.6m

14. No information is given as to how much of the 2013 figure relates to within the relevant period, however, it is likely to be a very small part of it given that the relevant period ended on 1 March of that year. The 2014 figures are outwith the relevant period. These are said to be ‘total’ sales figures and Mr Swalwell has not broken down those figures by product.

15. At SS2, Mr Swalwell exhibits printouts taken from the internet which he says show “examples of my company's products on sale at a number of the selected retailers.” The quality of the print of the 28 pages forming the exhibit is very poor but they are, as follows:

Pages 1-17: Extracts downloaded from the webarchive.org website on 24 February 2014. I am able to see a Dunelm Mill logo and, at the top of each page, the heading "Rebound Mattress Topper/Dunelm Mill. At page 15 it shows product details which, as far as I can see, reads: "Add an extra layer of comfort to your bed and get the restful night's sleep you deserve with our Rebound Mattress Topper..." Further down the page it gives other details which include: "Brand: Dunelm". On page 16 is a graphic headed "Product Image". Whilst there is an image within the box underneath, which appears to be some sort of package with words written on it, I cannot see what those words are.

Pages 18-21: Pages taken from the Tesco website showing 'Slumberdown Rebound Pillow 2 pack'. The pages bear a download date of 24 February 2014.

Pages 22-23: Pages taken from the Sainsburys website showing 'Tu Rebound Pillow Pair'. The pages bear a download date of 24 February 2014.

Pages 24-26: Pages taken from the Asdadirect website. They are headed "Slumberdown Rebound Pillow Pair" and show a graphic though I cannot see what the graphic actually shows. The pages bear a download date of 24 February 2014.

Pages 27-28: Pages taken from the Matalan website. The pages are headed "Homestore Medium Rebound Pillow Pair" and "Homestore Rebound Mattress Protector" and bear a download date of 24 February 2014.

16. At SS3, Mr Swalwell exhibits internet printouts taken from a number of websites which he says "show customer reviews of our products dating back as early as 2008, thereby demonstrating sales under the REBOUND brand prior to the Applicant's application". They are:

Page 30: From the Homebase website. I can see that it is headed "John Cotton Pair of Rebound Pillows but cannot read any other text on the page. It has a download date of 24 February 2014.

Pages 31-32: From the Sainsburys website, headed Tu Rebound Pillow Pair and showing a price of £10. Whilst it appears to contain some reviews, the quality of the print means I cannot read what they say or when they might have been posted. The pages have a download date of 24 February 2014.

Pages 33-34: From the Argos website. Headed John Cotton pair of Rebound Pillows they appear to show customer reviews though I cannot see the reviews themselves or the dates they were posted. The pages have a download date of 24 February 2014.

Pages 35-40: Taken from the Reevoo website showing Tesco Rebound Cotton Cover Pillow Twinpack reviews. Said to show 14 reviews, I can only see 10. The reviews bear dates between June 2009 and February 2011.

Pages 41-43: Taken from the Dunelm website and headed Rebound Mattress Topper. The reviews are dated April and May 2013.

17. Also exhibited are the following:

SS4: Pages said to be “highlighted Google results which show how many returned relate to goods produced by my company. The extent of our company’s brand on this market is evidenced and the number of items and the spread across the market is also clear.” I do not know how many results may have been returned from whatever search(es) was/were carried out but all that is exhibited are four pages, two showing download dates of 21 January 2014 and two, 12 February 2014.

SS5: 3 pages said to show design documents for packaging. As far I can see they are not dated.

18. Ms West’s evidence is no more than a vehicle for some brief submissions and for this reason I do not intend to summarise it save to say that, by way of exhibits LW1 and LW2, she draws attention to two decisions of the Community Trade Mark Office.

Findings on the evidence of use

19. As set out above, earlier mark 1493284 is registered for a range of goods in classes 20 and 24. There is no evidence of any sort which shows use of the mark in relation to cushions and sleeping bags as are registered in class 20, nor any of the goods as registered in class 24 with the exception of duvets. The evidence in relation to the remaining goods, pillows and duvets, comes from Mr Swalwell’s witness statement. He states that his company began trading in relation to these goods in 1916 and first used the mark REBOUND in 1992 but he does not give any indication of what the position might have been within the relevant period which, I remind myself, is 2 March 2008 to 1 March 2013. He gives sales figures which include the years 2009 to 2013, however, as indicated earlier, these figures are said to be total sales and are not broken down by product. The documentation exhibited is of very poor quality and relates to sales by third parties. Leaving aside the question of whether any such sales would accrue goodwill to the opponent, I can see that the vast majority of it was downloaded from the internet in 2014 and so dates from after the relevant period. The exception is that at SS2, pages 35-40. As indicated above, these are said to be reviews from purchasers of pillows and which bear dates between June 2009 and February 2011. Most are anonymous but four are said to be from people in Trowbridge, Glasgow, Kent and Cornwall. I have no reason to doubt that these are not genuine posts, however, in none of them are details given of when or where the products they are reviewing were purchased or under what mark and I consider them to be insufficient to show genuine use of the mark in respect of these goods.

20. In short, the opponent has failed to show use within the relevant period of its earlier mark no 1493284 in relation to any of the goods for which it is registered. That being the case, it is not entitled to rely on this mark in respect of these goods and I make no further mention of it.

21. As the proof of use requirements are not applicable to the opponent's earlier mark no 2448045, however, the opponent is entitled to rely on this mark in respect of all goods for which it is registered and I go on to consider the objections further.

The objection under section 5(2)(b)

22. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd - BL O/330/10* (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

23. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of the respective goods

24. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
Wadding; wadding for mattresses; wadding for sleeping bags; wadding for duvets	Ortheapeodic mattresses

25. In its statement of grounds, the opponent submits that the respective goods are highly similar in composition and nature and further submits that:

“the goods covered by the Opponent's trade mark are necessary in order to produce the mattresses covered by the Application at issue. Not only are they therefore similar goods, they are also complimentary (sic) to the extent that

one cannot be sold without the other. They are part of the same trade process”.

In relation to the respective users of the goods it submits:

“The user group for the goods offered by the parties is identical and/or highly similar.”

26. In her witness statement, Ms West submits:

“...wadding for mattresses should be deemed similar to orthopaedic mattresses as they are used together and both aim to facilitate sleep. Moreover, they are, by their very nature, always bought together (as one is a crucial element within the other) and can therefore have the same end user and distribution points.”

27. In its counterstatement the applicant submits:

“The Opponent has suggested that our Goods are highly similar in composition to the Goods covered by the Opponent’s Mark. The Opposition applied for Classes 20 and 24 and if the Opposer was of this Opinion then the question has to be asked as to why the Opposer didn’t make an application to include Class 10.

Class 10 covers Orthapeodic (sic) Articles and the Applicant does not believe the Opposition Goods have any connection to this Category. The Opposition does not sell Mattresses or Beds, the argument suggesting that the Goods are complimentary (sic) to a Mattress surely cannot stand on the Basis that the Goods that the Applicant manufactures are specifically catered for Orthapeodic (sic) Articles, The Applicant Goods do not travel through the same Trade channels as the Opposition.”

28. It goes on to submit:

“The Fact remains that the Opposition has not applied to cover the Goods in this Class and the Applicant is only applying in this Category and not the Classes that the Opposition has filed their Goods under.

The Opponent has suggested that our Goods are highly similar in Composition to the Goods covered by the Opponent’s Mark.

The Applicant contests the statement that the Applicant requires the Opposition Goods to manufacture the Mattresses and the Applicant invites the Opposition to prove this point. Wadding has a wide definition and again the Applicant has not applied in Class 22.

...

The Opposition is not a manufacturer of Mattresses or Beds.”

29. Before I go on to compare the respective goods, I pause to address some of the applicant's submissions. In doing so, I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

30. I also bear in mind the findings of the same court in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59)."

31. It is clear from these cases that regardless of the way the parties have conducted their businesses in the past, or may intend to in the future, the goods I have to compare are those as registered and applied for.

32. The applicant makes much of the fact that the respective goods are classified in different classes. The significance of the process of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] R.P.C. 639, by the Court of Appeal, and in *Avnet Incorporated v. Isoact Limited* [1998] F.S.R. 16, by the High Court. In *Proctor & Gamble Company v. Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

"32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

33. It is clear from these cases that the fact that the goods to be compared appear in different classes is not something that is determinative of (dis)similarity.

34. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (a) The respective uses of the respective goods;
- (b) The respective users of the respective goods;
- (c) The physical nature of the goods;
- (d) The respective trade channels through which the goods reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify the goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.”

35. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

36. In relation to what constitutes complementary goods and services, the following comments of the General Court in *Boston Scientific Ltd v OHIM* Case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM –Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM –Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM –Bolaños Sabri (PiraÑam diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

37. Also of relevance in determining whether goods are complementary are the comments of the appointed person Mr Daniel Alexander Q.C. in *Sandra Amalia Mary Elliott and LRC Products Limited* (BL O-255-13).

38. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

39. Finally, in considering the issue of similarity, I also bear in mind the findings of the CFI in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished

goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

40. The opponent’s specification includes wadding at large as well as wadding for specific purposes including for mattresses. Wadding is a semi-finished product used in the manufacture of other products. Contrary to the opponent’s submission that it is used to “facilitate sleep”, I consider its use is to provide padding within a finished article, be that e.g. a chair, a cushion or mattress. The user is most likely to be a business such as an upholsterer or furniture manufacturer but could also include hobbyists and crafters who make or refurbish goods for their own domestic use. Wadding is sold through specialist suppliers such as textile manufacturers, haberdashers and craft supply stores. Mattresses are finished products which are items of furniture intended to provide a comfortable sleeping platform (whether or not as part of a bed) and are bought by members of the general public for their own use but are also items bought by businesses or organisations such as hotels and hospitals. They are sold through furniture suppliers. The users, uses and nature of the respective goods differ as do the channels of trade. I reject the opponent’s submission that “one cannot be sold without the other” by which I take it to mean a mattress cannot be sold without wadding. Whilst some mattress may incorporate wadding, I have no evidence that all mattresses use it. Even if they did, that does not, as per the case law referred to above, make them similar. One is not a substitute for the other. I do not consider that the average consumer would consider that responsibility for the respective goods lies with the same undertaking and thus I find the respective goods not to be complementary. Taking all matters into account, I find the respective goods to be dissimilar, however, if I am wrong in this finding, then any similarity is a very low one. On this basis, I go on to consider the matter further.


The average consumer and the nature of the purchasing process

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

42. As also indicated above, the average consumer for wadding is most likely to be a business who wishes to use it as a component in another product, though I do not exclude the possibility that it may also be purchased by an individual (e.g. as part of hobby or DIY activities). The average consumer for mattresses could be a member of the general public or a business or other organisation. I am aware from my own experience that wadding can be an inexpensive purchase but can be e.g. made of different materials and come in different weights (density) and therefore it is likely that a reasonable degree of care will be taken with the purchase to ensure that the product is suitable for the use to which it is intended to be put. Mattresses are goods that are bought by the general public but are an infrequent purchase which, coupled with the likely cost and need to ensure they are of the required size, composition and comfort level means a fairly high degree of care is likely to be taken.

Comparison of the respective marks

43. The marks to be compared are:

Opponent's earlier mark	Applicant's mark
REBOUND	

44. The earlier mark consists of the word REBOUND in plain block capitals. As a single word, no part of which is highlighted in any way, any distinctiveness rests in its whole. The applicant's mark includes the word REBOUND in upper case with the middle letters BOU in a somewhat rounded and magnified form as if being viewed through a magnifying glass or coming closer to the viewer. Underneath are the non-distinctive words Memory Foam Mattresses in title case. Whilst the applicant's mark has a degree of stylisation, there is a high degree of visual, aural and conceptual similarity between the respective marks due to the presence in both of the dominant word REBOUND.

The distinctiveness of the earlier mark

45. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

46. The word REBOUND is an ordinary dictionary word in common use and will bring to mind something that springs or bounces back. Whilst it is clear from the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, that it is not permissible for me to regard the opponent's earlier mark as having no distinctive character, the word REBOUND must, in my view, and absent use, be possessed of a very low degree of inherent distinctive character in relation to goods which provide a touch of bounce or padding.

47. I set out above the evidence of use filed by the opponent. Whilst he states the opponent has been trading since 1916, Mr Swalwell also states the REBOUND product was not developed until 1992. He gives no details of the extent of that use at that time. Whilst he provides sales figures for a number of years, those figures are said to relate to "total" sales on a variety of goods. Whilst the evidence shows sales by third parties, those sales are very much made under those third parties' own trade marks in such a way that I am unconvinced the word REBOUND would be given any trade mark significance and certainly none that would enhance the distinctiveness of the earlier mark for the opponent. In any event, this third party material does not

show what the position might have been at the relevant date given the date it was downloaded. In my view the evidence is insufficient to enable me to find the earlier mark has any enhanced distinctive character through its use at the relevant date, 13 January 2013.

The likelihood of confusion

48. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

49. Earlier in this decision I found:

- If there is any similarity between the respective goods, it is, at best, a very low one;
- The goods are such as would be the subject of a least a reasonable degree of care over their purchase;
- The respective marks have a high degree of visual, aural and conceptual similarity;
- The earlier mark has a very low degree of inherent distinctiveness which has not been shown to have been enhanced through its use.

50. Taking all matters into account, I find that there is no likelihood of confusion. The distance between the goods and the very low level of distinctiveness in the earlier mark, which has not been shown to have been enhanced through use, obviates against it. The presence in the applicant's mark of the words Memory Foam Mattresses, creates further distance. The opposition brought under section 5(2)(b) of the Act fails.

The objection under section 5(3)

51. Section 5(3) of the Act states:

“ A trade mark which-

- (a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

52. Whilst there is no requirement under this section for there to be similarity between the respective goods, the opponent must show that it has a reputation. Reputation means that an earlier trade mark relied upon is known by a significant part of the public concerned with the goods covered by that mark (see paragraph 26 of the CJEU's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking promoting it.”

53. I set out above the totality of the opponent's evidence of use. Whilst Mr Swalwell states that his company “developed a product in 1992” which they named REBOUND and exhibits figures said to show total sales of a variety of goods under the mark in the period 2009-2014, the evidence gives no detail which allows me to determine the market share held by the trade mark, the intensity or geographical extent of that use or the size of the investment made in promoting it. The opponent claims it is a “leading manufacturer in Europe” but gives no indication of how it reaches that view or how this affects the position in the UK. There are no details of how the mark may have been promoted nor is there any evidence from the trade or the relevant public. In the circumstances, I find that the opponent has not shown it has the requisite reputation. That being the case, the objection under this ground fails.

The objection under section 5(4)(a) of the Act

54. Given my findings above on the evidence of use, I fail to see how the opponent can be in any better position under this ground than under the grounds I have already considered and I decline to deal with it further.

Summary

55. The opposition fails on each ground on which it was brought.

Costs

56. The applicant having succeeded, it is entitled to an award of costs in its favour. In making the award I take into account that a case management conference (“CMC”) took place at which both parties were represented and at which I allowed the opponent an extension of time to file its evidence; the only evidence filed was that filed by the opponent; the decision has been reached without a hearing taking place; and, that neither party filed written submissions in lieu of attendance at a hearing. I make the award on the following basis:

For filing a statement and reviewing the other party's statement:	£400
For reviewing evidence:	£300
For preparation for and attendance at the CMC:	£100
Total:	£800

57. I order John Cotton Group Ltd to pay Joseph International Ltd the sum of £800 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of August 2014

**Ann Corbett
For the Registrar
The Comptroller-General**