

O-250-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NOS 3 057 748: MEDI-MATT and 3 061 416: MEDI-FOAM IN CLASS 20 IN THE NAME OF BREASLY PILLOWS LIMITED

AND

IN THE MATTER OF AN APPLICATION FOR INVALIDATION BY THE FOAM COMPANY LIMITED

Background and pleadings

1. This invalidation decision concerns two registrations in the name of Breasly Pillows Limited, the Registered Proprietor (RP): No 3 057 748: MEDI-MATT and 3 061 416: MEDI-FOAM respectively. These were entered into the Register on 05/09/2014 and 10/10/2014 in respect of mattresses in Class 20. The application for invalidation is by The Foam Company Limited (FCL) and founded upon grounds under sections 3(1)(b) and (c). The original claim also included a ground under Section 5(4)(a) of the Act in respect of both registrations. However, in an email to the Registry dated 2nd July 2015, the applicant for invalidation confirmed that it did not wish to pursue this ground in respect of 3 057 748 MEDI-MATT as it had been included in error. Thus the TM26I was amended in respect of this trade mark registration to reflect this. The RP filed a counterstatement denying all the grounds of invalidation in respect of both trade mark registrations.
2. The proceedings were consolidated. Only FCL has filed evidence and the relevant parts will be summarised below. No hearing was requested though submissions were filed by the RP in lieu. These have not been summarised but have been taken into account in reaching this decision. This decision is taken following a careful perusal of the papers.

Legislation

Section 3(1)

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 47

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

Evidence filed

3. As already stated, only FCL filed evidence. This is in the form of a witness statement, from Michael Nash, the Managing Director for FCL. He explains that FCL have been trading using the sign MEDICAL GRADE FOAM under an agreement with Mammoth Sport Limited within the UK since October 2011. Exhibit 1 of the witness statement contains the results of a google search. When MEDI FOAM is typed into the search engine, it is Mammoth Sport Ltd and the website www.mammothmattress.co.uk which is returned first. Exhibit 2 contains the results of a google search for MEDI-FOAM. According to Mr Nash, the top 3 references are to MEDI FOAM in a descriptive sense – a foam used for wound care. However, it is noted that the results returned include the term Medi Foam used as a trade mark along with an explanation as to what the product sold under the mark does. I do not therefore reach quite the same conclusion as Mr Nash as to the significance of these results.
4. Mr Nash goes on to describe Exhibit 3 which is an extract from the RP's website in respect of its Medi Foam products. It is noted that in its product description, the mattress is described as being a medical grade foam mattress. Mr Nash argues that this is use of its marketing term. And much is made of the fact that the term medical grade foam was "invented" by the applicant as consumers could more easily understand its meaning and associate it with mattresses used in hospitals and nursing homes etc. However it is considered that this would be an obvious way of describing such a product. This is so even if other terms could also be used, such as high specification foam, medical foam etc. Mr Nash claims that MEDICAL GRADE FOAM was first used by the applicant in October 2011 in a trade price list and in brochures from June 2012 onwards (Exhibits 6 and 7 corroborate this). Exhibit 8 contains examples of numerous publications in which the applicant's products have been advertised including OMYoga, Cycling Plus, Health and Fitness Magazine, Women's Running Magazine etc. It is noted that MAMMOTH is clearly the "trade mark" and MEDICAL GRADE FOAM the descriptor for the type of mattress. Indeed one of the adverts provided includes the line "Mammoth mattresses use Medical Grade Foam which provides a greater level of comfort and support than traditional memory foam".

5. Turnover and advertising figures are provided. These do not appear to be specific to MEDICAL GRADE FOAM products so are difficult to place into the correct context. The products in question are also fairly expensive (running to several hundred pounds) and so a total turnover of around £500,000 for all mattresses sold each year between 2001 and 2015 is not hugely impressive. Advertising spend is around £100,000 per each of the years mentioned. These figures are corroborated by the financial reports included in the evidence.
6. In respect of the RP's MEDI-MATT, Mr Nash explains that Exhibit 19 to his witness statement contains a print out from the RP's website. He argues that this information clearly shows that the MEDI-MATT brand is leaning towards the healthcare/medical route, specifically with its colour scheme (green), healthy heart symbol and healthcare cross. Finally, Mr Nash describes the contents of Exhibit 19. He argues that this shows the term MEDI-MATT in use by a company called Medaco. According to Mr Nash, this term has been used by this company for over 15 years, again in respect of mattresses focussed at health care. Exhibit 19 also shows a printout of further results from a google search. The search term is "what is "medi" short for in terms of health care". A list of websites is returned, all of which appear to include the term "Medical".

Section 3(1)(b)and(c) – General:

7. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

8. Bearing in mind the aforesaid, it is clear that Section 3(1)(b) and (c) must be considered independently of one another. I will first assess the ground under Section 3(1)(c).

Section 3(1)(c)

9. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in

use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the

application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

10. In terms of distinctiveness and descriptiveness, this must be assessed via the perception of the relevant public – as well as the average consumers of the goods, this also includes those in the trade.

11. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004]

ECR I-1619, paragraph 77; and Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50).”

12. In *Exalation v OHIM*, Case T-85/08, the General Court confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

“38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner’s observations to the effect that the element ‘lycopin’ (lycopene) designated a carotenoid with antioxidant properties.

39 For the first time at the hearing, the applicant challenged the Board of Appeal’s assessment that the term ‘lycopin’ is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term ‘lycopin’ by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element ‘lycopin’ by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term ‘lycopin’ was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term ‘lycopin’ does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term ‘lycopin’ will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term ‘lycopin’.

43 The relevant public must therefore be regarded as being aware of the meaning of the term ‘lycopin’, or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above).”

13. The questions relevant to these grounds of invalidation must be assessed and answered with reference to the goods for which these trade marks are protected. I will consider the trade mark MEDI-FOAM first which is registered in respect of mattresses in Class 20.

14. The position of FCL is that the term MEDICAL is a known abbreviation for MEDICAL. As such, the addition of the word FOAM does not elevate the combination into acting as a badge of origin. Rather it describes the product: a mattress made from a foam specific to aid comfort for those with particular medical conditions and/or ailments. Much is made of google search results in support of this line of argument. However, such reliance is far from fool proof. Search engines are designed to bring back results based on the combination of letters used as a search term. They are also designed to pick out particular letters and to fill in gaps. As such, it is unsurprising that a search for medi-foam would return results which include MEDICAL, FOAM and indeed MEDICAL GRADE FOAM. I fail to see how such results should lead to the conclusion that MEDI-FOAM as a combination is clearly descriptive in respect of mattresses. It is my view that this combination, though not the most creative, is at worst merely allusive of a potential function of such a mattress or what such a mattress may contain as one of its core materials. This is true when considered from the perspective of the relevant consumer in the trade, i.e. healthcare professionals and also the general public. It is not descriptive and as such, the ground of invalidation under Section 3(1)(c) fails.
15. Turning now to MEDI-MATT, which is also registered for mattresses in Class 20. Although not the same mark as MEDI-FOAM, similar arguments apply, namely that MEDICAL is a known abbreviation of medical and the addition of matt does not assist nor avoid its essential descriptiveness: that these are mattresses which can be used by those with a medical condition and/or ailment. Evidence is provided which consists of use of the term by a third party, alongside pictures of mattresses which appear flexible whereas regular mattresses are not (they can be raised and lowered for example). That a third party uses the term does not assist FCL in my view as this third party is clearly using the term in a trade mark sense. Further, the pages from the RP's website do not assist: the combination of MEDI-MATT is comprised of an abbreviation of medical and an abbreviation of mattress. However in combination, this does not, in my view, render the trade mark as descriptive. It alludes, but does not directly describe. As above, this is true from both the perspective of a healthcare professional and the public at large. As such, the claim under Section 3(1)(c) fails.

Section 3(1)(b)

16. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character

for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17. I will consider the position in respect of MEDI-FOAM first. Bearing in mind the findings under Section 3(1)(c) above, I must now consider whether, even if not descriptive, the mark is in any case devoid of distinctive character in respect of mattresses. Foam is clearly non distinctive for mattresses as it can be used as a material to manufacture such goods. Medi may be a known abbreviation for medical (though this is not conclusively proven). In any case, even if it is, in my view the combination of terms and their overall presentation lend a distinctive spark to the combination as a whole. The ground under Section 3(1)(b) as regards MEDI-FOAM therefore fails.

18. The position as regards to MEDI-MATT is similar. Indeed in respect of this trade mark, it is even clearer: Matt is not a known abbreviation for mattresses and is unusual. Its combined form with MEDI and its overall presentation is considered to be clearly not devoid of distinctive character and a perfectly acceptable trade mark. The ground under Section 3(1)(b) also fails here.

Passing Off – Section 5(4)(a)

19. As already stated, this applies only to the MEDI-FOAM trade mark and is based upon use of an earlier sign, namely MEDICAL GRADE FOAM.

Legislation

Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

General principles of Section 5(4)(a)

20. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

21. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

GOODWILL

22. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the court said:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

MISREPRESENTATION

23. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me

that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

24. In these proceedings, the earlier sign pleaded is MEDICAL GRADE FOAM and I can see no evidence that goodwill in the earlier business attaches purely to this name as it is clearly an obvious descriptor for the products sold under the term. Rather any goodwill attaches to MAMMOTH, which is the distinctive feature used with the descriptor MEDICAL GRADE FOAM throughout the evidence filed. MAMMOTH is not pleaded in the Notice of Opposition. However for the sake of pragmatism, I will consider the matter in respect of both MAMMOTH MEDICAL GRADE FOAM (which is what the evidence focusses upon) and, in the event I am incorrect as regards goodwill, MEDICAL GRADE FOAM alone.
25. It is true that the parties appear to operate in the same fields of activity; indeed they will be used on the same products, namely mattresses. However, the earlier sign is MAMMOTH MEDICAL GRADE FOAM and the later mark is MEDI-FOAM. As I have already found that MEDICAL GRADE FOAM is a clear, unequivocal descriptor, it is clear that the presence of MAMMOTH is that which goodwill will attach to. It is difficult to see how a consumer could be deceived here as the signs are entirely different. There is considered to be no misrepresentation.
26. As regards MEDICAL GRADE FOAM alone, FCL is even worse off. Without wishing to repeat oneself, this is clearly purely descriptive, whereas the later mark has more than a spark of distinctiveness to it. I note that Mr Nash makes much of internet results from a search of MEDI-FOAM which brings back MEDICAL GRADE FOAM products. However, as I have already found, it is considered that this proves only that a search engine is working correctly in picking out particular letters, filling in gaps and returning results on that basis: MED FOAM or even M FOAM as a search term could well produce the same result. It proves no more than that. It is concluded that the clear differences between MEDI-FOAM and MEDICAL GRADE FOAM ensure no one is deceived here, let alone a substantial number. There is no misrepresentation here either.
27. The application for invalidation as based upon Section 5(4)(a) therefore fails.
28. The sum of all this is that the application for invalidation fails in its entirety.

COSTS

29. The Registered Proprietor has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Registered Proprietor the sum of £1050 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering invalidation application and accompanying statement: £400

Statement of case in reply: £300

Considering evidence and filing submissions: £350

30. I therefore order The Foam Company Limited to pay Breasly Pillows Limited the sum of £1050. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH day of May 2016

Louise White

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