

O/323/20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3397274 BY
RABECA SHAHEEN SHAHID
TO REGISTER:**

CosyDreams

AS A TRADE MARK IN CLASSES 20 & 24

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 417380 BY
DREAMS LIMITED**

BACKGROUND AND PLEADINGS

1. Ms Rabecca Shaheen Shahid (“the applicant”) applied to register **CosyDreams** as a trade mark in the United Kingdom on 6 May 2019. The application was accepted and published on 17 May 2019 in respect of the following goods:

Class 20

Nursing pillows; U-shaped pillows; Pillows; Maternity pillows; Nursing pillows.

Class 24

Duvets; Textile covers for duvets; Covers for pillows.

2. On 19 August 2019, the application was opposed by Dreams Limited (“the opponent”). The opposition was originally based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), although the section 5(3) ground was withdrawn during the evidence round, and concerns all the goods in the application.

3. The opponent is relying upon the following earlier EU Trade Marks (“EUTMs”):

a) EUTM 017963494 (“the 494 mark”)

DREAMS

Filing date: 1 October 2018

Registration date: 15 February 2019

In this opposition, the opponent is relying on the following goods and services:

Class 20

Furniture; bedroom furniture; mirrors; beds; water beds; divans; bedsteads; headboards; bedding, other than bed linen; pillows; mattresses; open spring and pocket spring mattresses; memory foam and latex mattresses; futons; air cushions and air pillows; air mattresses; bed casters not of metal; bed fittings not of metal; chairs; armchairs; cabinets; chests of drawers; desks; footstools; cots and cradles; parts and fittings for all the aforesaid goods.

Class 24

Textiles; fabrics and textiles for beds and furniture; bed linen; duvets; bed covers; bed blankets; bed clothes; covers for duvets; mattress covers; covers for pillows and pillow cases; covers for cushions; bedspreads; covers for hot water bottles; furniture coverings of textile; quilts; parts and fittings for all the aforesaid goods.

Class 35

Retail services relating to the sale of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, non-medicated soaps, perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, scents, fragrances, oils for perfumes and scents, perfumeries, room scenting sprays, scented fabric refresher sprays, scented linen sprays, scented oils, scented room sprays, air fragrance preparations; Retail services relating to the sale of air fragrance reed diffusers, air fragrancing preparations, aromatics for fragrances, cleaning and fragrancing preparations, Cushions filled with fragrant substances, cushions impregnated with fragrant substances, fragrance for household purposes, fragrance preparations, fragrance refills for non-electric room fragrance dispensers, fragrance sachets, refills for electric room fragrance dispensers, room fragrances, room fragrancing products; Retail services relating to the sale of Scientific, measuring, checking (supervision), life-saving and teaching apparatus and instruments, data processing equipment, computer software, computer hardware, mobile apps, downloadable software applications, wearable monitors, monitoring instruments, monitoring apparatus, other than for medical purposes, monitoring units [electric], electronic sensors, bio-sensors, movement sensors; Retail services relating to the sale of sensors for scientific use to be worn by a human to gather human biometric data, electronic tracking apparatus and instruments, wearable activity trackers, measuring apparatus and instruments, computer software in the field of tracking, monitoring and analysing of sleep, movement and heart rate [other than for medical use]; Retail services relating to the sale of mobiles apps in the field of tracking, monitoring and analysing of sleep, movement and heart rate, downloadable software applications in the field of tracking, monitoring and analysing of sleep, movement and heart rate; Retail services relating to the sale of medical and surgical apparatus and instruments, namely medical devices for sensing, measuring, diagnostic and treatment purposes in the field of sleep including wearable medical devices to be worn while sleeping, Pulse rate monitors, medical devices for measuring sleep, precision sensors for medical use, sensor apparatus for medical use; Retail services relating to the sale of apparatus for lighting, lighting, light bulbs, lamps and light sources, lighting connected to alarm clocks, luminaires, controllable light sources and lighting apparatus, filters for lighting appliances; Retail services relating to the sale of horological and chronometric instruments, clocks, alarm clocks, electronic alarm clocks, alarm clocks which use light to wake-up users, alarm clocks with in-built lights; Retail services relating to the sale of furniture, bedroom furniture, mirrors, beds, water beds, divans, bedsteads, headboards, bedding, pillows, mattresses, open spring and

pocket spring mattresses, memory foam and latex mattresses, futons, air cushions and air pillows, air mattresses, sleeping bags, bed casters not of metal, bed fittings not of metal, chairs, armchairs, cabinets, chests of drawers, desks, footstools, cots and cradles; Retail services relating to the sale of household or kitchen utensils and containers, articles for cleaning purposes, scent sprays [atomizers], air fragrancing apparatus, aerosol dispensers, not for medical purposes, perfume burners, perfume vaporizers, perfume sprayers, plug-in diffusers for mosquito repellents, plug-in diffusers for air fragrancing; Retail services relating to the sale of textiles, fabrics and textiles for beds and furniture, bed linen, duvets, bed covers, bed blankets, bed clothes, covers for duvets, mattress covers, covers for pillows and pillow cases, covers for cushions, bedspreads, covers for hot water bottles, pyjama cases, furniture coverings of textile, eiderdowns, quilts, parts and fittings for all the aforesaid goods; all the aforesaid provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order or catalogues or by means of telecommunications; information, advisory and consultancy services relating to all of the aforesaid.

b) EUTM 012933362 (“the 362 mark”):



Filing date: 3 June 2014

Registration date: 14 October 2014

Colours claimed: Purple; Pink

The mark is registered for the following goods and services, all of which the opponent is relying on:

Class 20

Furniture; bedroom furniture; mirrors; beds; water beds; divans; bedsteads; headboards; bedding, other than bed linen; pillows; mattresses; open spring and pocket spring mattresses; memory foam and latex mattresses; futons; air cushions and air pillows; air mattresses; sleeping bags; bed casters not of metal; bed fittings not of metal; chairs; armchairs; cabinets; chests of drawers; desks; footstools; cots and cradles; parts and fittings for all the aforesaid goods.

Class 24

Fabrics and textiles for beds and furniture; bed linen; duvets; bed covers; bed blankets; bed clothes; covers for duvets; mattress covers; covers for pillows and pillow cases; covers for cushion; bedspreads; non-fitted covers of textile or fabric for hot water bottles; pyjama cases; furniture coverings of textile; quilts; parts and fittings for all the aforesaid goods.

Class 35

Retail services relating to the sale of furniture, bedroom furniture, mirrors, beds, water beds, divans, bedsteads, headboards, bedding, pillows, mattresses, open spring and pocket spring mattresses, memory foam and latex mattresses, futons, air cushions and air pillows, air mattresses, sleeping bags, bed casters not of metal, bed fittings not of metal, chairs for beds and furniture, bed linen, duvets, bed covers, bed blankets, bed clothes, covers for duvets, mattress covers, covers for pillow and pillow cases, covers for cushions, bedspreads, covers for hot water bottles, pyjama cases, furniture coverings of textile, eiderdowns, quilts, parts and fittings for all the aforesaid goods, all provided in a retail furniture and bedding superstore, online via the Internet or other interactive electronic platforms, via mail order to catalogues or by means of telecommunications; information, advisory and consultancy services relating to all of the aforesaid.

4. The opponent claims that the applicant's mark is highly similar to the earlier marks and that the goods are identical or at least similar, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.

5. The applicant filed a defence and counterstatement denying the claims, although it admitted that its goods were at least similar to goods in Classes 20 and 24 covered by the earlier marks.

6. Neither side filed evidence in these proceedings. The opponent requested a hearing, which took place before me via video link on 1 June 2020. At the hearing the opponent was represented by Philip Harris of Counsel, instructed by Lane IP Limited. The applicant made written submissions on 28 May 2020 in lieu of attendance. During these proceedings it has been represented by Wilson Gunn.

DECISION

Section 5(2)(b)

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

“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.”

8. Section 5A of the Act is as follows:

“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.”

9. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (CJEU) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

(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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 greater degree of similarity between the marks and vice versa;

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

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

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

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

Comparison of goods and services

10. In its written submissions, the applicant sensibly admits that its goods are identical to goods in the opponent's specifications, which include *pillows, duvets, covers for duvets and covers for pillows and pillow cases*.

Average consumer and the purchasing process

11. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”¹

12. Mr Harris for the opponent submitted that the average consumer is a member of the general public, who will buy the goods in a shop or online and that they will see the mark. In his view the level of attention may be above average, but not of the highest

¹ Paragraph 60.

degree. This was the finding made by the Hearing Officer in an earlier case (*LIVINGDREAMS*, BL O-731-18), cited by Mr Harris. However, I note that in that particular case the contested goods were *furniture* and *garden furniture*. The goods at issue here are less expensive and bought more frequently. I accept that the average consumer is a member of the general public and that visual considerations will be most significant, although the aural element may also play a part, for instance when a consumer seeks advice from sales staff. In my view, the average consumer will pay an average degree of attention when purchasing these goods.

Comparison of marks

13. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²

14. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

² Paragraph 34.

15. Mr Harris admitted that the 494 mark represents the opponent's better case and so I confine my comparison to this mark. If the opposition fails with respect to the 494 mark, the 362 mark would not improve the opponent's position.

16. The respective marks are shown below:

Earlier mark	Contested mark
DREAMS	CosyDreams

17. The earlier mark consists of the word "DREAMS" in capital letters. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16. The overall impression of the earlier mark lies in the word itself.

18. The contested mark is also a word mark, comprising two words "COSY" and "DREAMS" joined together. The applicant submits that "COSYDREAMS" is an invented word. To my mind, however, the average consumer will see it as a juxtaposition of two dictionary words, with both playing a part in the overall impression of the mark.

19. The earlier mark appears in full at the end of the contested mark, preceded by the word "COSY". At the hearing, Mr Harris submitted:

"As to the length of the mark, ten letters as opposed to our six-letter mark, in my submission, that is slightly disingenuous. It is essentially two words and the part about which we have greatest concern is exactly the same length as our mark, because it is the same word, DREAMS."

20. I found that the contested mark will be seen as essentially two words joined together with both contributing to the overall impression of the mark which, I remind myself, should not be artificially dissected. In my view, the marks are visually and aurally similar to at least a medium degree.

21. I turn now to the conceptual comparison. The applicant submits that the contested mark alludes to comfort while sleeping or dreaming, and that it is conceptually dissimilar to the earlier mark. I agree with the description of the mark's conceptual content, but I do not see that it follows that it is dissimilar to the earlier mark, which carries the clear concept of dreaming, something that often happens during sleep, although I recognise that "DREAMS" may also refer to aspirations. I find the marks to be conceptually highly similar.

Distinctiveness of the earlier mark

22. There is, as I have already noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1989 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)."

23. The opponent filed no evidence in these proceedings, so I have only the inherent distinctiveness of the earlier mark to consider. The applicant submits that it is allusive and hence its distinctiveness is of a low to medium level. I agree with the applicant. As I have already noted, dreams tend to occur while a person is sleeping, and so it is suggestive of pillows, duvets and covers for these goods.

Conclusions on likelihood of confusion

24. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 9 of this decision. Such a global assessment is not a mechanical exercise. I must keep in mind the average consumer of the goods and the nature of the purchasing process. I remind myself that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

25. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later

mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”³

26. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark. That would be mere association, not indirect confusion.

27. The applicant has admitted that the goods are identical, and I found there to be at least a medium degree of visual and aural similarity and a high degree of conceptual similarity between the marks. The average consumer will be paying an average degree of attention and it seems to me that, given the presence of “DREAMS” in both marks and the imperfect recollection of the consumer there is a likelihood of direct confusion.

28. In the event that I am wrong in this, I shall also consider the likelihood of indirect confusion. In my view, it is likely that if the average consumer notices the differences between the marks, they will assume that the contested mark is a sub-brand of the earlier mark, denoting goods that are particularly soft or warm. I find that there is a likelihood of indirect confusion.

CONCLUSION

29. The opposition has been successful. The application by Ms Rabecca Shaheen Shahid will be refused.

COSTS

30. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

³ Paragraph 16.

<i>Preparing a statement and considering the other side's statement:</i>	£200
<i>Preparing for and attending a hearing:</i>	£500
<i>Official fee</i>	£100
<i>TOTAL:</i>	£800

In making this calculation, I have taken account of the level of complexity of the issues, the length of the skeleton arguments and submissions, and the short duration of the hearing itself. The sum also includes £100 as reimbursement of the official fee, as the section 5(3) ground was dropped at an early stage.

31. I therefore order Ms Rabecca Shaheen Shahid to pay Dreams Limited the sum of £800. The above sum should be paid within 2 months of the expiry of the appeal period or, if there is an appeal, within 2 months of the conclusion of the appeal proceedings.

Dated this 12th day of June 2020

**Clare Boucher,
For the Registrar,
Comptroller-General**