

O-498-20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3356245
BY SILENTNIGHT GROUP LIMITED IN RESPECT OF THE FOLLOWING TRADE
MARK**

ACTICOOL

IN CLASSES 20 AND 24

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415797 BY
SLEEPEEZEE HOLDINGS PLC**

BACKGROUND AND PLEADINGS

1) Silentnight Group Limited (hereafter “the applicant”) applied, on 26 November 2018, to register the trade mark ACTICOOL in respect of the following list of goods:

Class 20: *Mattresses; floating inflatable mattresses (airbeds); beds; bedsteads; headboards; bedding (other than bed clothing), bedding for cots (other than bed linen); cots; pillows (not for surgical or curative purposes), cushions and bolsters (upholstery); settees convertible into beds; divans; couches; furniture; bedroom furniture; mattress toppers; accessories for upholstery being non-metallic fittings for cushions and bolsters and other upholstery in this class; blinds; furnishings, accessories and decorations being non-metallic bed fittings; parts and fittings for all the aforesaid goods.*

Class 24: *Household textile articles; textiles included in this class; textiles and textile goods; household linen; household textiles; bedroom textile fabrics; blinds of textile; furniture coverings of textile; curtains of textile; towels of textile; quilts of textile; textile covers for duvets; bed covers; bedding; bed linen; bed sheets; duvets and duvet covers; covers for pillows, cushions and duvets; mattress protectors; curtains.*

2) It was subsequently published for opposition purposes on 21 December 2018 and on 15 March 2019, Sleepzee Holdings Plc (“the opponent”) opposed the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies upon the three UK trade marks, the relevant details of which are shown below.

3088321
ACTIFLEX
<p>Filing date: 7 January 2015</p> <p>Date of entry in register: 3 April 2015</p> <p>Class 20: <i>Beds, divans, bunk beds, folding beds, furniture incorporating beds; mattresses, mattress toppers, pillows, bolsters, bedding, cushions; cots; headboards, mattress bases, bedsteads; furniture; parts and fittings for all the aforesaid goods.</i></p>

3055714
ACTIGEL
<p>Filing date: 15 May 2014</p> <p>Date of entry in register: 22 August 2014</p> <p>Class 20: <i>Beds, divans, bunkbeds, folding beds, furniture incorporating beds; mattresses, pillows, bolsters, bedding, cushions; cots, headboards, bedsteads; furniture.</i></p>

3080408
ACTILITE
<p>Filing date: 6 November 2014</p> <p>Date of entry in register: 6 February 2015</p> <p>Class 20: <i>Beds, divans, bunk beds, folding beds, furniture incorporating beds; mattresses, mattress toppers, pillows, bolsters, bedding, cushions; cots; headboards, mattress bases, bedsteads; furniture; parts and fittings for all the aforesaid goods.</i></p>

3) The opponent's marks are earlier marks within the meaning of section 6(1) of the Act because they all have an earlier filing date than the contested application. They all completed their registration procedures less than five years before the application

date of the contested application and, as a result, they are not subject to the proof of use provisions contained in section 6A of the Act. As a consequence of this, the opponent is entitled to rely upon the full list of goods in each of its earlier marks.

4) The opponent claims that because its earlier marks and the contested mark all consist of the “word element” ACTI together with another word element and because it is established that consumers are likely to pay more attention to the beginning of a mark, there exists a likelihood of confusion. It submits that it “has a family of marks which contain the word element ACTI as a prefix in relation to various items of bedding, beds and furniture” and that the contested mark “is likely to be considered by consumers as an extension of the range ... offered by the opponent under its family of marks”. It claims that the respective Class 20 goods are identical or highly similar and that the applicant’s Class 24 goods are similar to its goods.

5) The applicant filed a counterstatement denying the opponent’s claims and claiming that:

- the only common element in the respective marks is the non-distinctive term ACTI that is commonly used as a shorthand expression for “active” and the mere inclusion of ACTI at the beginning of the mark would not cause consumers to associate or otherwise confuse it with other ACTI marks;
- in order to rely upon a claim to a family of marks it is necessary to provide proof of use of the marks in the family and, secondly, that the respective marks display characteristics capable of associating it with the family;
- there are numerous examples of other UK trade mark registrations including the ACTI prefix in classes 20 and 24;
- there are numerous examples of third-party use of ACTI- marks in the UK in respect of mattresses, pillows and bedding, and;
- therefore, even if use is shown of the opponent’s family of marks, because of these registrations and third -party use of ACTI-prefixed marks, the opponent’s marks would not be viewed as a family of marks;
- when comparing the respective marks, the visual, aural and conceptual differences are sufficient for there to be no likelihood of confusion.

6) The parties both filed evidence and written submissions in lieu of a hearing. I will keep these in mind and refer them as necessary. I make my decision after careful consideration of the papers.

EVIDENCE

Opponent's evidence

7) This is in the form of a witness statement by Howard Wilson, Vice-President of the opponent. He states that the opponent has made significant use its ACTIGEL and ACTILITE marks in the UK in respect of Class 20 goods. He also states that ACTIFLEX has been used. I will consider this evidence in more detail later.

Applicant's evidence

8) This consists of a witness statement by Graham Pierssene Johnson, trade mark attorney at Appleyard Lees [IP LLP, the applicant's representative in these proceedings]. The purpose of Mr Johnson's statement is to formalise the evidence originally filed with the counterstatement that consists of exhibits relating to UK registered marks containing the ACTI-prefix and to use by third parties, in respect of mattresses, pillows and bedding, of marks using an ACTI-prefix. Again, I will discuss this in more detail later.

DECISION

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods

10) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

11) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

13) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

14) The opponent’s 3088321 ACTILITE and 3080408 ACTIFLEX marks are both registered in respect of an identical list of Class 20 goods that is slightly broader in scope than the specification of its 3055714 ACTIGEL mark. I will consider the issue of similarity of goods based upon these slightly broader specifications.

The applicant’s Class 20 goods

15) The respective goods are:

Opponent's goods	Applicant's goods
<p><i>Beds, divans, bunk beds, folding beds, furniture incorporating beds; mattresses, mattress toppers, pillows, bolsters, bedding, cushions; cots; headboards, mattress bases, bedsteads; furniture; parts and fittings for all the aforesaid goods.</i></p>	<p><i>Mattresses; floating inflatable mattresses (airbeds); beds; bedsteads; headboards; bedding (other than bed clothing), bedding for cots (other than bed linen); cots; pillows (not for surgical or curative purposes), cushions and bolsters (upholstery); settees convertible into beds; divans; couches; furniture; bedroom furniture; mattress toppers; accessories for upholstery being non-metallic fittings for cushions and bolsters and other upholstery in this class; blinds; furnishings, accessories and decorations being non-metallic bed fittings; parts and fittings for all the aforesaid goods.</i></p>

16) The applicant's *Mattresses; ...beds; bedsteads; headboards; bedding (other than bed clothing), bedding for cots (other than bed linen); cots; pillows (not for surgical or curative purposes), cushions and bolsters (upholstery); ... divans; ...furniture; mattress toppers* are matched by identical terms in the opponent's specification and they are self-evidently identical.

17) The applicant's *floating inflatable mattresses (airbeds)* are a subset of the opponent's *mattresses* and, applying the *MERIC* principle, they are identical.

18) The applicant's *settees convertible into beds* and *couches* are both covered by the opponent's *furniture incorporating beds* and *furniture* and, once again, applying the *MERIC* principle, are identical.

19) The applicant's *bedroom furniture* is a sub-set of the opponent's *furniture* and is identical applying the *MERIC* principle.

20) The applicant's *accessories for upholstery being non-metallic fittings for cushions and bolsters and other upholstery in this class; ... furnishings, accessories and decorations being non-metallic bed fittings; parts and fittings for all the aforesaid goods* are identical to the opponent's *parts and fittings for all the aforesaid goods* [and, in particular, for its *bolsters, cushions, beds*].

21) Finally, in respect of the applicant's *blinds*, these goods are not covered by any of the opponent's terms. However, the opponent submits that they are commonly manufactured, produced and sold by the same undertakings and they are directed at the same public. Blinds and bedding and cushions may be purchased because they all share an aesthetic theme, but this does not amount to one being indispensable or important for the use of the other. Therefore, they are not complementary in the sense expressed in *BOSTON SCIENTIFIC*. Whilst, customer wishes for a coordinated look will create overlap of trade channels and users. However, blinds are different in nature, intended purpose and method of use to all of the opponent's good and they are not in competition. Taking all of this into account, I conclude that if there is any similarity it is low.

Class 24

22) The respective goods are:

Opponent's goods	Applicant's goods
<p>Class 20: <i>Beds, divans, bunk beds, folding beds, furniture incorporating beds; mattresses, mattress toppers, pillows, bolsters, bedding, cushions; cots; headboards, mattress bases, bedsteads; furniture; parts and fittings for all the aforesaid goods.</i></p>	<p><i>Household textile articles; textiles included in this class; textiles and textile goods; household linen; household textiles; bedroom textile fabrics; blinds of textile; furniture coverings of textile; curtains of textile; towels of textile; quilts of textile; textile covers for duvets; bed covers; bedding; bed linen; bed sheets; duvets and duvet covers; covers for pillows, cushions and duvets; mattress protectors; curtains.</i></p>

23) A provider of *furniture* may also provide *furniture coverings of textile* and therefore, there is an overlap of trade channels and users. However, they are different in nature, purpose and method of use. I conclude that they share a low level of similarity.

24) The terms *Household textile articles; textiles included in this class; textiles and textile goods; household linen; household textiles* are terms that can all include furniture coverings of textile and, therefore, applying my analysis in the previous paragraph, they share a low to medium level of similarity to the opponent's *furniture*.

25) In respect of the applicant's *bedroom textile fabrics; blinds of textile; ... curtains of textile; quilts of textile; textile covers for duvets; bed covers; bedding; bed linen; bed sheets; duvets and duvet covers; covers for pillows, cushions and duvets; curtains*, these terms will not include furniture coverings. Nevertheless, they are goods that may be designed for, and utilised, in a bedroom environment and similarly to my comments in paragraph 21, above, this creates overlap of channels of trade and end users even though, in other respects there are differences to the opponent's goods. I conclude that they share a low degree of similarity to the opponent's goods.

26) The applicant's *towels of textile* are goods not normally associated with having matching patterns to the fabric on items of furniture even though they may be bought to match the general colour schemes of a bathroom or kitchen. Therefore, they are not likely to share trade channels. They are also different in terms of purpose, nature and methods of use compared to all of the opponent's goods. They are not in competition, nor are they complementary in the *BOSTON SCIENTIFIC* sense. I conclude that they do not share any similarity.

27) Finally, in respect of the applicant's *mattress protectors* the opponent submits that they are for use in connection its Class 20 goods and are, therefore, complementary and share the same distribution channels. I agree with this but disagree that they are "highly similar" because the respective goods differ in terms of their nature, purpose, methods of use and neither are they in competition. I find that they share no more than a low to medium level of similarity.

Comparison of marks

28) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a

whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

30) The respective marks are:

Opponent's mark	Applicant's mark
ACTIFLEX	ACTICOOL
ACTIGEL	
ACTILITE	

31) The opponent's marks all consist of the prefix ACTI conjoined with FLEX, GEL and LITE respectively. This prefix and, as the opponent submits¹, the three suffixes all have the power to create a concept in the mind of the average consumer and it is the combination of suffix and prefix in each case that lends each mark its distinctive

¹ Opponent's written submissions, para 9

character. As such, I disagree with the opponent when it submits² that the ACTI element has a higher degree of distinctive character than the suffixes. The opponent refers to Opposition 49792 where the mark VERIDATA was being compared to VERIPHONE, VERISMART and VERISIGN. However, that case is not on all-fours with the current case because the prefix VERI is more impenetrable than ACTI. In respect of the applicant's mark, it also consists of the same prefix ACTI and a suggestive suffix, this time the word COOL. Again, it is the combination of these two elements that creates the mark's distinctive character.

32) Visually, the applicant's mark shares the same ACTI prefix of all three of the opponent's marks. Its suffix is different to that present in the three marks of the opponent. These suffixes share little similarity other than in two of the opponent's marks (ACTIFLEX and ACTILITE) the suffixes share the same number of letters (four) as the suffix in the applicant's mark. The opponent's ACTIGEL mark has a shorter suffix, but it shares the same final letter "L". Taking all of this into account, I conclude that the applicant mark shares a medium level of visual similarity with all three of the opponent's marks.

33) Aurally, the opponent's marks all consist of three syllables, being ACT-EE-FLEX, ACT-EE-JELL and ACT-EE-LITE respectively. The applicant's mark also consists of three syllables ACT_EE_KOOL. Therefore, the respective marks share the same first two syllables, but differ in that the third and final syllable is different. Taking all of this into account, I conclude that the applicant's mark shares a medium level of aural similarity.

34) Conceptually, I keep in mind that whilst that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), "he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him"³. All of the respective marks contain the

² Opponent's written submissions, para 10

³ See Case T-189/05 *Usinor v OHIM — Corus (UK) (GALVALLOY)* at [62] citing Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, [51], and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, [57]

prefix ACTI. As the opponent suggests, this is likely to be perceived by the average consumer as suggesting some kind of “active” characteristic of the goods. The three marks of the opponent and the applicant’s mark all have different and diverse suffixes. The opponent first mark has the suffix FLEX being suggestive of the characteristic of “flexible”. Its second mark has the suffix GEL suggesting the use of gel or goods with a gel-like quality or characteristic. Its third mark has the suffix LITE suggesting a lightness of weight. The applicant’s mark has the suffix COOL that suggests to the consumer that the goods have a cooling characteristic. The meanings of these suffixes are all quite different and are points of conceptual difference with the applicant’s mark. Taking all of this into account, I conclude that the applicant’s mark shares conceptual similarity with all three of the opponent’s marks that is somewhere between low and medium.

Average consumer and the purchasing act

35) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

36) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37) The goods at issue are all beds, furniture or home furnishings and textiles. The consumer of such goods is normally the ordinary member of the public. The purchasing process in respect of these goods is primarily visual in nature with the purchasing process involving viewing, and in some cases (e.g. beds) testing for comfort and/or size etc. This is likely to be done in a physical shop or they may be purchased from an online equivalent. Aural considerations may play a part where, for example, the consumer is recommended a particular brand or where a particular brand is promoted via radio advertising. The level of care and attention paid to the purchase of such goods may be higher than in respect of more everyday purchases. This is because they are purchased less often and consideration is likely to be given to aesthetic characteristics and to assessing the goods suitability to the purchasers' requirements. However, the level of care and attention is still not at the highest level. I would categorise as a higher than medium level of care and attention.

Distinctive character of the earlier trade marks

38) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39) In respect of inherent distinctive character, all three of the opponent’s marks are suggestive in their nature despite being invented words. This is because they all consist of a prefix and suffix that both impart the suggestion of a characteristic of the goods. Consequently, they are not endowed with a particularly high level of distinctive character, but rather all three have a below medium level of inherent distinctive character.

40) The opponent’s evidence regarding the scale of use of its marks can be summarised as follows:

- the opponent has made use of all three of its marks since 2010⁴;
- sales of goods bearing the ACTILITE and/or the ACTIGEL marks for Class 20 goods have been “several million pounds per annum” since being launched in 2014/15⁵;
- The ACTIGEL mark is a key part of the “Therapur” range which is sold extensively and exclusively by Dreams in the UK⁶;
- Eleven, undated promotional flyers. The first is co-branded “TheraPur” and “Dreams” and also makes reference to two “Acti” marks but the suffix is not visible⁷;
- Examples of such use are shown below⁸:


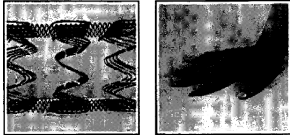
⁴ Mr Wilson’s witness statement, para 6

⁵ Ditto, para 7

⁶ Ditto, para 8

⁷ Exhibit HW1




⁸ Exhibit HW1

activeTM

ACTIVE SUPPORT for an active life


With 40% more springs than traditional Bonnell units, Active is a highly responsive spring system which runs from head to toe giving independent support and preventing roll together. This mattress also includes:

-  A Sanitized sleep surface with anti-bacterial treatment to guard against dust mites, helping to prevent asthma and other allergies.
-  A new advanced comfort layer that offers exceptional resilience & support.
-  Aircool vertical fibre technology allows the mattress to breath, helping maintain an ambient, hygienic and healthy sleeping climate.

TheraPur

invents

ActiGel[®]



supported by



Sleepeeze

41) There is no evidence corroborating Mr Wilson's statement that ACTILITE has been used since 2010. In addition, there is tension between this statement and his further statement that "sales of goods bearing the ACTILITE and/or the ACTIGEL marks for Class 20 goods have been several million pounds per annum since being

launched in 2014/15. It is therefore unclear whether the claimed use began in 2010 or 2014/15. Further, it is unclear what proportion of the several million pounds of annual sales relates to the ACTILITE mark. Taking all of this together, the evidence is insufficient to demonstrate that the ACTILITE mark benefits from any enhanced distinctive character.

42) In respect of the ACTIGEL, the evidence suffers from the same defects except that there are undated examples provided showing the mark in use and a further statement that the ACTIGEL mark is a key part of the “Therapur” range which is sold extensively and exclusively by Dreams in the UK. There is no further information regarding the Therapur range and in the absence of corroboratory evidence to support this statement, I conclude that ACTIGEL does not benefit from an enhanced level of distinctive character.

43) Finally, in respect of the mark ACTIFLEX, there is no specific claim made by Mr Wilson other than it (as with the other two marks) has been used since 2010. There is one undated example of it being used in promotional material. Therefore, the evidence is insufficient to illustrate that it has an enhanced level of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

44) The following principles are obtained from the decisions of the 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

45) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

46) I have found that:

- The majority of the respective goods are either identical or share similarity that varies between low and medium;
- The one exception is the applicant's *towels of textile* that do not share any similarity to the opponent's goods;
- It is the combination of the prefix ACTI and the various suffixes, when combined, that create the distinctive character of the parties' marks;
- The respective marks share a medium level of visual and aural similarity and conceptual similarity that is somewhere between low and medium;
- The average consumer is likely to be the ordinary member of the UK public who will pay a higher than medium level of care and attention during the purchasing process;
- The purchasing act is predominantly visual in nature, but aural considerations may play a part;

- The opponent's marks have a below medium level of inherent distinctive character and this is not enhanced through use.

47) The opponent relies upon a claim that its marks are recognised as a family of marks and that the applicant's mark will merely be seen as another member of the same family and that this will lead to a likelihood of confusion. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the

trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

48) Therefore, as the applicant has claimed in its counterstatement, in order that the opponent may rely upon a claim to a family of marks, it is necessary that it produces evidence to illustrate that the marks relied upon are on the market in sufficient numbers for them to be capable of constituting a family of marks and that the respective marks display characteristics capable of associating it with the family. It also pointed to there being numerous examples of other UK trade mark registrations including the ACTI prefix in classes 20 and 24 and there being numerous examples of third-party use of ACTI- marks in the UK in respect of mattresses, pillows and bedding. It submits that because of the existence of these registrations and third party use the opponent's marks would not be viewed as a family of marks.

49) The opponent's corroborative evidence to support what Mr Wilson describes as "significant use" of ACTIGEL and ACTILITE is very thin. The exhibits provided consist of eleven promotional flyers. The first of these shows a number of marks. The mark "TheraPur" appears prominently and along the bottom of the flyer the mark "Dreams" appears. Either side of this mark are two "Acti..." marks, but the quality of the copying has obscured the suffixes of both. Two of the flyers show the mark "Simmons" (and device) appearing prominently together with a secondary mark ("activie" and device and "Beautyrest" respectively). These flyers also describe propriety features of the product that also have their own trade marks. One of these

is “actiFLEX” and device (of a woman appearing to be lying down on the word). The remaining eight flyers all show use of “ActiGel” to identify a propriety feature of the product.

50) All these exhibits are undated and I am unable to conclude that they were produced for promotions before the relevant date of these proceedings (26 November 2016). Further, Mr Wilson’s evidence is inconsistent in terms of identifying from when these marks were used. In addition, the levels of use of ACTILITE and ACTIGEL are not separated by Mr Wilson (rather he gives a single amount of turnover for both). There is nothing more to substantiate the existence of the claimed family of marks. In light of all of this, I find that the evidence fails to substantiate with any certainty that the marks have been used in sufficient numbers for them to constitute a family of marks at the relevant date.

51) In addition, whilst I have found the evidence is insufficient to support a claim to a family of marks, even if the claimed family exists, the use that is shown appears to only relate specifically to different mattress technologies. Therefore, only the applicant’s *mattresses* in Class 24 could have potentially fallen foul of such a claim.

52) Having dismissed the claim of a family of marks, I need to consider whether a likelihood of confusion exists between the applicant’s mark and each of the opponent’s earlier marks. On behalf of the applicant, Mr Johnson provides evidence⁹ of eight ACTI- prefixed marks on the register, two of which (ACTI-THERM and ACTI-WARM) include goods in Class 20 and/or Class 24. This is provided in support of the submission that ACTI is used by third parties “as a shorthand phrase for the word ‘active’”¹⁰. It is well established that such “state of the register” evidence is not enough to establish that the distinctive character of an element has been weakened because of its frequent use in the field concerned¹¹. This is because it does not necessarily reflect what is happening in the market place. Mr Johnson’s Exhibit B1 does attempt to address this. It consists of search re on Google for “acti active - biotech” listing eight results. The most relevant of these is a reference to “ACTI-

⁹ Exhibit A1

¹⁰ Applicant’s written submissions of 18 November 2019, paras 5 and 6

¹¹ *Zero Industry Srl v OHIM*, Case T-400/06 at [73]

BREAK” to refer to a primary school’s active break programme, “acticare” for case home equipment, “Actiforce” for adjustable desk frames and “Acti Labs” in respect of supplements for the skin. As the opponent submits¹², this evidence fails to illustrate that ACTI is commonly used in respect of Class 20 and 24 goods. However, as I found earlier (at paragraph 34) it is, nonetheless, reasonable to assume that the ACTI element of the marks will create the impression of goods endowed with an active characteristic. Therefore, the ACTI element is not strongly distinctive but rather, it has a low level of distinctive character.

53) In respect of a likelihood of confusion to the opponent’s ACTIFLEX mark, the respective prefixes are the same and, as I have found, it creates the impression of “active”. The respective suffixes are FLEX and COOL and are both likely to be seen as a verb and, when considering the respective marks as a whole, they create respective suggestive meanings of “active flexing” and “active cooling”. These suffixes both consist of four letters. The differences between the marks are sufficient for the average consumer to be able to differentiate them even where identical goods are concerned. This is likely to be so even when imperfect recollection is taken into account. Therefore, when the marks are considered as a whole and even where identical goods are involved, I find that there is no likelihood of direct confusion.

54) I now turn to consider whether there is a likelihood of indirect confusion (with the opponent’s ACTIFLEX mark). I have found that ACTI is likely to be perceived as suggesting some kind of “active” characteristic of the goods. With this in mind the suffix ACTI is not strongly suggestive. The prefix is endowed with a low level of distinctive character and it is its combination with other elements that give a mark its individual distinctive character. When factoring this into my considerations and giving due account to my other findings, I find that because of the combination of the low level of distinctive character of ACTI and the differences between the suffixes, there is no likelihood of indirect confusion between ACTIFLEX and ACTICOOL even where the respective goods are identical.

¹² Opponent’s written submissions, para 14

55) Turning to the likelihood of confusion between the applicant's mark and the opponent's ACTIGEL mark, the differences are greater than in respect of the previous comparison. Here, the suffix GEL in the opponent's mark will be perceived as a noun whereas the suffix COOL, as I have already commented, is likely to be perceived as a verb. Further, there is a difference in length of the respective suffixes. It follows that because of these greater differences there is a lesser likelihood of confusion (either direct or indirect) than in the previous comparison. I find that there is no likelihood of confusion.

56) In respect of the likelihood of confusion between the applicant's mark and the opponent's ACTILITE mark, the suffix LITE is likely to be perceived as an adjectival way to indicate the characteristic of lightness and, therefore, functions differently to the suffix COOL that acts as a verb. This additional difference further reduces the likelihood of confusion compared to the ACTIFLEX/ACTICOOL comparison and it follows that there is no likelihood of confusion.

Summary

57) The opposition fails in its entirety

Costs

58) The applicant has been wholly successful in defending the opposition and is entitled to an award of costs. Awards of costs are made on a contributory basis as set out in the scale published in Tribunal Practice Notice 2/2016. I keep in mind that both sides filed evidence, that both filed written submissions but that neither side requested to be heard. I award costs as follows:

Preparing statement and considering counterstatement (including statutory fee):	£250
Considering other side's evidence and preparing own Evidence:	£700
Preparing written submissions:	£400
TOTAL	£1350

59) I, therefore, order Sleeppezee Holdings PLC to pay Silentnight Group Limited the sum of £1350. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of October 2020

Mark Bryant
For the Registrar
The Comptroller-General