BL O/0945/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF PROCEEDINGS

FOR TRADE MARK APPLICATION NO. UK3852049

BY NAEEM RASOOL FOR THE TRADE MARK

Foamily

IN CLASSES 10, 12, 17, 20, 22, 24 & 26

AND THE OPPOSITION THERETO UNDER NO. 600002768

BY M&A STYLES LTD

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF E FISHER (O/0228/24) DATED 18 MARCH 2024.

DECISION

Introduction

1. This is an appeal by M&A Styles Ltd ("**Appellant**") from decision O/0228/24 of Mrs E. Fisher ("**Decision**") concerning the opposition by the Appellant to Naeem Rasool's ("**Respondent**") application for the mark "Foamily" ("**Application**"), applied for on 22 November 2022 in respect of the following goods:

   Class 10: Orthopaedic foot cushions; Pressure relief pads and cushions; Anti-decubitus cushions; Orthopedic cushions; Arch cushions [orthopaedic]; Inflatable cushions for medical use; Incontinence bed pads; Contoured cushions for patients' use on chairs [adapted for medical purposes]; Contoured cushions for patients' use on beds [adapted for medical purposes]; Crutch cushion covers; Inflatable cushions for medical purposes; Padded cushions for medical purposes; Padded neck supports [cushions] for surgical use; Low air loss sectional pneumatic therapeutic mattresses; Polyurethane foam bandage [supportive]; Incontinence mattress protectors; Heating cushions [pads], electric, for medical purposes; Heating cushions [pads], non-electric for medical purposes; Toe relief pads [orthopaedic].

   Class 12: Automobile seat cushions; Wheelchair cushions; Shaped seat covers made of beads for use in vehicles; Seat cushions for the seats of aircraft; Vehicle safety seat cushions; Seat cushions for the seats of boats; Loose seat covers [shaped] for vehicle seats; Seat cushions for the seats of water vehicles; Seat cushions for the seats of cars; Child booster cushions for vehicle seats; Air cushion vehicles; Seat cushions for the seats of vehicles; Seat cushions for the seats of land vehicles.

   Class 17: Polyurethane foam in blocks for use in flower arranging.

   Class 20: Seat pads; Chair pads.

Class 22: Fillings for upholstered pillows; Soy foam for padding and stuffing; Upholstery wool [stuffing]; Straw for stuffing upholstery; Fillings for pillows; Padding cushioning and stuffing materials, except of paper, cardboard, rubber or plastics; Feathers for stuffing upholstery; Wadding for padding and stuffing; Fabric in the form of a canopy cover.

Class 24: Pillowcases [pillow slips]; Textile piece goods for making cushion covers; Covers for pillows; Cushion covers; Pillow slips; Pillow covers; Covers for cushions; Fitted toilet lid covers of fabric; Quilted blankets [bedding]; Cloth for tatami mat edging ribbons; Bed blankets made of cotton; Fitted toilet covers [fabric]; Covers (fitted toilet lid -)[fabric]; Fabric bed valances; Fitted toilet seat covers of textile; Pillow shams; Sofa blankets; Crib bumpers [bed linen]; Cot bumpers [bed linen]; Replacement seat covers [loose] for furniture; Cushion covering materials; Seat covers [loose] for furniture; Silk bed blankets; Covers (Fitted toilet lid -) of fabric; Lace table mats not made of paper; Ticks [mattress covers]; Sleeping bag sheet liners; Fabric table toppers; Table covers of damask; Toilet seat covers of textile; Covers for toilet lids of fabric; Quilt bedding mats; Protective loose covers for mattresses and furniture; Ticks (mattress and pillow coverings); Contoured mattress covers; Woven fabrics for cushions; Bed linen and blankets; Mattress covers; Covers for eiderdown and duvets; Bed blankets; Unfitted fabric furniture covers; Unfitted fabric slipcovers for furniture; Mattress slips [other than incontinence]; Duvet covers; Sofa covers.

Class 26: Pin cushions.

2. On 20 February 2023, the Appellant filed a fast track opposition opposing the application in full under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994.

3. The Appellant relied upon UK trade mark number 3835610, "Foamily" (the "**Earlier Mark**"), which has a filing date of 3 October 2022 and a registration date of 27 January 2023. For the purposes of the opposition, the Appellant relied upon all the goods for which its mark is registered, which are as follows:

Class 20: Throw pillows; Beds, bedding, mattresses, pillows and cushions; Pillows.

4. Neither side sought leave to file evidence, and a hearing was neither requested nor considered necessary. The Respondent filed written submissions, and a decision was made on the papers. In the Decision, E. Fisher for the Registrar held that the opposition was largely, but not entirely, successful.

5. On 16 May 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

    a. The average consumer of the goods will be a member of the general public, paying no more than a medium degree of attention;

    b. The purchase will be overwhelmingly visual, although the potential for an aural aspect to the purchasing process, where retail assistants offer their assistance in stores, cannot be completely ignored;

    c. The marks are self-evidently identical;

d. The Earlier Mark is inherently distinctive to a medium degree, with no enhanced distinctiveness through use;

e. The Hearing Officer assessed the similarity of the goods in categories, finding some to be identical, some to be similar to a low, low to medium, or medium degree, and some to be dissimilar;

f. For goods which are dissimilar, the issue of likelihood of confusion does not arise, and the opposition therefore failed in relation to such goods. However, given the identity between the competing marks, the Hearing Officer held that the average consumer will be directly confused, even for goods that are similar to a very low degree due to the interdependency principle.

Grounds of Appeal

7. The Appellant's Grounds of Appeal are as follows:

a. **Ground 1** Likelihood of Confusion: The partially allowed registration of the mark "Foamily" across multiple classes creates a significant risk of confusion among consumers, particularly given the identical and similar goods involved.

b. **Ground 2** Protection of Established Mark: The Appellant's mark "Foamily" is already established and registered in class 20. Registering the Respondent's mark "Foamily" for classes 10, 12, 17, 20, 22, 24, and 26 would undermine the distinctiveness and reputation of the Appellant's mark and could damage its brand.

c. **Ground 3** Similarity in Mark: Both marks are phonetically and visually similar, which exacerbates the likelihood of confusion and risk to the Appellant's existing and established brand. Given the overlap in goods and similarity of the marks, making them easily interchangeable in the minds of consumers.

d. **Ground 4** Consumer Protection: Allowing registration of "Foamily" could mislead consumers, causing them to associate the Respondent's products with the Appellant's established brand, resulting in potential damage to its business and reputation directly and deeply.

e. **Ground 5** Overlap in Goods/Services: There is an overlap in the classes in which the marks are registered, particularly class 20. This similarity in goods/services increases the likelihood of confusion, as consumers may mistake one for the other or believe they are associated with the same source.

f. **Ground 6** Actual Confusion: Given the similarities between the marks and the overlap in goods, there is potential for actual confusion among consumers, which could lead to misdirected sales, customer dissatisfaction, and harm to the Appellant's brand reputation.

g. **Ground 7** Reputation of Foamily: The Appellant's mark, "Foamily," is a well-established brand in class 20 and has developed a reputation for quality products. Allowing the registration of " Foamily " in the same or related classes could dilute the mark's distinctiveness and impact the brand's market presence.

h. **Ground 8** Risk of Dilution: The partial registration of "Foamily" threatens to dilute the uniqueness and strength of the Appellant's established mark, "Foamily." This would undermine its ability to protect its brand and negatively impact its business operations.

i. **Ground 9** Cross-Class Considerations: The partial registration of "Foamily" across multiple classes increases the likelihood of infringement of the Appellant's established mark, as products and services in different classes may be related or complementary.

j. **Ground 10** Consumer Perception: Consumers may believe that "Foamily" is an extension or variant of "Foamily," leading to misattribution and potential infringement of the Appellant's mark.

k. **Ground 11** Consumer Rights: Allowing the partial registration of "Foamily" again can mislead consumers into believing that the products or services offered under the partially allowed "Foamily" are affiliated with or endorsed by the Appellant's existing, registered, and established brand Foamily.

l. **Ground 12** Market Confusion: The decision to partially register "Foamily" may create market confusion and disrupt consumer choice, which is not in the best interest of a fair and competitive marketplace. The similarity in name could dilute the distinctiveness and value of the Appellant's brand, resulting in a loss of consumer trust and market position.

8. The Appellant's director, Mr Farooq, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a skeleton argument but did not attend the hearing, and I have taken into account the Respondent's submissions.

Standard of review

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

> **"Appellate Function**
>
> 24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
>
> i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
>
> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);
>
> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant

matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark*

BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"…the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

2. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 "It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable"; and

- The Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 "…on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion".

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

Preliminary point

11. The Respondent's covering email attaching its skeleton argument stated "we wish to bring to your attention that the Opponent's skeleton arguments were submitted late, as was the appeal, which was filed alongside a TM9R extension request".

12. There is nothing in either point. The Appellant's TM55 was filed late, and was accompanied by a TM9R extension request. On 24 May 2024 the Appointed Persons Secretariat wrote to the parties to say:

"*Whilst the Opponent has requested a two-month extension to the Appeal period, it is the Registry's view that the Opponent intended to request an extension covering the period 10 May 2024 (the deadline for filing the TM55P) to 14 May 2024 (the date the opponent filed its TM55P), totalling 4 days.*

Given that (i) the opponent had filed its grounds of appeal prior to the deadline of 10 May, (ii) failing to file the TM55P was an oversight on the opponent's part and (iii) the extent to which the deadline was missed totalled only 4 days, it is the Registry's preliminary view that a retrospective extension of time is allowed and the TM55P filed on 14 May will be progressed.

If either party disagrees, they must request a Case Management Conference ('CMC') by Tuesday 4 June 2024".

13. Neither party requested a CMC, and the extension of time granted therefore stands.

14. As for the Appellant's skeleton argument, it was filed at 15.11 on Thursday, 26 September 2024, and the hearing took place on the following Monday (30 September 2024). Section 6.8.2 of the Manual of trade marks practice states "Where skeleton arguments are required, or filed, they must be received by the Tribunal by 14:00 two working days before the hearing, regardless of the start time of the hearing".

15. The Appellant did not strictly need to file a skeleton argument, as section 6.8.2 also states "Parties with legally qualified representatives are required to submit skeleton arguments in advance of a Substantive Hearing. Where parties intend to rely on authorities (other precedent cases) then details of these should be included within the skeleton arguments. Parties who do not have a legally qualified representative are not required to provide skeleton arguments, although they may do so if they wish".

16. Strictly speaking, therefore, the Appellant was 71 minutes late in filing its voluntary skeleton argument. However, no prejudice has been caused by this late filing. The Respondent had already elected not to attend the hearing, and I did not read the papers until the weekend between filing and the hearing. I therefore overlook this minor breach by the Appellant, and take the contents of its skeleton argument fully into account.

Grounds of Appeal

17. The Grounds are numerous, but it is not necessary to consider each one separately. First, many of the issues raised overlap - for example, grounds 1, 3, 5, 6 and 11 cover essentially the same issue - likelihood of direct or indirect confusion - but with different wording. Secondly, some of the grounds raise issues which were not, and could not have been, raised before the Hearing Officer below. Grounds 2, 4, 7, 8 and 12 are concerned with likelihood of dilution of distinctiveness and reputation. A section 5(3) opposition was not raised before the Hearing Officer, and could not have been raised using the fast track procedure. I will therefore not

consider those grounds further. Similarly, grounds 9 and 10 are concerned with an increased likelihood of infringement of the Appellant's mark. Issues of infringement are a matter for the courts, not the Registrar, and again I shall not consider those grounds further. Thirdly, during the hearing the Appellant informed me that the Respondent has been filing multiple infringement notices against the Appellant on Amazon, including in relation to goods for which his Application was refused. That may be so, and the Appellant may well be able to bring an action in the courts for unjustified threats of infringement proceedings, but it is not a matter that can be raised before the Registrar.

18. Turning now to grounds 1, 3, 5, 6 and 11, the opposition failed only in respect of the following goods, which the Hearing Officer held to be dissimilar:

Class 10: Incontinence bed pads; Crutch cushion covers; Polyurethane foam bandage [supportive]; Incontinence mattress protectors; Toe relief pads [orthopaedic].

Class 17: Polyurethane foam in blocks for use in flower arranging.

Class 22: Fabric in the form of a canopy cover.

Class 24: Fitted toilet lid covers of fabric; Cloth for tatami mat edging ribbons; Fitted toilet covers [fabric]; Covers (fitted toilet lid -)[fabric]; Fitted toilet seat covers of textile; Covers (Fitted toilet lid -) of fabric; Lace table mats not made of paper; Fabric table toppers; Table covers of damask; Toilet seat covers of textile; Covers for toilet lids of fabric.

Class 26: Pin cushions.

19. The Hearing Officer correctly identified at §46 that a finding of at least some degree of similarity of goods is a threshold condition (*eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA), in the absence of which the issue of likelihood of confusion under s. 5(2) simply does not arise. I therefore invited the Appellant, at the hearing, to explain why he contends that the Hearing Officer's above findings of dissimilarity involved an error of principle or were wrong. The Appellant responded to say that he does not contend that the Hearing Officer erred in making her findings of dissimilarity, but nonetheless contends that there remains a likelihood of confusion. That contention is wrong in law. Given that there is no challenge to the Hearing Officer's findings of dissimilarity, there can be no likelihood of confusion under s. 5(2), and the Hearing Officer was correct to dismiss the opposition in relation to the goods listed above.

20. I accordingly dismiss this appeal.

Conclusion

21. The appeal is dismissed, and the Application may proceed to registration for the following goods:

Class 10: Incontinence bed pads; Crutch cushion covers; Polyurethane foam bandage [supportive]; Incontinence mattress protectors; Toe relief pads [orthopaedic].

Class 17: Polyurethane foam in blocks for use in flower arranging.

Class 22: Fabric in the form of a canopy cover.

Class 24: Fitted toilet lid covers of fabric; Cloth for tatami mat edging ribbons; Fitted toilet covers [fabric]; Covers (fitted toilet lid -)[fabric]; Fitted toilet seat covers of textile; Covers (Fitted

toilet lid -) of fabric; Lace table mats not made of paper; Fabric table toppers; Table covers of damask; Toilet seat covers of textile; Covers for toilet lids of fabric.

Class 26: Pin cushions.

Costs

22. Clearly, the Respondent has been the successful party. I order that the Appellant shall pay the Respondent the sum of £600 for preparation of the skeleton argument.

23. The Hearing Officer's order that the Respondent should pay the Appellant £175.50 by way of costs of the proceedings below still stands. The net effect is that the Appellant shall pay the Respondent £424.50 within 21 days of this decision.

Dr. Brian Whitehead

2 October 2024

Representation

Mr Mobeen Farooq for the Appellant/Opponent

Lincoln Solicitors for the Respondent/Applicant