O/0968/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001811612

DESIGNATING THE UK

IN THE NAME OF PLEASURE CRUISES & SAFARIS PTY LTD

FOR THE FOLLOWING TRADE MARK:

SLUMBER SOCIETY

IN CLASSES 3, 20, 24, 25 AND 30

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 451816

BY JOHN COTTON GROUP LIMITED

BACKGROUND AND PLEADINGS

1. The international registration shown on the cover page of this decision ("the IR") was registered on 7 August 2024 in the name of Pleasure Cruises & Safaris Pty Ltd ("the holder"). With effect from the same date, the holder designated the UK as a territory in which it sought to protect the IR pursuant to the Protocol to the Madrid Agreement. A priority date of 2 July 2024 is claimed. Protection is sought for the following goods:

Class 3 Essential oils; reed diffusers; reed diffusers comprised of scented oils in a container and including reeds; fragrances; aromatics for fragrances; body care balms, other than for medical purposes; cosmetics for body care; body cleaning and beauty care preparations; body and beauty care preparations; skin care products; fragrance refills for electronic essential oil diffusers.

Class 20 Travel cushions; travel pillows; inflatable pillows; pillows; neck pillows.

Class 24 Bed linen; bed sheet sets; sleeping bag sheets; covers for cushions; quilt covers; pillow cases; household linen.

Class 25 Clothing; footwear; headgear; pyjamas; sleep masks; fabric face masks.

Class 30 Tea; chai tea; fruit teas; tea for infusions; mixes of tea; herbal tea preparations for making beverages; herb teas, other than for medicinal use; aromatic teas, other than for medicinal use.

2. On 10 January 2025, the application to protect the IR in the UK was partially opposed by John Cotton Group Ltd ("the opponent") based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at the goods underlined in paragraph 1 above.

3. Under section 5(2)(b) of the Act, the opponent relies upon UKTM no. 909398413 for the trade mark **SLUMBERDOWN**, which was filed on 23 September 2010 and registered on 6 March 2011. The opponent relies upon all goods for which its mark is registered, namely:

Class 20 Furniture; bedroom furniture; beds; mattresses; beanbags, pillows, neck pillows, bolsters, cushions, sleeping bags and bedding; pillow protectors; support pillows; back support pillows.

Class 24 Household textile articles; quilts and duvets; eiderdowns; sheeting including mattress protection; mattress protectors; bedding; curtains and curtain material.

The opponent claims that the marks are similar and the goods are similar, with the result that there is a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the opponent relies upon the sign **SLUMBERDOWN** which it claims to have used throughout the UK since 1916 in relation to "duvets; pillows; mattress toppers; mattress protectors; pillow protectors; electric blankets; heated throws; cushions; blankets". The opponent claims that use of the IR would be contrary to the law of passing off.[1]

5. The holder filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use.

6. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

7. The holder is represented by Avatar IP.

[1] I note that the opponent's submissions contained within the TM7 (see Q5) refer to the earlier sign as SNUGGLEDOWN. Clearly, this is not the sign relied upon, and so I have disregarded it.

8. The opponent is represented by Mathys & Squire LLP.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in chief in the form of the witness statement of Stephen George Swalwell dated 27 May 2025, which is accompanied by 6 exhibits (SS01 to SS06). Mr Swalwell is the Company Secretary of the opponent, a position that he has held since 1 November 2000.

10. The opponent's evidence in chief was accompanied by written submissions dated 27 May 2025.

11. The holder filed evidence in the form of the witness statement of Ms Claire Miles dated 27 July 2025, which is accompanied by 9 exhibits (CM01 to CM09). Ms Miles is a director of the holder, a position she has held since 29 April 2024.

12. The opponent did not file evidence in reply.

13. Both parties filed written submissions in lieu dated 16 October 2025.

RELEVANCE OF EU LAW

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Proof of use

15. As the earlier mark had completed its registration process more than five years before the priority date of the IR, it is subject to the use provisions in section 6A of the Act. I will, therefore, begin by dealing with proof of use.

16. The relevant statutory provisions are as follows:

> "6A(1) This section applies where:
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

17. Section 100 of the Act is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

18. The relevant period for assessing genuine use is the five-year period ending with the priority date of the IR, namely 3 July 2019 to 2 July 2024. As the earlier mark is a comparable mark, use within the EU is relevant for the part of the relevant period which

falls prior to IP Completion Day (i.e. 31 December 2020).[2] After that date, only use in the UK will be relevant.

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

[2] See paragraph 7 of Part 1, Schedule 2A of the Act.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

20. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

21. Mr Swalwell gives evidence that the opponent acquired rights to the trade mark SLUMBERDOWN from another company in 2010. He states that since registration, the earlier mark has been used in relation to the "promotion and sale of, among other items, pillows, duvets, pillow protectors and mattress protectors". Mr Swalwell has provided the following turnover figures for goods sold under the earlier mark during the relevant years:[3]

2019/2020	17,298,739.42
2020/2021	21,689,230.82

[3] Exhibit SS01

2021/2022	22,170,991.19
2022/2023	25,842,394.92
2023/2024	29,973,144.63

22. I note that no currency information is provided for these figures.

23. The opponent's customers during this period include national retailers such as Argos, Asda, Sainsbury's, Morrisons, Tesco, Lidl, TK Maxx and B&Q. This is supported by screenshots from some of these retailers' websites.[4]

24. Invoices have been provided, some of which fall within the relevant period and some of which do not.[5] The invoices display the opponent's name, in logo form. I note that these invoices appear to show some products which are branded for the customer (e.g. TESCO ANTI ALLERGY MAT PROT KS) or which display a different brand altogether (e.g. FOX & IVY FEELS LIKE DOWN PILLOW). It is not, therefore, clear to me that all of the goods listed in these invoices are products sold under the earlier mark, despite Mr Swalwell's narrative evidence to that effect. I note that at least some of the product descriptions include the words "S/DOWN" or "S/D". Whilst, on the face of it, it may be possible to infer that these entries relate to goods sold under the SLUMBERDOWN brand, there is evidence before me that the opponent also sells goods under the brand SNUGGLEDOWN. These abbreviations could also be a reference to that brand, and so I am not prepared to infer that they must relate to the SLUMBERDOWN brand. It is not always clear from the descriptions contained within the invoices what products are being referred to (e.g. S/D SUMMER COOL). However, I am able to identify that the invoices cover sales of pillows, duvets and mattresses (I take the word "matt" to be an abbreviation for mattress) under the mark SLUMBERDOWN during the relevant period.

25. There is evidence of promotional activities taking place in the UK during the relevant period. For example, some examples of advertising through supermarkets Aldi and Lidl are in evidence.[6] These are said to have taken place in February/March

[4] Exhibit SS06
[5] Exhibit SS02
[6] Exhibit SS04

2024 and April 2023 respectively. There is also an example of a promotional banner for the opponent's products which was displayed on the Argos website in March 2023:



26. The opponent's website shows duvets, pillows, electric blankets, mattress toppers, mattress protectors and pillow protectors for sale during the relevant period.[7]

Form of the mark

27. Where the opponent has used the word SLUMBERDOWN on its own (such as on its website), that is clearly use upon which the opponent can rely. I note that a lot of the use shown is of the figurative mark shown in paragraph 25 above. In my view, this is plainly use as part of another mark, and the word SLUMBERDOWN continues to indicate origin.[8] Consequently, this is use of the mark as registered.

Sufficient Use

28. On the face of it, assuming that they are provided in GBP, the opponent's turnover figures appear significant. However, I bear in mind that they are not broken down by product category or mark. Mr Swalwell provides narrative evidence that the figures provided relate to the SLUMBERDOWN mark. However, he also states the same about the invoices, but these clearly cover both SLUMBERDOWN goods and those that are not branded with that mark. Consequently, I have some reservations about whether these figures can be wholly attributed to goods sold under the mark. That being said, the opponent has plainly sold its goods into a number of national retailers and had clearly invested in advertisement of the mark during the relevant period. The

[7] Exhibit SS05
[8] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12

opponent's invoice evidence shows use in relation to pillows, duvets and mattresses. Whilst I bear in mind that a broader range of goods is visible for sale in other parts of the evidence (such as on the opponent's website), I have no evidence of such goods having actually been sold during the relevant period (or, if so, on what scale).

Fair Specification

29. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

30. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

31. The terms "pillows" and "mattresses" appear in the opponent's class 20 specification. Plainly, these will be terms upon which the opponent can rely. I also note that the term "duvets" appears in the class 24 specification and, again, the opponent can clearly rely upon that term.

32. I bear in mind that the opponent's specification also includes some broader terms. For example, "furniture" and "bedroom furniture" in class 20. However, in my view, the average consumer would not consider the opponent's goods to fall within these terms (which would be understood to cover things like beds, wardrobes etc.). The term "household textile articles" clearly covers some of the goods for which the opponent has shown use (such as duvets). However, this is a very broad term which would cover a range of textile goods for all aspects of the home. In my view, the terms identified above are a fair representation of the opponent's use and it should not be entitled to retain the broader term. Finally, with regard to the term "bedding" in class 24, I do not consider that goods such as "duvets" and "pillows" themselves would be considered

bedding. In my view, this is more typically used to refer to goods such as duvet and pillow covers. In any event, nothing will turn on this for the reasons below. Taking all of this into account, I consider a fair specification to be:

Class 20 Mattresses; pillows.

Class 24 Duvets.

Section 5(2)(b)

33. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

> "5A 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."

35. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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; and

(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.

Comparison of goods

36. In light of my findings above, the competing goods are as follows:

Opponent's goods	**Holder's goods**
Class 20 Mattresses; pillows. Class 24 Duvets.	Class 20 Travel cushions; travel pillows; inflatable pillows; pillows; neck pillows. Class 24 Bed linen; bed sheet sets; sleeping bag sheets; covers for cushions; quilt covers; pillow cases; household linen.

37. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, 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."

38. 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.

39. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, the General Court 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 for Lernsysterne*

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."

40. Another factor in assessing similarity is to consider the extent to which the goods at issue may be regarded as "complementary", which case law describes as meaning that "…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 the responsibility for those goods lies with the same undertaking."[9]

41. Specifications should be scrutinised carefully and terms should not be given a wide construction; they should be confined to the substance or core of their possible meanings.[10] For the purposes of assessing similarity, it is permissible to group specified terms together where they are sufficiently comparable in essentially the same way for essentially the same reasons.[11]

Class 20

Travel cushions.

42. In my view, this term is synonymous with travel pillows. Consequently, I find it to be identical on the principle outlined in *Meric* to "pillows" in the opponent's specification. Even if I am wrong in that finding, the goods will overlap in purpose (being to provide comfort and support to the user), method of use (being placed under the head), nature (being made of the same or similar materials) and user (being members of the general public). Consequently, I would find the goods to be highly similar.

9 *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06

10 See, for instance, *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) at [19].

11 See *Separode* Trade Mark (BL O/399/10)

Travel pillows; inflatable pillows; neck pillows.

43. These goods are all identical on the principle outlined in *Meric* to "pillows" in the opponent's specification.

Pillows.

44. This term appears identically in the opponent's specification.

Class 24

Bed linen; bed sheet sets; covers for cushions; quilt covers; pillow cases; household linen.

45. All of these terms are (or could include) goods that are used on a bed. Consequently, they are likely to be sold through the same trade channels as the opponent's "pillows" and "duvets" and, where they are sold through larger retailers, will be sold in close proximity to each other. The user will plainly overlap. The method of use, purpose and nature of the goods will overlap and, in some cases, there may be complementarity. Consequently, I find the goods to be similar to at least a medium degree.

Sleeping bag sheets.

46. These goods are likely to be sold through retailers that specialise in camping or outdoor pursuits. However, there is still some overlap in purpose with the opponent's goods, because they are all intended to facilitate comfort for the user whilst sleeping. For the same reason, there may be some overlap in nature (such as the same materials being used for both). The user will plainly overlap, as they could all be purchased by members of the general public. Consequently, I consider that these goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

48. In *Iconix*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
>
> (e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

49. The average consumer for the goods will be members of the general public. The average consumer is likely to consider factors such as materials, tog rating and aesthetics (such as colour or pattern) when purchasing the goods. The goods are likely to vary in price considerably, but are likely to be infrequent purchases. Overall, I find that the average consumer will pay a medium degree of attention during the purchasing process.

50. The goods are likely to be self-selected from physical retail outlets or their online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component given that advice may be sought from retail assistants.

Comparison of trade marks

51. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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."

52. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account 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.

53. The respective trade marks are shown below:

Opponent's trade mark	The IR
SLUMBERDOWN	SLUMBER SOCIETY

54. The opponent's trade mark consists of the word SLUMBERDOWN. The word SLUMBER is likely to be understood as highly allusive for goods that are used on a bed. Consequently, I find that the overall impression of the mark lies in the word as a whole (i.e. the conjoining of the word SLUMBER with the word DOWN).

55. The IR consists of the words SLUMBER SOCIETY. Again, the word SLUMBER will be recognised as highly allusive. Consequently, I find that the overall impression lies in the combination of these words which come together to form a unit.

56. Visually, the marks coincide in the same first word (being SLUMBER). The opponent submits that its mark is "essentially contained in its entirety within the mark applied for". Clearly, that is not the case because the marks differ in the second word, being DOWN in the opponent's mark and SOCIETY in the IR. They also differ in that the words in the opponent's mark are conjoined, whereas they are not in the IR. I bear in mind that the beginning of marks tend to make more of an impact than the ends.[12] However, I find that this is not the case where the first word is weakly distinctive. In my view, the marks are visually similar to a medium degree.

57. Aurally, the word SLUMBER will be pronounced the same in both marks. The word DOWN in the opponent's mark and the word SOCIETY in the IR will be pronounced completely differently. In my view, the marks are aurally similar to a medium degree.

[12] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

58. Conceptually, the word SLUMBER will be understood as referring to sleep.[13] The word DOWN in the opponent's mark clearly has its own dictionary meaning, but the two words in combination do not appear to convey any clear meaning. The words SLUMBER SOCIETY in the IR clearly convey a message of a society that is concerned with sleep in some way. Consequently, there is some conceptual overlap in that both refer to sleep, although this is not a particularly distinctive point of overlap given the goods in question. Further, the concept of a society is entirely absent from the opponent's mark. Overall, I find the marks to be conceptually similar to between a low and medium degree.

Distinctive character of the earlier mark

59. 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 1-2779, 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

[13] See, for example, Exhibit CM04

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

60. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use made of it.

61. The earlier mark consists of the conjoined words SLUMBERDOWN. As noted above, the word SLUMBER is clearly highly allusive of the goods in issue. However, the words in combination do not convey any clear meaning. In my view, the mark as a whole is distinctive to between a low and medium degree. However, as the distinctiveness of the common element is key, I will also make a finding as to the distinctiveness of the word SLUMBER for the relevant goods.[14] In my view, given its highly allusive nature, I find that the word SLUMBER is distinctive to only a low degree.

62. I am fortified in this finding by the evidence filed by Ms Miles which shows various third-party products bearing the word SLUMBER for sale in the UK in relation to the relevant goods.[15] For example, the evidence shows a SLUMBERLAND pillow and mattress, a SLUMBERNIGHT mattress, a SLUMBER SLEEP mattress, a SLUMBER KING mattress and a baby sleeping bag described as a "slumber bag". All of these products are listed for sale in GBP. Whilst I note that the examples provided are from July 2025 (i.e. after the relevant date), this lends support to my finding above regarding the weak nature of the word SLUMBER for the relevant goods.

63. The opponent has filed evidence of use as discussed above. In addition to the evidence discussed above, I bear in mind that there is also evidence of press coverage, some of which refers to the relevant goods, such as:[16]

[14] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13
[15] Exhibit CM06
[16] GS03 (I note that some of the articles in question are after the relevant date).

a. An article on *Mail Online* from 5 February 2024 in which the SLUMBERDOWN duvet is listed as one of the top 10 bedding deals on Amazon.

b. An article on *Good Housekeeping* dated 30 May 2024 which announces the winners of the GHI Sleep Awards 2024 (as voted for by a panel of experts). The SLUMBERDOWN mattress topper and duvets were both listed.

c. An article from *The Independent* online dated 9 January 2024, which lists SLUMBERDOWN as the best budget memory foam pillow, as tested by *The Independent*.

64. There are clearly issues with the opponent's evidence. For example, it is not clear whether some or all of the sales figures provided actually relate to the SLUMBERDOWN brand, given that the same statement has been made in respect of invoices which clearly do not only relate to goods sold under that mark. Whilst the opponent's brand has appeared in a number of lists for "best" products in national publications, I bear in mind that these lists have not been voted for by members of the public. Nonetheless, coverage in national publications (with large readerships) is clearly relevant. In my view, the distinctiveness of the earlier mark has been enhanced through use to (at best) a medium degree for the relevant goods.

Likelihood of confusion

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a higher degree of similarity between the goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that

the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

66. I have found as follows:

a. The goods vary from being similar to a medium degree to identical.

b. The average consumer for the goods will be a member of the general public, who will pay a medium degree of attention during the purchasing process.

c. The purchasing process will be predominantly visual, although I do not discount an aural component.

d. The marks are visually and aurally similar to a medium degree, and conceptually similar to between a low and medium degree.

e. The earlier mark is inherently distinctive to between a low and medium degree, which has been enhanced through use to (at best) a medium degree.

67. I do not consider that the different second word (SOCIETY in the IR and DOWN in the earlier mark) would be overlooked or misremembered, even where the marks are used on identical goods. Consequently, I do not consider there to be a likelihood of direct confusion.

68. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. 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 recognized 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'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

69. The common element, being the word SLUMBER is distinctive to only a low degree for the relevant goods. There is no enhancement to this word alone arising from the opponent's use, because any enhancement relates to the mark SLUMBERDOWN as a whole. Category (a) of *LA Sugar* does not, therefore, apply. This is not a scenario where there is a non-distinctive addition, and so category (b) does not apply. In my view, the removal of the word DOWN and the addition of the word SOCIETY is not consistent with a brand extension or sub-brand. Category (c) of *LA Sugar* does not,

therefore, apply. This is because the distinctiveness of the earlier mark (including that which comes from the enhancement through use) relates to the mark as a whole. Consequently, I can see no reason why the replacement of the second word with an entirely new word would be viewed in this way. Whilst I bear in mind that the categories in *LA Sugar* are not exhaustive, I can see no other basis upon which indirect confusion would arise.

70. The opposition based upon section 5(2)(b) of the Act is dismissed.

Section 5(4)(a)

71. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

72. Subsection (4A) of section 5 of the Act states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

73. I can deal with this ground relatively swiftly. The evidence filed by the opponent is, in my view, sufficient to demonstrate a protectable goodwill for the goods listed at paragraph 32 above at the relevant date. However, whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it has been acknowledged that they are unlikely to produce different outcomes in practice.[17] I find that to be the case here. The claim under this ground will, therefore, stand or fall with the 5(2)(b) ground.

74. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

75. The opposition is unsuccessful and, subject to appeal, the IR may proceed to registration.

COSTS

76. The holder has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of **£1,550**, calculated as follows:

Preparing a counterstatement and considering the Notice of opposition	£350
Considering the opponent's evidence and preparing evidence	£800
Written submissions in lieu	£400
Total	**£1,550**

[17] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

77. I therefore order John Cotton Group Ltd to pay Pleasure Cruises & Safaris Pty Ltd the sum of **£1,550**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of October 2026

S WILSON
For the Registrar