

O/1117/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 916475841
IN THE NAME OF HELIOS WEB
IN RESPECT OF THE FOLLOWING TRADE MARK:



IN CLASSES 20 & 35

AND

AN APPLICATION FOR THE REVOCATION THEREOF
UNDER NO. 507030
BY
HYPNOS LIMITED

BACKGROUND AND PLEADINGS

1. Trade mark No. 916475841 shown on the cover page of this decision stands registered in the name of Helios Web (“the registered proprietor”). It is a UK comparable mark created pursuant to section 7A of the European Union (Withdrawal) Act 2018, which gave effect to Article 54 of the Withdrawal Agreement. The mark has the same legal status as if it had been applied for and registered under UK law and retains the original filing and registration dates of the EU Trade Mark from which it was created. These are 15 March 2017 and 28 June 2017 respectively. The colours claimed are black, white, orange and light orange.

2. The mark stands registered for the following goods and services:

Class 20

Foam mattresses; Mattress toppers; Beds, bedding, mattresses, pillows and cushions.

Class 35

Retail services connected with the sale of furniture; Wholesale services in relation to furniture.

3. The mark claimed seniority from UK Trade Mark (“UKTM”) No. 2517629, which was invalidated in an earlier decision, BL O/1211/24. The invalidation against the comparable mark failed.

4. On 21 February 2024, Hypnos Limited (“the applicant”) sought revocation of the mark on the grounds of non-use. Under section 46(1)(b), the applicant claims that the mark has not been used during the following period: 21 February 2019 to 20 February 2024. The date on which it wants revocation to take effect is 21 February 2024. The applicant referred to evidence filed in the invalidation proceedings in which it was stated that the registered proprietor had moved away from use of the mark and submissions that the registration had last been used in December 2017.

5. The registered proprietor filed a defence and counterstatement, claiming that the mark had been put to genuine use in the UK by the proprietor and/or by its predecessors in title or with their consent during the relevant period. It argued that any

statement made in the invalidation proceedings had been made for a wholly different purpose, that the paragraphs relied on by the applicant had been taken out of context and that it would therefore be inappropriate to treat any such statements as an admission for the purposes of these proceedings. It denied that the registration had been abandoned.

6. The applicant had also applied to revoke UKTM No. 2517629 and the registered proprietor filed a defence. As this mark has been invalidated, this revocation has fallen away and I do not need to deal with it here.

7. The registered proprietor filed evidence in the form of a witness statement from Samuel Georges Parfait Galloo, director of Phasis Web Limited, a wholly owned subsidiary of the registered proprietor. His witness statement is dated 9 July 2024 and is accompanied by 11 exhibits. There is also a witness statement dated 26 July 2024 from Séverine Guyot, a lawyer at the registered proprietor's EU legal representative. She explains that she is a native French speaker and has sufficient competence in English to confirm that a translation of a Trademark Assignment Contract reflects the French-language original. The registered proprietor also filed written submissions dated 10 July 2024.

8. The applicant filed written submissions during the evidence rounds. These are dated 7 October 2024.

9. On 15 November 2024, I held a Case Management Conference to deal with a request made by the registered proprietor to amend its submissions in the invalidation proceedings. It had explained that the statement that the contested registrations had last been used in December 2017 was an error and the relevant part of the submissions should state that they had last been used in April 2022. There was indeed a discrepancy between the submissions and what Mr Galloo had said in his witness statement in those proceedings. This was that the registrations were being used up to April 2022 by the proprietor's predecessor in title and thereafter by the proprietor. I therefore allowed the amendment to the submissions to be made.

10. Neither party requested a hearing and the registered proprietor filed written submissions in lieu of the same on 9 December 2024. In these proceedings, the

applicant is represented by Barron Warren Redfern LLP and the registered proprietor by Fladgate LLP. I have taken this decision after a careful consideration of the papers.

RELEVANCE OF EU LAW

11. 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

12. Section 46 of the Act is as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

...

(2) For the purposes of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

13. As the contested mark is a comparable mark, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the ‘five-year period’) has expired before IP completion day-

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.”

14. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“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 *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 Bundersvereinigung 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) 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] and [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].”

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The

General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.’”

Evidence

15. Mr Galloo states that the Hypnia brand was established in 2009 and the first proprietor was a Hong Kong company, 3am Ltd. The contested mark, along with other Hypnia trade marks, was assigned to the registered proprietor in April 2022. A copy of the deed of assignment is contained in Exhibit SG2. From May 2022 onwards, the marketing and sale of goods under the contested mark was carried out in the UK by Phasis, which I have already said is a wholly owned subsidiary of the registered proprietor. Some of the evidence comes from the period 2009-2019. In this summary, I shall focus on the evidence that concentrates on the relevant period., which is 21 February 2019 to 20 February 2024

16. The evidence relating to the first part of the relevant period (i.e. up to the assignment of the mark to the registered proprietor) comes from generally available websites, Hypnia's Amazon account, which Mr Galloo states was transferred to Phasis, and an Excel spreadsheet giving information on sales. Mr Galloo explains that this was *"prepared by the Proprietor with the assistance of contacts they still have at 3am Ltd (who are still willing to provide, to some extent, historic data)"*.¹ He describes this spreadsheet as containing UK and global turnover for goods sold under the contested mark. I have summarised the figures for the years within the relevant period in the table below:²

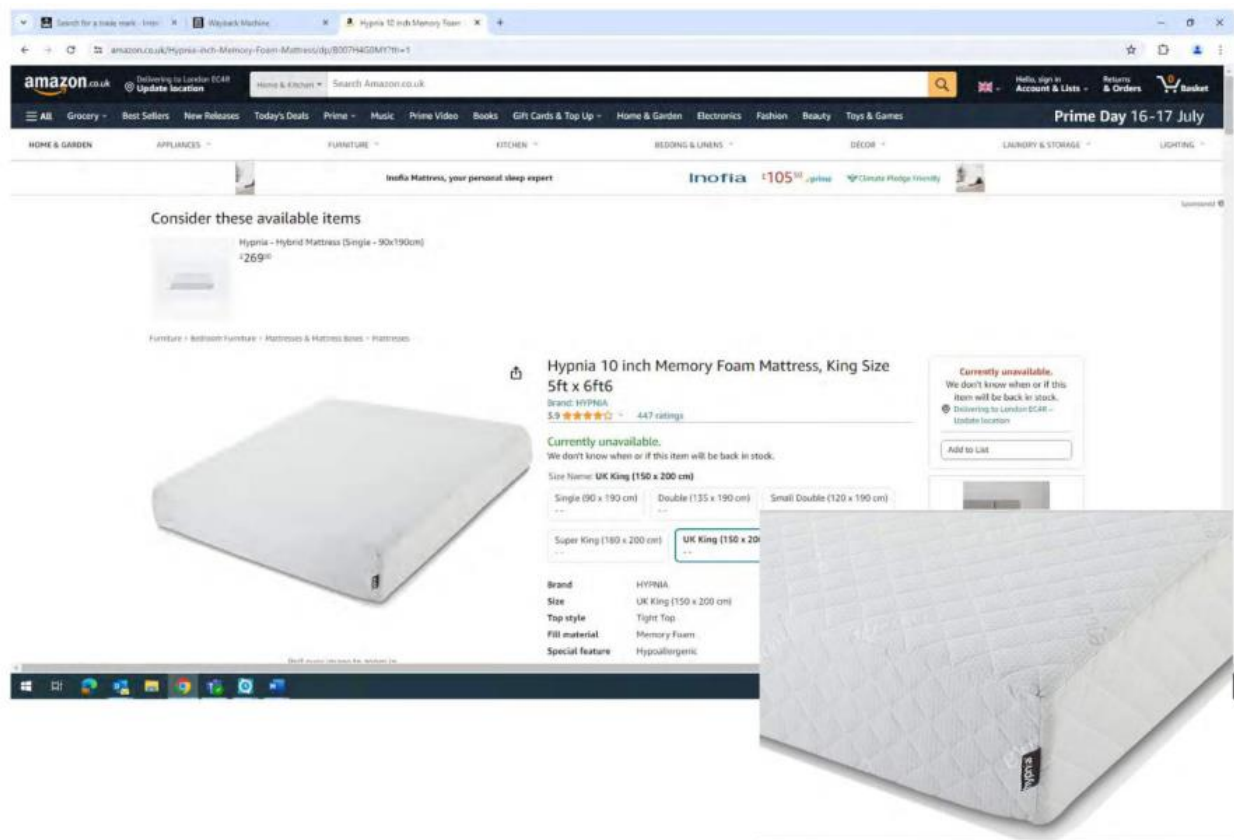
Year	Number of Orders	Turnover GBP
2019	1,148	60,552.55
2020	2,133	366,635.60
2021	795	225,568.19
2022	163	54,413.40

17. These figures do not indicate what proportion of sales can be accounted for by individual products but they are divided according to sales channel. These include the Hypnia website, Amazon, sleeptightmemoryfoam.co.uk and ebay. Exhibit SG7 contains data taken from Amazon showing sales of particular Hypnia Memory Foam Mattresses and Hypnia Memory Foam Toppers between January 2016 and 2 May

¹ Paragraph 36.

² Exhibit SG6.

2022. The following exhibit contains undated screenshots from Amazon showing some of the mattresses, such as the example below:³

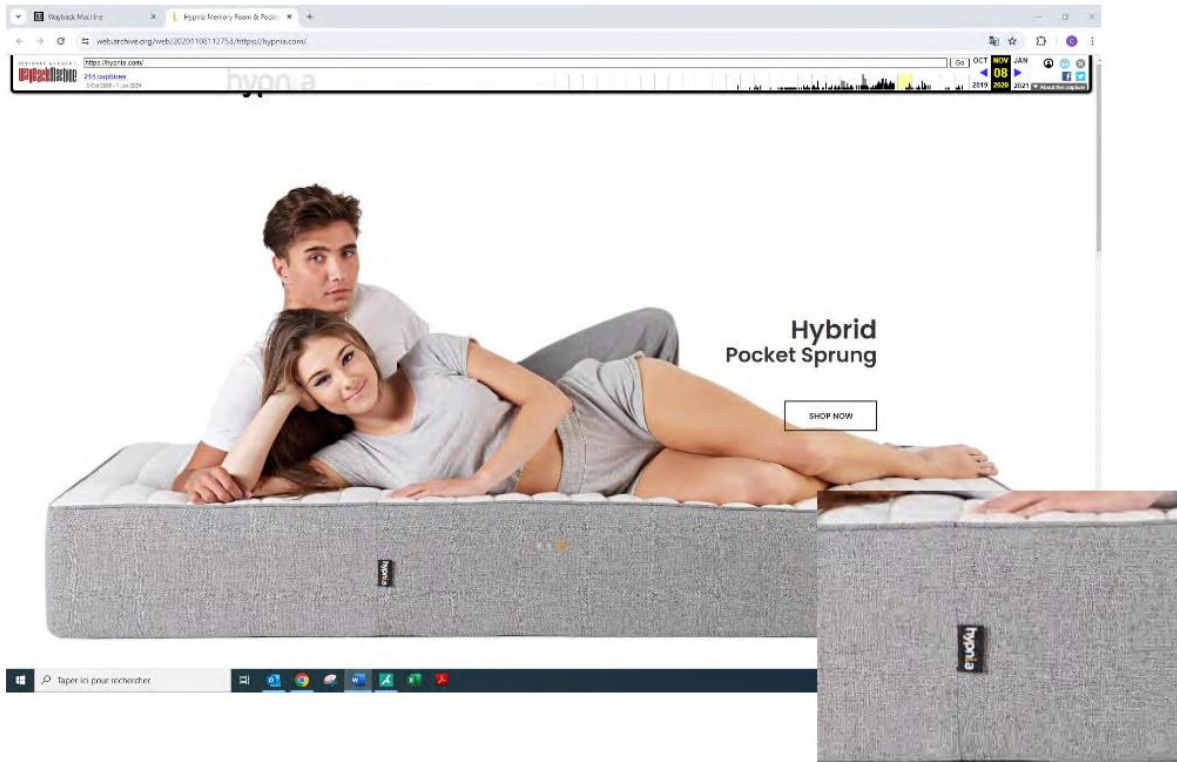


18. The word “hypnia” in the stylisation used in the contested mark can be seen on the label at the end of the mattress. All the mattresses in these screenshots are shown as being “*currently unavailable*” and there are no Amazon screenshots dating from the relevant period. However, the same black label can be seen on goods in screenshots from the hypnia.com website.⁴ This website is in English and shows prices in sterling, so I infer that it was targeted towards UK customers. An example that shows the label most clearly is reproduced below. It is dated 8 November 2020:⁵

³ Exhibit SG8, page 131.

⁴ Exhibit SG4.

⁵ Page 78.

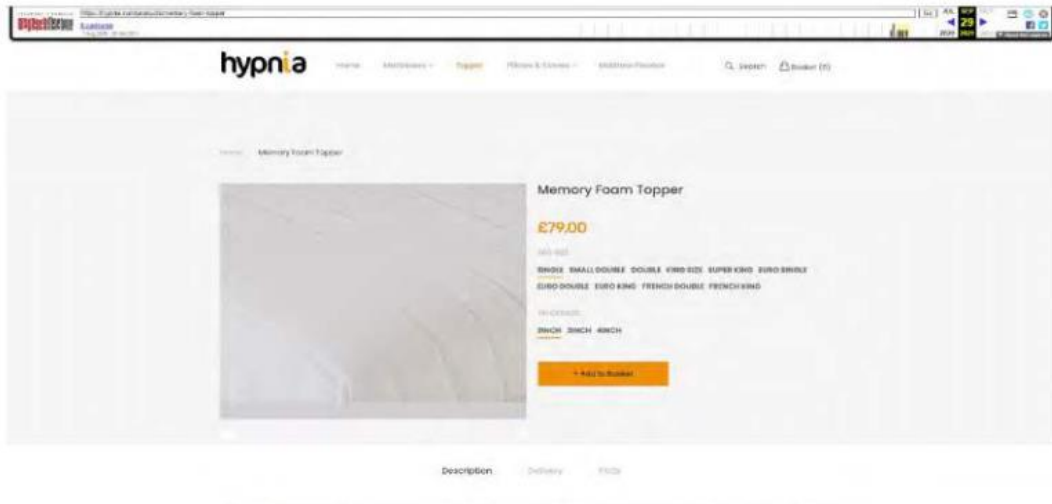


19. The goods offered for sale on the website during the relevant period are mattresses, memory foam toppers, memory foam pillows and pillow and mattress covers. The screenshot dated 25 October 2021 contains the following wording in small print “3am Ltd T/A Hypnia is a registered trading name.”⁶ I can accept that the website at this point was under the control of the registered proprietor’s predecessor in title. The screenshot includes the word “hypnia” on a black background in the same typeface as used in the contested mark.

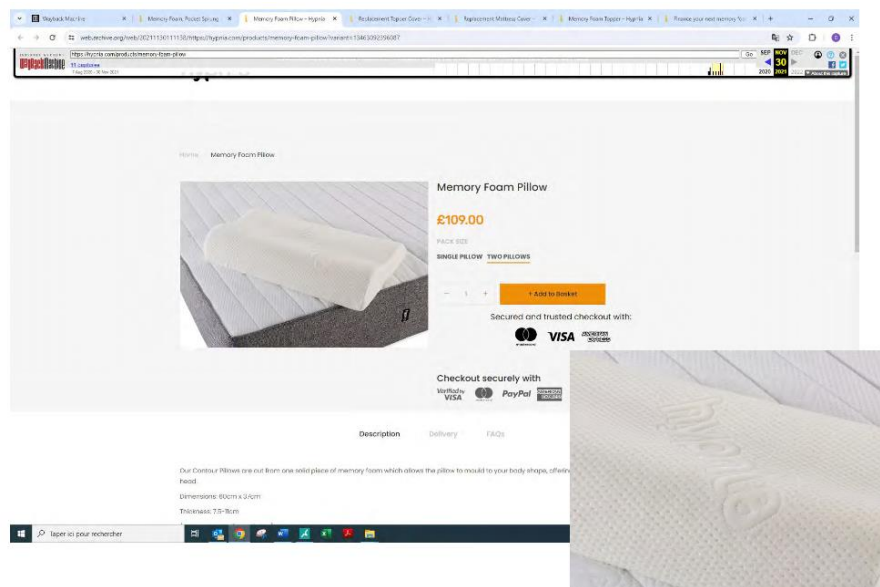
20. Other screenshots show the word “hypnia” in the same typeface as used in the contested mark, together with the letter “i” in orange. The example below is dated 29 September 2021.⁷

⁶ Page 89.

⁷ Page 83.



21. Some of the mattress toppers and pillows are shown to be marked with the word “hypnia”, as in the example below from 30 November 2021:⁸



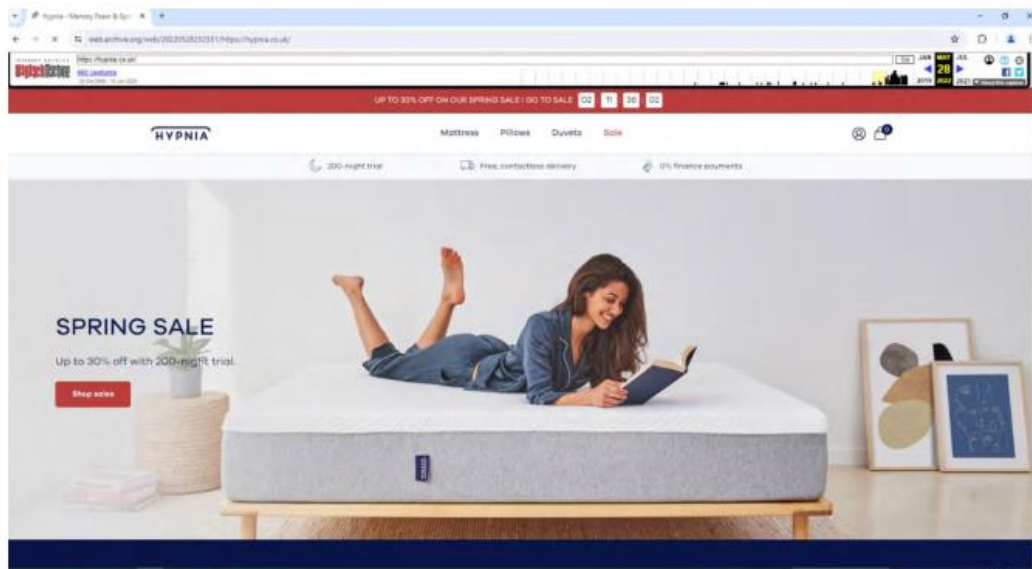
22. Exhibit SG11 contains a selection of invoices from the Shopify account. They are summarised in the table below:

Date	Location of Customer	Goods	Cost GBP
15.04.19	Dartford	Pocket Sprung – Single/Memory Foam	249.00
17.04.19	Uxbridge	Pocket Sprung – King Size/Memory Foam Pocket Sprung – Single/Memory Foam	618.00

⁸ Exhibit SG4, page 101.

Date	Location of Customer	Goods	Cost GBP
27.09.19	Bridgnorth	Memory Foam Topper – Super King	175.00
18.11.19	Wolverhampton	Original Mattress – Double	287.10
17.03.20	Chelmsford	Original Mattress – King Size	359.00
18.03.20	Poole	Original Mattress – Double	199.20
22.11.20	Malmesbury	Original Mattress – Double	195.30
05.03.22	Glasgow	Premium Mattress – King Size	479.40

23. Mr Galloo states that the registered proprietor had been using another Hypnia mark in the EU and that following its acquisition of the contested registration from 3am, it decided to unify the Hypnia brand across the EU and UK. Exhibit SG9 contains screenshots from the website showing the use of this variant mark. The example reproduced below dates from 22 May 2022:⁹



⁹ Page 142.

24. The table below shows UK sales of goods by product category, covering the period 1 May 2022 to 20 August 2023:¹⁰

HYPNIA UK via PHASIS WEB	Accounting Exercises Sales in HYPNIA product exclusively	
	2022-2023	2023-2024
Product categories	01/05/22 to 30/04/23	01/05/23 to 20/08/23
Duvets	2 151,27	552,92
Mattress topper	16 287,61	8 945,67
Pillows	8 973,20	2 255,73
Mattress	686 078,01	218 440,73
Bedside	5 785,74	2 433,91
Sheets	273,77	114,36
Total Turnover UK	719 549,59	232 743,33
	GBP	GBP

Assessment of the evidence

25. The applicant has produced a detailed critique of the registered proprietor's evidence. I shall deal with the points raised, but first remind myself that I am required to view the evidence as a whole. In *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, the General Court said:

“53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark in the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”

¹⁰ Exhibit SG10.

26. I also note that the submissions relate to the revocation actions against both marks and that one of these actions has, as I have already said, fallen away. I shall not address the few criticisms that relate solely to the invalidated mark.

27. The applicant submits that evidence relating to the activities of 3am, such as paragraphs 8 and 9 of Mr Galloo's statement, where he recounts the history of the brand, and the financial information in Exhibit SG6 are hearsay and should be disregarded. Mr Galloo has admitted that he does not have access to the records that were used to create Exhibit SG6. It is this exhibit where the criticisms are most pertinent, as it goes directly to sales made under the contested mark. I remind myself that hearsay evidence can be taken into account and given such weight as the Tribunal deems appropriate. What weight is to be attached to that evidence will depend upon a number of factors that are set out in section 4 of the Civil Evidence Act 1995, which is as follows:

"(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following-

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

28. The registered proprietor submits that the evidence should be given considerable weight, for the following reasons:

“(a) Taken as a whole, it is coherent and strives to provide as accurate an account of historic information as possible.

(b) It is given by a witness with little ability to ‘force’ the relevant party (3am Limited) to become involved in legal matters (such as witness statements), and has to use what contacts he has with them to obtain historically relevant evidence from them, and advance that evidence himself.

(c) The evidence he has been able to obtain is forensic, to at least a reasonable degree of detail, and is corroborated with other historic evidence (including from public sources, such as the internet). It is therefore deeply unlikely to have been falsified or designed to conceal or misrepresent matters merely for the purpose of these Cancellations.

(d) Neither has it been ‘edited’ in some way. The evidence Mr Galloo has been able to obtain from 3am Limited is presented as it was provided to him, or following him being given access to it from sources such as Amazon accounts, etc.”

29. Given the fact that it is stated that someone at 3am was prepared to give Mr Galloo the data, it is surprising that this was not provided under a witness statement. Even so, there are issues with the exhibit that reduce the weight I can give it, regardless of its nature as hearsay. It is described on the table as “*GLOBAL 3am Turnover on Hypnia*”. It does not say that these are global turnover figures for the UK. It therefore seems to me that the figures could include sales made to customers outside the UK, notwithstanding the fact that the figures are displayed in pounds sterling and that some of the websites have UK domains. In addition, the figures are not broken down by product. In *W Sternoff LLC v Kertels (EROS BODYGLIDE)*, BL O/0984/25, Professor Phillip Johnson, sitting as the Appointed Person, said:

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.”

30. I shall therefore look to the other evidence adduced by the registered proprietor to assess the extent of the use that has been made of the contested mark. This consists of records of sales from the Hypnia Amazon account, invoices extracted from Shopify, website screenshots, and the table reproduced in paragraph 22 above.

31. I shall begin with the Amazon records which, according to my calculations, show that 128 mattresses and 64 mattress toppers were shipped to UK customers. I note that the applicant has submitted that the exhibit does not show any shipping or customer information. However, the final column is headed “*ship-country*”. Where this is listed as “GB”, I have inferred that the sales were made to customers in the UK. The applicant also submits that there is no indication as to whether the mark was applied to the goods. The registered proprietor has supplied Amazon screenshots of the products identified by some of the ASIN codes in the table. These are all mattresses with the word “hypnia” on a label, presented in the same colours and stylisation as used in the registered mark. I consider that this is an acceptable variant of the contested mark, as the only matter that is missing is the non-distinctive phrase “memory mattress specialists”, which simply describes the nature of the business.

32. The applicant makes a similar point about the Shopify invoices. It notes that the items listed are not described using the word “Hypnia”. The registered proprietor responds by submitting that, as the invoices come from “Hypnia”, they “*can only*

*sensibly be Hypnia goods because the invoice is coming from Hypnia for what are transparently products sold by the brand. Neither do invoices routinely detail what marks a given product are branded with.*¹¹ Invoices frequently need to be read together with other evidence. I note that the address of Hypnia is the same address as show on the Hypnia website.¹² I have already quoted another website screenshot that states that 3am Ltd traded as Hypnia in 2021.¹³ I can accept that these invoices came from the registered proprietor's predecessor-in-title.

33. I consider that the evidence shows that mattresses and mattress toppers were sold under the mark during the period from 21 February 2019 to April 2022. I note that other goods appear on the website, but I have no evidence that any of these were sold. There is sufficient evidence for me to be satisfied that these were sold by, or with the consent of, the registered proprietor at the time, 3am Ltd. The volumes do not appear to have been very large, but there is no *de minimis* level of sales that must be achieved.

34. I consider it likely, on a balance of probabilities, that the Amazon account from which the sales figures in Exhibit SH7 were taken, was that of 3am Limited. The trade mark assignment agreement states that:

“The other intangible assets held by 3 am ltd, in particular the databases, contracts, domain names, customer files, websites and the Assignor’s Amazon account, are transferred to PHASIS WEB LTD, a wholly owned subsidiary of HELIOS WEB, by separate deed subject to English law.”¹⁴

35. This separate deed is not in evidence, an omission that is noted by the applicant, but I am reluctant to conclude on the basis of its absence that it did not exist. The assignment agreement does not state that the intangible assets are to be transferred to Phasis, but that they are transferred, albeit by a separate deed. Mr Galloo says, under a statement of truth, that the Amazon account belonged to 3am but was transferred to Phasis after the sale.¹⁵ I see no good reason to disbelieve him on this point.

¹¹ Final written submissions, pages 15-16, point (k).

¹² See, for example, Exhibit SG4, page 66.

¹³ Exhibit SG4, page 89.

¹⁴ Exhibit SG2, page 29.

¹⁵ Witness statement, paragraph 39.

36. I shall now turn to the period after April 2022 and the assignment of the contested mark to the registered proprietor. The applicant denies that Phasis had a licence to use the mark and so submits that there is no evidence that any use that was made was with the consent of the registered proprietor. I accept that there is no evidence of a licence between the registered proprietor and Phasis. However, as Phasis was a wholly owned subsidiary of the registered proprietor, I find, on a balance of probabilities, that any use by Phasis would have been with the consent of the registered proprietor.

37. I now turn to the question of whether the mark that was being used at this point is an acceptable variant. For convenience, I reproduce it again here:



38. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This

suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

39. In my view, the dominant and distinctive element of the registered mark is the word “HYPNIA”, with the stylisation and colour making only a small contribution. As I have already noted, I do not consider that the phrase “memory mattress specialists” is a distinctive element of the mark. Comparing the contested mark to the newer form, I note that both marks contain the word “HYPNIA”. The additional material in the newer variant is a line above the word. This is straight, but curves at each end. The whole mark is in blue, as opposed to the registered mark’s white, black and orange. The typeface is different and the newer variant uses upper-case rather than lower-case letters. Nevertheless, I find that the distinctiveness of the variant lies in the word “HYPNIA”. In my view, and following the case law set out above, the distinctive character of the contested mark is not changed, and so this is an acceptable variant.

40. Website screenshots show the mark in use on mattresses. I also note that at the top of the screenshot, there are links to other products. For example, on the screenshot dated 30 October 2023, these are “Topper”, “Pillows”, “Duvets” and “Bedding”. The table of sales between 1 May 2022 and 20 August 2023 shows that mattresses were the largest category of goods sold, followed by mattress toppers and pillows. I am unsure what is meant by the term “Bedside” and note that there is no explanation of this in the witness statement. Sales of sheets and duvets are noticeably lower than those of the other goods. I have no images of these goods offered for sale and so am unable to see how, or if, the mark was used in connection with them. The applicant submits that these figures do not show sales in the UK. However, as the table specifically gives a “Total Turnover UK”, I accept that these are UK figures.

41. Taking the evidence as a whole, I consider that the registered proprietor has shown genuine use of the mark for *Foam mattresses; Mattress toppers; mattresses; pillows*. I can see no evidence of use for beds or cushions. I understand the term *Bedding* to mean bedclothes, and I have found no genuine use for these goods.

42. Turning to the services, I note that there is evidence of a website offering goods for sale. However, in *Apple, Inc. v Deutsches Patent- und Markenamt*, Case C-421/13, the Court of Justice of the European Union (“CJEU”) ruled that a trade mark registered for retail services may be protected for services intended to induce the consumer to purchase the goods provided that those services do not form an integral part of the offer for sale of the goods. It said:

“26. ... it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple’s application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of ‘service’.”

43. It follows that merely selling goods is not a service for which a trade mark may be protected in Class 35. I see no evidence of services that do not form an integral part of the offer for sale of goods, and so I find that the contested mark has not been genuinely used for those services.

OUTCOME

44. The application for revocation is partially successful. The registered proprietor has not shown that the mark has been genuinely used for the following goods and services, and, subject to a successful appeal, UKTM No. 916475841 is revoked in respect of them with effect from 21 February 2024:

Class 20

Beds, bedding ... and cushions.

Class 35

Retail services connected with the sale of furniture; Wholesale services in relation to furniture.

45. The registration is maintained for the following goods:

Class 20

Foam mattresses; Mattress toppers; Mattresses, pillows.

COSTS

46. Both parties have had some success in these proceedings, with honours being roughly even. I therefore make no order as to costs.

Dated this 27th day of November 2025

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