

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3,229,490 IN THE NAME OF DREAMERSCLUB LTD

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF ANDREW FELDON DATED 24 SEPTEMBER 2018 (O/596/18)

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DECISION

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**Introduction**

1. This is an appeal from the decision of Andrew Feldon, for the Registrar, dated 24 September 2018 in which he dismissed the KTS Group Limited's opposition under section 5(2)(b) of the Trade Marks Act 1994 to the application of Dreamersclub Ltd. KTS appeal that decision.
2. Originally, the application in suit (No 3,229,490) covered two word marks and one stylised mark. The two word marks were deleted and now the Respondent is seeking to register only the following stylised mark in Classes 25 and 35:



3. The opposition was based on two earlier trade marks. The first was the word mark DREAM (No. 2,216,417) and the second the word mark DREAMS (No 2,060,937). Both of these marks were more than five years old at the date of filing of the application in suit and so the Appellant was required to prove use.
4. This appeal relates to a single issue. The Hearing Officer found that the Appellant had proved use of a stylised version of the word mark DREAMS. However, he found that this stylised form of the mark differed sufficiently from the word mark such that it altered its distinctive character and so the use of that stylised mark was not use of the word mark. The Appellant appeals this finding.

**Standard of appeal**

5. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person. Mr Alexander summarised the position at paragraph 52 of his Decision (I made a few minor updates to this summary in *Grill'O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([...][CPR 52.21]).
- (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
- (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).
- (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person 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. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
- (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

6. I will apply these principles.

### **The appeal**

7. As I have already indicated, the single issue in the appeal was whether the use of the mark in the form below amounted to use of the simple word mark DREAMS (and DREAM) for the purposes of section 6A of the Trade Marks Act 1994:

The image shows the word 'dreams' written in a highly stylized, cursive, handwritten font. The letters are thick and connected, with a fluid, signature-like appearance.


8. The key provision is section 6A(4)(a) (which implements article 16(5)(b) of the Recast Trade Marks Directive 2015/2436):

(4) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered...

9. The Hearing Officer's conclusions were in paragraphs 21 and 22 of the Decision:

The distinctiveness of the earlier marks as registered, lies in the plain words 'DREAM' and 'DREAMS'. The mark 'DREAM' has not been shown in use by the opponent. The mark 'DREAMS', as used in trade by the opponent, is presented in a heavily stylised design, similar in some respects to a signature effect. The mark 'DREAMS' as used, is a substantially altered variation of the registered mark in my opinion, and would have a significant impact on the average consumer...

I find the mark in use, namely:  to be a variant of the registered mark 'DREAMS' that goes beyond the normal course of trade evolution, and in which the stylistic differences from the plain word mark can be said to clearly alter the distinctive character found in that plain word mark. I am reminded of *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL 0/404/13, in which Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, reviewed a mark which had been registered in plain letters, but used in stylised form. He said "The way in which the former individualises the latter may perhaps be analogised to the way in which a signature individualises the name it represents." The way in which the opponent in this case has used its mark is in the style of a signature. I do not find that the average consumer, even presupposing that they perceive the word 'dreams' in the mark being used by the opponent, something that cannot be guaranteed, would assume that the goods provided under that stylised mark originate from the same undertaking as those products badged with the earlier registered mark 'DREAMS'. Accordingly, I find that there has been no genuine use of the opponent's earlier marks during the relevant period

10. The Appellant's case is that the use of the stylised mark was sufficient use of the word mark DREAMS (and DREAM) as it does not alter its distinctive character.

### **Word marks**

11. The Hearing Officer treated the word mark as a "plain word mark". He did not consider the extent of protection granted to word marks. The General Court has long held a view on word marks which was recently reiterated in T-24/17 *La Superquimica v EUIPO*, EU:T:2018:668 at paragraph 39:

it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which

the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type...

12. The broad protection for word marks originated in comparisons for similarity (see T-211/03 *Faber v OHIM* [2005] ECR II-1297, paragraph 37 and T-434/07 *Volvo v OHIM* [2009] ECR II-4415 at paragraph 37). When this rule was applied to use in T-333/15 *Josel v EUIPO*, EU:T:2017:444, the General Court held that “the font that the sign might be presented in must not be taken into account” (at paragraph 38) and this was reiterated in *Superquimica*. The word “font” is now widely used to mean “typeface and font” and this must be what the General Court meant. In printing, the typeface is the particular design of the type (e.g. Times New Roman) and the font is its size and weight (e.g. 10pts and bold).
13. Neither the Hearing Officer nor the parties in their written submissions before the Hearing Officer (or in their written submissions before me) addressed this well-known rule. This led the Hearing Officer into error. The presentation of the DREAMS mark in paragraph 7 above is no more than it being represented in a cursive typeface.
14. Accordingly, for the purposes of assessing use of the DREAMS word mark the fact it has been presented in what might be called a cursive typeface and not as a plain word mark must be disregarded. Following the Hearing Officer’s finding in paragraph 13 of his Decision that the stylised DREAMS mark had been used he should have gone on to find that the “plain” word mark DREAMS has been sufficiently used for the purpose of section 6A.
15. Another question arises as to whether the addition of the letter “S” in the stylised DREAMS mark used affects the distinctive character of the word mark DREAM. In other words, whether use of the mark in paragraph 7 above is use of both word marks DREAM and DREAMS.
16. The General Court has held in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333):

... where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.
17. It appears that the General Court applies quite a liberal test in this regard, it has held that the addition of words or minor figurative elements can be seen as broadly equivalent and so do not alter the distinctive character of the mark: see for instance: T-287/15 *Tayto Group*, EU:T:2017:443; T-418/16 *Galletas Gullón*, EU:T:2017:746; and T-204/14 *Victor International*, EU:T:2016:448.
18. In the circumstances, the pluralisation of DREAM into DREAMS cannot be held to alter the distinctive character of the word mark DREAM. Accordingly, the use of the stylised DREAMS would also be use of the mark DREAM.

19. Therefore, I overturn the Hearing Officer's finding that there was no use of the marks DREAM and DREAMS and remit the matter back to him to consider the substantive objection under section 5(2)(b). I also discharge his costs order.
20. The parties provided only short written submissions for this appeal and so I make no award as to costs.

PHILLIP JOHNSON  
11 February 2019