

**O-455-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 1452228  
IN THE NAME OF BUILDING ROBOTICS, INC.  
FOR THE TRADE MARK**

**COMFY**

**IN CLASSES 9 AND 42**

**AND**

**OPPOSITION THERETO UNDER NO. 416539  
BY SOMFY ACTIVITIES SA**

## **Background and pleadings**

1. This is an opposition against international trade mark registration number 1452228 **COMFY**, in the name of Building Robotics, Inc. (“the holder”). The international registration date, and the date of designation, is 14 January 2019. The mark was accepted and published in the Trade Marks Journal on 8 March 2019 in respect of the following goods and services:

Class 9        Computer hardware and mobile software for control and automation of building systems and climate control systems.

Class 42        Providing temporary use of on-line non-downloadable software for control and automation of building systems and climate control systems.

2. Somfy Activities SA (“the opponent”) opposes the trade mark on the basis of sections 3(1)(b), 3(1)(c) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition under each of these grounds is directed against all of the goods and services of the application. The opponent claims under ss. 3(1)(b) and (c) that the mark is non-distinctive and/or descriptive because:

- “Comfy” is the commonly understood English word for being in a state of comfort or for an object that provides comfort as in “I do not want to move, I am comfy” and also “Is this chair comfy?”;
- “Climate control systems” make the users of buildings comfortable by controlling the climate [...] so that it is not too hot or cold, these goods/services therefore make buildings comfortable and therefore they make the users of the building “comfy”.

3. Under s. 5(2)(b), the opponent relies upon its European Union trade mark registration number 12191301 for the mark shown below:



The colour yellow (Pantone 1235C) is claimed. The trade mark has a filing date of 2 October 2013 and was registered on 27 February 2014. The mark is registered for a wide range of goods and services; for the purposes of this opposition, the opponent relies upon all of the goods and services in classes 9, 41, 42 and 45 for which the mark is registered and which are listed in full in the annexe to this decision. The opponent claims that the similarity or identity between the goods and services, combined with the similarity between the marks, will result in a likelihood of confusion.

4. The holder filed a counterstatement, subsequently amended, denying the basis of the claims. In particular, it denies that the marks are similar, claiming that there is no conceptual similarity. It also disputes the meanings of “comfy” outlined in the claim and put the opponent to proof thereof.

5. Both parties filed evidence, all of which I have read but which I will summarise only to the extent that I consider necessary. A hearing took place before me on 6 July 2020, by video conference, at which the opponent was represented by Kieron Taylor of Swindell & Pearson Ltd and the holder by Martin Krause of Haseltine Lake Kempner LLP.

## **Evidence**

### **Opponent’s evidence**

6. This consists of the witness statement of Kieron Taylor, an IP Director at the opponent’s professional representatives, with accompanying exhibits KPMT01-KMPT09.

7. Mr Taylor provides ten dictionary definitions of the word “comfy”.<sup>1</sup> These include: “a comfy item of clothing, piece of furniture, room, or position is a comfortable one” ([www.collinsdictionary.com](http://www.collinsdictionary.com)); “comfortable” ([www.merriam-webster.com](http://www.merriam-webster.com)); and that it is informal or colloquial for “comfortable” ([dictionary.cambridge.org](http://dictionary.cambridge.org), *Concise Oxford Dictionary of English*, 8<sup>th</sup> ed.1990). None indicates that “comfy” is anything other than a synonym or shortening of “comfortable”. All but two specify that it is an informal word.<sup>2</sup>

8. Four dictionary definitions of “climate control” are also provided, from sources including [www.collinsdictionary.com](http://www.collinsdictionary.com) and [en.wiktionary.org](http://en.wiktionary.org).<sup>3</sup> They all agree that the term includes air conditioning, though two also refer to temperature and relative humidity being controlled by a heating system.

9. Definitions of “HVAC” are in evidence, from [www.collinsdictionary.com](http://www.collinsdictionary.com) and [www.dictionary.com](http://www.dictionary.com).<sup>4</sup> Both agree it means “heating, ventilation and air conditioning”, though the Collins entry suggests that it is a term in American English. There is also an article from [boxt.co.uk](http://boxt.co.uk) about HVAC systems.<sup>5</sup> It says that they are also known as “climate control” systems. There are references to the HVAC systems making “more comfortable living conditions” and ensuring a comfortable temperature. There is also an article from Wikipedia about HVAC systems, which says that HVAC is “the technology of indoor and vehicular environmental comfort” and refers to “thermal comfort”.<sup>6</sup> It also says that “natural ventilation schemes can use very little energy, but care must be taken to ensure comfort”.

10. There are also prints from Wikipedia about “air conditioning” as well as dictionary definitions of the same term.<sup>7</sup>

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<sup>1</sup> KPMT01.

<sup>2</sup> The exceptions are [www.merriam-webster.com](http://www.merriam-webster.com), [www.urbandictionary.com](http://www.urbandictionary.com)

<sup>3</sup> KPMT02.

<sup>4</sup> KPMT03.

<sup>5</sup> KPMT05.

<sup>6</sup> KPMT06.

<sup>7</sup> KPMT04.

11. An undated print from keibasolutions.co.uk discusses climate control systems and says that the various technologies will be used to maximise the comfort of family or staff.<sup>8</sup>

12. An undated print from simplyclimatecontrol.com (apparently located in Suffolk) refers twice to “year-round comfort” in relation to climate control systems.<sup>9</sup>

13. An article from ambiclimate.com dated 26 January 2018 is entitled “How to make sure your baby is comfy when using the air conditioner” and refers to both comfort and thermal comfort.<sup>10</sup>

### **Holder’s evidence**

14. This consists of the witness statement of Martin Krause, a partner and Trade Mark Attorney at the holder’s professional representatives.

15. Mr Krause exhibits an article entitled “Building Systems Efficiency”, dated 12 July 2018, from www.ase.org, which appears to be concerned with the US (references appear to be to, for example, US government websites and building codes).<sup>11</sup> It defines a “building system” as “a combination of equipment, operations, controls, accessories, and means of interconnection that use energy to perform a specific function. Examples include HVAC, water heating, lighting, thermal envelope, and miscellaneous electrical load systems”.

16. The *Collins* online definition of “comfortable” is provided.<sup>12</sup> The *Collins English Dictionary* meanings are “giving comfort or physical relief”, “at ease”, “free from affliction or pain”, “relaxing”, “having adequate income” and “(of income) adequate to provide income”. Various example sentences are shown, such as “if a building or room is

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<sup>8</sup> KPMT07.

<sup>9</sup> KPMT08.

<sup>10</sup> KPMT09.

<sup>11</sup> MK1.

<sup>12</sup> MK2.

comfortable, it makes you feel physically relaxed when you spend time in it, for example because it is warm and has nice furniture”.

17. Examples of use of the word “comfy”, mainly in national press publications, between 2006 and 2016, and taken from *Collins* online are in evidence.<sup>13</sup> Seats, beds and chairs, rooms and clothes are described as “comfy”. One sentence reads “we all have our preference when it comes to getting comfy in the air” (*Sun*, 2015).

18. There is also a print from thesaurus.com, which lists synonyms for “comfortable” (“comfy” is not included) and “comfy” (“comfortable” is given as the definition but not a synonym).<sup>14</sup> The copyright notice is 2013.

## **Decision**

19. The relevant parts of s. 3 of the Act read:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

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<sup>13</sup> MK3.

<sup>14</sup> MK4.

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it”.

20. There is no claim to acquired distinctiveness. The relevant date for determining whether the mark is objectionable under the above grounds is the date of designation, i.e. 14 January 2019.

21. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of s. 3(1)(c), but still be objectionable under s. 3(1)(b) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

### **Section 3(1)(c)**

22. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate

the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. [...] due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the



order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And,

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from

Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused

registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]”.

23. The position must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. Mr Taylor made no submissions on the identity of the average consumer, though he did accept that the level of attention will not be at a low level (such as that for a bag of sweets). Mr Krause submitted that the average consumer will be either a member of the public or a professional. He submitted that the average consumer will pay a high degree of attention because the goods and services are technical in nature and not in common use, and their precise specifications and functionality will be of concern.

24. I accept Mr Krause’s submission that the average consumer will be a member of the general public or a professional. Whilst I agree that the average consumer will take some care in the process, and that factors such as functionality will be considered, I am not persuaded that the goods and services are susceptible to a high degree of attention. They are hardware, software and software services: unlike the systems which they regulate, they do not strike me as very expensive, specialist or very rare purchases. Overall, the member of the public will pay a medium degree of attention, with professional users, for

whom contracts/installations are likely to be more costly or complex, paying a reasonably high level of attention.

25. I also agree with Mr Krause that the purchasing process is likely to be mainly visual: the goods and services will be selected from the shelves of retail premises, or their online equivalents, perhaps after browsing catalogues, in digital or paper form. Discussions with sales representatives or shop assistants may, however, introduce an aural aspect to the purchase, which I will keep in mind.

26. There appears to be no dispute that “comfy” is a synonym of the word “comfortable” and that it will be so perceived by the average consumer. However, the holder’s position is that the term is not interchangeable with “comfortable” in every sense: it argues that “comfy” has a specific meaning concerned with “tactile comfort” (e.g. whilst a chair might be described as comfy, comfy would not be used to indicate financial comfort). I am not persuaded that the meaning of “comfy” is so restricted. None of the dictionary evidence before me limits the meaning in any way: all that is indicated is that “comfy” is an informal abbreviation of “comfortable”. Even if “comfy” does not tend to be used in certain circumstances, there is no obvious reason why the consumer would not understand “comfy” to mean “comfortable” if it were used to indicate, for example, that an individual had adequate income. In any event, I have no doubt that “comfy” may be and was at the relevant date used to describe people or rooms as physically comfortable.

27. The opponent’s case is that “comfy” is descriptive of an object that provides comfort or that the goods/services make buildings comfortable and therefore they make the users of the building “comfy”. There was a suggestion that “building systems” is not a clear term. I do not agree: it is doubtless a wide term but it will cover all types of building systems (such as electrical and plumbing systems) and will include temperature control systems. However, I do not see how “comfy” describes a characteristic of the contested hardware, software or software services (as opposed to the effect that the use of such goods or services in temperature control systems may have on people or a building). Whilst air conditioning could be described as comfy, I am doubtful that the same can be said of the

computing goods or services which stand behind the air conditioning systems. The contested goods and services themselves are not apt to be described as “comfy”, as they are neither worn nor inhabited, nor can I see any other circumstance in which “comfy” would be understood as a characteristic of these goods and services.

28. The opponent’s second claim, that the use of the contested goods and services will result in a comfy environment or comfy individuals, appears to be a claim regarding the intended purpose of the goods and services. However, the connection between the goods/services and the term “comfy” on the one hand, and on the other the resulting effect of the goods and services, specifically their use in climate control/air conditioning or heating systems, is insufficiently direct and specific for “comfy” to be perceived as the intended purpose of the goods and services. In my view, “COMFY” evokes the intended purpose (i.e. the effect of temperature control systems on people/their environment) but does not describe it. The opposition under s. 3(1)(c) is dismissed.

### **Section 3(1)(b)**

29. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29. [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37”).

30. The opponent maintains that the mark is devoid of distinctive character, both because it is descriptive and because it is non-distinctive per se. However, as pleaded there is no separate basis for the objection under s. 3(1)(b). The ground must, therefore, fail for the same reasons as given above. Mr Taylor suggested at the hearing that the term should be kept free for others to use, as they may be in difficulty if they wished to use the term descriptively. Even if this had been pleaded originally, given my findings in relation to descriptiveness, I see no justification for keeping the term free for the use of others. That is particularly the case as purely descriptive use is unlikely to cause traders difficulty of the sort suggested by Mr Taylor. Furthermore, the evidence is insufficient to establish that “COMFY” is commonly used in the sector and that it is consequently unable to distinguish the goods and services of one undertaking. The ground under s. 3(1)(b) fails.

### **Section 5(2)(b)**

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

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

32. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case

C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

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

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

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

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

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

### **Comparison of goods and services**

33. Some of the contested goods and services in classes 9 and 42 are identical to the goods and services on which the opposition is based. The opponent argues that the remaining goods and services are similar. For reasons which will become clear, I will not undertake a full comparison of the goods and services. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade mark. If the opposition fails even where the goods and services are identical, it follows that the opposition will also fail where they are only similar.

### **The average consumer and the nature of the purchasing act**

34. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. 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 in question: *Lloyd Schuhfabrik*.

35. I indicated, above, that the average consumer of the contested goods and services will be a member of the general public or a professional. I also found that the member of the public selecting such goods and services will pay a medium degree of attention, with professional users, who may require more costly or sophisticated goods/services, paying a reasonably high level of attention. I also found that the purchasing process will be predominantly visual but that there may be an aural element, which I will not discount. Self-evidently, the same will be true for the identical goods/services in the earlier specification. For the sake of completeness, I would add that I see no reason why the same would not also apply to the remainder of the earlier specification, though I acknowledge that some of the goods/services are more likely to be purchased by one group than the other (for example, the average consumer of smoke detectors is more likely to be a member of the public).

### **Distinctive character of the earlier trade mark**

36. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

37. There is no evidence that the earlier mark has been used and there is, therefore, only the inherent position to consider. The earlier mark is the word “somfy”, presented in a

stylised format and in yellow. The word has no apparent meaning and no connection with the goods or services for which the mark is registered. It is inherently distinctive to a high degree.

### Comparison of trade marks

38. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

39. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Contested mark
 The logo for Somfy, featuring the word 'somfy' in a lowercase, rounded, sans-serif font. The 's' is yellow, and the 'omfy' is orange.	COMFY

40. The earlier mark consists of the word “somfy”, presented in a stylised typeface and a particular shade of yellow. The “o” is rather more stylised than the other letters in the mark but that will not prevent the mark being perceived as the word “somfy”. That word dominates the overall impression; the stylisation and colour are likely to be perceived as decorative and will play only a weak role.

41. The contested mark consists of the word “COMFY”. The overall impression is contained in that word.

42. Mr Taylor submitted that the marks are visually and aurally similar. He argued that the letters “C” and “s” do not have a fixed pronunciation which, as I understood his submission, may result in the letters being articulated in the same fashion in the marks at issue.

43. Mr Krause submitted that there is an immediate difference visually between the letters “C” and “s” and, while he accepted that the pronunciation of “C” and “s” can be similar, he argued that that would not be the case with the marks at issue. He submitted that there was no more than a relatively low degree of similarity, if any.

44. The most important visual difference between the marks is the different first letter (“C” and “s”), though there are also differences because of the particular stylisation in the earlier mark. As the contested mark could be used in any colour, the colour of the earlier mark does not assist the holder. Bearing in mind the position of the different letters, the impact that difference will have in words only five letters long and the weak impact of the presentational elements of the earlier mark, there is a medium degree of visual similarity.

45. Turning to the aural comparison, I do not accept that the letters “s” and “C” will, in this case, bear any resemblance to one another. The word “COMFY” is a common one whose pronunciation is settled and I have no doubt that the “C” will have a hard sound. The “-

OMFY” element will be the same in both marks. I consider that there is a medium degree of aural similarity.

46. Mr Taylor accepted that the marks are conceptually different because “COMFY” has a meaning, whilst “somfy” does not. I agree: the meaning of “COMFY” will be known to the average consumer and renders it conceptually different from the earlier mark.

### **Likelihood of confusion**

47. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner.

48. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law”.

49. However, conceptual differences between trade marks are not always sufficient to avoid the likelihood of confusion: *Nokia Oyj v OHIM*, Case T-460/07.

50. Confusion is more likely the lower a consumer's level of attention. I will, therefore, look first at the general public purchasing these goods and services, which will entail a medium degree of attention and will be a predominantly visual process. The fact that it is a visual purchase must be properly considered alongside my finding of a medium degree of visual (and aural) similarity between the marks. Notwithstanding that I have proceeded on the basis that the goods and services are identical, which is a factor in favour of confusion, I find that there is no likelihood of confusion in this case. The strong conceptual message conveyed by the word "COMFY" will be understood and retained by the average consumer. The mark will not be mistaken for the invented word "somfy", or vice versa. Whilst imperfect recollection must be borne in mind, my view is that the clear concept of the contested mark will more than outweigh the visual and aural similarities. It follows that where the consumer pays a higher level of attention to the purchase, there is even less likelihood of confusion. The opposition based upon s. 5(2)(b) is dismissed.

## **Conclusion**

51. The opposition has failed. The mark will proceed to registration.

## **Costs**

52. The holder has been successful and is entitled to an award of costs, which are sought on the scale (Tribunal Practice Notice (2/2016) refers). I award costs to the holder as follows:

Considering the notice of opposition and filing the counterstatement: £200

Filing evidence and considering the other party's evidence £500

Preparing for and attending a hearing: £600

Total: £1,300

53. I order SOMFY ACTIVITIES SA to pay Building Robotics, Inc. the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of September 2020**

**Heather Harrison**

**For the Registrar**

## ANNEXE

### **EUTM 12191301: specification relied upon:**

Class 9: Electric or electronic apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for the transmission of sound or images in the field of home automation; Apparatus for biometric, visual and vocal recognition of people; Electric or electronic apparatus and instruments for timing, recording and/or controlling events; Electric actuators containing a motor; Computer operation systems for the automation and management of the household and household equipment; Communications software for home automation servers; Computer software for downloading application programs and for remote configuration in the field of home automation; Electrical apparatus and/or software for monitoring communications networks; Connectors (electrical); Electric valve actuators; Remote controls; Electronic tags and memory cards containing data or programs used for authenticating and/or controlling access and/or for transmitting parameters to building equipment, all the aforesaid goods used for manoeuvring, commanding, controlling, remotely controlling, regulating, monitoring or programming electric or electronic equipment for use in lighting, security, alarms, heating, steam production, cooking, refrigeration, drying, ventilation, air conditioning, water distribution, access control, solar protection, opening, closing and locking of doors, garage doors, gates, barriers, fences, shutters, blinds, grilles, manoeuvring locks, door handles, window handles, curtains, curtain rods, projector screens, moving movable walls, sliding panels, all the aforesaid goods relating to individual or collective households, public or private buildings and public or private parking spaces, leisure or rest areas; Electric or electronic apparatus and instruments for processing, storing, transmitting, broadcasting, receiving data relating to automation and management of the household and household equipment; Interfaces for home automation applications; Electric or electronic remote control apparatus with home automation functions for equipment in the household and/or buildings, in particular via Internet communication and telecommunication networks including mobile telephones, enabling installation, configuration, control, management, surveillance, in particular from computers or mobile telephones, of home automation functions and applications for automation and/or motorisation of blinds, shutters, window openings, locks, doors, gates and other access systems, lighting, ventilation, air conditioning, heating, control and management of security, access control, surveillance and alarm, fire detection systems, apparatus for measuring the quality of ambient air, controllers of electric (electronic apparatus for controlling energy supply for electric apparatus) and/or gas consumption, electricity, heat or other types of energy, automatic watering monitors, water consumption apparatus; Computer software enabling driving, automation and control of said electric, electronic and/or computer applications; Servers for home automation applications facilitating the reception and transmission of commands by remote control and the operation of data storage; Modems for home automation servers, connectors to a computer network or home automation network; Telecommunication terminals for automation and management of the household and household equipment; Computerised



and communication transmitting and receiving apparatus for home automation; Electronic docking stations and electronic digital tablets for automation and management of the household and household equipment; Digital terminals for tertiary and residential buildings; Digital terminals for tertiary and residential buildings providing transmission, reception and decoding functions; Handheld electronic devices for the wireless receipt and/or transmission of data for remote automation and management of the household and household equipment; Brochures, guidebooks and instruction manuals on electronic media relating to household automation; Magnetic or encoded access control, identity and identification cards; Occupancy sensors, wind sensors, internal light sensors, sunlight sensors, temperature sensors, rain sensors, snow sensors for electrical lighting, alarm, blind, shutter or heating control apparatus; Smoke detectors; Detectors; Video telephones; Thermostats; Video surveillance cameras; Electrical sockets; plugs and jacks; Sirens; Electronic identification apparatus for use in the assistance of biometric identification techniques; batteries, including electric batteries and rechargeable batteries; Safety or signalling luminous beacons; Signals (luminous); Electric and electronic apparatus and installations for security and access supervision; Electronic keys; Electric and electronic control, signalling and measuring apparatus and instruments for electric and electronic data processing systems and data carriers, cash registers, automatic machines operating via banknotes, coins, magnetic or microprocessor cards or bank cards, for controlled access to restricted areas and parking areas; Encoded and pre-paid magnetic cards, magnetic access-control, identity and identification cards; Electric and electronic locks; Remotely controlled electric locks; Remotely controlled electric sockets.

Class 41: Providing of training relating to assembly, installation, use and maintenance of electric or electronic remote control apparatus and instruments with home automation functions for equipment in the household and/or buildings; Providing of training relating to home automation applications for automation of the household and/or buildings; Organisation and conducting of conferences and seminars in the field of home automation.

Class 42: Rental of apparatus for recording, reproduction and processing of text, data, sound, images and moving images, computer database servers (software), personal digital assistants in the field of automation and management of the household and household equipment; Hosting of websites, secure messaging in the field of motorisation of openings, automation and management of the household and household equipment; Technical consultancy and expertise in the field of home automation; Consultancy (technical assistance) relating to computer systems in the field of motorisation of openings, automation and management of the household and household equipment; Remote management of computerised data in the field of motorisation of openings, automation and management of the household and household equipment; Computer systems facilitating remote access to telecommunications services in the field of motorisation of openings, automation and management of the household and household equipment; Conversion of data and computer programs (other than physical conversion) in the field of home automation; Conversion of documents from physical to electronic

media in the field of home automation; Providing of technical information relating to home automation networks in the household.

Class 45: Surveillance, remote surveillance and video surveillance for the protection of people, goods and buildings; Security consultancy.