

O/365/21

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 1452228
IN THE NAME OF BUILDING ROBOTICS, INC.**

**AND IN THE MATTER OF OPPOSITION No. 416539 THERETO
BY SOMFY ACTIVITIES SA**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MS HEATHER HARRISON
DATED 17 SEPTEMBER 2020**

DECISION

Introduction

1. This is an appeal against a decision of Ms Heather Harrison, acting for the Registrar, dated 17 September 2020, BL O/455/20. In that decision Ms Harrison refused an opposition brought by Somfy Activities SA (“the Opponent”) against protection in the UK being afforded to International Trade Mark Registration number 1452228 in the name of Building Robotics, Inc. (“the Holder”).
2. The request for protection in the UK of International Trade Mark 1452228 for the designation COMFY was made on 14 January 2019 in relation to 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
3. The designation was published in the Trade Marks Journal on 8 March 2019.
4. On 10 June 2019, the request for protection in the UK was opposed by the Opponent under Sections 3(1)(b), 3(1)(c) and 5(2)(b) of the Trade Marks Act 1994.

5. Under Section 5(2)(b) the Opponent relied on the Opponent's earlier EU Trade Mark Registration number 12191301 **somfy** registered for goods and services *inter alia* in Classes 9, 41, 42 and 45 as listed in the annexe to the Hearing Officer's decision.
6. The Holder denied the opposition in an amended Notice of defence and counterstatement dated 12 August 2019.
7. Both sides filed evidence and attended a hearing by video conference that took place on 6 July 2020 when the Opponent was represented by Mr Kieron Taylor of Swindell & Pearson Ltd and the Holder by Mr Martin Krause of Haseltine Lake Kempner LLP.
8. As I have said, the Hearing Officer dismissed the opposition on both absolute and relative grounds for reasons stated in her decision, BL O/455/20, issued on 17 September 2020.
9. On 15 October 2020, the Opponent filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's decision under Sections 3(1)(b), 3(1)(c) and 5(2)(b).
10. It was accepted that the appeal was by way of review, not rehearing and that I should be reluctant to interfere in the absence of error. In those regards I was referred to *TALK FOR LEARNING Trade Mark*, BL O/017/17, *Apple Inc. v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) and *Abanka D.D. v Abanca Corporación Bancaria S.A.* [2017] EWHC 2428 (Ch).
11. The appeal hearing was held by video conference on 7 April 2021. Mr Krause continued to represent the Holder whereas the Opponent was represented by Mr Edward Cronan of Counsel instructed by Swindell & Pearson Ltd.

Hearing Officer's decision

Absolute grounds

12. The thrust of the Hearing Officer's decision was under Section 3(1)(c) of the Act although she noted that a mark which was unobjectionable under Section 3(1)(c) might still be precluded from registration under Section 3(1)(b) (para. 21).
13. Section 3(1)(c) excluded from registration trade marks which consist exclusively of signs or indications which may serve, in trade, to designate characteristics of goods or services. The time for determining the ground was the date of filing, 14 January 2019, and there was no claim to acquired distinctiveness (paras.19 – 20).
14. The Hearing Officer instructed herself according to the principles set out in the judgment of Arnold J. in *Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) at paragraphs 91 - 92 in turn largely derived from the decision of the CJEU in Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v. OHIM* [2011] ECR I-1541, paragraphs 33, 36 – 39, 46 – 50 (para. 22)
15. The ground was to be assessed from the perspective of the reasonably observant and circumspect average consumer who was a member of the general public or a professional. The former would pay a medium degree of attention to the purchase act,

the latter a reasonably high level of attention. The purchasing process was likely to be visual although aural discussions with sales persons needed to be borne in mind (paras. 23 – 25).

16. The Hearing Officer's deliberations were then as follows:

“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.”

17. Regarding Section 3(1)(b) denying registration to trade marks that are devoid of any distinctive character, the Hearing Officer was guided by the applicable principles summarised by the CJEU in Case C-265/09), *OHIM v. BORCO-Marken-Import Matthiesen GmbH & Co. KG* [2010] ECR I-8265, paragraphs 29 – 33 (para. 29).

18. Here her findings were:

“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.”

Relative ground

19. Section 5(2)(b) precluded the registration of a trade mark that because 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. In applying this ground, the Hearing Officer would be guided by the Registrar’s usual summary of applicable principles from the case law of the CJEU (paras. 31 – 32).

20. Identity in some of the respective goods and services in Classes 9 and 42 was involved (para. 33).

21. The average consumer was already identified as a member of the general public or a professional. A member of the general public would pay a medium degree of attention, and a professional a reasonably high level of attention in selecting the goods/services. The purchasing process would largely be visual although aural considerations were relevant (para. 35).

22. The earlier trade mark was inherently distinctive to a high degree (para. 37).

23. There was a medium degree of visual and aural similarity in SOMFY figurative and COMFY. On the other hand the marks were conceptually different:

“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.”

24. Globally assessed there was no likelihood of confusion:

“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.”

Grounds of appeal

Absolute grounds

25. It is fair to say that argument on appeal focussed on Section 3(1)(c) of the Act.
26. The Opponent contended that the word “comfy” was an ordinary descriptor and must be refused registration. This was because COMFY was descriptive of the effect that the contested goods and services could have on people (making them comfortable), which was a characteristic or intended purpose of the contested goods and services: *Computer hardware and mobile software for control and automation of building systems and climate control systems*” (CI 9); *“Providing temporary use of on-line non-downloadable software for control and automation of building systems and climate control systems”* (CI 42).
27. Attractively though these points were argued by the Opponent, it was important not to lose sight of the established law underlying the application of Section 3(1)(c).
28. The General Court of the CJEU has summarised the applicable principles on number of occasions (in relation to the equivalent Article 7(1)(c) of the EUTMR) including more recently in Case T-738/19, *Clouds Sky GmbH v. EUIPO* EU:T:2020:441 as follows:
 - “29. Article 7(1)(c) ... provides that ‘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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered.
 30. Article 7(1)(c) ... pursues an aim which is in the public interest, which requires that signs or indications which may serve, in trade, to designate characteristics of the goods or services for which registration is sought, may be freely used by all. That provision accordingly prevents such signs and

indications from being reserved to one undertaking alone because they have been registered as trade marks ...

31. It follows that, for a sign to be caught by the prohibition set out in Article 7(1)(c) ... there must be a sufficiently direct and specific link between the sign and the goods or services at issue to enable the public concerned immediately to perceive, without further thought, a description of the goods or services or one of their characteristics ...

32. Accordingly, descriptive character must be assessed, first, by reference to the goods and services in respect of which registration was sought and, second, by reference to the perception of the relevant public ...”.

29. Further, as the EUIPO guidelines state (again in relation to the equivalent Article 7(1)(c) of the EUTMR):

“... it is important to distinguish laudatory terms that describe — although in general terms — desirable characteristics of goods and services as being cheap, convenient, of high quality, etc. and that are excluded from registration, from those terms that are laudatory in a broader sense, that is to say, they refer to vague positive connotations or to the person of the purchaser or producer of the goods without specifically referring to the goods and services themselves.” (Part B Examination, Chapter 4, 2.1).

30. The Opponent put to the Hearing Officer that the trade mark COMFY was descriptive of the contested goods and services. The Hearing Officer stated that she was unable to: “... *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)*”.

31. The Opponent contended that this was wrong and contrary to the *NOW TV* cases especially the decision of the Court of Appeal in *Starbucks HK Limited v. BSB Group plc* [2013] EWCA Civ 1465.

32. At first instance, Arnold J held that the NOW (figurative) trade mark in suit was invalid as having been registered in respect of primarily TV and telecommunication services in Class 38 contrary to Article 7(1)(c) of the EUTMR (the equivalent of Section 3(1)):

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration in relation to the services in issue because NOW would be understood by the average consumer as a description of the characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of Article 7(1)(b).” (emphasis mine)

33. The Court of Appeal upheld Arnold J's findings on Article 7(1)(c). Mr Cronan referred me particularly to reasons 3 – 6 in the judgment of Mummery LJ that Mr Cronan submitted were relevant to the present case:

“94. As already explained, the trade mark claim is for exclusive use of the word NOW for various goods and services, including an internet TV subscription service registered in class 38. On that claim I will state briefly in my own words the reasons why I would dismiss the trade mark appeal.

95. First, the registered word mark NOW is devoid of distinctive character that would serve to identify the claimants' service and to distinguish it from the service offered by other undertakings. It is not inherently distinctive of the claimants' TV service nor is it alleged to have become distinctive here by use made of the mark.

96. Secondly, the fact that there are other instances in which the word "now" is distinctive of a service (or a product) does not assist the court in deciding its character in this case. Context is not everything, but it certainly counts in determining whether a word is being used in a distinctive way or in a descriptive way. The judge gave examples of how "now" was a popular choice of mark and how it could be used distinctively, while also pointing out that it was widely used descriptively, either alone or in conjunction with other signs: see [111] and [112].

96. Thirdly, for reasons inseparable from perceived commercial self-interest and advantage, the claimants chose as their trade mark a commonplace, easily understood, ordinary English word, which was also used by other undertakings in relation to other products or services. There was evidence that "now" is reckoned to be the 73rd most common word in the English language. There are many other words that they could have chosen or invented to designate the service.

97. Fourthly, it must have been obvious to the claimants that, in making that choice, they were running the risk of invalidity on the ground that the message that was conveyed or could be conveyed by the everyday word to the average consumer designated a characteristic of that service.

98. Fifthly, the characteristic of the service that was likely to strike and attract the average consumer was the offer of something new and different. The essential appeal of the claimants' service is that programmes of choice are available on demand in an instant, immediately, without waiting around for the arrival of the scheduled time set by someone else for the broadcast of a programme. That "nowness" is not a characteristic possessed by an ordinary TV service broadcasting scheduled programmes at pre-set times. The trade mark would attract the custom of all those viewers who "want it now." The attraction is of having immediate and instant access to programmes of choice on demand rather than having to settle for waiting. (The media communications world is not one in which one would expect "The Stature of Waiting" to have any place.)

99. Sixthly, I see nothing wayward in the assessment made by Arnold J that, when viewed from the position of the hypothetical average consumer of the claimants' service, the mark NOW would be understood as designating that attractive instant and immediate characteristic of the service for which it was registered. The mark NOW refers to more than just the service itself. It refers to something about the service, an appealing characteristic that will pull in the punters. What is that something if it is not the characteristic of delivering programmes of choice instantly on demand?"

34. Mr Cronan sought to apply Mummery LJ's reasons 3 – 6 to the present facts. However, in *NOW TV*, NOW was an instant and immediate characteristic of the service for which it was registered, that is, signifying the provision of TV programmes of choice instantly on demand. In other words, there was a specific and direct reference to the service which was capable of immediately being recognised by the consumer.
 35. On the other hand, COMFY cannot be said to be an instant and immediate characteristic of the computer hardware and mobile software and temporary online software services in hand. At most, as the Hearing Officer found, it alluded to a possible end-result on the overall environment employing a building system/climate control system. I consider this to be too tenuous to amount to a specific and direct reference as required by Section 3(1)(c) to the contested goods and services as previously stated. The *NOW TV* and present cases are not, in my view, comparable.
 36. For these reasons, I was unpersuaded that the Hearing Officer erred in dismissing the Opponent's objection to the Holder's request for protection of IR 1452228 under Section 3(1)(c) of the Act¹.
 37. Turning to Section 3(1)(b), the Opponent criticised the Hearing Officer for stating: "... as pleaded there is no separate basis for the for the objection under s. 3(1)(b)".
 38. The basis for that criticism appeared to be that COMFY was an ordinary English word that therefore inherently lacked the ability to function as a trade mark. However, equally the Opponent's skeleton argument appeared to accept that COMFY was allegedly non-distinctive for the same reasons that it was allegedly descriptive in relation to the Holder's goods and services.
 39. I set out in full the Hearing Officer's findings in relation to the Opponent's objections to the mark in suit under Section 3(1)(b) (including those raised by Mr Taylor for the Opponent for the first time before her), and I see no reason(s) to interfere with them.
- Relative ground**
40. The Opponent contended that the Hearing Officer was wrong in finding there was no likelihood of confusion for the reasons set out below.
 41. First, it was argued that the Hearing Officer failed to take into account the high degree of distinctive character she had found in the earlier trade mark. As I have mentioned,

¹ For the sake of completeness, Ground 1C of the Grounds of Appeal, that is, ensuring free use by other traders of ordinary terms consequently fell away.

the Hearing Officer at paragraph 32 instructed herself by reference to the Registrar's usual summary of applicable principles under Section 5(2)(b). Principle (h) that the Hearing Officer stated, read: "*(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character ...*". She then went on to conclude under the heading "**Distinctive character of the earlier trade mark**" that SOMFY figurative was inherently distinctive to a high degree (paras. 36 – 37). Under the heading "**Likelihood of confusion**" the Hearing Officer reminded herself that the factors she had already considered were interdependent in her global assessment in the light of those factors of the likelihood of confusion in the present case (para. 47). Although she made no express reference here to the distinctive character of the earlier trade mark, I have no reason to believe that she omitted its consideration in her avowed global assessment of likelihood of confusion.

42. Second, the Opponent argued that the Hearing Officer erred in concluding there was a medium degree of visual similarity in the marks when she should have found there was a very high degree of similarity because of the string of letters "omfy" present in both marks. It is clear that the Hearing Officer was cognisant of this point and I am not prepared to interfere in her appraisal.
43. Third, the Opponent said that the Hearing Officer wrongly applied Case C-361/04 P, *Claude Ruiz-Picasso v. EUIPO* [2006] ECR I-0643.
44. The Hearing Officer noted from the judgment of the CJEU 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" (para. 20). That said, the Hearing Officer also noted citing Case T-460/07, *Nokia Oyj v. OHIM* [2010] ECR II-0089 that conceptual differences in marks may not always preclude any likelihood of confusion between them.
45. On the conceptual aspects, the Hearing Officer followed the two-stage approach advocated by the CJEU in Case C-437/16P, *Wolf Oil Corp. v. EUIPO* EU:C:2017:737 at paragraphs 43 – 45 (and see the discussion by Mr Geoffrey Hobbs QC sitting as the Appointed Person in *PINKIES Trade Mark*, BL O/566/19, paras. 26 – 29).
46. First, she made a finding of the conceptual differences in the marks (para. 46). Indeed, the Opponent's representative at the time, Mr Taylor, had accepted before her that the marks were conceptually different because COMFY had a meaning whereas SOMFY figurative did not.
47. Second, the Hearing Officer assessed the degree of conceptual differences with a view to determining whether they might lead to the neutralisation of the visual and aural similarities in the marks (which she had found to a medium degree), and in her assessment, they did.
48. Mr Cronan said that the Hearing Officer was wrong to apply *Picasso* because COMFY did not have a "*rich*" meaning (*Picasso*, para. 27) in the sense that "*Picasso*" did as signifying a famous painter. At the hearing before me, Mr Cronan also sought to argue that SOMFY figurative would suggest "comfy" to the relevant consumer so that there was a conceptual overlap in the marks.

49. In my judgment, in this and the above arguments, the Opponent is merely asking me to reappraise the Section 5(2)(b) ground anew, which undertaking is beyond my role as the appellate tribunal to do.

Conclusion

50. In the result the appeal has failed. The Hearing Officer ordered the Opponent to pay the Holder costs of the opposition in the sum of £1,300.00. I will order the Opponent to pay to the Holder costs of the appeal in the sum of £500.00. The total sum of £1,800 is to be paid by the Opponent to the Holder within 28 days of the date of this decision.

Professor Ruth Annand, 14 May 2021

Mr Edward Cronan of Counsel instructed by Swindell & Pearson Ltd appeared for the Opponent/Appellant

Mr Martin Krause of Haseltine Lake Kempner LLP appeared for the Holder/Respondent