

O-437-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3116417 BY
ACCROL PAPERS LIMITED**

TO REGISTER:

COMFYSOFT

&

Comfysoft

AS A SERIES OF TWO TRADE MARKS IN CLASS 16

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 405751 BY SUN MARK LIMITED**

BACKGROUND

1. On 2 July 2015, Accrol Papers Limited (“the applicant”) applied to register **COMFYSOFT** and **Comfysoft** as a series of two trade marks for: “Toilet rolls, kitchen towels, facial tissue” in class 16. The application was published for opposition purposes on 25 September 2015.

2. The application is opposed by Sun Mark Limited (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in the following United Kingdom Trade Mark registrations:

No. 3101147 for the trade mark:



which was applied for on 26 March 2015 and entered in the register on 26 June 2015:

Class 3 - Baby wipes.

Class 5 - Babies' disposable napkins made of paper; Babies' nappies [paper or cellulose]; Diapers for incontinents; Napkins for incontinents; Sanitizing wipes.

Class 16 - Kitchen rolls [paper]; Paper hand-towels; Toilet paper in roll form; Toilet rolls; Toilet tissues.

No: 2399279 for the trade mark: **COMFI** which was applied for on 15 August 2005 and entered in the register on 17 February 2006:

Class 16 - Toilet rolls, toilet paper, and goods made from these materials not included in other classes.

3. The applicant filed a counterstatement, in which it states:

“COMFYSOFT is already a well-established name in its own right and has been established for 2 years. The name has a different spelling, the packaging is different and the product specification is different and will not cause a detriment to the opponents business.”

4. Neither party is professionally represented. Only the opponent filed evidence; no hearing was sought nor were written submissions filed in lieu of attendance at a hearing.

Evidence

5. This consists of a witness statement (accompanied by three enclosures) from Harmeet Ahuja, one of the opponent’s directors. I will return to Mr Ahuja’s evidence when I consider the distinctiveness of the earlier trade marks.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which 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.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As no. 3101147 had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act; as a consequence, the opponent is entitled to rely upon it in respect of all of the goods it has identified. No. 2399279 is, however, subject to the proof of use requirements and in its Notice of opposition, the opponent indicated that this trade mark had been used for all the goods upon which it relies. However, as the applicant indicated in its counterstatement that it did not require the opponent to provide proof of use, the opponent is entitled to rely upon it in relation to all the goods it has identified i.e. “Toilet rolls, toilet paper, and goods made from these materials not included in other classes.”

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-

342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(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.

My approach to the comparison/the opponent's best case

The applicant's trade marks

10. The applicant has applied to register a series of two trade marks i.e. COMFYSOFT and Comfysoft. Although these trade marks are presented as one word in upper and title case respectively, as the words "COMFY"/"Comfy" and "SOFT"/"soft" and their individual and collective meanings will be very well-known to the average consumer, I have no doubt that is how the average consumer will construe the applicant's trade

marks. Consequently, when I come to compare the competing trade marks, I shall, for the sake of convenience, refer only to the applicant's COMFYSOFT trade mark

The opponent's trade marks

11. Although the opponent has based its opposition on two trade marks, it is no. 3101147 which, in my view, offers the opponent the best prospect of success and it is on the basis of this trade mark that I shall conduct the comparison.

Comparison of goods

12. Although the opponent relies upon all of the goods in the registration I have identified, it is only necessary for me to refer to its goods in class 16. Approached on that basis, the comparison is as follows:

The opponent's goods	The applicant's goods
Kitchen rolls [paper]; Paper hand-towels; Toilet paper in roll form; Toilet rolls; Toilet tissues.	Toilet rolls, kitchen towels, facial tissue.

In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. “Toilet rolls” appears in both parties’ specifications and are literally identical. As “Kitchen rolls [paper]” in the opponent’s specification and “kitchen towels” in the application are alternative ways of describing the same commercial product, they too are identical. That leaves “facial tissue” in the application to consider. Facial tissues are most often sold in boxes and are designed to be used, for example, for blowing one’s nose. Although the intended purpose of, inter alia, the opponent’s “toilet tissues” and “kitchen rolls” clearly differs from that of “facial tissue”, the obvious similarities in the physical nature of such goods and the likely proximity of their sale in, for example, a supermarket, leads me to conclude that they are similar to a high degree.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *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), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. The average consumer is a member of the general public who is likely to purchase the goods at issue on a fairly regular basis. As such goods will, typically, be self-selected from the shelves of a retail outlet such as a supermarket or from the pages of a website, visual considerations will dominate the selection process. Although I do not discount aural considerations, they will, in my view, be a much less significant feature of the process. Given the low cost of the goods and the likely frequency of purchase, I would expect the average consumer to pay a lower than normal degree of attention during the selection process.

Comparison of trade marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

17. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
 <p>Comfi <i>Soft & Strong</i></p>	<p>COMFYSOFT</p>

18. I have commented on the applicant's trade mark earlier in this decision. It is presented in block capital letters and consists of, and will be understood by the average consumer as, the two very well-known English language words i.e. "COMFY" and "SOFT" conjoined which, for the avoidance of doubt, collinsdictionary.com defines as, inter alia, "informal short for comfortable" and "not hard", respectively. The overall impression the trade mark conveys and its distinctiveness lies in the totality, rather than in the individual words of which it is made up.

19. The opponent's trade mark consists of two components. The first, is the word "Comfi" presented in title case in an unremarkable heavy bold font. Below this word in much smaller letters appears the second component i.e. the phrase "Soft & Strong" also presented in title case in an unremarkable heavy bold font. Considered in relation to the goods at issue, this phrase is clearly descriptive and non-distinctive and will have little or no weight in the overall impression the trade mark conveys. In view of that finding and bearing in mind its size and positioning, the distinctiveness of the opponent's trade mark lies in the word "Comfi" and it is this component that will dominate the overall impression the opponent's trade mark conveys.

20. Having reached those conclusions, I must now go on and compare the competing trade marks from the visual, aural and conceptual perspectives. The trade marks coincide in that they share the same first four letters i.e. “C-o-m-f-“/“C-O-M-F-“; the letters in the sixth to ninth letter positions are also the same and form the word “Soft”/“SOFT”. They differ in their fifth letters i.e. “i” in the opponent’s trade mark and “Y” in the applicant’s trade mark and the opponent’s trade mark also contains the punctuation symbol “&” and the word “Strong”. In my view, the competing trade marks are visually similar to a high degree.

21. Turning to the aural comparison, the pronunciation of the word “COMFY” and “SOFT” are entirely predictable. Given their descriptive and non-distinctive nature, I think it unlikely that when referring to the opponent’s trade mark the average consumer would articulate the words “Soft and Strong”. As to the word “Comfi”, this would be articulated in exactly the same way as the word “COMFY” in the applicant’s trade mark. If I am correct, the most likely aural comparison is between “Comfi” and “COMFY-SOFT” which, in turn, leads to at least a medium degree of aural similarity. However, if I am wrong and the average consumer does articulate the phrase in the opponent’s trade mark, the fact that the words “Comfi Soft” would be articulated first in the opponent’s trade mark or exclusively in the case of the applicant’s trade mark, would, notwithstanding that the word “Strong” would also be articulated, lead to a high degree of aural similarity between them.

22. Conceptually, the word “Comfi” in the opponent’s trade mark is a misspelling of the word “Comfy” and alludes to a characteristic of the goods; a concept which is reinforced by the descriptive and non-distinctive phrase which accompanies it. As the applicant’s trade mark conveys exactly the same concept of comfort/absence of hardness, the competing trade marks are conceptually identical in part and conceptually highly similar overall.

Distinctive character of the earlier trade mark

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

24. In his witness statement, Mr Ahuja states:

“7. Under the brand name Comfi, opponent produces and sells toilet rolls and kitchen towels. Opponent also recently launched baby wipes and baby nappies under this brand.”

25. He explains that the trade mark has been used since 2003 and that in the period 2011 to 2015, sales of such goods in the United Kingdom under the “brand Comfi” amounted to some £78k; he states that the “opponent also produces Comfi in the UK for export” to “African and Middle East countries.” Enclosures 2 and 3 to his statement consist of invoices in which references to, for example, “COMFI STRONG KITCHEN TOWEL” and “COMFI LUXURY TOILET ROLL WHITE” appear. Although no examples of use of the trade mark on the goods at issue have been provided, I accept that prior to the date of the application the opponent has conducted a trade in relation to the goods mentioned under its “brand Comfi”. However, no turnover figures are provided for the period 2003 to 2010 and the scale of use provided for the period 2011 to 2015 is, given what is likely to be the not inconsiderable size of the market in the United Kingdom for such goods, at best, modest. On the basis of the evidence provided, I am, therefore, unable to conclude that the opponent’s trade mark has acquired an enhanced distinctive

character by virtue of the use made of it. Having reached that conclusion, I have only the trade mark's inherent distinctiveness to consider.

26. I have already concluded that the word "Comfi" in the opponent's trade mark is a misspelling of the word "Comfy" (which alludes to a characteristic of the goods) and that the additional component i.e. the phrase "Soft & Strong" is descriptive and non-distinctive. Considered overall, the opponent's trade mark is possessed of a low degree of inherent distinctive character.

Likelihood of confusion

27. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are either identical or similar to a high degree;
- the average consumer is a member of the general public who will select the goods at issue by predominantly visual means and who will pay a lower than normal degree of attention when doing so;
- the competing trade marks are visually and conceptually similar to a high degree and aurally similar to at least a medium degree;

- the opponent's trade mark is possessed of a low degree of inherent distinctive character which, on the basis of the evidence provided, has not been enhanced through use.

28. Although I have found that the earlier trade mark has only a low degree of distinctive character, for the reasons explained by the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, that does not preclude a likelihood of confusion. The Court found that:

“45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

29. In reaching a conclusion, I begin by reminding myself that identical/highly similar low cost/frequently selected goods are involved and that such goods are bought with a lower than normal degree of attention (thus making the average consumer more prone to the effects of imperfect recollection). Those factors combined with the degree of similarity between the competing trade marks I have identified earlier will, notwithstanding the low degree of distinctive character the earlier trade mark possesses, lead to a likelihood of direct confusion i.e. the competing trade marks are likely to be mistaken for one another; the opposition succeeds accordingly. In reaching

that conclusion, I have not overlooked the comments in the applicant's counterstatement i.e.

"COMFYSOFT is already a well-established name in its own right and has been established for 2 years. The name has a different spelling, the packaging is different and the product specification is different and will not cause a detriment to the opponent business."

30. I have already commented on the "different spelling" earlier in this decision. In relation to the applicant's comments regarding "packaging" and "product specification", the comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, are relevant. The Court stated that:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

31. Finally, as the applicant has not filed any evidence in these proceedings, its comment regarding its use of its trade mark cannot assist it.

Conclusion

32. The opposition succeeds and, subject to any successful appeal, the application will be refused.

Costs

33. As the opponent has been successful it is, in principle, entitled to a contribution towards its costs. As both parties are unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate if they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed “no costs will be awarded”; neither party responded to that invitation. While the opponent has not sought costs in relation to the prosecution of its opposition, it is, of course, entitled to recover the official fee for filing the opposition i.e. £100.

34. I order Accrol Papers Limited to pay to Sun Mark Limited the sum of **£100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of September 2016

C J BOWEN

For the Registrar

The Comptroller-General